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Cancellation TESTAROSSA



VIAGRA is one of Pfizer's main trademarks. Since its introduction in 1998, the product is a great success with a yearly revenue of little over a billion Euros. The product is available on medical prescription.

However, success has its downside, when third parties try to take a piece of the pie as well. Discussing erection problems with a doctor might be a bit of an embarrassment for many men, which is probably the reason for a flourishing online trade of the product.

Research reveals that 60% of the amount of pills sold, is being obtained via illegal trade.

Recently, the sexually stimulating capsules, named VidaGra, have been introduced on the market. Offering a good alternative for a greatly needed and wanted product, like VIAGRA, is no problem, as long as it is marketed under a clearly different trademark.

This way the consumer will not be confused, competition will cause quality to improve and prices to go down.

Nevertheless, this case is a clear case of infringement of trademark rights, taking advantage of the possibly embarrassed consumers. Hopefully, Pfizer will put an end to this.

Copy rights – design rights

Infringement Scotch & Soda down jacket

Scotch & Soda sells down jackets since 2012. When Esprit launches a similar jacket in 2015, Scotch protests, claiming its copyrights (No European design was timely filed). Esprit stops the sale in the Netherlands and is willing to pay for the damages, but not for the whole European Union.

In Court, Esprit claims that the shape of the design is too trivial for protection by copyright. The judge disagrees. The jacket consists of several (commonplace) elements. The combination of these elements is sufficient to provide the jacket with a character of its own. The Esprit coat is almost an exact copy, making the same overall impression, and

is therefore considered an infringement. In Europe, copyright law is not yet harmonized. In the Dutch system Scotch & Soda is entitled to the copyrights, since it employs the designer, but in many other EU-countries such a provision does not exist. As a consequence, the claims for infraction of copyright are being rejected outside the Netherlands. It is a big shame that Scotch & Soda did not opt for protection by way of a registered EU-design. If that were the case, a judge would most likely have granted a prohibition and awarded damages for the whole of the European Union.



Cancellation TESTAROSSA

In many countries trademarks have to be used within 5 years, if not, third parties can initiate a cancellation procedure. Could this rule be used, to obtain a well-known trademark which is not being used anymore? This question was recently brought before the German Court.

From 1984 till 1996, Ferrari produced the TESTAROSSA cars. Famous, among other reasons, for the popular 80's TV-show Miami Vice. In 2013 the trademark TESTA ROSSA is filed in Germany and the EU, for electrical bicycles. According to the German press, this party did not want to pay for the costly license offered by Ferrari. The latter files an opposition against the (unauthorized) trademark application of TESTA ROSSA and the applicant strikes back with a cancellation action, due to non-use of the TESTAROSSA trademark for a period longer than 5 years.



The judge agrees. Ferrari still offers services like maintenance and repair in its own name, but not by the name TESTAROSSA. Also the sale of used cars is no sufficient ground to maintain the trademark rights. So the TESTAROSSA trademark has been cancelled. Fortunately, TESTAROSSA is still a well-known trademark. It is likely that Ferrari will win the case in the EU-procedure, in which they did base the claim on protection of a well-known trademark.

Thailand joins the Madrid treaty

WIPO'S International trademark registration offers the possibility of affordable trademark protection abroad. Almost a hundred countries have joined already. The latest newcomer is Thailand. From November 7th 2017, it is no longer necessary to go through the rather costly procedure of filing for a national trademark in Thailand. The large amount of Asian countries that joined the treaty lately is remarkable.

BALR – counterfeit and supplier

Three Dutch professional football players launch the fashion trademark BALR in 2013. The black and white T-shirts with the print BALR have become popular and well-known. Especially

when Angel di Maria, a famous football player, is spotted in a BALR t-shirt. The trademark is registered in 2015 for a wide range of products. In February, BALR is tipped off about the possible sale of counterfeit products. By way of a private investigator some sample products are purchased which, after a closer look appear to be fake.



The reseller hands over his remaining stock, but refuses to sign a prior rights agreement, nor is he willing to disclose the name of his supplier. BALR takes the matter to court and wins convincingly. In case of a trademark infringement, there is an obligation to reveal its source. The shop owner is summoned to end sale and is forced to hand over all correspondence, including invoices, between him and the supplier.

Ice cream and soft drinks similar?

For the new Magnum Ice-cream campaign, Unilever files the trademark RELEASE THE BEAST. The trademark is claimed for ice cream and ice lollies. Monster opposes on the basis of its word trademark UNLEASH THE BEAST, registered in 2011 for non-alcoholic beverages. The Benelux Office for Intellectual Property (BOIP) denies the opposition because the goods are not considered similar.



Monster successfully appeals the decision. According to the Court, non-alcoholic beverages are somewhat similar to ice cream, ice lollies, milkshakes and frozen yogurt. All these products are intended for human consumption and serve as refreshment. Furthermore, they are interchangeable. Consumers looking for refreshment can choose between a cold drink or an ice cream.

The products are distributed through the same channels, like snack bars, gas stations and supermarkets. The trademarks are visually, phonetically and conceptually very similar (a total of 3 words, nearly the same amount of letters, 2 of the words identical). Therefore, the trademark is refused for these goods. The decision proves the importance of a well-chosen classification of the goods and services. The right combination of generic and specific terms provides a broad protection of a trademark.

Importance of logo protection

As early as in 1999, Diesel registered its D-logo for clothing in the European Union. When Sprinter Megacentros files its own D-logo in the European Union, Diesel opposes. Initially Diesel's claim is denied, based on the assumption that the average consumer would not recognize the character D in the logo and see it as a mere trivial shape. Therefore the trademarks are visually, phonetically and conceptually dissimilar. However, the EU Court disagrees.



A substantial part of the public will recognize the character D, despite the fact that the capital letter is incomplete. Therefore, the trademarks are considered similar and the new trademark filing is refused. Especially in fashion, logos are very important. Consumers will see them as a trademark; therefore protection of the logo is at least as important as the protection of the name.

Design law

Queengarden: EU design infringement

Until a few years ago design law was of minor importance in the Benelux. Those days are over now. Over the last few years multiple decisions have been issued based on registered EU designs, like in this Honda case. Honda has protected the shape of its HONDA MSX125 as a registered EU-design. A Belgian distributor introduces a similar design on the market and the case is taken to court. The judge defines the relevant audience does not merely consist of professional traders, but of motorcycle affectionates as well. In addition, there is a lot of room for creative freedom. The Honda

motorcycle has numerous characteristic features like its stretched saddle, the exhaust pipe just below the saddle, the angular shape of the headlight and its side pieces.



All these specific features have been copied, resulting in the same overall impression. So further sales are prohibited by court-order and the decision is accompanied by a penalty payment to the sum of one million Euros.

Copyrights

Reasonable interest ordinary people

It is common knowledge that fame and fortune has its price. So, what about the privacy protection of ordinary people? As a rule, pictures of persons (with the exception of ordered portraits) can be used freely to a certain extent. The Supreme Court in the Netherlands has previously ruled that also ordinary people are entitled to protection, if they are being depicted for commercial purposes, as can be concluded from its decision in the IT's Disco dancer case. The audience might think that the person in question authorized the use of the picture and/or supports the campaign. This protection is often in conflict with the corporate freedom of speech. The question which of the two prevails is being considered in the Schiphol Picture case.



Volkscrant, a well-known Dutch daily newspaper, displays on front page a picture of an unknown person, easily recognizable, in a car carrying the following headline "Is Schiphol still safe?". The article is about increased security checks on the airport due to recent terrorism threat levels, and has nothing to do with the background of the person depicted. The person in the picture does not want to be seen as associated with terrorism and demands a rectification. Finally, the Court has to decide which interest has to prevail.

The headline and picture do not support the story in the article. Besides, the picture does not support or improve public debate. Therefore, the reasonable interest of the person depicted outweighs the freedom of press of the newspaper. The picture is considered an infringement of the person's privacy, and damages are awarded to the amount of € 1500,-.

Advertising law

Radio 538: naughty commercials

Dutch radio-station "Radio 538" has a reputation for making controversial campaigns, resulting in many complaints before the RCC (The Dutch Advertising Code) after the launch of every summer campaign. It is remarkable that the Netherlands seem to have become more prudish lately. See, for example, the Shameless campaign of Suit supply, featuring a lady drinking coffee while being "taken" on the kitchen counter (this campaign was allowed after all).



The new 538 commercial features a young woman, dressed only in a top, sitting in front of a blower-fan with her legs opened towards the viewer. A domestic cat is placed in front of her on the couch, blocking the view of the model's genitals.

According to the complaint, the image of the woman creates an association with pornography. The billboard is placed in plain sight at bus-stops. Therefore the campaign is allegedly immoral and lacking good taste.

In its defense of its campaign Radio-538 claims that a mere reference is made to sexuality, but not to pornography. The use of sexuality explicit images in advertisements does not automatically mean moral boundaries are crossed.

The RCC agrees with the latter. However, in case of outdoor advertising to be used at bus stops these rules should be applied more strictly, because the general public can hardly avoid this bill-board. A direct association with pornography is not created, but the positioning of the cat between the woman's opened legs is clearly meant to direct the attention to her genitals. So with this bill board in combination with it being shown in public bus stops, the line is being crossed, resulting in a warning to not use it in this way.

Online - internet

Vlogging: fee Botox treatment

Mascha Feoktistova is a well-known vlogger (her Beautygloss vlog has over half a million followers). She publishes a video about her Botox treatment on YouTube. Firstly claiming that she wants to treat herself to a present, but at the end of the video stating the following: *"Jani, of all people, if I would do it, I would do it with you, he is simply the best, doctors.inc is very professional...in the end I got the treatment for free, very sweet but it was agreed upon beforehand"*.

The video is only available on YouTube and underneath the link to the Video it is stated that Mascha received the treatment for free.



A complaint is filed. The video is said to be an infraction of the RSM (The Dutch Social Media Code). The RCC states that extensive description of the treatment accompanied by a laudatory remark like "he is simply the best of the best", upholds the conclusion that the video is to be seen as a recommendation. Via this vlog-post a large audience is reached, so it should be seen as an advertisement.

According to article 3 of the RSM a vlogger has to state if any form of compensation is received.

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.

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Sources:

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