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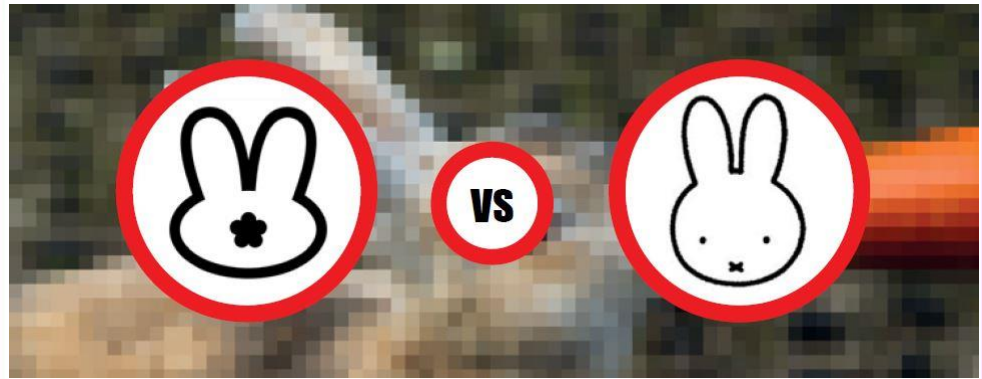
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Miffy's sex toys



When a logo depicting a stylized rabbit's head is filed in the European Union for clothing and sex toys, Mercis objects. After all, Miffy is known worldwide for its child-friendly innocent image.

Miffy has been registered as a figurative trademark in several variations for among others books and clothing, but not for sex toys. For that reason, Mercis also appeals to the notoriety of the character Miffy. That notoriety is substantiated by numerous articles on the origins of Miffy which show that more than 85 million books have been sold worldwide in more than 50 languages, awards have been won and all kinds of products and publications on licensed use.

Initially, the trademark will be cancelled only for clothing. The trademark will remain in place for sex toys. EUIPO judges that these products are not similar and are sold through totally different distribution channels. Also, it has not been proven that Miffy is a world-famous character.

Mercis (fortunately) appeals and submits a lot of additional evidence. This time successfully. Miffy is well known, the trademarks are similar, there is a link to the well-known trademark and the use of the new trademark is detrimental to the image so carefully built up. Consequence: the trademark application is refused.

Trademarks

Bad Spaniel's parody or trademark infringement

More Internationally, the US Supreme Court's ruling on whether the Bad Spaniel's dog toys infringe on the Jack Daniel's trademark is eagerly awaited.

VIP Products makes these chew toys in the shape of famous liquor bottles with similar labels. In the place of 'Jack Daniel's Old no 7' the products now depict 'Bad Spaniel's Old no 2' and '40% alcohol' has been replaced with '43% poop'. Jack Daniel's does not wish to be associated with this and demands a ban. VIP Products argues that this is a permissible form of parody.



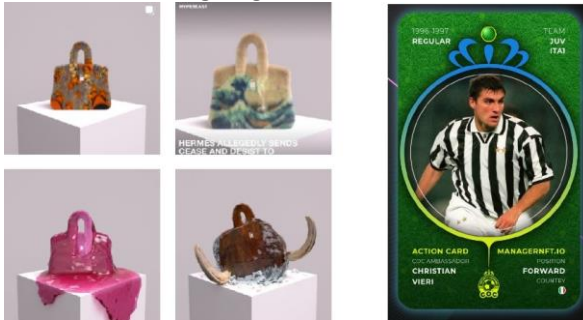
They state that since this is a creative expression, there is no dilution and no one will think there is a relationship with Jack Daniel's. We shall wait and see how the U.S. Supreme Court rules on this, especially since this is an ordinary consumer item. We have had similar cases in Europe. There, the parody defense has little chances of success. Often the verdict is that the sale of parody objects simply constitutes trademark infringement (see Puma vs Pudel, Harry Potter vs Harry Popper condoms and iPod vs eiPott eggcup, among others).

Trademarks

NFT: MetaBirkins and Juventus

NFTs and the Metaverse are a hot topic at the moment. The main question is, should trademark owners now massively re-file all their trademarks to include these digital products and related services?

Digital artist Mason Rothschild created and sold 100 NFTs of virtual Birkin bags via <metabirkins.com>. Hermes did not give permission for this and claims that this constitutes an infringement of its well-known trademark and demands a ban of the sale. The artist refuses, arguing that it is art.



Although the case is ongoing, initially Hermes was vindicated by the jury in New York. Partly because of the artist's statements on social media, which showed that the creator was primarily concerned with commercial success. For well-known trademarks, protection also extends to non-similar goods, such as NFTs. In this situation there is clearly a link to the real product and the use of NFT leads to dilution. Conclusion: trademark infringement and initial compensation of damages of USD 133,000.

In Europe there was a lawsuit surrounding NFTs of Christian Vieri in the famous black and white JUVENTUS shirt (digital cards with his image on them). The creators had a deal with Christian about this, but not with Juventus. Juventus claims infringement of its well-known trademark JUVENTUS. This trademark is also used for a wide range of merchandise items, including digital games. Therefore, the mark was also once applied for in Class 9, for digital downloadable publications. The goods are then deemed similar. The public may be confused and think Juventus is involved in the issuing of these NFTs.

In both cases, the fact that it concerns well-known trademarks played a role in the assessment. Therefore, it is wise to immediately extend protection to NFTs and the Metaverse in new trademark applications for consumer products. After all, not every company can rely on the broad protection of a well-known trademark.

Ban on KATY PERRY

When Famous artists, movie stars, athletes et cetera often register their names as trademarks. Not only for the services they provide under that name, but often also to start selling merchandise products. For example, almost every pop star now has their own clothing line or that person has licensed the name and/or image to another company.

KATY  PERRY

Katy Hudson, better known as Katy Perry, is a well-known singer-songwriter. On top of owning her own perfume line, she now also has her own clothing line.

In 2008, Australian fashion designer Katie Taylor had the name KATY PERRIE registered as a trademark for clothing in Australia.


katieperry
MADE IN AUSTRALIA

A problem arises when the pop star sells clothing under the KATY PERRY brand during her 2014 and 2018 tours. the Australian fashion designer argues that this constitutes infringement.

The final verdict arrived this spring, it was deemed trademark infringement indeed. Even if you are famous and are known by a special name, this is not a license to merchandise under that name. Avoid problems and just check this out with a trademark search, so you know in advance where the risks lie.

Brand BIG MAC normally used

The ruling in Supercor's cancellation case against the Big Mac trademark shook trademark law in the European Union. McDonald's relied on its prior trademark Big Mac in the earlier opposition proceedings. Because this mark was older than 5 years, McDonald's had to submit genuine use. The EUIPO found this insufficient.



Fortunately, McDonald's appealed and submitted additional evidence. The Board of Appeal (BoA) states that this is sufficient.

Fortunately, McDonald's appealed and submitted additional evidence. The Board of Appeal (BoA) states that this is sufficient. Also, the BoA provided additional comments. A Wikipedia page can serve as evidence if it does contain references to other reliable sources, such as newspapers and magazines that again provide information about the brand. In addition, consumer research, financial pieces and other articles clearly show that the trademark has been used to its fullest extent in countries such as Germany, France and the UK. The ruling is corrected, the trademark is upheld.

TOBLERONE and the Matterhorn

It is common knowledge that state symbols should not be used in trademarks. The reason being that consumers may deem the products/services approved by the government. In Switzerland, a law was passed in 2017 that goes a bit further. That law prevents companies from being allowed to use Swiss symbols/names if those products are not made in Switzerland. Think of symbols such as the white cross on a red background, certain mountains, as well as Wilhem Tell.



Depending on the type of product, the rules are stricter, but for dairy products, the requirement is that 100% of the material must come from Switzerland.

When Toblerone (founded in Switzerland in 1908) announces that it is moving part of its production to Slovakia, its packaging must also be changed. Not only are the words "Switzerland" replaced by "established in Switzerland 1908," but the summit of the Matterhorn also has to make way. The ancient mountain peak will be replaced by a more generic one. The question is whether consumers will notice this. They will mainly associate the chocolate and the quality of the chocolate with the logo, the triangular packaging and especially the triangular shape of the pieces of chocolate.

MK Michael Kors – cancellation trademark

Companies sometimes think they are safe once their trademark is registered and that possible older similar marks can then no longer be a problem. This is not correct.

Sometimes a company does not know that a similar mark is registered and only commences an action when confronted with it. Even then, all rights can be asserted. This used to be possible only through the courts, now it is also possible in a simple cancellation procedure with the trademark authorities.



Michael Kors starts a cancellation against the Union trademark logo MK. The logo consists of the white capital letters MK, positioned large and centrally in a circle with black background. At the bottom it states 'marktomi marktomi' in small letters. Michael Kors has a similar logo, with black letters in a circle with a white background is not and at the bottom the words 'Michael Kors'. The words at the bottom are clearly different and is this sufficient? No, the Court rules. The letters MK are substantial. They are in the middle of a white/black circle. The letters are the eye-catcher and thus the dominant part. Visually, the marks are similar. Phonetically too, as most will pronounce the marks as MK. The differences between the words at the bottom are too little to neutralize this. The mark will be cancelled. Avoid this kind of problem by researching the availability of a trademark.

Nike stops Max Verstappen

When Max Verstappen applies for the trademark MAX 1 for clothing, Nike objects based on its trademark AIR MAX. In the opposition proceedings, Nike wins. Max Verstappen did not appeal this. This is unfortunate, because there is much to be said against the ruling.



Max states that his trademark is pronounced in Dutch (everyone knows his name), so as MAX EEN (the number refers to his starting position in Formula 1). Due to the combination with the number 1, the trademark refers to his person.

The trademark Air Max consists of English words. It is pronounced AIR MEX. Not only does that sound totally different, it is conceptually different as well. The BOIP disagrees, stating that both trademarks will be pronounced in English in the Benelux and the public may think that Max 1 is a sub-brand of Nike. According to the BOIP, the name Max 1 is not (yet) synonymous with Max Verstappen in pole position. The BOIP follows Nike's reasoning that Max is seen as an abbreviation for maximum and that Max's prominence is not a factor. With regards to the conceptual comparison, there is much to disagree with. The issue here is precisely the combination of Max with the number 1. In my view, the verdict could just as easily have fallen the other way, because of the prominence of Max in pole position in Formula 1.

Advertising law

Misleading advertisement Nissan car

Nissan launched an advertisement on YouTube for the Nissan Qashqai with e-Power. The consumer sees images of a moving car with the text, "Who says you need a plug to drive electric? New Nissan Qashqai with e-Power. A unique electric experience, without a plug."



The complainant feels that the impression is given that the car is completely electric while it is not. The car is powered by an electric motor. It requires power, and that power is generated while driving with traditional fuel.

Nissan argues that there can be no consumer confusion because it is clearly explained in the showroom how the car works. However, the Advertising Code Committee agrees with the complainant. Consumers will think it is an all-electric car.

The advertisement does not clearly convey all the essential information. If consumers go to the showroom to buy a car based on this advertisement, they could be misled. Merely providing additional information in the showroom does not eliminate this.

Conclusion: in advertising on social media, clearly provide consumers with all relevant information so they can make a considered buying decision based on it.

Online

Reimbursement domain name transfer

Often companies forget to include separate clauses in cooperation agreements about the use of trademarks. For example, may a distributor register domain names or social media accounts in which the trademark appears? Should these then be transferred free and immediately if the parties part ways? In 2017, Kawasaki Motors entered into a verbal agreement with a third party. That party will offer insurance to owners of Kawasaki motorcycles. As part of the cooperation, the company is allowed to use the trademark and register domain names (in which the trademark appears).

In 2022, Kawasaki decides to end the cooperation, to which the user agrees. Then a discussion arises about the transfer of the domain name and the compensation the Respondent wants to receive. Meanwhile, the domain name <kawasaki-insurance.co.uk> remains active and Kawasaki motorcyclists can purchase insurance there.

Everything in these WIPO proceedings revolves around whether the Respondent has an interest of its own. Due to the termination of the cooperation, the Respondent no longer has the right to use the trademark. Not transferring the domain name is used as leverage to receive compensation. That is not legitimate. Use after termination of the agreement is use in bad faith. The domain name has to be transferred. If the defendant still wants compensation, then he should challenge the decision in civil court. The latter can then factor this into its judgment.

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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