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Prohibition on Reselling Modified Products



A trademark owner has the exclusive right to sell their product for the first time within the European Union. Once that sale has occurred, the company can no longer oppose further trading within the EU (known as exhaustion). But is this always the case, particularly when modified products are being resold?

Lego has registered its building blocks and figures as trademarks. The defendant sells kits made from Lego bricks to build trains. These kits contain original Lego bricks, but some have been modified. Ball bearings have been inserted into the bricks to help the trains run better, and logos of third parties (such as the Dutch railways, NS) have

been added. Lego objects to this. Rightly so—exhaustion does not apply if the condition of the product has been altered or deteriorated.

The insertion of ball bearings has deteriorated the condition of the bricks. The quality of the plastic has been compromised, and the bricks no longer meet safety standards, especially with regards to children's toys and the reported presence of lead in the ball bearings.

The same applies to the printing of the third-party logos, as it's unclear which materials or printing techniques were used (e.g. lead-based ink). Lego's prohibition is therefore upheld.

Trademarks

No Trump's beer, but Trump condoms?

Donald Trump is not just a former U.S. president, but also a real estate tycoon. Among his assets are hotels and golf courses within the UK and Ireland.

In the European Union, Trump has registered the TRUMP name for a wide variety of goods, including clothing, hotels, and golf courses. When another party tries to register TRUMP for condoms, beer, and sparkling wine, Trump's organisation (DTTM) objects.

European authorities partly agree with DTTM. In hotels, guests can not only stay but also dine, so food and considered complementary goods).



(Fictief voorbeeld)

drink are seen as an integral part of hotel services. As a result, the application is rejected for beer and sparkling wine.

However, this reasoning does not apply to condoms (since DTTM instead relies on Trump's reputation. This makes sense, as well-known brands tend to enjoy broader protection.

Nevertheless, this argument fails. While Donald Trump himself may be famous, that does not automatically mean his trademarks are widely recognized.

The TRUMP brand is not considered famous for hotels or golf courses, meaning the registration for condoms is allowed. No appeal has been lodged against this decision.

Trademarks

Chocomel Yellow and T-Mobile Pink

A trademark isn't limited to just words or logos. Other elements—such as colours, shapes, sounds, or even videos—can also function as trademarks. But is a colour trademark always effective at stopping competitors?

T-Mobile has used magenta extensively in the Netherlands since 1990 and has registered the colour as a trademark. The company is rather strict when others use a similar shade. However, not everyone immediately backs down.

The T-Mobile logo, featuring a white 'T' with a magenta dot on the top bar, followed by the word 'Mobile' in white, all on a magenta background.

When Lebara is challenged, it fights back by launching a nullity procedure with the Benelux trademark authorities. The argument is that a colour can only be a trademark if it has become distinctive among the relevant public. For colours, this must include consumers across the Netherlands, Belgium, and Luxembourg. Since T-Mobile doesn't use magenta in Belgium or Luxembourg, the authorities ruled the colour trademark invalid.

In contrast, a few months earlier, the outcome of a similar case was different. FrieslandCampina has used yellow for its CHOCOMEL products since 1932 and registered the colour as a trademark.



When CACAOLAT applied for protection for a logo with a similar shade of yellow, FrieslandCampina objected. The trademark authorities confirmed that CHOCOMEL's yellow was valid because it had been used consistently across the entire Benelux region. Moreover, the colour had become widely known and reputable due to its long-standing use. Since CACAOLAT's colour was nearly identical, it was ruled that consumers might associate it with CHOCOMEL, which would amount to riding on CHOCOMEL's reputation. Consequently, the CACAOLAT logo was rejected for similar products.

Joint-Smoking Mermaid and Starbucks

Parodies of well-known brands pop up regularly. When these cases escalate, the defence often centres around freedom of expression or the idea that it's a legitimate parody. However, European trademark law (currently) does not

recognize a parody exception. This makes sense, as such cases are often about gaining commercial advantage by piggybacking on a famous brand.



Starbucks has registered both its name and its mermaid logo as trademarks for a wide range of products. A New York-based business, StarBuds Flowers, began selling marijuana from a van, using a logo featuring a mermaid holding a joint. A legal dispute soon followed.

The names STARBUCKS and STARBUDS clearly resemble each other. By using a similar logo, it's evident that StarBuds was trying to capitalise on Starbucks' reputation. The image of a mermaid smoking a joint isn't likely to help the coffee chain's image either. Even though the products differ, a ban is expected. This case is a good example of the additional protection a logo can offer.

ROOMBETER and Dairy Naming Regulations

BLUE BAND has developed a plant-based alternative to butter, marketed under the name ROOMBETER (similar to *cream better*, in stead of *butter*). The Dutch Dairy Organisation raised an objection. According to European regulations, words like 'cream' and 'butter' can only be used for dairy products. Even though the packaging clearly states that it is 100% plant-based and an alternative to butter, this makes no difference.



The term 'cream' can only be used in product names if the product contains dairy. This ruling isn't entirely surprising, as the European Court had already ruled in 2017 that names like Tofubutter and Pflanzenkäse couldn't be used for plant-based products. BLUE BAND is free to compete with butter, and can advertise that its product is 100% plant-based and better for the climate. It just can't use the word 'cream' in the product name. As a result, BLUE BAND is redesigning its packaging.

Lacoste vs Crocodile

Since 1927, Lacoste has used the logo of an embroidered crocodile along with the name Lacoste, which it has registered in many countries. The Singaporean company Crocodile also uses a crocodile in its logo, which is registered in several countries, including India. After a series of legal battles (in Singapore and Japan), both companies decided to settle. They signed a coexistence agreement, stating that both brands could exist alongside each other and halting any further legal disputes. Such agreements are common in trademark disputes.



Years later, when Crocodile sought to protect its new logo in India, Lacoste objected. The ruling stated that while Crocodile held an older trademark in India, this did not extend to all possible variations, including the new logo. Lacoste won the case, as it had registered the crocodile symbol (without the word Lacoste) earlier. The coexistence agreement applied to several countries, but India wasn't explicitly included.

This case highlights the importance of securing protection for the symbols used in branding. When drafting coexistence agreements, businesses should not only consider the current situation but also anticipate potential future changes.

FOOTWARE: Descriptive Trademarks

From a marketing perspective, descriptive trademarks can be appealing because they immediately convey the product's purpose. However, the downside is that such terms are often ineligible for trademark protection. Even if an application is accepted (perhaps because the specific use isn't claimed), there's always the risk that a competitor could argue the mark is too descriptive, leading to it being revoked.



In 2019, Nike registered the trademark FOOTWARE for software and data transmission services. Puma then sought to have the trademark cancelled. Smart shoes contain chips that provide real-time

feedback to the wearer, so the term 'footware' describes a characteristic of the product—it refers to software used in footwear. The EU General Court agreed, ruling that the mark was descriptive of one of the product's features, and therefore couldn't be monopolised by any manufacturer.

Copyright Law

No Copyright for Cheese Slicer

Since 2009, Boska has sold its cheese slicer through Plus supermarkets. When their collaboration ended in 2023, Plus introduced a new cheese slicer that bore a striking resemblance to Boska's model. The ensuing lawsuit centred on whether Boska's cheese slicer was protected by copyright and, if not, whether it could claim unfair imitation. There are many similar cheese slicers on the market, most of which look nearly identical. Boska argued that the combination of design elements gave the slicer copyright protection. However, the court disagreed.



Boska kaasschaaf

Klaverland kaasschaaf

All of these elements were already part of existing design traditions. The features were basic and driven by utility, ease of use, or functionality. The combination of these elements did not amount to an original creation. As such, Boska's claim to copyright protection was not amount to an original creation. As such, Boska's claim to copyright protection was rejected.

As for unfair imitation, the court found that the new cheese slicer did not possess distinctive identity in the marketplace. Boska was left empty-handed. One wonders how the case might have turned out if Boska had registered design rights for the slicer in time.

Design Law

Grace Period for Instagram Post

Since the Cofemel ruling, there has been uncertainty as to whether every piece of applied art can be protected by copyright.

We are awaiting further clarification from the Court on this matter. In the meantime, savvy businesses are opting for design protection under model law, and rightly so—but it must be done in time!

Knaap sells and imports fatbikes. In 2021, Knaap registered the frame of the KNAAP RTD as a Community Design. The design originated from a Chinese company with which Knaap has an agreement, and permission was granted for the registration. When ECC showcased a similar model, the Diablo Zipper, in its brochures, a legal battle ensued.



A design is valid if it is novel and has individual character. On 23 January 2020, a sales manager posted a video clip on Instagram. Knaap's design application was filed almost a year later, on 21 January 2021. However, in the European Union, we have a 12-month grace period (term de grace). This means the design is still valid. The shape of the frame and the suspension give the model its unique character. ECC's Diablo Zipper does not create a different overall impression, so the court granted an injunction against its sale.

Online - Internet

TikTok Influencer Fined

The influence of social media personalities should not be underestimated. Research shows that one in three young people buy products recommended by influencers. It is therefore essential that videos clearly indicate when they contain advertising. If they do not, fines can be imposed.

There is now self-regulation within the industry. Influencers can obtain a certificate from the Dutch Advertising Code Foundation and the DDMA, demonstrating that they are

familiar with the advertising regulations and agree to follow them.



The Dutch Media Authority has issued its first fine to an influencer with over one million followers on TikTok, who was promoting products such as a skincare cream. Several of the videos failed to mention that they were advertisements. Although the description at the end of the video contained "#ad," this was not visible on mobile devices. Even after a warning, the videos were not amended. As a result, a fine of over €6,000 was imposed. However, the fine was reduced, as the influencer has since shown remorse. The videos were updated, and the influencer obtained her certification, demonstrating that she has taken measures to prevent this from happening again.

Abcor makes headlines

Pride and acquisition Anchor portfolio

Pride Recently, we've made headlines on several fronts. On the business side, we announced that this summer we acquired the client portfolio of Anchor, another trademark agency.



On the community side, we gained attention for our sponsorship activities, including supporting the Pride and Canal Parade in Leiden. For us, this is an important statement, as we believe that inclusivity should not be limited to the workplace. Everyone should be free to be themselves, anywhere and at any time, especially in our wonderful home city of Leiden.

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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