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## Tiger and Giraffe nuts



Since 1993, Frito-Lay has been marketing TIJGERNOOTJES (TIGERNUTS); a peanut with a crispy shell. As result of the baking process, the outer dough layer is cracked. therefore, the nut has a varied pattern in the colours orange/brown and yellow. The baking process had been patented, but its protection has now expired. In order to protect the unique look and feel of the product, Frito-Lay has also trademarked the packaging and the nut itself. When the Aldi introduces a very similar looking product under the name GIRAF NOOTJES, a lawsuit follows. The use of the name GIRAFNOOTJES is not deemed a

trademark infringement. Conceptually, the trademarks are similar. A tiger and a giraffe are both wild exotic animals with spotted skins. However, the words TIGER and GIRAF differ sufficiently, both visually and phonetically. Also the packaging does not infringe. The situation is different for the nuts, they are identical. The registered trademarks for the nut is a position trademark and it is valid. As of 1 March 2019 new legislation came into force by which these trademarks are protected, but GIRAFNOOTJES cannot invoke this because the trademarks of Frito-Lay are older. As a result GIRAFNOOTJES in this colour are banned.

## Well-known trademarks

### Red Bull's reputation

Red Bull has a reputation of vigorously enforcing its trademark rights. Actions are taken against every new player in the market for energy drinks, using the word BULL or any other animal depicted in the logo. Sometimes the branding differs so much from the Red Bull trademark that it becomes questionable whether a consumer will confuse them. But as the Red Bull trademark has been such a well-known brand for years, it can often act successfully against "infringers". In 2016, Big Horn files a trademark for its logo in the European Union.

Red Bull objects invoking a number of its trademarks, including the logo of the fighting red bulls in front of a yellow sun background. Market figures, marketing costs, campaigns and research are submitted showing the reputation of this logo. Red bull gets its way. Even though the similarity between the trademarks is low, the public will still see a link with the well-known brand. The filed trademark uses the same concept: two horned animals duelling. Big Horn seeks to take advantage of the great popularity of Red Bull. The application is therefore refused.



## Trademarks

### Guns 'N' Rosé beer

Rock band Guns N' Roses has been an established name for decades. Its popularity hasn't faded, given the 17 million followers on Facebook. The band holds three American trademark registrations GUNS N' ROSES, one of them for clothing. In 2018 the Californian brewery Oskar Blues launches a beer under the name Guns 'N' Rosé, along with all kinds of merchandise, such as caps, stickers, bandanas etcetera. The band objects.



The trademark application is refused, but the brewery refuses to take the products off the market, saying it wants to sell out stock until March 2020. Enough reason for the band to start a lawsuit in California. Consumers may think that the beer is linked economically to the band. Not unusual in the scene, given the ties between bands like AC/DC, Deftones, Anthrax and Iron Maiden with alcoholic beverages. The case has just started and the brewery hasn't responded yet. Taking advantage from the reputation of well-known bands and brands seems attractive, but it is not without risk.

### Bad faith trademark filing in China

In China the number of trademarks filed is the highest worldwide. Comparing, in the Benelux 22,000 trademarks are filed per year, whereas an astounding 7.7 million trademark applications were filed in China last year. To combat the practice of trademark hijacking, a new law has been passed in China to deal with bad faith filings. The law will enter into force on 1 November 2019.



Under this new law, trademark registrations that are clearly not going to be used are regarded as filings in bad faith. Another example of bad faith filings are the variations on well-known foreign trademarks. The Chinese trademark authority

will refuse applications of this kind and the applicant may even receive a warning or a fine. There will also be an opposition period, during which rights' holders have the opportunity to object to such applications. A nullification action can also be initiated afterwards. Because the register in China is quite full, also with trademarks that have been registered with a different purpose (e.g. to sell them), the new legislation offers possibilities for foreign companies to get their trademarks registered in China.

### Neymar claims his name

In 2011 and 2012, Neymar was named best football player in South America. Ever since that moment, NEYMAR trademarks were registered all over the world taking advantage of his success. Not only in Brazil, but also in the EU, Turkey and Morocco trademarks were filed for all kinds of products like clothing, food and drinks. Mostly without the consent of the football player.



When Neymar transferred to Paris Saint-Germain in 2017, he had his trademark registered in the EU. However, a Portuguese businessman had done so too in 2012. The European Court ruled that this application was in bad faith. At the time of application, Neymar's star was already rising and well-known in Europe, as evidenced by the many articles that were published in the football press. That the Portuguese businessman was aware of this, is also indicated by the fact that on the same day he filed a trademark application as well for Iker Casillas (at that time one of the best goalkeepers in the world). The trademark was therefore rightfully cancelled by the European trademark authorities.

## Cheaper trademark protection in Canada

With an International Registration it is quite cheap and easy to claim protection abroad. At present, 120 countries are already members of this treaty. Canada joined on June 17<sup>th</sup> of this year. Beside the fact that the application costs are much lower, the costs to maintain one's rights are also more attractive.

## Similarity Kordaat- Kornuit

It's no secret that Lidl regularly has private labels that have striking similarity to those of well-known A-brands. Think of Zagerman sausages (vs Stegeman) and Duetti chocolate spread (vs. Duo Penotti). Only rarely do these teasers actually make it to court. However, this spring the judge had to rule on a new trademark for beer. Since 2013, Grolsch has been marketing beer under the name KORNUIT. Various trademarks have been registered for this beer, including a word mark. When Lidl introduces a lager with the name KORDAAT, Grolsch takes Lidl to court.



Grolsch argues that the trademarks are similar. The beginning is identical (KOR) and emphasis is placed on the beginning of a trademark. Both trademarks have the same length (seven letters), end with -T and consist of two syllables. Lidl's main defence is that the marks clearly have a different meaning. Dutch word *Kornuit* translates as 'buddy' whereas *kordaat* means 'determined'. This clear conceptual difference rules out the possibility of any similarity between the trademarks. The logical thing for the judge would have been to rule on the conceptual difference first, because it is the only potentially successful argument for Lidl. However, despite the fact that Grolsch disputes that there is a conceptual difference, arguing that the average consumer does not understand the meaning of *kornuit*, (the archaic word is listed to be removed from the Dutch dictionary), the court miraculously does not take this into account.

The court ruled in this case with an unusual motivation, disregarding of the line of reasoning set out in recent case law. Most striking is the reasoning that the trademarks have little visual similarity, due to the letters 'NUI' and 'DAA' at the end. The decision should be different in case the letters were 'VV' in stead of 'W'. The similarity between the two trademarks is now so small that there can be no confusion among the public. The claim was rejected. An incomprehensible decision. Fortunately, Grolsch appealed.

## Holiday Ray-Ban sunglasses via Facebook

Ray-ban sunglasses are offered for sale on a closed Facebook group called 'Marketplace without rules' with the following text: "*This spring/summer original Ray-ban sunglasses from € 85,-. Nowhere to be found cheaper. More than 280 models in varying colours.*" A representative of Ray-Ban places a test order and unveils the person behind the Facebook page. When this person refuses to sign an undertaking agreement, parties meet again in court.



Defendant claims that there is no trademark infringement. He got the offered sunglasses for his birthday and had bought some other glasses on his holidays. Ray-Ban's trademark rights are therefore exhausted. He hasn't kept receipts for these purchases. And that the number 280 was a typo, he only had 28 of them. Court ignores this, as defendant cannot provide any substantiating evidence. Ray-Ban also proves at the hearing (by means of the case and the packaging) there are fakes. Prohibition, compensation of damages, court costs, etc. are granted.

## Advertising law

## Discarded donkeys and delicate children's hearts

On TV the most horrifying images can be seen on a daily basis, violence and aggression are also commonly seen in games. However, there are quite strict rules to ensure that the delicate child's soul is not confronted with the rough realities of life.

Ever since 2016 “Donkey Sanctuary” has been broadcasting a commercial about the suffering and poor living conditions of donkeys. Viewer meets 'Monu', a worker donkey with a fractured leg, that nevertheless has to carry a heavy load uphill.



This spring a complaint was submitted to the Advertising Code Committee. The children of the complainant were completely upset when they were confronted with the horrible images. He claims the commercial is emotionally blackmailing viewers to raise funds. The commercial is against good taste, and young children should not see it. The board agrees with this. The images are so intense and shocking that they are not suitable for children. The commercial is banned from being broadcast before 8pm.

Online - internet

### Data breach Youth care

This spring, RTL News reports that personal data of thousands of children had fallen into the hands of third parties. Youth care Utrecht had changed its name. For that reason, the old internet domain registration was not renewed. If a domain registration is not renewed, it will become available and third parties can register it again.



### 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](mailto:info@abcor.eu)

Sources:

Adformatie, BIE, BMM, Boek9.nl, Class46.eu, Domjur.nl, Elsevier, GPD, IER, IE-Forum.nl, INTA bulletin, Nu.nl, OHIM.eu, PCM-newspapers, Quote, SIDN, Trademark Reporter and WIPO

Two whistleblowers had re-registered the domain name and had reactivated the mail address. As a result emails were received from employees still using the old e-mail address.

As a company, it is easy to anticipate these situations. Do not only keep internal policies about trademarks (how and what to register), but do the same for domain names and social media. Which domain names are registered? Which extensions? Against which infringement action is to be taken and what rules apply if a domain name is to be not renewed?

Abcor news

### New trademark advisors at Abcor

This spring Ellen Streekstra and Tanja Oosterman joined Abcor. Ellen has been active as a trademark attorney for 20 years. She gained a lot of experience at various trademark agencies, including Bouma, Bakker & Verkuijl and Kneppelhout & Korthals. She also worked as an in-house attorney for several years at Berggruen Group, where she managed the trademark portfolio of German department store Karstadt.



Tanja has worked as a paralegal for various trademark agencies over the past 10 years. Ellen and Tanja will focus on SME and our international practice.

### Contact Abcor

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