

ABCOR's ABChronicle

Trademarks

Prohibition Van Haren for stiletto heels with red sole

Christian Louboutin has caused a revival of the stiletto heel. His shoes are easily recognizable by its red sole (and the 500.- to 1,000.- Euro price tag). Because of its stark contrast with the rest of the shoe, the red sole is stand out feature on all designs since 1992. It is an exclusive brand that celebrities such as Emma Stone and Jessica Alba swear by. The shoes are an international success and in order to ensure her interests Louboutin protected its red soles, not only to act against pure counterfeiting, but also against coat tail riding.



Louboutin shoes- Louboutin's CTM registration

Van Haren introduced black stiletto heels for 50.- Euros, which prompted Louboutin to act immediately. The Court in The Hague agreed with Louboutin that Van Haren infringed her trademark rights. The red sole is not a decorative element, but a trademark through acquired distinctiveness. The fact that the general consumer sees the red sole as a trademark is confirmed by the widespread counterfeiting on the market. Van Haren's shoe is visually similar to such a degree that a consumer may assume it is a Louboutin. Consequence: prohibition on sale of this shoes on penalty of 500,- per pair.

READY to FUCK! immoral

Trademarks are usually refused because they are descriptive. In some rare cases a trademark is refused because it is deemed offensive to a part of the public. In Germany the trademark READY TO FUCK! Was

refused for merchandising goods (such as clothing and printed goods).

The Bundesgericht agreed with this refusal.

Children and teenagers will also encounter these products

and for a large portion of the public it may be offensive. The applicant defends his trademark by stating that the letters AA are added, referring to FAAK a place in Germany. Apart from that 'fuck' is used in general to describe intensity. Not entirely unexpected the Court of Appeal does not change the earlier decision.



Google and the battle against generic use

Popular trademarks are sometimes used by the general public to describe a certain type of product. For example ASPERINE and LUXAFLEX, and GOOGLE and TWITTER in our time. For a trademark owner this is a nightmare, because generic use of a trademark destroys its ability to enable customers to determine its origin. Trademark owners should therefore actively repel any such use, which can lead to rather strange situations.



The Swedish language board added the word 'ooglebar' in the list of new Swedish words. The word means ungoogleable, meaning you cannot find something on Google or any other search engine. Google did not like this one bit and acted immediately with a cease and desist letter. Google was unable to prohibit the use of the word 'Google', but was successful in removing 'any other search engine', since you can google only on Google. Furthermore, a notification had to be added stating the GOOGLE is a

registered trademark. For the Swedish language board this was all too much, they decided to remove the word from this year's edition.

Interior of Apple Store protected

The Apple Store is a worldwide phenomenon. It has a unique and transparent character. Not only because of the glass front, but also because of the glass, floating stairs, the angular tables and the lighting. Its success is so large that worldwide (from the United States to China) competitors try to copy the look. Reason for Apple to protect her interior.



The authorities rejected the application at first, because the interior does not have a distinctive character. After a large report from Apple this decision was quickly overturned. Bad news for Microsoft who had objected against this application.

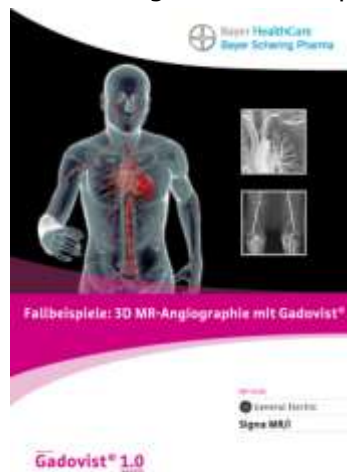
In Europe protection of interiors is usually done through design registrations. However, Esso and BP have successfully registered their gas stations as a trademark. Protecting your interior through a trademark registration is the more expensive and difficult route, but it will also give long-lasting protection.

Pharma

Gadovist vs Gadogita – use INN stem

The use of INN stems in trademarks has caused quite a stir. The World health Organization has issued a memo in 2011 on the use thereof. It is desirable that manufacturers do not base their trademark on INNs and that INNs are not used in trademarks. Because this is merely a recommendation, many countries did not include this in their legislation. The consequence of this is that

manufacturers are trying to find the limit of what is allowed. Trademarks are often composed of an INN (or variation on it) in combination with another word that may refer to application, for example. The question is what the extent of trademark protection is for such names. Bayer registered the name Gadovist for radiological contrast products.



When Agfa Healthcare Imaging Agents files the trademark GadoGita for the same goods Bayer starts an opposition. The beginning of the

trademarks GADO refers to gadolinium, the chemical solution used in contrast products. Policy is that the used stems are descriptive so that many comparable trademarks may coexist.

The Swiss authorities decided differently, however. Many contrast products on the basis of gadolinium are sold under different trademarks (without the element GADO). It is therefore no certain fact that GADO stands for 'gadolinium'. Consequence is that the trademarks are deemed similar and the opposition is granted. Whether this will be the new standard in such cases remains to be seen. When assessing a trademark's descriptiveness one should also take future use into account. The decision therefore seems to be drawn a bit too easy.

Copyrights

Copying a style is allowed

The Dutch Court of Cassation has recently given a very clear verdict on the extent of copyright law. Can a style or trend be protected against passing off if no copyright claims are available? The answer, clearly in line with previous rulings, is NO, unless

there are special circumstances. Artist Duijsens creates paintings of big men and women with notably pointy noses. Artist Theo Broeren also creates these type of paintings. Some paintings are so alike that there is an infringement of copyright. In other paintings only some key elements are similar.



Gerdine-Duijsens



Theo Broeren

These cases are not copyright infringements. In this case both the Court and Court of Appeal find that the two paintings are too alike and rule that there is an infringement. The Court of Cassation disagrees, however. Styles and trends cannot be protected through copyright laws. This would constitute a severe obstacle in cultural development. It is also not desirable to grant protection through passing off in cases like these.

Advertising

Pussy – irresponsible commercial

Misogynistic or sexually loaded commercials can usually expect their fair share of criticism. In the Netherlands the boundary of what is allowed is often being explored. It is clear that internationally the rules are a bit more strict. In England the advertising campaign for PUSSY energy drinks has been prohibited: 'PUSSY, The drink's pure, it's your mind that's the problem' (conceived by Trevor Beattie famous for the brand FCUK).



The campaign rendered 156 complaints with the ASA (the British advertising authorities). PUSSY had a sexual meaning and was sexist, misogynistic and derogatory towards women.

Because of this the campaign was not suitable for minors who could encounter the billboards. The

advertiser defended himself by stating that according to the Oxford dictionary PUSSY is a cat, or kitten, and therefore referred to feline characteristics such as aloofness, beauty and elegance. The ASA decided that although the word 'pussy' in the ad did not refer to women directly and this does not mean it is not derogatory. Because of the obvious double meaning of the commercial it does become derogatory. For older children the reference is obvious making it an unsuitable commercial. The campaign may therefore not be continued in its current form.

Internet

The new gTld's – Trademark Clearinghouse

On March 26 the TCH (de Trademark ClearingHouse) has finally opened. Around 12.000 new gTld's have been filed. Over 600 of those are generic names, such as .ACCOUNTANTS, .BIO, .CHEAP, .CLOTHING, .FINANCE, .SHOP etc. From a commercial point of view it can be interesting to link your trademark with the new extension when the type of services are mentioned. On the other hand it is necessary to block your own trademark on some new extensions, such as .CHEAP (to counteract online counterfeiting).



We expect the first extensions to be launched after the summer.

Trademark owners can already register their trademark in the TCH. The advantage is that this application can be used with every sunrise.

Furthermore, the owner will be notified in case of an application that is identical to his trademark. Rights in the TCH are obtained by registration. There is still much unclear about the procedure and when the first phase of the Trademark Clearinghouse starts. But, because we are already behind schedule, it is expected that one of

these days progress will be made. However, it is clear that the preventive blocking of trademarks will cost businesses a lot of money. It is estimated that the standard fees between are between 200 and 750 USD. Assuming the launch of around 1,200 new gTLDs blocking one trademark would cost around half a million. This would be impossible for many. It is therefore necessary businesses to already have an online brand strategy. Call one of our specialists in this field for further advice.

GOOLFY.NL – too complex for UDRP

In domain name conflicts there are two possibilities for a procedure. Either a court procedure or a procedure with WIPO, the UDRP. The UDRP was conceived in order to obtain a quick decision in simple infringement cases. However, sometimes this procedure is not optimal, especially if the case is simply too complex.



For one of our clients we have been able to successfully claim that the procedure at hand was too complicated for a UDRP. It concerned the domain name GOOLFY.NL. Plaintiff had involved multiple parties in the procedure, the original trademark owner had gone bankrupt and there was great confusion on whether or not the trademark had been transferred legitimately. Reason enough to deny the request for transfer simply because the case was too complex. A UDRP procedure seems easy and simple, however, sometimes it is strategically better to choose a different route. In this case a court procedure would have been better.

Adwords: Practicomfort infringes trademark rights OTOLIFT

The ECJ has decided that use of a trademark as an Adword is allowed as long as the consumer has the ability to determine the origin of the sign used. Across Europe the practical application of this rule is interpreted differently. In the Netherlands use of a trademark as an Adword is allowed if the use is part of an allowable for of comparative advertising. It does seem, however, that Dutch rulings are shifting toward the rest of Europe on this.



Practicomfort sells a variety of products including stairlifts from third parties. On Practi-comfort's website only stairlifts from competitors are offered for sale. In her adword campaign, Practicomfort using the word OTOLIFT, the following ad appeared: (translated from Dutch- traplift means stairlift)

Buy Traplift – traplift.nl - www.traplift.nl/ - Tip: Temporarily 10% discount on all stairlift models from 2012! stairlift Models – Advice – Quote-Brochures.

OTOLIFT is registered as a trademark. The Court decided that use of an Adword in this way this is a trademark infringement. The ad only contains the generic word stairlift. This may refer to stairlifts from OTOLIFT or third parties. The advertisement is not clear enough on what it offers, making it impossible for the consumer to understand that an alternative is being offered. The average internet consumer will assume that the devices are from OTOLIFT or an affiliated company, making it impossible to determine the origin of the products.

Abcor BV

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

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