

# ABCOR's ABChronicle



## Trademarks

### Association sufficient to ward off Swoosh

Famous brands have a wider scope of protection. The European Court in the case of L'Oréal / Bellure decided that "It is no longer admissible to sail in the wake of a famous trademark and profit from its reputation and prestige, without a financial compensation." Many court decisions followed based on this case, but they always concerned a wordmark. To date there is little case law on how these rules apply to pure logos (logos without any accompanying words).



Now finally there is a decision in Europe that concerns a famous logo. The issue revolves around Nike's "Swoosh" logo (an extremely well known brand) and a similar logo for shoes from a Chinese proprietor. The Court has ruled that the logos are not confusingly similar. But the marks resemble each other enough to be associated with each other. Confusion is not required for a reputable brand, association is sufficient to take advantage of the reputation of the Nike logo. Nike therefore won this case based on the reputation of her logo. A victory not only for NIKE, but for all famous figurative trademarks in general. in any countries in which you may use it.

### Louis Vuitton – Long live freedom of expression

Ever since 2008 when Danish artist Nadia Plesner designed a T-shirt with an African child on it holding a Louis Vuitton-like bag in her hand, there has been a fight with Louis Vuitton. In 2008 the T shirt was prohibited in France.



This year the fight flared up again because the image resurfaced on a painting: "Darfurnica". A contemporary version of Picasso's Guernica, that must be seen as an indictment of the (Western) World. The

humanitarian disaster in Darfur is symbolized by the thin African child with the hotly debated bag on her arm. To prevent abuse and to tackle counterfeiting Louis Vuitton has registered the design of the bag in the European register. Louis Vuitton was shocked by the action and started a procedure which resulted in an immediate prohibition with a penalty of € 5,000 per day. The artist objected, however.

As an artist, freedom of expression should still prevail over the design rights from the manufacturer. This is a clash between two fundamental rights, but the Judge decided that free speech should prevail. The earlier decision was reversed completely, including all penalties.

### Reapplication of a mark not in bad faith

A brand should be used within five years after registration, otherwise it becomes subject to cancellation by third parties. The idea behind this is to enable third parties to use a certain name if no one else is using anymore.



Sometimes, however, it takes longer to get a product on the market (e.g. drugs). Or a manufacturer may not want a competitor to start using the brand while the product are being phased out. For this reason, companies often re-register a brand after five years, in order to re-claim those rights. The question remains whether this is allowed (especially since there are different views on this in

This matter came up in a procedure concerning WE, a company that re-registers the mark ME every five years. The mark had actually not been used for nearly twenty years. WE, however, did not want any third party to use her old trademarks ME, SHE or HE.

When MEXX launched its campaign ME+XX, the problems started. The Court found that defensive registration of trademarks are in fact permissible. But that was not the end

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of this case. The court held that ME+XX was sufficiently different from ME, so that no confusion is to be expected. WE ended up with empty hands, despite having a valid and legitimate trademark. To add insult to injury, WE was ordered to pay the costs (estimated at € 35,000, -)

### War for a cup of coffee

Deac sells CAFEMA coffee to companies in the Netherlands. COFFEMA produces coffee machines for the professional market. In order to protect its trademark rights COFFEMA seeks to register her name as a trademark with the European authorities. Deac opposed this action, stating that coffee and coffee machines are so connected, that the market may think that the products originate from the same company.



The court agrees, which is striking. Previously, the European Court had ruled that even wine and glassware were not sufficiently

connected with each other. The Court specifically mentions this case but suggests that in order to prepare coffee from Deac a coffee machine is needed. Therefore, this time there is a stronger connection between the goods. The goods are complementary and the brands sufficiently similar in the opinion of the court, so much that confusion is expected. Therefore, a ban on the use of the name brand for COFFEMA for coffee machines, and for use as the company name, followed.

### Baby Gaga mother's milk

A restaurant in London has started selling ice cream made from breast milk, called Baby Gaga. Fifteen young mothers



supplied their milk and received an unknown payment in return. There are no English laws that prohibit the use of (human) breast milk.

Of course, the milk is first fully checked for pathogens. Ms. Victoria Hiley delivered the first three liters, enough for the first fifty servings.

When served the ice cream is flooded with liquid nitrogen and a cracker is added. The dessert is then served by waitresses in a "Baby Gaga" costume. On the first day of

the launch, the ice cream immediately sold out and the responses were very positive. The name is of course very reminiscent of the famous pop star LADY GAGA.

She has registered her name as a trademark for entertainment, CDs and printed materials, but also for clothing and jewelry, not for ice cream. Nevertheless, that is not an immediate problem in this case because LADY GAGA is in fact a reputable trademark. This means that the trademark may even be invoked against similar and identical marks that are used for completely different products, such as in this case ice cream.

LADY GAGA has not filed a complaint up until now, however. Perhaps the fact that she rather enjoys unusual and bizarre activities has prevented her from taking any steps.

### Shape of a Flash Light

Mag Instruments, manufacturer of the famous flash lights, registered the shape of the Mini Maglite as a trademark in the registers of the Benelux and the European Union. The flash light is a very big success (50% market share).



Mini Maglite



Mini Volume Trading flashlight

Trading Volume from China imported flash lights that were quite similar to Mag Instruments products. According to Mag Instruments too similar and thus Mag Instruments started a lawsuit. The procedure was based on its shape marks. There has been much discussion on the validity of shape marks in the past. The court simply states that Mag's shapemarks are valid trademarks. The intensive use of the established brands has enabled them to acquire the required distinctiveness. However, this was not the end the case. The question is whether the forms of both products are so similar, that the overall impression is the same. That was not the case. The main visual elements are the distinctive shape of the reflector, the cap and grip pattern on the handle. These key elements were different in Trading Volume's products, and therefore there was no infringement.

### Designs

#### Taking a stand

Van Raalte, specialized in plastic displays conceived and created a mobile plastic display with a separate base / stand. This

product was registered as a design in 2000.



In 2009 a competitor offers a similar display. The buyer is a acquaintance, who had negotiated in 2008 with Van Raalte on one order. Because of the price the order was canceled. So the negotiations ended and the contract was awarded to the competitor.

Van Raalte demanded and received a prohibition on the basis of its design rights. The court found that the overall impressions of the design were similar to the competitor's product. The differences were too small to offset the overall similarity. A prohibition followed as well as and a conviction in the court proceedings.

#### Copyrights

#### BRATZ / stolen or not? - 88 million

Bratz is a line of toys, featuring dolls with exaggerated facial features, owned by American MGA ENTERTAINMENT. The first dolls were launched in 2001, but the real success came in 2005 / 2006 when sales reached about two billion. The growth in market share (up 40%) came at the expense of Mattel's Barbie. When the Mattel My Scene line came (same body as Barbie but with larger head and eyes - like Bratz), first blood was drawn. Bratz launched a case against Mattel. Mattel also initiated a case against MGA since the BRATZ doll was designed by a former Mattel employee, during his time with Mattel.



Bratz - Bling pop



Barbie My Scene My Bling

Initially, Mattel won, despite the statement by the designer that he was not employed by Mattel in 1998 and that the doll was developed during a period when he was self employed between two the jobs. Ultimately, the federal court in California decided that MGA had not stolen the doll from Mattel. MGA will get a compensation of over \$ 88,000,000. Mattel will appeal against the verdict.

This case illustrates the importance of good and water-tight contracts with freelancers

or self-employed workers. If changing employers within an X number of years was regulated in the designer's contract all this may have been prevented.

#### Advertising

#### Slogan Check essential

Advertising campaigns are often not checked for problems with earlier marks. That is dangerous, especially if a campaign is planned to run for a long time. Chivas found this out the hard way. Chivas wanted to protect the slogan CHIVAS LIVE WITH CHIVALRY.

A simple check in the registry could have prevented the following problem from ever occurring.



Old Label Chivalery



Chivas Campaign

The Scottish Whisky company Glencairn opposed against Chivas' mark based on its English trademark registration, which concerned a label with the word CHIVALRY. Glencairn won the case. Similarity between an image (label) and a word (slogan) is possible. This is particularly the case if the earlier mark plays an important role in the overall impression of the brand. In this case, the whole idea is based around the slogan and around the word CHIVALRY. The average consumer may therefore think there is an economic link between the two brands (indirect confusion).

#### Sapph, misogynistic and discriminatory?

In our last newsletter we showcased a campaign by Suit Supply, that was borderline inadmissible. The Advertising Code Committee was not given a reprieve because a new case, this time against lingerie company Sapph followed almost immediately.

In the picture of the ad a Black man (in boxer shorts) is seen making a kicking motion towards the rear end of a Caucasian woman in lingerie. The accompanying text says "LETS KICK SOME ASS" and "K1 boxer Remy Bonjaski Sapph for Men". Bonjaski is in fact the new face of Sapph.

The filed complaint stated that this campaign was aggressive and would motivate men to kick women in the behind. Furthermore, because the man is Black, the ad also insulted men of color.



The Advertising Code Committee treated this case in a fashion we have come to expect, that is with great precaution. The Committee is generally very careful in banning ads, since determining exactly what is contrary to morality and unnecessarily offensive is highly subjective. The Committee declared that when viewing the ad it was clear that it was a staged photograph. Especially the posture of the woman clearly indicated that there is no element of violence involved. An appeal was made with the Advertising Commission, but the Commission had the same opinion. The campaign is not misogynistic and still in conformity with the standards of decency.

**Internet/ social media/ domains  
Website names acquire distinctiveness faster**

Within a few years time VAKANTIEVEILINGEN.NL (vacation auctions.nl) became a leader in online auctions of vacations. In 2010 the site was named the most popular website in the travel category. Success often leads to imitation, and sure enough a competitor launched VAKANTIEVEILING.NL. VAKANTIEVEILINGEN.NL immediately sued their competitor for the use of this website.



VAKANTIEVEILINGEN.NL invoked her word mark. The other party claimed that this mark was a purely descriptive name and therefore could not be invoked successfully. The court disagreed, however. Through intense use on the internet a name may acquire distinctiveness much faster than through traditional means. VAKANTIEVEILINGEN.NL had the required distinctiveness and won the lawsuit. The other party was prohibited to use her domain name any longer and was to pay damages (approx. € 13,000, -).

**Typosquatting - LOI calls on LOIKIDZ.NL**

In proceedings before the WIPO, LOI successfully claimed the domain name LOIKIDZ.NL. The infringer was a notorious typosquatter that had been convicted of

similar cases fourteen times already in the past.

Under the name LOIKIDZZ and using the website LOIKIDZZ.NL LOI provides courses, especially for children. Given the success of this new label, there are always parties that want to profit from it. Most often by registering a very similar domain name in order to generate sponsored links (pay per clicks).



LOI was not the only sponsored link on LOIKIDZ.NL. Its competitors also had sponsored links on the site as well. That way the owner of the website earned a buck from all of them.

The WIPO arbitration panel, however, did not see any good coming from practices such like these. LOI won the case based on their trademark. Opponent was clearly in bad faith by offering a pay per click site that had a domain name which was a clear typo. The domain name registration was transferred to LOI

**Domain name holders suffer from phishing**

Phishing is a form of Internet fraud, using a false (but identical) website. Especially banks are affected. As a user you get an email stating that, for example, you should check your login details on the site. That site is not the real site of the company, but a copy. The unsuspecting user logs on with his password or credit card number. With this information the fraudster obtains this sensitive information and no doubt will use it immediately.



The Canadian domain registry authority (CIRA) is currently being plagued by phishing. Holders of a Canadian domain name received emails with pictures of the official CIRA website, asking for personal information such as credit card information. Domain name holders please be forewarned!

**Abcor BV**

Abcor is an IP Law firm, Located in 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: Adformatie, BIE, BMM, Boek9.nl, Class46.eu, Domjur.nl, Elsevier, GPD, IER, INTA bulletin, Nu.nl, OHIM.eu, PCM-dagbladen, Quote, SIDN, Trademark Reporter and WIPO



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