

In dit nummer

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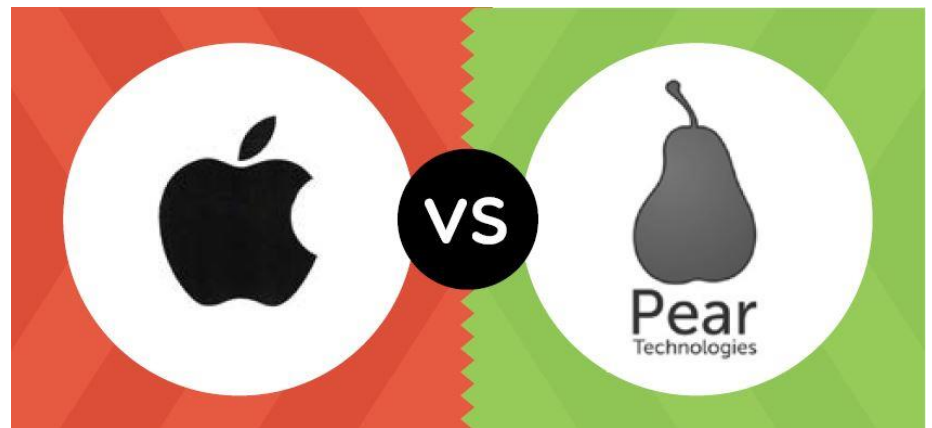
Jägermeister: design filings
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Free eBook: IE-in Bedrijf:
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Comparing apples to pears/ oranges



Well-known trademarks have a broader protection against third parties that seek to take advantage of their reputation. How far does the protection reach? For many years, Apple has been one of the most valuable trademarks in the world. The brand is known for more the 35 years, as innovative and has a formidable reputation. The Apple logo is a distinctive sign that appears everywhere (for example on the iPhone and iPad). When Pear Technologies from China files for protection for a stylized pear to distinguish ICT software products, Apple files a complaint.

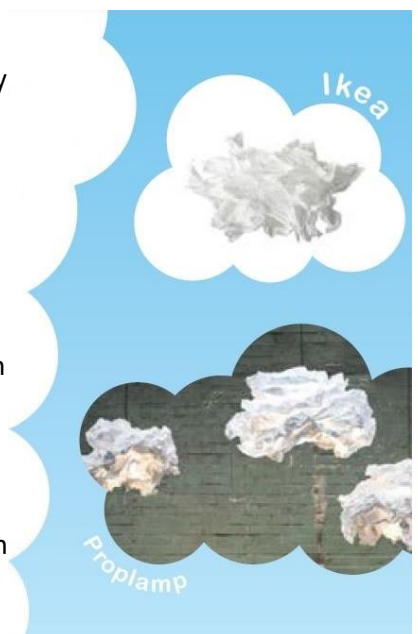
Eventually the Board of Appeal has to compare the apples to the pears and, perhaps to the surprise of some, the Board judges that the pear logo is an infringement. The key factor is the proven reputation of the apple logo which is very well-known. Furthermore, both logo's are stylized pieces of fruit resulting in a great conceptual resemblance. The consumer will associate both logo's, because of the acquired distinctiveness of the Apple logo. The latter is known for its high quality products, so Pear would profit from its reputation. Therefore, the trademark application is refused.

Unfair competition – design rights

Ikea lamp not derived from Proplamp

An idea itself cannot be protected, only its implementation can. The shape of a product can be protected by copyrights or design rights. If these rights are not available, in the Netherlands one can rely on the regime of unfair competition to protect the shapes of its products. Especially in the case of counterfeiting this ground has been invoked on a regular base. However, what if a third party, by coincidence, develops the same idea independently? This is the main question in the Proplamp case. In 2010 Margje Teeuwen designs the Proplamp, a preshaped lamp that can be further shaped by the customer. De lamp was sold to the Gumbar in

Amsterdam. In 2013 it is succeeded by a synthetic version. In 2014 Ikea enters the market with a similar lamp and the question arises if this lamp was developed independently or derived from Teeuwen's lamp. De judge is convinced that Ikea did not know of the existence of the Proplamp. Therefore, the introduction of the lamp is not a case of unfair competition. The whole case would probably have been judged differently if Teeuwen had registered the lamp as a design. In that case, the similarity of the overall impression would have been the key factor.



Trademarks

'Witte wieven' are witches

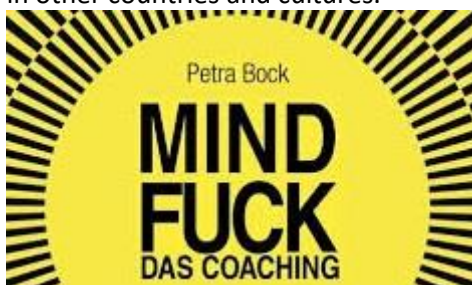
Trademarks may not be confusingly similar. The trademarks are being compared in order to decide if this is the case. The judge compares the trademarks visually, phonetically and conceptually. However, is one of these criteria sufficient to obstruct another trademark. This is the central question in the 'Witte Wieven' cheese case. Heks'nkaas (literally translated: witches cheese) is very popular in the Netherlands and is registered as a trademark for cheese, cheese based sauces and spices. When the trademark Witte Wievenkaas is being applied for to distinguish cheese smears Heks'nkaas opposes.



In first instance the complaint is denied, but the court decides differently. According to the court, witches are female and magical creatures that frighten and usually live isolated. They possess magical powers, which are used for evil purposes. Witte Wieven (women with white hair) are witches as well, according to the court, so conceptually the trademarks are strongly similar. Therefore the trademark Witte Wieven is cancelled from the register. A pity though, that the court has not taken into account the fact that Heks'nkaas is a well known trademark. The decision would have made a lot more sense.

Refusal Mindfuck

Not every trademark is automatically accepted by the authorities. As everybody knows, a trademark should be sufficiently distinctive, in order to be admitted. But there are other criteria as well. For example, a trademark may not be conflictive with the public order and morals. In the Benelux trademarks are hardly ever refused on this ground. However, this might be different in other countries and cultures.



In Switzerland, the trademark MINDFUCK, to distinguish clothing and mental training, has recently been refused. Whereas the trademark

trademark was accepted in the surrounding countries, like Germany, Austria and Liechtenstein. The Swiss authorities reasoned that FUCK (also in combination with the word MIND) refers to sex, and for that reason it is deemed offensive to a part of the public. This decision is not unique. Before, the trademarks FUCKING FREEZING (European authorities) and READY TO F**K (German authorities) were refused as well.

LOCK - why to register logo's?

A word trademark registration covers the use of the word in every writing style. For that reason, companies prefer registering trademarks in standard characters. So if the logo changes, the word will still be protected via the wordmark registration. However, sometimes the design of the logo does not clearly reveal which word it contains. In these cases the logo should be protected as a trademark as well. The LOCK-case is a good example. The holder of the German word trademark LOCK files a cancellation action against the European trademark LOCKMASTER. Both trademarks distinguish electric motors. The wordmark LOCK is older than 5 years, so the use of the trademark must be proven.



The holder of the mark files several documents: certified declarations of its director, a catalogue and pictures of the products. In all the evidence, only the logo is displayed and not the wordmark itself. The European authorities judge that the average consumer does not recognize the wordmark in the logo (with the gearing wheel and the stylized letter "L"). As a consequence, the cancellation action is denied, because the normal and proper use of the invoked wordmark LOCK has not been proven. Therefore, in case of complex logo's it is advisory to not only claim the wordmark, but the logo as well.

Increasing number of hashtag brands

There are various types of trademarks. Besides words and logo's companies also claim less common signs like, packaging, melodies, and even the outline of a shop. Since 2010 there is a new player, namely the hashtag trademark.

Recent research shows that in the past year more # trademarks have been filed. Most of them in the US. The hashtag itself does not make a trademark distinctive, so a combination with a descriptive element will not be sufficient to pass the absolute grounds test. For this reason, probably a lot of social media campaigns are not registered as a trademark.



Furthermore, many of these campaigns are short term only, and therefore alone not registered as a trademark. The same goes for campaigns on Twitter. However, if a campaign is used consistently and for a longer period, a registration as trademark is recommended.

Design law

Jägermeister: photos or dotted lines

In order to register a product as a design, a number of images should be filed, which basically explain what the design actually looks like. Not a great deal of other demands need to be fulfilled. Almost every design filing is accepted. Validity problems just arise in case of conflicts. However, one of the few demands that are required of the images is that they have a neutral background. Not too difficult to overcome, but in sometimes it apparently is. Recently, a design application for cups in the name of the firm Jägermeister has been denied. The images displayed a bottle and a glass.



fictional similar erroneous picture

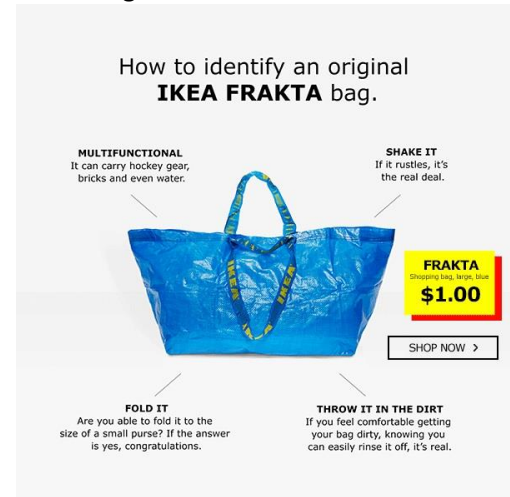
The court judged that the refusal was legitimate, because the Locarno classification (a glass) did not coincide with the images. Jägermeister should have used dotted lines for the bottle, if they really

wanted it to be displayed as well. In this case it was not clear what the protection was claimed for, so the application was rightfully denied. Therefore, prevent these type of problems and use the expertise of a recognized European Trademark Attorney.

Copyrights

Humour or cease and desist letter?

During Balenciaga's spring show, all of a sudden an oversized bag is shown on the catwalk which very much resembles the famous cobalt blue Ikea bag, designed by Marianne and Knut Hagberg. However, the shown bag is made of leather and has a zipper. Apart from that, the bag only costs 2.145 dollars. Ikea could invoke its copyrights on the design (which apparently has not been registered as a design right). The shape of common day to day products are protected by copyright, if they can be considered as intellectual creations, where the designer made personal choices. So legal action is possible in this case, but is it the smart thing to do?



Acne collective

Ikea chooses another path, humour. In our opinion, a brilliant move that goes viral and gains overall sympathy among the public. The Swedish marketing company ACNE came with the idea of an online action: the four best tips how to reveal the original Ikea bag (among others of course the price, the original costs only 0,99 dollars) A legal action might be tempting in case of infringement, but a humorous reaction might be a better alternative. Especially if the targeted audience is completely different, or in the case of social media expressions. When the positive and funny reaction goes viral, more goodwill and advantages will be gained for the company than by a lawsuit.

18 months in prison - scam

For the first time a suspect has been condemned, in the Netherlands, to 18 months in prison for sending fake invoices. By the end of March this year, the court of Arnhem-Leeuwarden judged that a scam had taken place. The case originally started in 2008. In December that year the suspect sends a first mailing of 385.000 letters to companies for the Chamber of Commerce contribution. On the invoice (149 Euros), a logo is displayed that strongly resembles the logo of the Chamber of Commerce in the Netherlands.



Thanks to the Chamber of Commerce's immediate reaction, the other letters are prevented from being sent. However, 530 companies already paid the invoice to the cheating party (total amount of 79.000 Euros) and 1.255 companies paid directly to the Chamber of Commerce (186.995 Euros). In this lawsuit the suspects are condemned for fraud. Both the logo and the word KVK (abbreviation for the word Chamber of Commerce) are registered as trademarks. The mischievous use of a similar layout, colour and logo is punishable by law. Besides the use of the logo trademark is an infringement of copyright. Therefore the court ruled that an imprisonment of 24 months is suitable. Because of the length of the procedure, the final judgement is 18 months.

Acquisition fraud is an immense problem for companies. Especially with the registration of trademarks and domain names. It's time for a chance worldwide, in order to tackle this problem seriously. Therefore, everybody should directly report the receipt of a fake invoice or payment of the same to the national authorities, or contact teams

dealing with this issue within ECTA, Marques and INTA.

Abcor in the press

Free eBook IE-inbedrijf part 4

Spring this year, part 4 of the eBook series IE- in bedrijf, which Theo-Willem co-authors was launched. The series follows the life cycle of a company (from start to sale).



This book focusses on comparative advertising, misleading advertising, the use of portraits, famous persons and ambush marketing. The working guide is made for mid-sized companies and not specialised IP lawyers. The book, which is in Dutch, may be downloaded for free at: www.ie-inbedrijf.nl.

New trademark advisers at Abcor

Per April 1, **Mirjam de Werd** and **Frank Schouten** joined the Abcor team in Leiden. Mirjam de Werd started her career at a trademark agency and made a transfer to Danone, where she handled the IP portfolio Asia-Pacific as an in-house attorney.



Afterwards, she worked as an in-house legal counsel at TV Entertainment Reality Network (new TV-Channel). For the past 15 years, Frank has worked at several trademark agencies, like VO Patents & Trademarks/ Houthoff Buruma Amsterdam/ Merkenbureau Keesom & Hendriks.

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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