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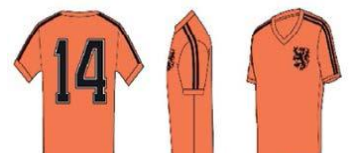
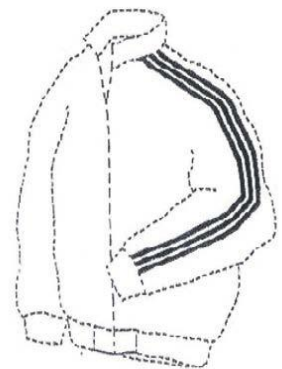
The Big Green Egg is a ceramic barbecue. The egg shaped barbecue ensures that the air is circulated, which means dishes are cooked evenly. Aside from barbecuing the machine can also slow cook, smoke and even bake pizza's. In 2014 an alternative is launched in the Netherlands, a more economic one. Named the Black Bastard, it is a black ceramic barbecue. The barbecue's success does not stay unnoticed. Old Amsterdam, a well know cheese manufacturer, starts the print campaign "Win a Black bastard BBQ", in order to promote the use of its cheese on hamburgers.

As an international company, Old Amsterdam encountered a lot of negative responses to this campaign due to the obvious meaning of Black Bastard, which is insulting. In response to this Old Amsterdam had decided to cease use of the name and speak of "a barbecue" only in her ads. This story reminds us of the introduction of SHAG beer in Australia and the Chevrolet Nova in Latin America. Our advice therefore is to always check whether or not your new trademark may have a meaning in another language.

Adidas block Cruyff shirt

A famous trademark may oppose the use of a comparable sign for completely different products. In a trademark application is filed for an orange T-Shirt that bears number 14, which is Johan Cruyff's (Holland's most talented soccer player of all time). The trademark was applied for a large amount of products such as clothing, but also cups and watches. Adidas opposes this application based on her famous "three stripes" trademark, and invokes her reputation, accusing the other party of coat tail riding. The European authorities agree with Adidas. Adidas shows (with statements and proof) that its trademark is indeed

famous. The Cruyff trademark is a sporting shirt that has two stripes along its sleeves. Since Adidas' three stripes are very famous the consumer will immediately associate the T-shirt with Adidas. Furthermore, merchandising products are usual with large sporting events and the consumer may also assume that the Cruyff products are in fact Adidas'. The fact that Johan Cruyff was the only player in 1974 who was **not** sponsored by Adidas and thus has two stripes on his shirt did not change the matter. Adidas emerged as the victor.



Roy Donders claims his name, application in bad faith

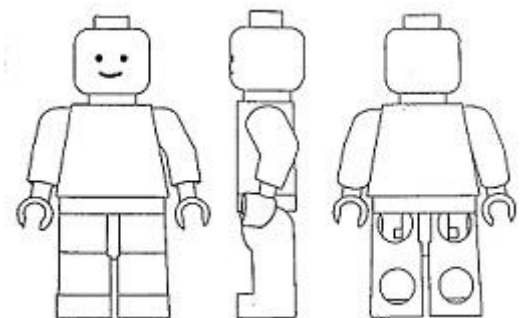
In the Benelux there are no separate rules for the registration of personal names as a trademark. Since 2012 Roy Donders has become famous, thanks to various TV shows. In 2013 a marketing agency registers the trademark ROY DONDERS for clothing in the Benelux. After this the agency contacted Roy Donders and proposed to work together. At the time Donders was busy with a marketing campaign for a supermarket. Matters quickly escalated after that.



The court judged that the registration was unlawful, despite the fact that there are no specific rules for personal names. The marketing agency had obviously been acting in bad faith since they knew of Roy Donders' existence. The consequences of all this was that the trademark registration was cancelled and the real Roy Donders was free to register his name as a trademark. Fortunately this case was in line with previous case law on such matters and demonstrates that hijacking someone's name, despite a lack of legislation, is not a profitable activity in the Benelux.

Lego figurines protected as shape mark

In 2000 Lego filed a drawing of her figurines as a shape mark to protect it from third parties that may want to copy it. BestLock (a competitor) started a cancellation action against this trademark but seems to have lost this procedure. For shape marks there are some specific rules and BestLock is making use of these. For example the figures are a technical solution more than anything else, since they can be combined with other pieces.



The European Court disagrees completely. The shape of the figurines is humanlike so that children can play with it, and does not serve some technical effect. Good news for Lego
In most cases, however, trademark authorities

are very careful in registering shape marks. Only if a shape is significantly different from other shapes of similar products on the market is there a chance it may be registered.

Famous in the European Union

Trademark protection is always limited by territory. A Benelux trademark is limited to its borders and usually not beyond. The consequence of this territorial limitation is that it is possible to file trademarks in the Benelux that are similar to older foreign trademarks. This summer the European Court has judged on whether a foreign trademark proprietor may invoke the reputation of his trademark to stop a new application.



IMPULSE is a deodorant brand owned by Unilever. Originally launched in 1972 in South Africa and in 1979 in England. Today it is one of the best-selling body sprays for women, with a market share of 5%. When "Be Impulsive" is filed in Hungary, Unilever invokes its European registration. Although the trademark is not in use in Hungary, it is in use in England, where it is also famous. The European Court decided that a proprietor may invoke the reputation of its trademark, even if it is used in another country. What is important is that the consumer will associate the new trademark with the older. For companies this is another reason not to copy trademarks that are well known abroad.

DISMALAND vs Disney

Some artists use trademarks to highlight societal problems. For the owner of the trademark in question this is often unpleasant. The trademark is linked to nasty experiences. In case of a conflict the artist usually invokes his freedom of speech and in many cases this is enough to persuade the judge. Because of media attention many companies even choose not to act anymore at all and simply wait until the storm is over. In August DISMALAND was opened in England. A satirical

amusement park (or object of art) designed by British graffiti artist Banksy. The project has 50 participants from 17 countries, including Jenny Holzer, Jimmy Cauty and Damien Hirst. The temporary project (open for only 30 days) could be visited by a maximum of 4,000 people per day and was sold out immediately.



Many works refer to Disney movies, such as the misshapen Princess Ariel and the guides that wear Mickey Mouse ears. Despite all this Disney had not given any comment yet or taken any action. Disney is generally known as a company that defends its intellectual property rights (actions were taken against Deadmau5 for example). Perhaps Disney decided not to take any action if this would mean it would only draw more attention.

Copyright

Logo Tokyo 2020 under pressure

In June the new logo for the 2020 Olympic Games in Tokyo was leaked. The logo was designed by the Japanese artist Kenjiro Sano and is based on the capital T, referring to Tokyo. Aside from the bent edges the red dot is also a prominent feature, it symbolizes a beating heart and the Japanese flag.



According to Belgian designer Olivier Debie the new logo has been plagiarized. In 2011 he designed a similar logo for the Théâtre de Liège. Reason for him to start a procedure against the Olympic Committee. The Olympic Committee has since proclaimed in a press conference not to use the logo. This decision is independent of any court procedure and the Committee maintains that the logos are sufficiently different. The designer had stated that he will let himself be inspired by other logos. Olivier Debie has stated that he will continue his court procedure.

Design

Table is the shape of a diamond

Eichholtz sells furniture in all of Europe. At an exhibition in Paris it shows its new tables. The tables are made of glass in a frame with eight corners (colours in gold and nickel) with a bottom plate made of marble. To protect its rights both tables are filed as European designs. When a similar table appears on the market Eichholtz demands a prohibition on this. The other party claims that the design registrations are not valid. The design would not be new and does not have its own character since it has the same shape as the Ascher-diamond. The main question is whether use of the same design for a different product affects novelty.



The court decides this is not the case. One should look at the type of product concerned and the sector in which it is being used. In this case they are very dissimilar. It is not expected that furniture manufacturers know which shapes are used in a diamond cutting business. The registrations are therefore valid. Since the tables of the other party give the same impression with the informed consumer they are prohibited and a recall also follows.

Advertising

Misleading packaging

In Europe there are certain guidelines one must follow when it comes to packaging of products. It is important that the packaging does not mislead the consumer as to the products and their ingredients. But where exactly is the line that determines what is and what is not misleading?

German manufacturer Teekanne sells tea under the name Felix Himbeer-Vanille Abenteuer.



On the packaging raspberries and vanilla blossom is depicted and it states

“fruit tea with natural aromas” it also has a seal that says “only natural ingredients”. A look at the listed ingredients, however, clearly shows that there are no natural elements in the tea at all.

The German Consumer Board finds this misleading and starts a court procedure. In first instance the court agrees with the manufacturer. The listed ingredients clearly show what the tea contains so nobody can be misled. The Appeal Court does not agree with this. The rules are applicable to all elements on the packaging, trademarks and other words and depictions. If the packaging gives the consumer the impression that it has certain ingredients, but those are not really in the product, then this is misleading and something the listed ingredients cannot compensate for.

Internet – online branding

Trade in domain names: OK tank stations do not get domain name

Fuelplaza exploits gas stations under the name OK. The company registered the logo OK in 1983 in the Benelux. On the internet the company is found at ok-olie.nl. Because ok.nl is a much better name the company approached Goas in 2007, 2013 and 2014 to buy the domain name. This was unsuccessful, and eventually a resolution was sought in court.



Fuelplaza invokes its trademark rights. Because there is not an active website, consumers would assume that the company is not active. This may affect the reputation of the company. The court, however, does not agree. The fact that a company is being disadvantaged because it cannot obtain the corresponding domain name does not affect its reputation. Trademark rights are meant to protect the reputation of a trademark, but they do not grant unlimited rights. Fuelplaza had another argument, though. It claims to have a better

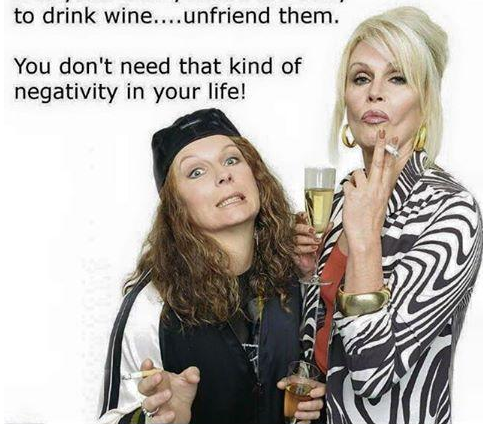
right on the domain name. Gaos is not using it after all. This would be, according to Fuelplaza, illegitimate use of the domain name. The court, however, does not agree with this. Registering a domain name that is similar to a trademark is not illegitimate on and of itself. The fact that Gaos does not wish to sell is not an abuse of power. There is no obligation to have an actual active website.

Facebook posts Ab Fab commercial

The advertising commission received a complaint about a liked message on the Facebook account of a grand café. The message (below) shows Patsy and Edina, who are apparently famous for being in a TV show called “Absolutely Fabulous”.

If anyone tells you it's too early to drink wine....unfriend them.

You don't need that kind of negativity in your life!



The plaintiff states that this message encourages people to start drinking early and pretends that the risks of addiction are something to laugh at. The Advertising Commission disagrees with this. The message was clearly a joke and if anything ridicules excessive alcohol consumption. However, liking messages is a form of advertising. The message should have contained a disclaimer “No 18, No alcohol” or something of the kind. A disclaimer is obligated, also for use on the internet, which includes liked messages on Facebook. The message is therefore in contravention with the Advertising Code and the advertiser was requested on to advertise in this way any longer.

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

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