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Design more important than words



In order to optimally protect the goodwill of their brand Coca Cola not only registered the word COCA COLA as a trademark, but also the figurative elements surrounding it, such as the shape of the bottle and the font. Recently an application was filed for the logo MASTER, for soda, which was opposed by Coca Cola.

At first Coca Cola is not successful, mostly because MASTER is a word very different from COCA COLA. Because of this the consumer would allegedly not be confused. Words generally play a larger role when comparing two trademarks. The European Court, however, took an

entirely different approach. The court noted that there were some striking similarities between the two trademarks as well. Both marks had a “tail” as an extension to their C and M, respectively. Furthermore, the typography was based on the (unusual) Spencer font.

Because the goods involved are supermarket products the design has a very important impact. The consequence of this is that the trademarks are in fact somewhat similar when taking this into account. The earlier ruling was overturned and it all ended for MASTER.

Tradename - trademarks

Eataly Tilburg has to change its name

In 2011 Italian restaurant Eataly opens its doors in Tilburg. According to the tradename register there are several other restaurants in the Netherlands with this name. Since the activities of an Italian restaurant are very locally bound the tradename rights are geographically very limited. Eataly does not expect to run into any problems. However, after three successful years the restaurant receives a cease and desist letter from Italy. Eataly is a restaurant chain originally from Italy. The first restaurant was opened in 2007 in Turin. Now there are twenty seven restaurants (in Italy, Japan, United States, Dubai and

Turkey). To protect the name the company has not only registered it as a trademark in Italy, but also in Europe, America and many Asian countries. Clever, because this way they can easily expand their business.

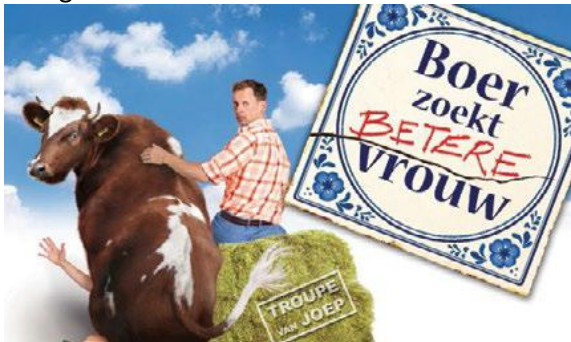
Eataly Tilburg assumes that they received the cease and desist letter because Eataly want to clean the Dutch market before they open chains here. Because the trademark rights of the Italian company are older and stronger, and because of the high costs of a law suit, Eataly Tilburg decides to change its name.



Trademarks

Farmer searches better wife not allowed

On February 7th the new theatre comedy of Toupe of Joep premiered. A week before opening night Blue Circle, the producer of Farmer searches Wife, clearly voiced its unhappiness. In order to prevent coat tail riding the company has registered the name of the program as a trademark. A parody exception is available in copyright law, but unknown in trademark law. The question is whether a producer should act this strict with use of the trademark and parody. The public opinion could turn against you if there really is a parody and no commercial coat tail riding.

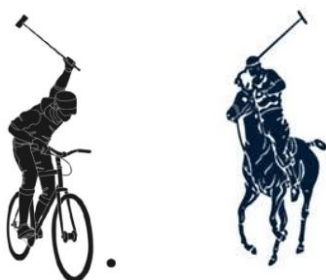


In order to not have the matter escalate the decision is made to change the name into Farmer searches better Wife. Quite expensive by itself since all promotional material, the website and Facebook needed to be changed. The theatre group of Joep Onderdelinden does not hold any grudges. All 68 farmers of the reality show attended the opening.

Logo polo and bike polo similar

Polo by horseback has been played since ancient antiquity. The American company Ralph Lauren uses this image as a logo for her clothing line. However, there are many other forms of polo, such as bike polo. This sport, which was conceived in 1891, has been going through a revival since the launch of hardcourt Bike polo in 2000.

The sport is mainly played on tennis and basketball courts. Chunk is an English clothing manufacturer, owned by FreshSide, which has a bike polo player as its logo. Ralph Lauren opposes the trademark application when it was filed in 2009.



The European trademark authorities decided that the trademarks were not similar. They were, after all, two completely different sports. The European court of First instance, however, agrees with Ralph Lauren on appeal. The consumer will notice the overall impression which is similar, and not the insignificant differences. The cyclist is depicted in a way that is very similar to Ralph Laurens polo player, with the stick in the air ready to hit the ball. The trademarks are therefore similar. FreshSide has filed a new logo in the meantime of two players riding towards each other. It appears that Ralph Lauren has no objection to this.

CARRERA, cars and navigation equipment

A trademark right does not only give protection against use by other of the trademark for similar products, but also for complementary products. The question is, however, how far does this reach? Porsche has registered the trademark CARRERA in 1976 for sports cars. After manufacturing the Porsche Carrera GT (2006), a European trademark is applied for CARRERA for navigation equipment. Porsche opposes this application.



In first instance Porsche loses the opposition. However, this past fall the European Court decided in Porsche's favor. Even though the products are completely different the consumer may still get confused. It may assume that the navigation equipment is made by Porsche or is related to the company. Furthermore, there is coat tail riding on the reputation of Porsche Carrera (as a technological superior company). The trademark is refused.

Pronails, big fish in a small pool

Under the name PRONAILS, for many years, Amazing Brands has sold artificial nails and related products. In 2012 trademark protection is sought in the Benelux, however, the trademark is refused by the authorities.

The trademark is descriptive according to them. NAILS is evidently a generic English term and PRO is an abbreviation of professional. The trademark is therefore descriptive for nail products provided by professionals. The trademark has, however, been accepted by the French and European trademark authorities. This does not influence the decision making policy in the Benelux, however.



In a final attempt Amazing Brands claims that the trademark has acquired distinctiveness. This argument is however also disregarded. The use has been too short and was mostly centered in Flanders. The trademark authorities claim that one can only acquire distinctiveness if this is done in all of the Benelux.

The high court of Brussels, agrees with Amazing Brands in the end. The company produces more than one hundred pieces of evidence to support acquired distinctiveness, going back more than ten years ago.

Clearly in the small niche market of gel- and artificial nails Amazing Brands is a well-known company. For acquired distinctiveness it is not necessary that the perception of a trademark is equally distributed throughout the Benelux territory. Sufficient is that with the use of the trademark a significant part of its target audience is reached. The Benelux authorities therefore had to register the trademark after all.

Hands off of Alexander Wang

Wang is a very successful fashion designer from America. In the Netherlands he's most familiar because of the fall collection 2014 of H&M. In December of 2011 the name ALEXANDER WANG had been registered by another company. This company also registered other famous designers such as Isabel Marant, Pierre Hardy and Guiseppe

Zanotti. Trademark rights are created by registration. However, this does not mean anyone can simply register the name of a celebrity.



ALEXANDER WANG × H&M

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Copyright

Copyright on old chair?

Plaintiff makes furniture made of glass fiber and polyethylen and is the maker of the Ball Chair (designed in 1998). Ramblaz produces promotion articles and at the request of a brewery a chair that looks very much like the Ball Chair. When Ramblaz is confronted by the designer he does not deny the copying, but claims that there are no copyrights, enabling him to freely copy the chair.



An object only receives copyright protection if it is original, and an independent intellectual creation. Which defendant claims it is not since there is an older chair made by Eero Aarnio in 1968, which also features a ball. The court disagrees with this stance. In designing the Ball Chair the designer obviously was inspired by the current trends of the 1960s (furniture in spherical shapes). This is not a problem because styles cannot be claimed.

Plaintiff has made several artistic choices when designing the Ball Chair, which make the chair entirely different from the already existing Pastil Chair. The Ball Chair is therefore protected by copyright and the infringement is assumed. The court decides that the damage is € 31,000.-.

Mondriaan and merchandising

At the beginning of this year the Hague Museum announced that they were able to buy one of the original Mondriaan dresses from Yves Saint Laurent. The dress is dubbed as the “mother of Mondriaan merchandise” by the director. We will see much of this merchandise since Piet Mondriaan died in 1944, and copyright expires after 70 years.

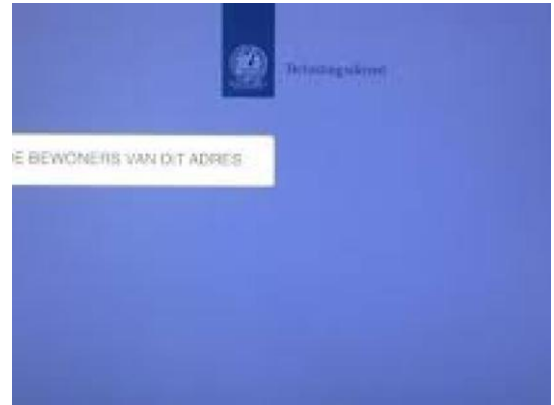


Does this mean everything is now free to be used? No. Aside from copyright you also have to take the rights of the photographer into account. Many museums forbid pictures of paintings. If a special painting is to be used for merchandising, it is advisable to pay off the photographer or museum, or use a stock bank.

Advertising

Tax assessment or commercial?

To commemorate its ten year anniversary Leerkus MotoFun sent a funny mailing with the theme “extreme amount of tax refunds!!”. The mailing was addressed to “whoever inhabits this address” and was sent in a blue envelope just as the Dutch IRS does. In the bottom left corner in small print (almost too small to see) it said “this is an action from MotoFun from Twello”. Although it was clearly a parody, not everyone was able to appreciate it. First the agency was reprimanded by the Ministry of Finance and



after that by the Advertising Code Commission. The complaint with the Advertising Code Commission centered around article 11.1. This article determines that a mailing should be immediately recognizable as an advertisement. The recipient of the mail should be immediately able to see that it was an advertisement and not an official communication from the IRS. This was not the case. The color blue and the print “belastingdienst” which means IRS, was clearly copied from the official IRS envelope. Since the announcement that it is an advertisement is depicted too small on the envelope the advertisement is deemed in contravention with article 11.1 of the Dutch Advertising Code.

Internet – online branding

eBay fights domain name hijacking

eBay filed a procedure with the WIPO in November to retrieve more than one thousand domain names. The domain names were registered by a Chinese company three months earlier and were composed of the trademark eBay, followed by three numbers and then an extension. (for example ebay070.com). According to WIPO it is the second largest claim ever. The past month the case has been looked into. The domain names are similar to the trademark and the numbers and extensions have no influence on the distinctive character of the mark eBay. eBay has not given permission and the domain names all refer to commercial sites and are recently registered. The domain names are therefore registered in bad faith, and should be transferred to eBay for free.

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

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

Contact Abcor

For more information please contact us:

ABCOR B.V.

Frambozenweg 109/111
P.O. Box 2134
2301 CC LEIDEN
The Netherlands

Tel: +31 71 576 3116
Fax: +31 71 576 8947
E-mail: info@abcor.eu
Website: www.abcor.eu

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