

Bently motors takes a hit



Bentley Clothing has been selling garments, such as T-shirts, sweatshirts and hats, in the UK since 1962. Their products sell at prices between £ 25 and £ 45. Bentley Motors, also from the UK, has been known as a car maker under the brand BENTLEY for almost 100 years (its entry level model starting at £ 135,000). In addition to cars, the company sells clothing with the stylized B logo (not using the wordmark Bentley). When Volkswagen took over Bentley in 1998, it launched a clothing line of its own offering leather jackets at £ 2,400, knitted sweaters at £ 215 and polo shirts at £ 167. From 2000 onwards the wordmark BENTLEY is used for this completely new clothing line. The mentioned clothing

company approached the car manufacturer offering a license to use the mark. Bentley Motors however does not take that offer. The company even goes as far as to starting a cancellation procedure against the former's trademark. This claim was denied in 2017. As a counter-action, the clothing company files suit for a prohibition. The word BENTLEY in the logo being the dominant part, the trademarks are deemed similar and used partly for identical goods. The argument that both trademarks had coexisted for 30 years is also put aside. Competing goods have been offered since 2000 and, due to the cancellation action, there can no longer be any question of peaceful coexistence. The result: a ban on the new line of clothing products from the car maker.

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European Design registrations

Nullity design Porsche 911

Two requirements have to be met to claim design protection of a product through a registered design. The design must be new and have its individual character. A product has individual character if it makes a different overall impression from already existing designs. The freedom of the designer plays a role in this (designs may vary a lot or a little). If that freedom is very limited (for example due to technical requirements), smaller differences will be sufficient for a different general impression. The basic shape for the Porsche 911 dates from 1963. Almost every year Porsche makes slight design modifications, for which design rights

are claimed. Is this possible? Autec questions this, when starting an invalidity action submitting previous design applications of earlier generations Porsche 911. The Court of First Instance holds that the design freedom is not limited. The shape and contours of the car are almost identical. There are minor differences (e.g. headlights and door-handles). It is irrelevant that Porsche does not wish to deviate too much from its iconic form. The result: the model is invalidated. If you want to claim design protection as a manufacturer, file new applications only for the new parts and not for the complete product.



previous registered design



new design application

Chelsea and José Mourinho

Famous athletes often file their name as a trademark. They often hold these registrations in their own IP company. This way, the athlete can cash in on his/her popularity and tackle use of their name by third parties. This is not limited to sportsmen (such as Max Verstappen or Ronaldo). José Mourinho is probably the most famous football (soccer) coach worldwide. After Chelsea won almost everything under his rule in 2005, the club files the name and signature of the trainer as a trademark, but on the name of the club as a holder.



In 2013 the trainer returns to the club, but when he later switches to competitor Manchester in 2016, the question arises: who owns the trademark rights to the name? What is mentioned in the contract about this? During the transfer it was rumored that these trademark rights formed an obstacle. When Mourinho later switches to archrival Tottenham Hotspur in November 2019, the question arises whether his name can be used freely for all intended merchandising? The rights are still held by Chelsea, but the club does not renew the registration in time. This may be the result of a settlement between the parties. A lesson for the future. Register the trademarks on your own IP entity and license it out to yourself.

Brexit update – transition period

England formally left the EU on 31 January 2020. A transition period was agreed with the EU on 24 January lasting until the end of 2020. Existing Union rights continue to apply until the end of December, and nothing changes for holders of EU trademarks and designs. English representatives will also continue to be entitled to represent rights' holders until that same date.



If no further delays are announced, said IP rights will then automatically be split into a community right for the EU and a similar national right in the UK. The national English (split) trademarks are

not re-examined and no new office fees are charged. This is followed by a nine-month period for converting then open applications. An office fee will probably be due for this conversion. We will report if any new developments occur.

Vegan Butcher – the importance of filing a logo

Many companies use (semi) descriptive brand names. The advantage being that the brand name immediately clarifies what product/service is offered. The disadvantage is that such brand names are often not acceptable as a trademark. Why then can it be important to have the brand name registered with a logo?

The Herbivorous Butcher (a producer of vegetarian products) attempts to trademark the wordmark VEGAN BUTCHER in 2017 in the USA. The US trademark authorities refuse the application on grounds of it being too descriptive. The company assumes that then nobody can register the trademark on these grounds and takes no further steps.



However, Nestle files a trademark application for the same word mark six weeks later, and surprisingly, the authorities allow its registration this time. To prevent the trademark from being registered, the first company had to start an opposition procedure on basis of its previous use. Better to avoid such disappointments. If a descriptive mark is used and if it refused registration as a word mark, then attempt to register it with a logo. In the logo, the word is often seen as the dominant part. This way it is always possible to take successful action against third parties attempting to claim the word mark later on.

Cheaper trademark protection in Malaysia

Following Brazil it will also be possible to claim trademark protection for Malaysia through the International Registration system from now on.

Using this International route it is quite cheap and easy to claim trademark protection in many countries worldwide.



122 countries are now part of this treaty. In addition to the fact that the application costs are much lower, the costs of maintaining the rights are more attractive as well.

Damn Perignon Collection – trademark use in art

Trademarks are sometimes used in works of art. Well-known examples of recent years are: Darfurnica by Nadia Plesner with the Louis Vuitton bag and Banksy's Dismaland (Disney trademarks). Trademark owners often let this slide, in order to avoid negative publicity. However, can trademark holders be entitled to demand a ban? And can the artist invoke freedom of expression? Is the use of a trademark in a work of art a valid reason to infringe the trademark holders' rights? The Benelux Court of Justice has recently ruled on this question.



Moët Hennesy markets the famous Dom Pérignon brand of champagne worldwide. This champagne is sold in a characteristic belly-shaped bottle with a long neck and a shield-shaped label. Cedric Peers produces "contemporary pop-art" style paintings that depict these Dom Pérignon bottles, often combined with scantily clad ladies. These works have (according to the Court) an ironic and sometimes even erotic appeal. Moët Hennesy seeks a ban.

The Court ruled that the use of a brand in a work of art does fall under the artistic freedom/freedom of expression of the artist. So this is a valid reason. But there is a limit to this. A work of art should not be intended to damage the brand or the trademark holder. Let us hope that by this the Court means (as the Advocate General already indicated) that the limit lies with the primary

objective of harming the trademark. Experience shows that art sometimes needs to be shocking, offensive and disturbing in order to put a social theme at the center stage. It is up to the judge to ultimately balance those interests.

Copyrights

Zigzag pattern Nikkie Plessen

Copyright also applies to works of applied art. Because trends change rapidly in the garments-/fashion industry, manufacturers often rely on unregistered designs or on copyright to protect their designs. The disadvantage, of course, is that the burden of proof of the copyright lies with the manufacturer, whereas in the case of a registered design, the court assumes this. This plays an important role in, among others, the clothing of designer Nikkie Plessen.



Nikki has been marketing a red-black dress with a zigzag pattern since 2018. When Just Dai comes with a similar pattern on a pair of pants and a top body, she seeks a ban order. Nikkie submits her original design drawings. The judge concludes that this pattern is the result of creative choices made by the designer, and holds that the design is copyright protected. The design is also clearly different from the zigzag patterns that Just Dai has found. Because this eye-catching pattern is used, the overall impression is the same. The fact that this concerns a pair of trousers and body top is irrelevant, nor is the different colour scheme. The result: infringement is assumed, prohibition is ordered, along with a profit transfer, payment of the costs of the legal proceedings.

Advertising law

Meat is for men, vegetables are for cows

Humor is not equally appreciated by everyone. After the riot with Jan Kooijman, sauce maker Remia is back on the game

with its BBQ sauce advertisement. On the label of "Black Jack Smokey BBQ sauce" is stated: "For real men only" and "Real men, real meat, real sauce ... Meat is for men, vegetables for cows!" A complaint is made on grounds of gender discrimination and offensiveness to vegetarians and vegans. The statement is therefore offensive and in violation of Articles 2 and 4 of the Dutch media code, so it must be prohibited. The complaint is denied, both at the Advertising Code Committee and at the Board of Appeal. There is no question of discrimination. Remia clearly winks at the stereotyping that real men want to eat meat. It is therefore considered a parody, one that no reasonable thinking person takes seriously. That idea that cows can be taken as a reference to vegetarians is part of the joke. The Committee understands that they may or may not appreciate the joke, but that does not mean that the advertisement is unacceptably offensive to people who do not want to eat meat. The complaint is rejected, fortunately there is still some room for absurdist advertising, keeping the advertising blocks sufferable.

Online - internet

Active role required from Facebook with regards to fake advertisements

The number of Facebook users was estimated at 2.3 billion early 2019. This makes the medium an ideal platform for advertisers. Facebook therefore makes high turnover, last year the advertising revenues alone were estimated at around 45 billion dollars. It is no surprise that Facebook is also used by individuals with less honorable intentions.

Since 2018, advertisements to invest in Bitcoins are very commonly seen on Facebook. In addition, Dutch media tycoon John de Mol is depicted as a successful Bitcoin investor, however these ads are a scam and lead to fraudulent websites. John de Mol demands a ban on the use of his name or face, for which he has not given

permission. He claims that Facebook should act actively to prevent this.



Many victims of this scam have reported to the online Fraud authorities, who estimated the damage caused by these fake advertisements at 1.7 million euros. Facebook's argues that it is not responsible for this. They claim that they're just a neutral online channel and therefore not liable for fraudulent ads on the platform (the so called safe harbor defense). Court does not agree with this especially taking into consideration the active role of Facebook in selling sell ads on Facebook and Instagram. Facebook appealed the decision. Wondering who will support John de Mol, because now fraudulent Bitcoin ads are appearing on Facebook portraying other celebrities.

Abcor news

Jos van der Linden –certified attorney

This January 17th our colleague Jos van der Linden passed the final exam of the 2 year professional training and certification program of the Benelux association of Trademark and Design Attorneys, for which he received the official certificate. Of the 22 candidates with whom the course started in 2018, 13 received the highly coveted certificate on this day. After successful completion of the exam, candidates who also have a demonstrable minimum of three years of relevant work experience may apply for the official BMM certification mark. This makes Jos the fourth Benelux certified and European trademark and design attorney within Abcor's team.

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:

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