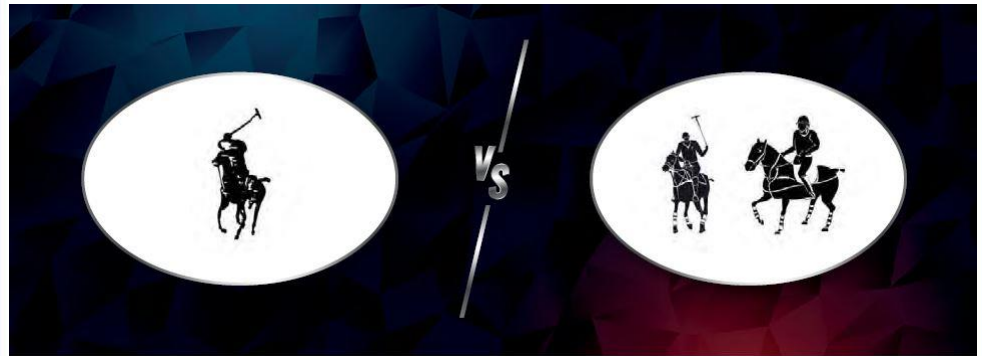


## Look-a-likes logo registration



### In dit nummer

Goodbye Yellow:  
when are trademarks descriptive

Art 6 of the Paris Convention:  
State symbols and the use of Flags

CAT vs FLOWERCAT:  
The description of goods and services

Starbucks vs Star Coffee:  
Russian copycats

New Balance vs New Burlon:  
China and damages

ITA vs De Warme Winkel:  
Theatre Group Amsterdam

Fennia vs Philips:  
product liability and licensing

EUOIP and Levin Nyman:  
misleading and fraudulent invoices

Numerous companies are still trying to capitalize on the reputation of well-known brands. They often use visual elements or logos which immediately remind us of well-known trademarks, regardless of the words accompanied by these visual elements. To deal with this type of practices, it is wise to register the logo separately as a self-contained trademark.

When Ralph Lauren is confronted with two new logo applications depicting a polo player in the European Union, the company objects on the grounds of its well-known trademark. The advantage of claiming the familiarity is that a company can not only object to identical products (clothing), but also to non-similar products like toys, for example.

Ralph Lauren substantiates this claim

with documentary evidence of the brand's reputation and use of its trademarks, sales figures, press articles, screen shots from websites, social media, history of the company, advertising material, and more. All this evidence leads to a sufficient reason for the European trademark authorities to assume the familiarity of the well-known trademark Ralph Lauren.

The logos applied for in the EU are both visually as conceptually similar to such an extent, that consumers immediately establish a link between the novel applications and Ralph Lauren. This is a clear example of lousy copying, profiting of the reputation of another's trademark. The applications were therefore denied.

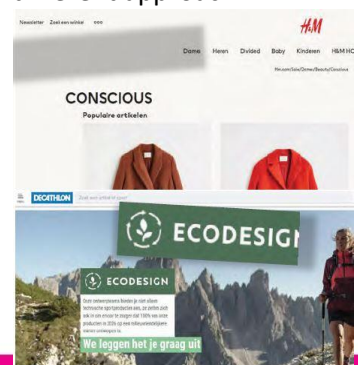
### Advertising law

## Sustainability claims in advertising

More and more people are concerned about what the world will look like in the future. Sustainability is becoming increasingly important for consumers and influences their purchasing behaviour, choosing particular brands that claim to be sustainable. Consumers must be able to rely on these claims. Companies that make efforts to promote sustainability, must be protected against companies that unfairly use misleading sustainability claims. This gave the ACM (Authority Consumer & Market) reason to investigate misleading claims in the clothing industry.

Decathlon and H&M promote clothing items using terms such as 'ecodesign' and 'conscious', without clearly indicating the sustainable benefit. When the ACM addresses the companies on this matter, they immediately promise improvement. The information on the websites was altered and a donation of 500,000 euros has been made to various causes aimed at improving sustainability. Within the field of intellectual property, we should also think more about sustainability. For example, when there is a situation of infringement (e.g. parallel imports),

we often demand immediate destruction of the infringing goods, which is of course anything but sustainable. Possible alternatives include the dismantling of products, so that the materials can be recycled or donated to charity. It's time for us take a different approach.



## Trademarks

### Issues of (semi) descriptive trademarks

From a marketing point of view, it is tempting to use semi-descriptive trademarks. With such a trademark, it is immediately clear to consumers what the attributes of a product or a service are. The disadvantage, however, is that descriptive terms cannot be claimed as trademarks and therefore, as a company, you cannot obtain monopolies on the use of such terms. But how do we know when a term is descriptive? What is considered the limit of descriptiveness? Henkel objects to the registration of the trademark GOODBYE YELLOW for hair and skin care products in the Benelux. Before the application of GOODBYE YELLOW, they themselves had attempted to register the trademark GOOD BYE YELLOW (Schwarzkopf) in the EU, which was refused by the European trademark authorities.



The Benelux trademark authorities argue that the mark is indeed invalid (Since the mark describes a characteristic of the product). Goodbye is a common expression to say farewell to something. In this case: aging yellow hair, teeth, skin and nails.

The Benelux Court of Justice upholds this decision. The relevant public will immediately understand the purpose of the product in relation to the goods for which the trademark was applied for. Therefore, a trademark is descriptive if the relevant public immediately and explicitly understands what a product is for, without the need for an additional explanatory sentence to explain this.

Therefore, as a company, choose a trademark where the consumer has to take some steps to understand the purpose of a product, so that the trademark can also be claimed.

### State symbol use in logo's

Companies sometimes use elements in their logo that refer to the country where the company is based. This can lead to problems when it comes to the use of symbols as flags, state emblems and certification marks. The consumer might think that the product or service is approved by the government. Even if only a small part of a flag is involved. This is often a reason for the

authorities to reject a mark.



A common mistake is the use of the European Union's 12 stars. Regardless of whether these are used in colour or black and white. The trademark authorities pay strict attention to this and then adequately refuse to register the trademark.

### CAT versus FLOWERCAT

When the mark FLOWERCAT is filed in the European Union for hand tools, toys and more, the company Caterpillar objects. Normally, a great deal of importance is given to the first part of a trademark. However, not in this case. The authorities argue that CAT (from the English consumer's point of view) is the dominant distinctive part. For this reason, the marks are visually, phonetically and conceptually similar.



However, this reasoning does not apply to toys, given the fact that there are, of course, toys available for cats. For that reason the word CAT is not viewed as distinctive. However, Caterpillar has not based its trademark claim solely on generic terms (such as "toy"), but has extended their trademark claims to specific products such as construction toys, scale models of vehicles etc.

The Board of Appeal decides that in cases such as these, the whole classification must be assessed. If the mark had only been claimed for "toys", the reasoning of the Board of Appeal would mean that the 'Cat-' in 'Cat'-erpillar would've been a descriptive term. In this case however, Caterpillar applied its trademark for very specific products. For instance, mini cars are not toys for cats (Like a plush mouse). Therefore, the trademark is distinctive for this type of toy.

Following this reasoning, the trademark FLOWERCAT is eventually refused for all goods. The above mentioned dispute is a perfect example of the importance of giving proper advice on how to apply for a trademark. For what specific products and services should a trademark be claimed so that it can be benefited from in a dispute? Using generic terms for a trademark can result in ending up empty-handed.

### STARS COFFEE

Western companies leaving Russia have opened the door for trademark hijackers. Many new brands look suspiciously similar to the logos of departed companies, but as the new trademark owners almost always argue, this is purely coincidental. They are not hesitant to fight similarity claims.



In March, Starbucks closed and sold 130 shops in Russia. Recently, a new owner reopened the shops under the new brand STAR COFFEE. The menu still consists of sandwiches and the customer's names are likewise written on the coffee cups. This doesn't sound at all familiar...

The question is how long these brands will last. They are still applications, for now. The Russian authorities should, in principle, refuse them due to the older registered (and still existing) well-known foreign brands.

### 3.6 million in damage repaires

New Balance successfully challenged the use of the New Burlon logo in China this spring. The sports brand had placed an N, similar to that of New Balance, on a very similar area on their shoes. The fact that the company had already registered the mark (in bad faith) in 2012, did not soften the blow.



The application had been successfully cancelled in 2019, making use of the mark infringing from the start. In these proceedings, New Burlon refused to disclose any information, which gave reason for the

authorities to independently determine the amount of damages.

If China is an important market for your company, check whether any trademarks may have been registered in bad faith. Attack those copycats, ask for disclosure of the books and, if not given, claim a substantially higher fine than usual.

### Tradename law

#### Resurrection of the Theatre Group Amsterdam

In 2018, *Toneelgroep Amsterdam* merged into Internationaal Theater Amsterdam (ITA). When the theatre group *De Warme Winkel* decides to change its name to Toneelgroep Amsterdam, ITA does not approve.



While the conflict is fought out through the media, ITA quickly files an application to have their former name trademarked. This causes theatre group De Warme Winkel to surrender the name change.

Should there be a change of name, register your former company or organization name as a trademark. This way, you can prohibit third parties from using a similar name for the next 5 years to come.

### Advertising law

**Product liability: Saeco and Philips too?** A company's core business can always change. A good example of this, is the company Philips. Known for its lamps, televisions and audio equipment in the past, Philips nowadays produces medical equipment. When a company decides to change the main focus of their business, the older brands are often licensed to third parties, so that they can continue producing the old products. This raises the question: who is liable if something is wrong with these products?



A faulty coffee machine caused a house to go up in flames in Finland. Saeco made the machine, but the packaging and product also bore the Philips' trademark. Is Philips liable? Positive, the European Court ruled. Not only is the manufacturer liable, so is the licensee. By placing their trademarks on a product, companies create the impression of being involved in the production. The consumer can therefore sue either company.

It is up to the companies involved to arrange who should pay the damages among themselves.

When licensing a trademark, make clear arrangements on how to guarantee the quality of a product and if the quality is not upheld by either one of the two parties, determine beforehand who is liable.

### Misleading and fraudulent invoices

It remains an evil that we cannot rid: misleading and phantom invoices. When someone applies for a trademark to be registered, the applicant often receives a letter or invoice from a rogue company sooner than one from the authorities. By using highly similar logos, people may think they are dealing with official authorities. Consequence: payments of up to €2,300 are made for publication on a totally meaningless website.



A good example of this are the invoices from EUOIP (Not to be confused with the EUIPO). In addition, companies are spammed by unofficial renewal offers (currently mainly by Levin Nyman & Partners).



LEVIN NYMAN & PARTNERS  
intellectual property

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The amounts charged by such companies are often many times higher than usual. The letters are written quite demandingly. Do not respond to such letters and when in doubt, always call your trademark agency first.

### Abcor makes headlines

#### Abcor featured in IP STARS 2022

After being listed in the WTR1000, Abcor has also been included in the IP STARS ranking this year. *Managing IP* annually conducts research among IP-firms and their clients in 70 countries. Based on these results, a firm can be included in the IP STARS ranking.



Through surveys and interviews with colleagues and clients, information is gathered about IP-firms. This includes new and ongoing cases, striking disputes and, of course, customer satisfaction. We are therefore thrilled to be included in this year's IP STARS ranking!

### European Trademark Agency Abcor

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

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