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**Kruidvat's SPA SECRETS prohibited**



Spa Monopole has been granted an exclusive license, by the authorities, to exploit the natural water sources and thermal baths of the Spa region. The firm has registered the trademark SPA for a wide scale of products, like bottled water and cosmetics. When Kruidvat uses the names SPA SECRETS, SENSE OF SPA, ZOUTSCRUB SPA and SEL DE GOMMAGE SPA, to launch a new line of cosmetics and care products, Spa Monopole objects.

Kruidvat wants to keep selling the mentioned products and initiates a lawsuit. Their main argument is that the word SPA refers to a wellness

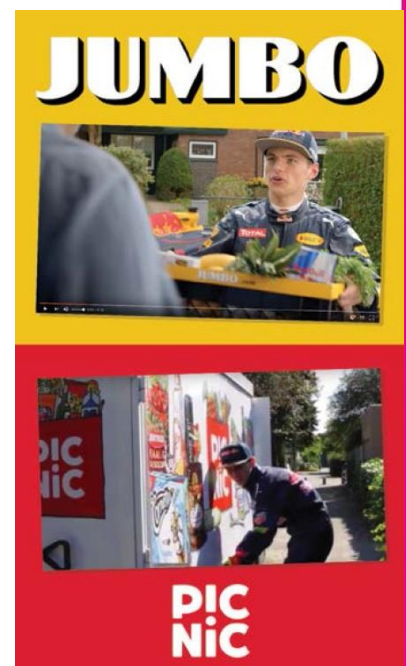
centre, which is the place where the products are being used. It is therefore descriptive and should be available to be used by everybody. The judge does not agree. SPA might be descriptive for a wellness centre, but not for cosmetics and care products. Because of the prominent place (due to the use of colors and formats) of the word SPA in the Kruidvat trademarks, consumers might link them to the well-known SPA trademark. Conclusion: infringement. The trademark SPA SECRETS is invalid and the products may no longer be sold, with a € 250 penalty for each infraction.

Advertising – portrait rights

**Max parody, € 350.000,- claim?**

In the new Jumbo commercials Max Verstappen is racing from client to client in his Formula 1 car delivering online orders. In less than a day after the launch of this campaign, the online supermarket, Picnic presents a parody. A Max look-alike is driving around at an easy pace making his deliveries. After a short pit stop (where the groceries are being delivered), Max continues his trip through the Dutch city Amersfoort. According to the Picnic management it's merely a comedy. However, the management of Max Verstappen is not amused, stating

that the commercial is an infringement of the image rights of Max. It is irrelevant that the character is obviously just a look/a-like and not the man himself. Max Verstappen has a redeemable popularity (his name, autograph and portrait are registered trademarks), so his management claims a compensation of no less than € 350,000.00. According to Dutch standards this claim is very high, so it is not very likely that the claim will be fully granted. However, it is clear is that the image of Max cannot be treated lightly.



### Monopoly vs Drinkopoly

Drinkopoly is a remarkable game. Basically, the main goal is to drink with your friends. As you can imagine, playing the game is a unique experience every time, because one simply does not remember the previous encounter. The logo speaks for itself, showing a drinking couple, with one of them laying on the ground, completely drunk. When trademark protection is being sought for the logo of Drinkopoly, Hasbro (the producer of Monopoly) opposes the application.



The EUIPO agrees with the fact that Monopoly is a well-known game. The consumer will link the games, which names both end with OPOLY. The use of the trademark DRINKOPOLY damages the reputation of the well-known trademark MONOPOLY. A game that encourages alcohol abuse, does not fit the carefully acquired image which is obtained. As a result, the DRINKOPOLY-logo is refused as a trademark, but it is still for sale online.

### H&M: design or trademark use?

When is the use of a text or design Trademark infringement? An important question, since the increasing use of words and bright colors on t-shirts and sweaters.

H&M sells sweaters with the word CHIEF and the face of an Indian printed on them. Jeans Centre summons H&M to stop the sale, claiming infringement of it's trademark CHIEF. H&M disagrees and continues the sale.



Jeans Centre takes the matter to court and the judge confirms that the prints of H&M are an infringement of the CHIEF trademark. The word CHIEF is dominant

and attracts the most attention of the consumer because of it's positioning above the face of the Indian. The consumer might recognize the word CHIEF as a trademark and confuse it with the sweater of Jeans Centre.

It is remarkable that in this judgment no word is written about the question, if this actually is trademark use, or rather mere design. This aspect is rather important, in my opinion, when judging if the consumer can be confused, or not. Many times, parties present marketing researches in such cases to proof their claim. Because H&M continued selling after being summoned by Jeans Centre, these sales have been in bad faith. In an additional hearing the amount of the damage is to be established.

### Non-distinctive logo's

In 2014 the EUIPO presented a new guideline regarding the admissibility of logo's as a registered trademark. A little stripe under the word or a square as background will not convert a logo in a distinctive and valid trademark. The idea is that consumers will not recognize the sign as a trademark, because the logo is too descriptive. As a consequence, many logo's are being refused by the authorities. In the meantime, the first appeals against these refusals have been judged by the court, that (unfortunately) confirms the new policy.



For example, the silhouette of a bodybuilder has been refused for food supplements, clothing and a web shop for these products. According to the court, the consumer directly links the stylized image of the bodybuilder in this pose with the claimed goods and services. This image may therefore not be monopolized.



The same faith was suffered by a logo for solar panels. The customers, being specialist, would directly recognize the drawing as a section of a solar panel. The fact that these panels might have very different shapes is not relevant, according to the court that refuses the trademark. A company that wishes to claim a descriptive word should therefore add a figurative element that does not refer to the distinguished product.

## An unpleasant encounter

In the year 2001, tapas restaurant 'the Encounter' opens its doors in the city of Nijmegen. They register their logo for catering services, in order to protect the goodwill of the restaurant.

In the year 2014, a restaurant named 'the Encounter Zutphen' is opened in the city of Zutphen (approximately 50 km from Nijmegen). The party from Nijmegen claims that this is infringement of their trademark rights.



The restaurant owner from Zutphen disagrees, claiming that over 800 companies are registered at the Chamber of Commerce using this name, so the name is free to be used by everybody. Furthermore, the logos are different, as are the cities where the parties are established and for these reasons, there is no risk of confusion.

The judge does not agree, stating that the dominant part of both logo's is the word 'encounter' and that the offered services are identical. It does not matter that the restaurants are 50 kilometers apart. Both companies direct themselves to the same audience through internet. Therefore, the consumers might think that the restaurant in Zutphen is a new establishment of the same owner in another city. In the end, the party from Zutphen has to change their name and, as the losing party, pay for the legal expenses of the other.

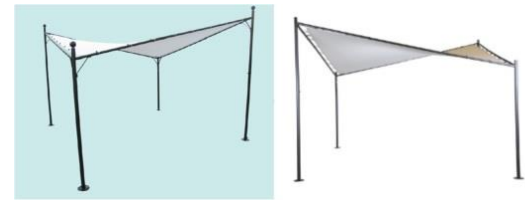
### Design rights

## The world upside down

It is a common thought among entrepreneurs that IP rights have no value in China. Nowadays, this (mis-) conception is completely outdated. In 2015 Chinese companies filed more than a million patent applications (a third of the total amount of 3 million patent applications worldwide). Whereas American and Japanese companies filed half a million applications each.

China is also the number one country regarding trademark registrations. In 2015 a vast number of 2.8 million trademark applications were filed in China. As a result, an increasing number of

Chinese companies can be found in the court of law as the demanding party in trademark infringement cases.



Above: left Blokker tent – right original Zhengte tent

In 2012 the Chinese company Zhengte launches a tent with a floating butterfly shaped roof. This unique shape is being protected through a European Union design registration.

When the Dutch firm Blokker introduces a similar tent, named Le Sud, the Chinese bring the matter before the court. Claiming infringement of their registered EU design.

First the judge checks if the registered design fulfils the legal requirements (new and individual character), because there are more tents on the market with a butterfly shaped roof. All these versions are different, so the design is new. It has also an individual character, because of its elegant shape, resulting in a distinct overall impression. According to the judge, the registered EU design is valid and this is a major setback for Blokker. The Blokker party tent is nearly identical to the Chinese tent, giving the same overall impression to the customer. As a result, the tent may no longer be sold and Blokker has to compensate the legal costs of the other party.

## Design rights on non-visible parts?

Design rights are the perfect tool to claim protection of shapes. However, this right has its limitations. Lose parts of an object cannot be protected through design rights. The philosophy behind this is that non-visible parts should be replaceable at all times. Therefore, the manufacturer can only claim design rights for the parts which are visible. However, how far can we take this?



# SAMSUNG

At the court, in the Hague, this question was discussed in a case about Samsung printer cartridges

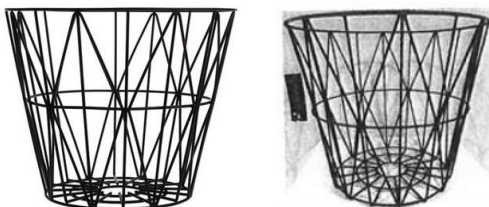


Can the design of the cartridge be legally claimed as a right? The cartridge can only be used within the printer, when it is not visible. And the printer itself cannot function without the cartridge. The court judges that the shape of a cartridge can be protected by design rights. A printer without a cartridge is still a complete product (like the lamp without the lamp bulb). This is good news for companies, because it enables them to protect the unique shapes of their products even more.

#### Copyrights

### Copyright claim on metal basket?

In 2012, Trine Anderson designs the Wire Basket. She created this design as an employee of the firm Ferm Living. In the Netherlands the copyrights belong to the company if the products have been made by employees (as part of their job). Many (daily used) products can be protected by copyrights. However, if no possible creative choices have been made (as the shape is too basic), the design cannot be protected. The Burly Basket Round, introduced by the company Lifestyle, has a great resemblance to the Wire Basket. This raises the question if the Burly Basket Round is an infringement of the copyrights of Ferm Living. Lifestyle states that, due to the trivial and functional shape of the Wire Basket Round, no Intellectual property claims can be made.



Above: left original Wire basket– right Burly Basket

The judge does not agree. The basket has symmetrical rhombic shapes and mirrored asymmetrical hourglasses. It is obvious that creative choices have been made. Nothing similar appeared on the market before. The copyright protected elements of the Wire Basket are being used in the Burly Basket as well. The fact that the steal is a bit thinner and that the wires are welded is irrelevant. The overall impression is the

same, leading to the conclusion that there is infringement. The stock has to be destroyed and Lifestyle has to compensate the damages, including legal costs, suffered by Ferm Living (a total of 17.000 Euros).

#### Internet – online branding

### Domain name hijacking AJAX.FOOTBALL

Since 2013 many new domain name extensions have been launched. One of them is .FOOTBALL (especially for Football teams). From June 2015, the domain name became available to the public, for 19 Euros per year. Last autumn the domain name AJAX.FOOTBALL is registered by a third party (not Ajax or its fan club). This person sends an email to Ajax offering to transfer the domain name for the amount of 6.500 Euros. Luckily there is no need to start an expensive procedure at the court, in order to fight domain name hijacking. A good alternative is a simple and relatively cheap procedure before the WIPO. The demand has to fulfill three conditions.



Firstly, the domain name has to be identical (or very similar) to the trademark of the demanding party. AJAX is a registered trademark, so the first condition is met.

Secondly, the registrant has no legal rights or interests in relation to the domain name. This is the case, because the registrant trades under another name on the market and he was not granted permission to use the name, Ajax.

At last, the registration has to be in bad faith. In this case, bad faith was proven by the email of the registrant, offering the domain name for a price which is a lot higher than the registration costs (6.500 Euros versus 19 Euros).

Therefore, the domain name has to be transferred to Ajax.

### 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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