

# ABCOR's ABChronical

## Trademarks

### The strength of a logo.

Often a logo acts as a powerful and distinctive sign. In clothing the consumer will readily recognize which logo belongs to which manufacturer. In order to act against an



infringement the protection of a logo is crucial.

The logo of LONSDALE is typified by a large L that underlines the entire trademark. The letters of the trademark also have a cinematographic lay out. This makes it a

strong logo. When LONSDALE found out clothes from LONDONER were using a similar logo, they were able to stop the import of these clothes from China, based on infringement of their logo. The LONDONER logo also used the same L and the letters had a cinematographic lay out.

### Trademark Value – Goodwill

In the Netherlands the strongest trademarks are Google en Cliniclowns. Google is not only the



strongest mark in the Netherlands, but worldwide as well. The trademark is estimated to be worth more than \$ 100 billion. The value of Google has increased more than 16% last year alone.

### RTL VANDAAG defeats EEN VANDAAG

In choosing a new name it is advisable to chose a fantasy name. Marketing specialists, however, will often advise to chose a descriptive name. The disadvantage of a descriptive name is that its scope of protection is



limited. Case in point:

VANDAAG means today in Dutch. And this word was at the center of a conflict between two television shows. The producers of EEN VANDAAG claimed that the new show RTL VANDAAG resembled their name too much. The court eventually ruled that this was not the case. The name RTL VANDAAG simply combined the network name (RTL) with the Dutch word for today. Because the word today is highly descriptive the producers of EEN VANDAAG had only a very small scope of protection on this word. By adding the word RTL it was clear that another network was involved.

It was also not proven that RTL gained any advantage through the success of EEN VANDAAG. Had the Trademark been distinctive, this case would have ended quite different.

### Benelux Authorities too strict?

KPN, a Dutch telecom company, has tried to register the sign 1333 as a trademark, without success. The Benelux authorities claimed that the consumer would not see the combination of numbers as a trademark.

A combination of numbers is not suitable to act as a trademark. Should the consumer recognize it as a trademark after all, they reasoned, it is still to descriptive. After all, it concerns a telephone information number. The fact



that the European Trademark authorities did recognize the combination 1333 (appl. No. 007401961) as a trademark had no effect. Unfortunately it is not uncommon for the Benelux authorities to go their own way. Procter & Gamble for example were able to have the shape of the packaging

of toilet wipes registered as a European (shape)trademark. Again when applying for the same in the Benelux, it was rejected, on the grounds that it did not differ to a significant degree from the rest of the market. It seems like it is easier sometimes to obtain a European trademark registration than a Benelux registration.



### Millionth international registration

Through an international registration companies are able to obtain protection in foreign countries, for a relatively low price. This form of registration has been around since 1893.



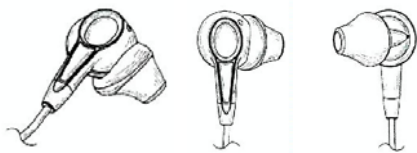
IR No. 1.000.000

Austrian company Grüne Erde Beteiligings GmbH has recently filed the millionth trademark.

## Designs

### Bose claims European ban

In order to protect the shape of her new ear phones BOSE registered the ear phones as a European Design. The product turned out to become a great success. The drawback of success is that third parties always want to gain from it as well. In some cases it inspires malignant companies to produce counterfeit products. Bose stumbled upon a web store where the ear pieces were being offered for less than 50% of the price. Naturally Bose suspected that an infringement was at hand.



CD No. 000615828-002 – head phones

The court declared that there was indeed an infringement on the design rights of Bose, the ear pieces on the website were similar to those registered by Bose as a design. All further trade in the ear pieces on the website was therefore prohibited. Since the procedure was based on a European registration this ban is effective in the entire European Union.

## Copyright

### Playmo-Bible forbidden

Some months ago a German priest launched a website aimed at informing young believers about the Bible. Using reshaped Playmobil figures the priest depicted scenes from both the Old and New Testament.



The Pope was a fan of the idea, but Playmobil did not share these sentiments. In reshaping the figurines and placing them on a website the priest infringed Playmobil's copyrights. Eventually the priest gave in to Playmobil and removed the website.

## Advertising

Due to the harsh winter climate the bottle of Grasovka Vodka is temporarily wrapped in bison fur. The Foundation for Alcohol Prevention objected this novelty. By wrapping the bottle in bison fur, they reasoned, the consumer would overlook the fact that it concerns vodka with over 40% alcohol. They further stated that because of its furriness the bottle was extra attractive to young children, and specifically aimed at them. So the Foundation filed a complaint with the Dutch Advertising Commission (RCC). The RCC did not agree with the Foundation. It is true that commercials featuring alcohol may not be directed at children. Using toys for commercial purposes for alcoholic beverages is strictly prohibited. However, in this case the RCC reasoned that the Grasovka's bottle cannot be seen as a pet toy.



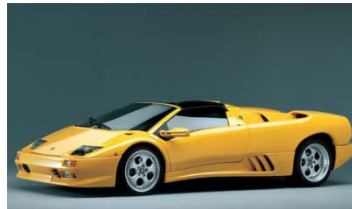
The fact that its shape might appeal to minors is of no influence. Although wrapped in fur the bottle does clearly show its label, so everyone can see it is a vodka bottle. The complaint of the Foundation was therefore rejected.

## Domain names

### Lamborghini claims lamborghini.tv

World renowned car manufacturer Automobili Lamborghini has claimed the domain name lamborghini.tv, through use of her Trademark LAMBORGHINI. The previous holder of lamborghini.tv linked the website to another site. It

was ruled that the holder had no legitimate interest in the use of



the name LAMBORGHINI. Consequently the trademark rights of Automobili Lamborghini were infringed by this use, and the domain name was ordered to be transferred.

### No pass for I-PAS

New IT has used the sign I-Pass regarding online pension services for some years. Since 2006 she is also the holder of the domain name I-PAS.NL. Although I-PAS was used as a trademark, it was not registered as such immediately. A painful mistake with dire consequences. Libra, the competition, has used the word IPAS for her online services since 2004, prior to New IT's trademark application.



Because New IT could not invoke older Trademark rights, she based her claim on her domain name and trade name rights, as well as

on the basis of an unlawful act. This failed. It is not possible to counter the use of a sign as a trademark if you do not have an older trademark registration yourself. Therefore her claim based on an unlawful act failed. The claims based on New IT's trade name rights also failed. Although the name was registered, it was not used as an actual trade name. (That is used to represent the company.) Factual use is the determiner in acknowledging trade name rights. New IT lost the case and had to pay the costs of the procedure (€ 7.000,-) Had they filed their trademark earlier things would have ended completely different.

### Abcor BV

Abcor is an IP law firm, located in the Netherlands. Our specialty is consultation with regards to intellectual property matters, trademarks, 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](mailto: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