

PEPSI prevents PAUPSY concept store



In dit nummer

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ABCOR back in WTR1000

In 2020 Paupsy opened its doors. Paupsy is a concept store which sells clothes, shoes and jewelry. Well-known brands such as PEPSI often register their trademarks not only for their core business, but also for other goods and services. The reason for this is to prevent other companies from catching on to the trademark's reputation, but also because these trademarks are often licensed to third parties to use. Therefore, the PEPSI trademark is registered not only for soft drinks, but also for food, cosmetics, audio equipment, furniture, household products, stationery, jewelry, bags, clothing and textile products. Following this reasoning, it is logical PEPSI would object the Paupsy trademark application.

After all, the products are the same. But are the marks similar, seeing that minor differences in short marks are often enough ensure sufficient difference?

Yes, the authorities judged. The marks in question contain five versus six letters, but the letters P*PS* are in the same order. Therefore, the marks are deemed visually similar. This is also the case in terms of sound. Both marks consist of two syllables and both marks are pronounced the same way. The trademark application is therefore rejected.

Are you considering merchandising or licensing a trademark? Then apply for a trademark application for all relevant products.

Trademarks

Thom Browne – three or four stripes

Logos sometimes consist of simple geometric figures, such as lines, dashes, circles, dots or squares. This leads to a limited protection for such a logo. Consequence: it is difficult to object to similar signs.

After more than 20 years of litigation, the curtain fell for Adidas in its case against H&M. The Adidas logo consists of a pattern of three stripes where the spacing is equally wide as the stripe. H&M used only two stripes and a smaller spacing. Therefore, the similarity was deemed too low.

Meanwhile, a similar case is ongoing in the USA.

Luxury brand Thom Browne uses four stripes on its clothes. Since 2018, the brand has also been marketing sportswear.

According to Adidas, Thom Browne's 4 stripes sign infringes on its '3 stripes trademark'. A lawsuit follows with a claim of approximately € 7 million. Browne's lawyers argue that use of stripes is common. Both companies target a completely different audience. Browne's stripes are additionally used horizontally around an arm or leg (and again, the spacing is smaller). The New York court followed this argument: no infringement.



Trademarks

The Oscars: a vibrant trademark

A trademark must be used normally after five years. If not, third parties can initiate a cancellation action against the mark. The question is though: where should that use take place? If the use takes place outside the European Union, should advertising in the European Union be sufficient? This is crucial for many industries such as the travel industry, real estate sales or large international events taking place outside the EU.

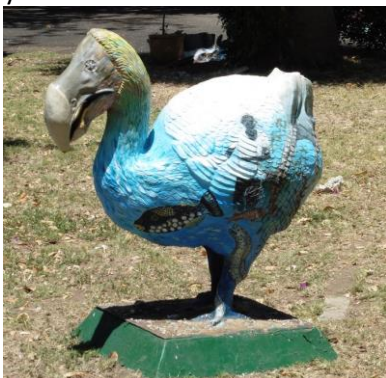


European authorities made two judgements on this subject last year. The criterion they formulated is: if a trademark owner targets audiences in the European Union through advertisements in order to pursue sales for products and services outside the EU, then there is sufficient genuine use.

In the latest case, trademark OSCAR was at issue. The Academy Award ceremony takes place in Los Angeles, but the event is widely promoted in the EU to attract viewers. It is also licensed to many television stations in the EU and the shows are watched by millions of people in the EU. Therefore, the trademark is deemed to be used normally in the EU and remains valid. If services are offered outside the EU but the sale is also aimed at consumers in the EU, register the mark as a Union mark as well.

Republic of Mauritius joins WIPO

Through the International Registration route, companies can easily claim trademark rights in many countries.



The big advantages are the cost (relatively cheap) and the central management of trademarks, which makes the managing of these rights more

efficient cheaper.

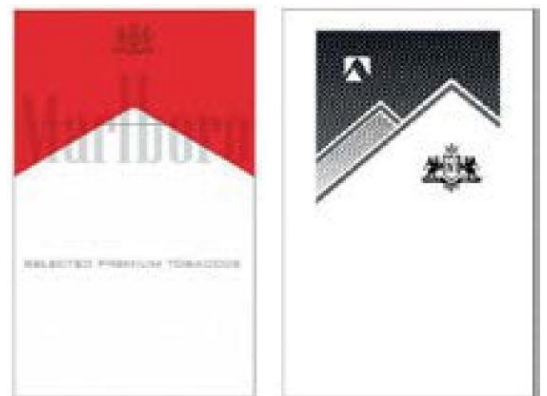
Many countries have joined in recent years, including Chile, Jamaica, Cape Verde, Belize and most recently Mauritius. That brings the number of countries where protection can be claimed through WIPO to 130.

Mountain top or Marlboro roof

A brand is more than just a word or a logo. The design of (or a part of) the packaging can also function as a sign of recognition. Because consumers can recognize a brand in this design, companies often register these designs. Clever, because copy-cats are always lurking.

When Masis Tabak applies for a trademark for its cigarette packaging, Philip Morris successfully objects based on Marlboro's red roof which is registered as a Union trademark. In the proceedings, the reputation of the red roof is not at issue. Masis disputes that the marks are similar.

Masis' logo consists of a stylised representation of two mountains, Mount Ararat (the mountain where Noah's Ark landed).



The General Court does not follow this. In the Marlboro logo, the text drops out. Actually, one sees a red roof lying on a white triangle. Masis' trademark has a similar dark shape at the top resting on two white triangles. The public does not recognize Mount Ararat in the shape. In the eyes of the relevant public the marks are similar. The fact that in the application, Masis described that the logo represents two mountains is irrelevant. What matters is the perception of the consumer confronted with the sign, not the intentions of the applicant. The fact that the mark is registered in many other countries is not a valid reason for accepting the mark in the EU. The Court confirms that the mark was justly refused.

Design law

Bottom of bicycle saddle visible

To qualify for design protection, a product must meet two requirements: it must be novel and have individual character. If the design is part of a composite product, there is an additional requirement. The design must be visible during normal use. But what exactly is normal use? The Court answers this using a special pattern of the bottom of a bicycle saddle.



A bicycle is a composite product. A saddle is part of a bicycle, because a bicycle cannot be used without one. When assessing normal use, is it about what you see when you use the product (i.e. when you are cycling)? In that case, the design of the bottom of a saddle cannot be a valid design. After all, as a cyclist, you cannot see the bottom of your saddle while cycling. Or should you explain normal use more broadly?

The European Court chooses the latter way. Normal use includes not only the purpose of the product (cycling), but also other uses (apart from maintenance and repair). After all, you store a bicycle in a bicycle rack or lift it to transport it. It falls under normal use when the bottom of a saddle shows. An important ruling for companies to protect the design of parts as a design and for companies offering alternatives to distance themselves from the original design.

Online

Amazon Liable for third-party sales

Amazon's online platform features a mix of ads. On the one hand, advertisements of products offered by Amazon itself, and on the other, third-party advertisements (the hybrid model). It is unclear whether the products are sold by Amazon or by someone else, because the ads are mixed. Third-party sellers often offer counterfeit products.

Amazon takes the position that, as a neutral platform, it is not responsible for this. If infringement is reported, the concerned ads are removed immediately.



Louboutin has a position mark for its stiletto with red sole. On Amazon, several (fake) stilettos with red soles can be found infringing this. Louboutin deems Amazon responsible for this, due to the way it advertises.

The court seems to agree. With a hybrid online platform, however, the hosting party may be liable. By placing uniform advertisements interchangeably, it may remain unclear to consumers whether or not the products come from the operator. This is reinforced by the use of the Amazon logo in all ads, since Amazon handles storage and shipping. In order to avoid liability as an online platform, clear distinctions must be made between ads for own and third-party products.

ANWB: domain names dispute

The Royal Dutch Touring Club ANWB known simply as ANWB is a travelers' association in the Netherlands, supporting all modes of travel. Within three months, 34 domain names containing the ANWB brand were registered. In case of domain name infringement, there are two options to put a stop to this. Bringing a case to court or starting a simple administrative procedure at WIPO.



The problem at hand is the multitude of different owners. Can you now claim all the domain names in one procedure? The answer is yes, if you can prove that only one party is behind it. ANWB proves this without any issues.

All domain names in question consist of the ANWB trade mark combined with a generic word, such as: administration, reminder, invoice. The domain names were applied for within three months with the same registrar and use the same privacy service (to disguise the identity of the real holder). The domain names refer to misleading websites or websites removed due to phishing or malware. The same postal code is used everywhere, while the addresses are different and some registrants' names do not seem to exist. In addition, the domain name holder has not filed an appeal. The complaint also meets the other conditions, so all domain names will be transferred to ANWB in accordance with the terms.

H&M 'rubbish featuring Justin Bieber

As a part of Justin Bieber's world tour, H&M launched a hoodie and bag featuring pictures of Justin Bieber. H&M has produced similar lines before. This time however, internal communication and legal checks did not seem to have gone smoothly. On Instagram, Justin Bieber reported that he did not give permission for H&M to use his pictures. He then urged his fans to not buy anything, because it is 'rubbish'.



Justin could have taken legal action, but the online storm caused on Instagram by Justin's the fans was arguably more damaging to

H&M. H&M claimed that it duly went through the procedure and received permission to do so. However, due to all the outcry, all products were removed immediately.

Abcor makes headlines

Abcor back in the WTR1000

We are joyful to announce that this year again, we have been included on the list of leading companies in the Benelux of the WTR1000. This is very special for us for us, given that WTR1000 (World Trademark Review 2023) is regarded as one of the most significant global reviews of trademark agencies and other companies in the area of the trademark law. The WTR1000 ranking is based on the appreciation of our clients and colleagues globally.



Since our clients' quotes are so pleasant, we would like to share them with everyone.

"A top-notch firm with an excellent international network, ABCOR is a prime pick for trademark services throughout the Benelux and Europe. Its team are praised for their hands-on mentality, proactivity and pragmatic attitude, all of which culminates in a dedicated service and straightforward advice."

"Group founder Theo-Willem van Leeuwen became president of the Benelux Association for Trademark and Design Law (BMM) in March 2021, and his patrons hold him in high regard for providing "five-star strategic solutions, whether it's for trademark registrations or litigation support. His astute guidance always considers the bigger picture, and he is enthusiastic in his approach." Alongside him, managing partner Mirjam de Werd also receives positive feedback: "Mirjam is the practical and down-to-earth partner any business needs. She is strategic, persuasive, knowledgeable and cost effective. An all-round outstanding adviser."

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:

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

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