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Bulldog – why trademark a logo?



In the Netherlands we have a very quick procedure in place to get an immediately enforceable banning order issued by court (the so called Art. 1019e). However, recently courts have become somewhat reluctant to grant such a request. In fact it is almost never granted anymore. The problem being that the opposite party has no right of speech. Only in the case of an obvious infringement this measure is sometimes still granted. The Bulldog logo is registered as a trademark. Not only for the services of a so called "coffee shop" (a place where soft drugs are sold legally in the Netherlands), but also for accessories such as weed grinders. When Magic Leaf starts

selling grinders with a very similar logo, Bulldog objects. Because the other party does not agree to hand over inventory and is not willing to sign a waiver, Bulldog starts such a ban procedure. It's important, because this will prevent Magic Leaf from selling out stock before the actual lawsuit.

Court agrees that the Bulldog logo is a well-known trademark. The figurative marks are quite similar and the consumer will associate the offered goods with the popular shop. So the court grants the request for a direct prohibition plus a EUR 5,000 penalty per violation. Therefore one should not only file a wordmark, but consider filing their logo as well, at least if this is distinctive.

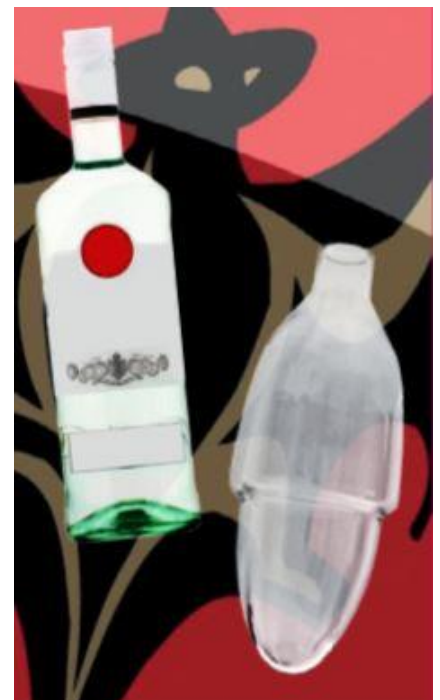
Trademark- shapemarks

The revival of the shape-mark?

There are more possible trademarks than just a logo or a word. Other characteristics also have the ability to distinguish one vendor's offering from another one's. A shape, sound, motion picture sequence or a pattern. However in practice it can prove difficult to get these kinds of marks registered. The authorities often assume that the consumer does not perceive these as a trademark, the shape is seen as commonplace. However it looks like this might change in the near future. For example, Bacardi succeeded in registering its bottle with red wax-seal, white cap and banner logo as a

trademark (without Bacardi written on it). The cap, the seal and the shield are no longer seen as purely decorative and the combination is enough to distinguish the bottle from other vendors' bottles.

A request for an amphora shaped bottle also made it to registration, by virtue of the narrowing part in the middle. These rulings seem to usher in a new policy. Enough reason for companies to give it another try and claim special shapes or designs as a trademark. The consumer has perceived them as trademarks for years, possibly the trademark authorities will now do so too.



Trademarks

Trademark BIG MAC not used???

In 2016, the word and logo SUPERMAC'S has been filed as a trademark for a new chain of fast food restaurants. McDonald's opposes this filing because SUPERMAC'S sounds confusingly like BIG MAC. McDonald's bases its opposition on their 1998 EU-trademark registration. As a counter-measure, Supermac's incites a cancellation action against the Big Mac trademark. The trademark is over five years old and the holder must prove that the trademark has been put to real and effective use for the past five years. McDonald's provides figures claiming Big Mac hamburgers sell over 200 million units per annum, along with screen-prints of websites and tons of advertising material. Yet all that evidence is set aside by the European trademark authorities for being too generic. There is no proof that a burger has actually been sold to a consumer. Additionally, no indication was given as to what extent the advertising material had been distributed. Consequence: the Big Mac trademark was canceled.



We see this problem more often with large companies selling directly to consumers (i.e. retailers etc.) as opposed to through online shops. To avoid this problem, some companies re-file the trademark every five years (so there is no obligation to submit proof of use). McDonald's did this too, but too late, in 2017. That might seem expensive, but it avoids many problems. Yet it would be nice if the European Trademark authorities would adapt its policy on this point. If convincing advertising material is submitted from several countries, this should be sufficient to maintain a trademark with supporting proof of use (such as statements). Fortunately for the corporate world McDonald's is appealing this.

Free riding on a familiar layout

Not only the typography of Coca-Cola is world famous, also the white wave against a red background design has a high grade of recognition. These elements are naturally registered as trademarks. When a Chinese importer starts using a similarly shaped logo, Coca-Cola objects. It starts a cancellation procedure against the EU trade mark, regardless

the fact that that mark was filed in black/white with the words PanPan. Nonetheless, the cancellation is successful.



The European authorities are of the opinion that although the trademarks are visually slightly similar but, because the wavy line is world-famous, the public will still it associate with the reputable Coca-Cola brand. But does the Chinese company also wrongfully benefit from the reputation of the Coca-Cola trademark? It does! Coca-Cola uses the logo in this format a lot, also in combination with other languages/scripts, like Arabic, Chinese, Cyrillic etc. In addition, the Chinese holder effectively uses the trademark without PanPan and on a red background. Coca-Cola wins and the PanPan logo is canceled for soft drinks and similar products.

Crocodile not exclusive to Lacoste

Lacoste has registered its crocodile emblem as a device-mark for clothing. Does this give the company a right to ban *any use* of crocodiles on clothing? The lawsuit that Lacoste filed against Dutch retailer Hema revolves around this question. In spring 2018, Hema launches new gray shirts and underwear with a variety of animal figures, one of which resembling a crocodile. Lacoste demands a ban, claiming the creatures look too much like the Lacoste logo. Hema in its defense claims that this is an adornment and that the general public does not perceive these creatures as a trademark.



The court agrees with Hema. The clothes display various animals. With children's clothing it is not unusual to see printed animal figures. Consequence: the public does not see the pattern of crocodiles as a trademark. This is purely decorative use (and no coat tail riding).

Lacoste submits a market research, but that does not hold in court either, as the form the questions are formulated is guiding. The claim is completely rejected. Conclusion: the use of different animals as a pattern is not easily seen as trademark use of someone else's logo.

Merchandising Amsterdam University

The Benelux trade mark office can refuse a trademark if it feels that this is descriptive. This decision can be appealed at the Benelux Court of Appeal. In the past ten years the Court of Appeal in The Hague has almost always followed the line of the BOIP, but at its latest decision from December 2018, the BOIP is suddenly overruled. A sign of hope for the future?



The UvA (University of Amsterdam) applies for protection in 2016 for the word mark AMSTERDAM UNIVERSITY. The trademark is not only refused by the Benelux authorities for educational services, but also for all kinds of merchandise items (such as coffee mugs, sweaters, etc.). These articles are in fact available at the UvA. The UvA offers these articles for sale in a souvenir shop or as giving them away at times.

The Court partly disagrees with this refusal. In an earlier judgment on Neuschwanstein Castle, the European Court of Appeal had to rule about trademark use for souvenirs. By trademarking souvenirs, the product doesn't suddenly become descriptive. Consequence: the trademark is not valid for educational services, but for merchandise items it is. For organizations active in merchandising (such as city marketing organizations) this ruling is a gift from heaven.

Hakuna matata and colonialism

The Lion King is launched in 1994 by Disney. To prevent parasitic use, the company registers the film title and logo as a trademark. Also songs titles from the film score, like "Hakuna matata", are trademarked (for T-shirts). With the upcoming relaunch of the film this year, Disney is suddenly involved in a riot. The

petition website <change.com> demands cancellation of the 1994 mark (the petition was signed more than 180,000 times). The trademark means 'no problem' in Swahili language. By this trademark registration, Disney would claim ownership of a piece of African cultural heritage. The petition's initiator sees this as insult and disrespect for the African population.



From a trademark law perspective, Disney does nothing wrong. With the registration, the company wants to prevent the sale of clothing by third parties under this trademark. No claim is made on the expression itself. That nuance is completely lost in the online discussion. As is the fact that the trademark has already been registered 61 times by third parties around the world, in the hope of being able free ride on the success of The Lion King. As a company, one should be aware of the sensitivities in the registration of images and expressions that belong to the cultural heritage (such as ALLAH, JESUS and the Night-Watch etc.). Sometimes it is better to choose an alternative.

Design law

Chinese scooter lethal for Multimox

Many companies register the design of new products in the EU with a Community Design. This allows counterfeiting to be tackled easily and the company maintains a monopoly on this design.



However not every design can be claimed just like that. The design must be novel and have its own character (something creative). However, this requirement of novelty applies worldwide and the authorities in the EU do not actively check this. So the applicant should always check first with the design team (or the manufacturer) if the design is actually new. If this is not the case, third parties can easily cancel the rights.

Multimox registers the design of its scooter in 2006 as a Community Design. Competitor Asian Gear is about to start selling a similar scooter, so it starts a nullity procedure against the CDR claiming that the design is not novel, because in 2005 a similar model was registered in China. But could a company have been aware of this in this pre-internet period? Yes, even back then design registrations could be checked via a trademark agency. This requirement of novelty applies worldwide, so the fact that the company has no registration in the EU is irrelevant. An older Chinese registered design is sufficient. The overall impression of both scooters is the same. Consequence: the design rights have been canceled and Asian Gear can start trading an alternative product.

Advertising law

Telephone scammers offer domain name registrations

A Dutch timber company claims it has been contacted by a company called “the Trademark Office” in 2018 with an offer to register its company name as <.com> and have it redirected to the <.nl> website for ten years for an amount of €297,- (per year). An audio recording was made, just from the moment the company agrees to the proposal (at the end of the conversation).



de Rechtspraak

After a few days the timber company sends a registered letter in order to cancel the contract for deception and error. The person calling had claimed that this “Trademark Office” is an independent organization overseeing internet domains and that a

competitor had tried to capture the <.com> domain name, but the timber company had a right to first registration. This false statement led the timber company into accepting the proposal. Of course these were false. A lawsuit follows, because the timber company claims nullity and refuses to pay. In court, Trademark Office denies that these statements had been made, only fails to produce recordings of the whole conversation. Court rules that it is to Trademark Offices discretion to record the entire conversation or not. When later a discussion arises about the content of the call, this is at the risk of the company. For this reason, the judge agrees with the timber company and the contract is nullified for reasons of deception.

Online - internet

Ok.nl – necessity of an active website?

A legal battle has been going on for years about the very nice domain name <ok.nl>. Gaos has registered this domain name as far back as 1999. Fuelplaza operates petrol stations and has owned the OK logo since 2003. The company uses the domain name <okolie.nl> online. The domain name <ok.nl> is however preferred. First the company attempts to buy the domain name. If this does not work, several lawsuits follow, up to the Dutch Supreme Court. Gaos plans to use the domain name for a social purpose, it claims, but it still has no active website on the URL. Is that allowed? The courts have ruled on this before. Not actually using a domain name is not enough reason to be forced to transfer the domain name. Unfortunately, the Court has not ruled on the descriptiveness of the name and that there are also dozens of other trademarks with OK. The Supreme Court has now put an end to all discussion. It rejects the appeal of FuelPlaza. An active website is not necessary. Only one option remains, get in touch with the holder and offer to buy the domain name at a reasonable price.

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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Contact Abcor

For more information please contact us:

ABCOR B.V.

Frambozenweg 109/111
P.O. Box 2134
2301 CC LEIDEN
The Netherlands

Tel: +31 71 576 3116
Fax: +31 71 576 8947
E-mail: info@abcor.eu
Website: www.abcor.eu

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