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The publisher of Asterix & Obelix owns not only the ASTERIX & OBELIX trademark, but also a separate registration for OBELIX. When an identical OBELIX trademark appeared for ballistic weapons and hand grenades, the publisher initiated a cancellation proceeding. A link with such weapons could damage the reputation of the OBELIX trademark.

Both the EUIPO and the Board of Appeal dismissed the action. Use of OBELIX alone as a trademark by the publisher has not been proven. Furthermore, the public would not make a connection with the trademark because the goods are entirely different. Fortunately, the General Court corrected this

decision. Various products display the OBELIX trademark together with the ® symbol. In addition, when ASTERIX & OBELIX is used, the ® symbol frequently appears next to each word. When assessing whether the public would establish a harmful link, the EUIPO focused solely on the differences between the goods. That was incorrect. The assessment must consider all relevant circumstances, including the uniqueness and distinctiveness of the trademark and the degree of recognition it enjoys. The earlier decision was therefore annulled. When using (semi-) descriptive signs and characters, always include the ® symbol to indicate that they are being used as trademarks.

Trademarks

Restyled logo, new filing?

It is simply a fact of life: logos change over time. That is why it is always advisable to register a word mark as well. Such a registration can provide continuous protection to the word elements when a new logo is introduced. A trademark must be genuinely used within five years; otherwise, third parties may seek its cancellation. Following a rebrand or restyling, the question is whether use of the modified logo still qualifies as use of the earlier registered mark. In 2012, the KIF RADIO logo was registered for radio broadcasting services. In 2023, cancellation proceedings were initiated because



the mark was no longer being genuinely used. By then, the logo had changed completely. The Benelux Office and, on appeal, the Benelux Court of Justice concluded that the updated logo did not constitute genuine use of the registered mark. A trademark may be used in a different form, provided its distinctive character is not altered. Here, the changes to the typeface, colours, positioning, design, composition, background and wording were too significant. The trademark was therefore cancelled. The lesson is clear: register the word mark and file a new application whenever a logo is substantially restyled.

Trademarks

James Bond blasts Pond out of the water

Gameware applies to register the trademark JAMES POND for video games, clothing, toys and entertainment services. The mark is clearly a parody of the famous 007 spy. Unsurprisingly, the owners of the JAMES BOND trademarks opposed the application.



(bron beeld: www.nintendo.com/nl-nl/Games)

Gameware argues that the game has been on the market since the 1990s and that the mark has built up its own reputation. Does this argument stand a chance?

In my view, it does not. This is a clear case of riding on the coattails of another trademark's reputation. I therefore expect the application to be refused. Nor do I believe that a parody defence will succeed, as demonstrated by the IKEA decision.

Trademark protection in the Gulf States

The International Registration system is a cost-effective and straightforward way to obtain trademark protection in many countries outside the European Union, including China, the United States, Brazil and Canada.



The system now covers 133 countries, with Saudi Arabia recently joining the Madrid System. This brings the number of Gulf states participating in the system to five: Bahrain, Oman, Qatar, Saudi Arabia and the United Arab Emirates. Kuwait remains the only Gulf state outside the system. In addition to lower filing costs, the expenses associated with maintaining trademark rights are often significantly more attractive.

IP rights in mergers and acquisitions

In mergers and acquisitions, IP rights often play a secondary role. That is surprising, as a significant part of a company's goodwill is based on its intellectual property. This includes trademarks, design rights, domain names, social media accounts, copyrights, patents and trade secrets. Buyers often conduct a due diligence investigation before completing an acquisition. If IP rights receive only limited attention,

unpleasant surprises may follow.

During the due diligence process for the acquisition of childcare provider BLOS, IP rights were not considered particularly relevant.



The parties agreed that the seller would no longer be liable for possible claims after three years. You can probably guess what happened next. Shortly afterwards, Stichting Blossie, another childcare provider, sent a cease-and-desist letter. It owned the earlier BLOSSE trademark and demanded that BLOS stop using its name. As the parties failed to reach a settlement, the buyer was forced to rebrand its 200 locations under the new name Basker. A proper IP review would have identified this risk. When acquiring a business, do not rely solely on information provided by the seller. Independently verify the status of earlier rights.

IKEA: parody and trademark law

For many years, the question has been whether parody can justify the use of a trademark. Parody may fall within the scope of freedom of expression, while trademark rights are protected as property rights. When these rights conflict, the circumstances of the case determine how they must be balanced. The European Court has now provided guidance on that assessment.



In 2022, the Flemish political party Vlaams Belang launched its "Ikea Plan", a proposal to reform Belgium's asylum and immigration policy. In this context, Ikea did not refer to the Swedish retailer, but stood for *Immigratie Kan Echt Anders* ("Immigration Can Really Be Different"). Ikea objected, arguing that the campaign conflicted with its politically neutral position.

Vlaams Belang responded that it used the well-known IKEA name to strengthen and spread its message, which it considered a valid reason.

The Court disagreed. A parody may constitute a valid reason, but the purpose of the use is crucial. Relevant questions include whether the sign has a meaning of its own, whether the parody relates directly to the trademark owner or its activities, and whether the use merely takes advantage of the attraction of a famous mark. Criticism of immigration policy has no connection with IKEA, and mere free-riding is not enough. Given the extensive online use, consumers could even believe that IKEA endorsed the political message. The balance therefore tipped in favour of the trademark owner.

Animal Farm and 1984

Can a book title be protected as a trademark? Around the world, the prevailing view is that it cannot. The exception is where a title has become highly distinctive through use. In the EU, however, the approach has traditionally been the opposite. After several years of uncertainty, the Board of Appeal has finally weighed in, and little has changed.



When the estate of George Orwell applied to register the titles ANIMAL FARM and 1984 as trademarks, the applications were refused. According to the EUIPO, the titles describe the content of the books. The Board of Appeal agreed. A significant part of the public will immediately associate these titles with the stories themselves. Ironically, the more famous the title becomes, the more likely consumers are to think of the book's content rather than its commercial origin. As a result, the titles are not regarded as indicators of origin, which is the role of a trademark. Instead, they are seen as describing the content of the work. Therefore, protection for books and other media is unlikely. For unrelated products, such as socks or ceramics, registration may still be possible. The lesson is simple: register book titles in the EU as early as possible. Once a title becomes famous, trademark registration can become an uphill battle.

Design law

Mercedes-Benz-S-Class: inspiration or imitation?

Design protection offers a relatively easy way to protect the appearance of a product. To qualify for protection, however, a design must be both novel and possess individual character. But what exactly qualifies as new? Are a few minor differences enough? Five years after Mercedes-Benz launched the Maybach S-Class, a design application was filed with the EUIPO for a highly similar car.



The designer appears to have taken inspiration so far that he even 'accidentally' incorporated the Mercedes logo into the design. Mercedes-Benz responded by filing an invalidity action. According to Mercedes-Benz, the design was not new. Press photographs of the Maybach had already appeared online in 2020. The images clearly showed both the vehicle and the publication date, meaning that an informed user could easily have found them online.

The EUIPO agreed. In the automotive sector, designers enjoy considerable freedom, which means that small differences are often insufficient to create a different overall impression. The most important features of the vehicle had been reproduced almost identically, including the body shape, front and rear sections, headlights, taillights, grille and bumper. There were some differences, such as the fuel cap, a different roofline and the three-door versus four-door configuration, but these were insufficient to create a different overall impression. The design was found to lack both novelty and individual character and was therefore declared invalid. Inspiration is perfectly acceptable, but keep a sufficient distance. A final tip: do not copy the logo, trademark or emblem of your source of inspiration in your design.

ABBA has song removed from Spotify

As a parody of *Take a Chance on Me*, the Dutch carnival band *De Kapotte Kachels* released the song *Dikke Pens* ("Big Belly"). When the track reached one million streams on Spotify, ABBA successfully requested its removal from the platform. *De Kapotte Kachels* responded by taking legal action, arguing that the song was a parody and that the ban should therefore be lifted. A parody is generally permissible if it evokes the well-known original work while being clearly different from it. In addition, it must contain an element of humour or mockery.



The court accepted that *Dikke Pens* met these requirements. However, that was not the end of the matter. A fair balance still had to be struck between ABBA's copyright interests and the band's freedom of expression. That is where the parody defence ultimately failed.

The melody of the ABBA song could be heard throughout the entire work. Moreover, the band had a clear commercial interest. By distributing the song through Spotify, it was able to reach a large audience, generate streaming income and increase performance bookings. Unlike a temporary or limited parody, a song uploaded to Spotify is available continuously and worldwide. The lyrics also focused on obesity rather than romance, creating an association that ABBA considered undesirable. In those circumstances, the band's appeal to freedom of expression did not succeed.

The band may continue to perform the song live at events, but commercial exploitation through Spotify is not permitted.

Others**Fake trademark invoices from the Benelux Office**

Many companies that file a trademark application receive an email demanding payment of €1,800 within a few days in order to keep their application alive. The sender appears to be the BOIP, the official Benelux authority responsible for trademark registrations. The attached "registration certificate" contains the BOIP logo and the letter is even signed by the Director General. How is this possible, and more importantly, how can applicants protect themselves? The problem is only getting worse.



The answer is relatively simple. The names of trademark applicants are publicly available in the online register. As a result, they are easily harvested by automated scripts operated by fraudsters. If these details were not immediately visible, as is often the case for domain name registrations, much of the problem could be prevented.

That said, applicants also have a responsibility. Companies that file through a professional trademark firm and a certified Benelux trademark attorney significantly reduce the risk of becoming a victim. Any invoice from a third party relating to a trademark application or renewal should immediately raise red flags internally. Hopefully, the authorities will also take strong action against these rogue operators, preferably including criminal enforcement. Fake invoices are nothing new, but the scale of the problem appears to be increasing rapidly.

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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