

In dit nummer

MOB vs Louis Vuitton bag:
parody in trademark law?

Lacoste vs Pacogi:
can a logo stop a word mark?

New European Trademark
Directive

Portrait right:
Van Gaal's popularity

Dentsu Utama:
Plagiarism in advertising

EUIPO – domain name
highjacking

Actions against misleading
acquisition trademark owners

Free eBook IE-inBedrijf:
Part 2 –protection of ideas

Smoking bad for jeans?



Mustang is a famous German jeans brand (launched in 1948). Its logo, which contains a stylized mustang, refers to the wild west. The trademark is registered in many countries. When a comparable logo is registered for tobacco the jeans company opposes this. The products are, of course, entirely different. Still the applied trademark may damage the distinctive qualities and reputation of the famous jeans brand.

A key element in all this is that the consumer makes a connection between the products. A theoretical assumption is not sufficient.

The fact that other cigarette companies (like Camel and Marlboro) also sell clothing (to promote their tobacco brand) is not enough to substantiate that the consumer will make this connection.

Smoking is unhealthy, as is generally known. However, this is not enough proof to assume that a cigarette brand has a negative effect on a jeans brand. The claim is therefore rejected. The case shows that reputable trademarks should not start this type of procedures without a solid market research preceding it.

Design - copyrights

Bicycle basket is a design, but has no copyright

In 2011 Basil Denton unveils the new rotan bicycle basket, with leather strips. Less than a year later the competition introduces a basket that looks suspiciously alike, the Java New Looks. This likeness is not be accident. A picture of the Basil Denton product served as its inspiration. The director did not want an exact copy, claiming: *"We would like to change the baskets a little bit so that they are not exactly the same as Basil"*. Basil demands that the baskets are removed from the market. Because no design registration took place, Basil had to invoke its copyrights and its unregistered design rights. The claim based on copyright failed. The

design is too basic and its looks are determined by function. The claim based on an unregistered design do stick, however. The combination of the distinctive elements are not found in any existing baskets. The Java basket does not differ sufficiently from this, and it was also based on the Basil design. Basil's claim on design rights was therefore successful. The only drawback is that the prohibition and the damages were limited. An unregistered design only has a life span of three years. An actual registration can last up to 25 years and would have earned Basil much higher damages.



Trademarks

MAB bag a parody of Louis Vuitton?

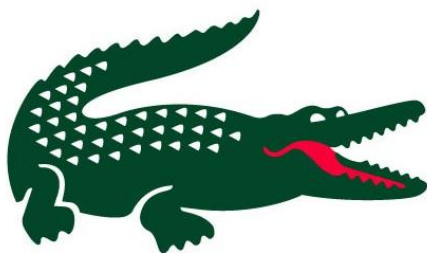
The court in New York has opened the door for parody in trademark law. My other Bag sells canvas bags with the text “My Other Bag” on the front and a drawing of a Louis Vuitton bag on the back side. The bag refers to the “my other car...” bumper stickers that were popular in the 70’s. Cars used to drive around with this sticker suggesting that the owner had another more luxurious car like a Mercedes. A joke that many Americans still remember today.



Louis Vuitton does not appreciate the joke and files a lawsuit. Its claim is based on its trademark and design rights. Use would be damaging to the image of Louis Vuitton and it would lead to dilution. My Other Bag claims that it is a parody that should be allowed. The consumer will immediately notice that it is a joke and no confusion can occur. The court agrees with this. *“Louis Vuitton is ... an active and aggressive enforcer of its trademark rights. In some cases, however, it is better to “accept the implied compliment in [a] parody” and to smile or laugh than it is to sue.”* In the Netherlands Louis Vuitton would almost certainly have won the case. Parody may be a defence, but only if there is no financial gain.

Logo stops word

Many companies register their company name and trademarks as wordmark only. Often, however, a logo is also used. If this logo is distinctive and plays an important role in communication it is advisable to register this as a trademark as well.



Lacoste sells clothing, shoes and perfume all over the world. The trademark is a logo of a green crocodile. The logo refers to the nickname -“le Crocodile”- of the company’s founder, tennis player René Lacoste. Apart from the name the stylized crocodile has been registered as a

trademark as well. When the trademark EAU CROCO is filed for perfume, jewellery and clothing, by a third company, La Coste opposes. The consumer will think of the crocodile logo when confronted with this new application. Especially since CROCO is the French abbreviation of crocodile. The new application is considered similar and is therefore not registered.

Change European Trademarks

The European Parliament has approved the new European Trademark Directive, which will come into force on March 23. There are some important changes. The registration fees will be paid per class, which would make applications in less than 3 classes more economical than they are now. The same goes for the renewal of European trademarks.

Apart from this the use of general terms is affected. Starting now the classification has to clearly indicate which goods and services the trademark will be applied for. This is also true for trademarks that are already registered. In the past class headings could be used, implying that all possible goods and services of that particular class were covered.



This is no longer the case. Owners of already registered trademarks will be allowed six months to rectify their classification. If this is not done there is a risk that the trademark loses its validity.

The requirement that a trademark must be graphically depicted will also disappear. This means that non-graphical signs may also be registered as a trademark. For example short films (like the lion from MGM), holograms, scent marks, sound marks and taste mark may all be registerable. We will send an extra newsletter regarding this in March.

Ajax soccer school in Dubai?

A difficult question for many companies that are active beyond the border is where to register the trademark. Just on the home market or in other countries as well.

For companies that also do a lot of merchandising this is very important. AFC Ajax has registered its logo in the Benelux, a few countries in Europe, Russia and the United States.

Today #Dubai opening #ajax academy



The soccer club was therefore unpleasantly surprised when they found out, through the Twitter account of an ex player, Mido, that he opened the Ajax Academy in Dubai. Mido was surrounded by players wearing Ajax shirts, which also showed their sponsors. Not good for the club and also not for the sponsors. Public relations spokesman Brinkhuis has indicated that Ajax has nothing to do with this initiative and that it is considering legal steps.

Copyright – portrait right

How much is Van Gaal worth?

advertising agency bought a picture at Getty Images concerning the Dutch soccer team of 2014. The image was a perfect fit for a writing competition. By buying the license the advertising agency took care of the rights of the photographer, but it did not change the rights of the people in the picture, including Van Gaal. Because Van Gaal is famous in the Netherlands, his image has a financial value. Since no fee was paid, Van Gaal demanded € 100,000.- in damages.



The court finds this amount a bit too high. Previously other famous people received up

to € 50,000.- for use of their pictures. Because this advertisement was only featured in one newspaper, the court decided that € 25,000.- would be sufficient. For Van Gaal it was all a matter of principle. The paid damages were apparently donated to Spieren voor Spieren, a foundation that focuses on muscular diseases. The lesson to be learnt here is that you should not only buy the copyrights at a stock agency but also make sure that the portrait rights are taken care of.

Advertising

Plagiarism of heavily inspired

In the Netherlands the ADCN lamps and the Cannes Lions are the important awards for the creativity of an advertising agency. Often there is a striking similarity between the winning campaign and earlier campaigns. This problem is not limited to the Netherlands. This year the Malaysian awards came under fire when many of its award winning campaigns seemed very similar to already existing campaigns. The advertisement of the Indonesian WWF (which won 26 bronze and 3 silver awards) seemed very similar to the work of 21 year old design student Tom Anders Watkins (published April 2014).



Also the advertisement for Web Private Watch seemed suspiciously similar to The Architect of Swedish photographer Erik Johansson. The idea of an inside-out house is the same, the man just wears ladies underwear to point out the dangers of online use and that nothing stays private. This did not stay without consequences. The advertisements were disqualified for plagiarism.

Internet – online branding

European Trademark office and hijackers

The European Trademark office (OHIM) will change its name on March 23 into EUIPO. Since trademark owners are confronted with many “ghost invoice” (invoices that are fake but claim to be from official organizations), it is important that the domain names are not owned by these people.

For this reason OHIM registered the following domain names in the last few months: EUIPO.EU, EUIPO.ORG, EUIPO.NET en EUIPO.ES. Nothing much more has been registered, though. Right after it was announced that the office would change its name into EUIPO (April of last year) another company already registered EUIPO.NL, EUIPO.UK, and EUIPO.LEGAL.



The company claims to use these sites to provide information on the change in regulations. In a response to this the office claims that they will keep a close eye on these websites to ensure there is no misleading taking place. Considering the legal costs involved in this, it would have been much better if the domain names were claimed by the office beforehand.

Actions and publications

Action against ghost invoices

A well-known phenomenon in our business are the so called ghost invoices. Unfortunately they are all too common, even these days. Invoices are sent to trademark owners after they filed their application. In return for a large sum of money the trademark is filed in a database by the ghost invoice sender, a database that is completely useless. All the while the owner believes that he received an invoice from an official organization. The letters contain the official registration date (name of the owner, filing number and date, logo) in order to increase the chances of fooling the trademark owner. To increase their chances of fooling the trademark owners names and logos that are surprisingly similar to those of the official

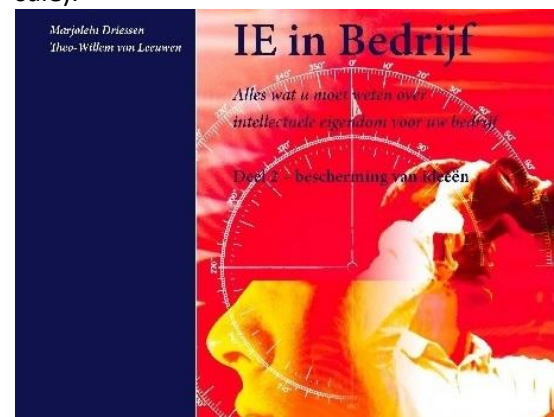
authorities are used, such as: “European Patent and Trademark Register” or “European Trademark Publication”.



Following Belgium, the Netherlands will now introduce a procedure that allows such false acquisition to be dealt with. The initiative has been approved unanimously by parliament. Until it becomes a final law our advice remains: do not pay and never respond to any suspicious emails or invoices. The rates that are being charged are often a multitude of the normal costs and the amount cannot be reclaimed.

Free eBook IE in Bedrijf part 2

In the fall of last year part 2 of the eBook series *IE- in bedrijf*, which Theo-Willem coauthors was launched. The series follows the life cycle of a company (from start to sale).



The protection of ideas is the central theme of part 2. How do ideas come to existence and what can and cannot be protected. The working guide was made for mid-sized companies that are active in the field of product development. The book, which is in Dutch, may be downloaded for free at: www.ie-inbedrijf.nl.

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

Follow Abcor:

Twitter: [www.twitter.com/abcor](https://twitter.com/abcor)
Facebook: www.facebook.com/abcor