

# ABCOR's ABChronicle



## Trademarks

### Polo/Lauren stops Polo Sport

The Polo/Lauren Company has successfully prevented the registration of the POLO SPORT's logo. The defendant claims that the trademark has been used since 2004 and that no problems ever occurred. The logo would supposedly refer to a sporting gentleman's lifestyle. The differences between the trademarks would enable both to co-exist.



BX 759109



BX 695570

The opposition department of the Benelux Office clearly disagreed. Since both signs consist of a horse and a polo player with a raised club, the signs were deemed similar. The application was refused for all similar products for which Polo/Lauren had registered their mark.

### CANNABIS beer invalid

Since 1996 Italian Giampietro Torresan has produced CANNABIS beer. In 2003 the trademark obtained European protection.



German beer manufacturer THE CANNABIS CLUB SUD started a cancellation procedure as a response. The reason being that CANNABIS would be descriptive for beer.

The Italian manufacturer contested this stance and claimed that it is merely a suggestive name that refers to the pleasure and relaxation the beer causes. Since there are no drugs in it, the beer cannot be descriptive. The court, however, decides that the word CANNABIS not only refers to the

drug but also to a certain type of hemp that is being used to produce consumer products and drinks, including beer. Because it concerns an ingredient that is commonly used in the production of beer the trademark is deemed to be descriptive.

### Napoleon as toilet paper

In Greece the figurative trademark NAPOLEON had been registered for tissues, kitchen- and toilet paper. The logo consists of Napoleon, with a toilet roll in his hand. The trademark had initially been refused, because it would contain a French state symbol. The highest Greek authority decided differently.



Ναπολέων

A historical figure cannot be a protected state symbol according to art. 6ter of the Paris Treaty. The trademark was subsequently granted.

### Shape mark is maintained

Since 1998 Revillon has sold chocolate shaped in the form of a wine branch. In 2003 they managed to register the branch as a shape mark. In 2004 Trianon started to sell chocolate in the shape of a wine branch. In 2006 Trianon started a cancellation procedure against Revillon's shape mark, claiming it does not have any distinctive character. The shape of the chocolate would not be unusual and contribute to its value.



BX trademark 0744485

The Court of first instance shared this opinion in 2008, however, in 2010 the Appeal Court judged differently. The shape of the trademark differs significantly from other chocolates. Furthermore, the shape of the chocolate does not determine its relative value. The relative value of chocolate is determined by its taste and substance, not by its attractive shape. Conclusion: Revillon's shape mark is valid. Since Trianon's chocolate is identical there is an infringement. Trianon was forbidden to use her chocolate and ordered to pay the Legal expenses of Revillon, totaling over € 95.000,-

### Unwanted associations

Someone else's trademark does not pose a problem unless it is similar and being used for similar products. The fact that companies have the same name does not automatically have to be a problem.



It is, however, recommended to check for similarities in an availability search. This may prevent unwanted associations. For example, in England PEDIGREE is being used for both beer and dog food.

## Advertising

### Stock photography and portrait rights

André Rieu is one of the most successful classical musicians in the Netherlands. For that reason he has registered both his name and his portrait as a trademark. Of course, there are always those who wish to prey on success. In the fall of 2009 a collector's magazine appeared

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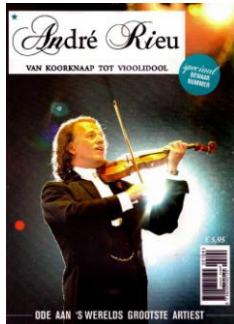
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named "André Rieu, from choir boy to violin idol". The magazine, containing 132 pages, was filled with pictures of the musician, both during performances and outside of them. André Rieu was not paid for the use of his pictures and started a procedure.



Collector's magazine



CTM registration 4713483

The publisher indicated that he has paid for the stock pictures. Often companies are under the impression that this mean they have also obtained the rights of the models in the pictures. This, however, is not the case. Because of his popularity André Rieu is able to object the publication based on his portrait rights. An injunction followed accompanied by a recall of the magazines from all retailers, making the sold issues a true collector's item.

### Copyright Law

#### The grey hairs of Sarah & Abraham

Happy Point rents and sells inflatable dolls. When an almost identical doll is spotted Happy Point starts a procedure.



Left original



Right Original

The opposing party claims that the dolls are not protected by copyrights because their look is composed of general physical traits, such as grey hairs. The judge does not agree. Not every Sarah (Dutch name for a typical female doll) has a bottle of wine in her hand and not every Abraham (Dutch name for a typical male doll) has a black suit. Since the dolls were nearly identical an injunction followed accompanied by a full restitution of the legal expenses.

### Parody

#### Coke for Miffy

Because of its child friendly character Dick Bruna's Miffy is often a humorous target. Bruna has more often than not successfully opposed unacceptable parodies on Miffy. For example in 2002 a campaign against rude behavior was revoked for using the same style as Miffy.



Revoked Campaign



Accepted parody

Since that time, however, the so-called parody-exception has been added to the Copyright Act. Punt.nl, a Dutch website successfully invoked this exception in a recent case before the Court of Amsterdam.

On punt.nl Miffy can be seen sniffing coke, acting as a DJ at a house party and taking party drugs. This all clashes with the character's child friendly nature. Bruna claims that his work is being maimed by Punt.nl. The court decided that five out of seven images were acceptable under the parody exception. They were deemed to be clearly humorous.

For two images, however, it was decided that they were too similar to the original Miffy. These images were an infringement.

### Domain Names

#### Domain Hijacking: 5 Million (T)rouble

Burger King, on the verge of opening her first franchise in Russia, discovered that the domain name BURGERKING.RU had already been registered in 2000 by Elvis Telecom. More often than not domain hijackers are able to sell their domain name for large sums of money. Not this time, however. The Russian law grants the exclusive right to use a domain name to trademark owners.



Burger King has registered her domain name in 1994 and successfully invokes this registration. Damages are also to be paid to Burger King, amounting to 5 million Rouble (approx. € 115.000,-).

### Abcor's IP Quiz

Every month a new case will be examined in Abcor's IP Quiz. The quiz can be found online at [www.abcor.nl/ipquiz](http://www.abcor.nl/ipquiz)



Answers may be sent by internet, regular mail or fax until the 15<sup>th</sup> of the month following the quiz. Abcor's special gift will be awarded to one of the participants with the correct answer.

### Abcor BV

Abcor is an IP Law firm, Located in 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.nl](mailto:info@abcor.nl)

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