

# ABCOR's ABChronicle



## Trademarks

### TUC forbids packaging

General Biscuits (LU) has been producing biscuits since the sixties under the brand TUC crackers. Through intensive use TUC became a reputable trademark and General Biscuits the market leader. In order to protect its rights, TUC not only registered the logo on the pack, but also some details of the packaging including the typical yellow background with the logo in blue and white.



TUC competitor Hoppe also produces cookies and introduces them under its own brand APERO. The court says that there is trademark infringement

and referred to the earlier ruling by the European Court in Carbonell-La Espanola. Most importantly, this time is the visual similarity. The visual impact caused the way General Biscuits uses different colour indications on the packaging played a key role. The yellow background, white letters, the blue square, red accents and the cookies on each other. Although the words APERO and TUC are not similar, the overall visual impression is the same and that is decisive.

This is especially important for products found in supermarkets, as consumers are guided by the visual impact and may thus inadvertently pick the wrong box. This will invariably lead to confusion. Result: ban, recall, sales information to determine damages. It is expected that this ruling will have major implications for the packaging of private label products, which are often the style and colours of brands take over.

### KEUKENCONCURRENT repels BADKAMERCONCURRENT

The KEUKENCONCURRENT (Dutch for kitchen competitor) has successfully opposed the registration of the logo of the BADKAMERCONCURRENT (Dutch for bathroom competitor).



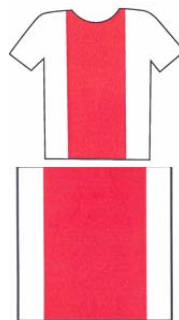
Both brands are a combination of a descriptive element (kitchen and bathroom), followed by the element COMPETITOR.

The Benelux trademark authorities deemed that there may be (indirect) confusion. The important consideration is that these are identical products / services. In addition, in both logos the element COMPETITOR is combined with a hand which catches the attention. The statement indicates that even descriptive marks and trade names may benefit from a trademark registration.

### Color mark AJAX invalid

Ajax sells merchandise items bearing the logo of Ajax, the red track and lyrics like 'Amsterdam' and 'Pride of Mokum'. In order to protect its goodwill (and exploit), AJAX has a number of trademark registrations made based on the red track. A trader sells a vest with a red stripe, crosses and the words "PRIDE OF Mokum". On the vest is a label FANSPORT, FANWEAR FOR FANS and "official licensed product". The vest is not from AJAX.

During the lawsuit AJAX invokes its colour marks, a square containing a red stripe and a T-shirt with a red stripe.



The judge ruled first that the colour marks are not valid. It is not exactly clear what colour is claimed. In the past a simple colour box used to be enough, but not anymore. Now the registration needs to be more specific. A PMS colour code is most certainly a requirement. The claim based on the colour marks is rejected. Fortunately, for AJAX their subsidiary claim based on unlawful act was successful. The items were presented in such a way that the consumer may believe they were official AJAX merchandise.

### Reputable trademarks and oppositions

Reputable trademarks have a wider scope of protection than regular marks. Judges take this into account in procedures, so

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they will more easily conclude that a reputable trademark is infringed. During new trademark applications, holders of earlier marks may object, if they believe that the new application is similar to their earlier mark.

An opposition procedure is a rapid procedure to prevent a similar mark from being registered. The downside is that owners of reputable trademarks in many countries (also in the Benelux countries) cannot invoke their trademark's reputation in an opposition procedure. Because of this sometimes trademark applications are being registered that ideally never should have reached that stage. A good example is the registration of a new logo for tea and coffee machines in Switzerland.



Coca Cola launched an opposition to stop the registration process. The products are similar (coffee and soft drinks are alternatives), so it comes to match or logos. Coca-Cola insisted on the reputation of its logo. Because this ground in opposition proceedings does not exist, it cannot be taken into account. The trademark office therefore finds no violation.

#### A squirrel is not a beaver

Chalet Center sells gazebos and used a beaver character in its communications. In order to prevent abuse by third parties, she registered the brand logo as a trademark. There is a conflict when a former employee founds a competing company: Miscellaneous Wood. Miscellaneous Wood sells gazebos and used as a squirrel family as their logo.



Chalet Center



Woodvaria

The court looks whether the marks are visually, aurally or conceptually similar to each other. Visually the logos are quite different. The beaver is a line drawing in black and white, the squirrel family includes colour.

Actually, the only visual similarity between the involved animals in the logos are large incisors and a large tail. Conceptually it is clear that both logos involve rodents. That is not enough, however, to constitute trademark infringement. The court rejects the claim.

## Designs

### Prior art, novelty of doll houses

Doll houses for children have been around for many years. However, new variations are constantly coming onto the market. In 2005 Henkes introduced a new doll house named DAAAK and applied for design protection in the European Union. Hajo introduced a similar house on the market in 2010. Henkes believed that this house was an infringement of her rights. Hajo claims that it was not. The houses were sufficiently different, but more importantly, the whole model of Henkes is not valid because it is not new. In 2004, a similar house was already registered, the Langley house.



Langley house



DAAAK house



HAJO house

The judge does not agree. The DAAAK-house is clearly new. This is evident from the fronts and the overflow of the roof in the walls. The house therefore has a different overall impression. This is not the case with Hajo's house. This house has the same general impression as the DAAAK. The distance that keeps the house Hajo DAAAK house, is much smaller than DAAAK vs. Langley. Result: violation and a prohibition.

## Copyrights

### Mediq and unlicensed use

Design agencies often provide clients an exclusive license for use of house styles. The aim of this is that any follow up work is also being done by the agency. The design agency, SVT, of pharmacy MEDIQ developed all the in store material and new house style. Subsequently, as is usual in projects like this SVT provided an exclusive licence MEDIQ for use of the newly developed material.

When Mediq opens offices in Poland and Belgium in 2008, SVT tried to arrange additional agreements on the use and continued work.



de Poolse apotheek



de ontwerpen van SVT

Mediq takes the position that it does not infringe the copyright of SVT and therefore do not have to pay anything.

SVT cancelled the license and started a lawsuit. The court came to the conclusion that the new use falls outside of the scope of the license. The license is legally terminated, but everything is still used in the Netherlands by MediQ. In accordance with the of the general terms of the license three times the fee paid fee (over € 1.8 million) had to be paid to SVT. The result: a ban on use, to pay costs and damages (more than € 65,000).

#### Protection of a concept / format

It is not possible to protect an idea, however, it is possible to protect the idea in its realized form. Because copyright is obtained automatically, it is sometimes unclear which part of an idea / format is protected. Knowing what part of a product is or is not protected may be vital if you intend to base your own products on someone else's.



BuurtKadoos sends new residents a box of vouchers from various companies. This way companies can easily introduce themselves to new residents. One of the suppliers discontinues their work with BuurtKadoos and introduces its own (similar) box.

Is this allowed, because a box of cards is after all a common marketing tool? The judge does not agree. He argues that the idea behind BuurtKadoos is a very detailed concept. The concept is realized in a certain way (maps in color, by category, with map and a hole), which leaves other options open. However, not only the box, but the whole concept around it is copyrighted. The defendant copied not only the look of Buurtkadoos, but also its visual elements. Both formats have therefore the same overall impression. Result: infringement.

#### Advertising

##### Parody and tobacco

The Tobacco Act prohibits advertising and sponsorship of tobacco. The secretary of public regularly has to file procedures against covert advertisement of tobacco. Even the parody poster of cinema 'The Ketelhuis' could not be approved. The playful poster, based on the Lucky Strike logo with a warning: "Dutch films are close to your heart" was seen as a form of circumvention of the Tobacco Act. The bill makes clear use of a symbol (part of the logo), which has been used for tobacco.

The court did not agree and joined the parody defence. Although the poster is a clear resemblance to the circle used in the logo of Lucky Strike, this poster is not regarded as an expression or a form of commercial sponsorship. It is clear that the movies were promoted using a parody of the cigarette package. No infringement, but a lot of publicity was received.



#### Tiger Mascara

The new campaign for Maybelline's 'The Colossal Cat Eyes' shows a leopard and two young tiger cubs on a leash. The mascara (and brush) gives a feline glance. Use of animals in commercials is a very sensitive and because of this a complaint with the Advertising Code Committee was filed. The complainant states that wild animals have nothing to do with mascara. Animals must not be exploited on television, they belong in the wild and not on a leash.



The Chairman of the complaint stated that based on the commercial, there is no animal abuse. Maybelline also presented a statement from the Animal Anti Cruelty League. The commercial is set in South Africa in a shelter for injured and rejected animals. These animals are completely domesticated and have been handled with care. There is no absolute prohibition to work with animals in commercials. The complaint is therefore unfounded.

#### Internet/ social media/ domains

##### Univé - reverse domain name hijacking

Univé is not the owner of the website UNIVE.COM. This is a Pay Per Click ads website for universities. Univé started a procedure with WIPO to claim the name, based on its trademark registration from 1991, the brand awareness and use of the name since 1949. In a domain name procedure with WIPO it must be demonstrated that (1) the domain name corresponds to the brand, (2) the holder does not own rights, and (3) that the

domain name was registered and used in bad faith. Univé not only failed to obtain the domain name and was ultimately convicted of misleading the panel.



Univé states that the domain name has been in her possession since 2000. In 2010 she allegedly forgot to renew the domain name on time, and the current holder of the domain name quickly snatched it away. The holder has no claims on the name Univé.

The defendant shows that Univé's statements are not true. The domain had been in his possession since 2003 and he offers this ad for education in universities. The Panel therefore rules that Univé had no actual proof for use in bad faith. The allegation that defendant secretly transferred the domain name into her possession in 2010, is wrong. E-mail evidence showed that Univé was actually aware of this. That mistake is unacceptable. The claim is rejected and Univé sentenced to mislead the panel (filing a complaint in bad faith in order to obtain a domain name).

### Marketplaces liable for counterfeit goods

After the first ruling on the use of brands such as Google Adwords, there is now a second important ruling relating to market places. L'Oreal filed a case against eBay, because counterfeit products were offered on this website. The European Court has indicated that eBay (and other electronic marketplaces on the Internet) is liable if it actively promotes the sale or if they do not immediately remove ad-aware if a complaint is filed. Hiding behind the e-commerce directive is not possible and that's good news for brand owners.



The verdict, however, works both ways. On the one hand sites are allowed to advertise using third party trademarks,

but they must also have a good take-down procedure in order to report violations. On the other hand companies are expected to adopt active policies to tackle online counterfeit (for example web monitoring).

### Bavaria Babes and Twitter

The Dutch Dress campaign by Bavaria has been named the most successful campaign

of 2010. In social media, the Bavaria Babes were also the topic of the day. Remarkably Bavaria has never acted in response to their success, which given the hype, is really strange. In February 2011 the Twitter account was still free! Movuz (a provider of mobile beer taps) eventually decided to register the name.



Bavaria filed a lawsuit and demanded that the account should be transferred to her. Given the importance of online communications and social media, it is remarkable that at the start apparently nobody checked whether the relevant domain names and Twitter/Facebook accounts are available. And if free, why not immediately registered.

### New to Abcor

Starting of October 1st Nashebo Noya will join our team of legal experts. After completing his law degrees (University of Amsterdam and a specialization IE from the University of Barcelona) Nashebo acquired over five years of working experience as a trademark lawyer both at home and abroad. He has been employed among others by Roland Legal Services (Barcelona, Spain) and Abbott Healthcare Products (Weesp, Netherlands).



### Abcor BV

Abcor is an IP Law firm, Located in 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, INTA bulletin, Nu.nl, OHIM.eu, PCM-dagbladen, Quote, SIDN, Trademark Reporter and WIPO

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