

ABCOR's ABChronicle

Trademarks

Specsavers; importance of registration of parts of a trademark

Specsavers is the largest optometrist chain in the United Kingdom. In 2009 Asda Stores (the competition) starts a campaign: "Be a ready specsaver at ASDA" using logos that are remarkably similar to those of Specsaver's. As a consequence a legal procedure followed. Specsavers invoked the following trademark registrations: the word mark, the logo and the shape of the glasses (without text in black and white). During the procedure the question arised whether this log is still valid since Specsavers only uses it in green accompanied by word elements. The black shape is not used separately, and the trademark is under obligation of use.



The European Court decides that the registration in black is fine. As long as its shape is perceived as a logo by the consumer, even if it is used exclusively in combination with word elements, it fulfills the requirements for use. For many companies this is all the more reason to not only register a figurative trademark as a whole (with word elements) but also its distinctive characters separately. This may be crucial in cases of coat tail riding.

Nutella upset with Nugtella

Nutella's choc paste is world famous. It is being sold in over 190 countries and has a very distinctive packaging. Ferrero has registered the name NUTELLA, as well as the logo,

packaging, and certain elements of the packaging as trademarks in order to protect the unique look and feel of the brand.



Californian company Organicers recently introduced NUGTELLA, a hazelnut paste with added marihuana. Not just the name is similar, the packaging and design is as good as identical as well. The only difference is that the costs are significantly higher, \$ 25.- per jar. Ferrero has stated to do whatever they can to end this infringement. In light of recent case law, especially regarding coat tale riding and well know trademarks, the case seems clear cut in Ferrero's favor. There is a large chance Organicers have already removed the product from the market.

Trademark with EU-symbols not allowed

Any inclusion of state symbols, such as flags, in a non-governmental logo can lead to problems. The use of symbols that refer to the European Union, such as the twelve stars, is closely monitored by the EU itself. The trademark MEMBER of EURO EXPERTS has been successfully opposed by the European Union. The trademark was registered for a variety of products and services (including financial services).

No permission had been given for use of the Euro sign and the twelve stars by the European Commission.

The European Union started a cancellation action and succeeded in



having the trademark cancelled by the OHIM.

The use of twelve stars may give consumers the impression that there is a relation between the trademark owner and EU institutions. The name MEMBER OF EURO EXPERTS furthermore gives the impression that the organization has been officially approved. The fact that the stars are aligned in a different way is irrelevant.

Importance trademark registration China

For companies that want to produce (or market) their products in China it is of great importance to timely register the brand. In China, the system of first-come first-served applies. If the proprietor does not register his trademark on time, chances are that the trademark is registered by a Chinese entity with dire consequences.

Apple ran into problems when it wanted to introduce the iPad in China. A Chinese company had previously registered the trademark rights to iPad in mainland China. The legal battle was settled in 2012. The trademark rights were transferred to Apple for \$ 60 million.



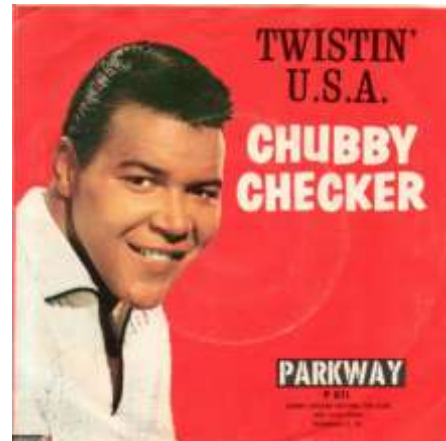
Tesla, the American manufacturer of luxury electric cars, got the same problem this summer when their showroom was going to open in Beijing. TESLA was in fact already registered by a Chinese company in 2006. When the U.S. manufacturer wanted to register the trademark in 2009 this was refused by the authorities because of the earlier mark. To obtain the trademark rights the U.S. manufacturer offered \$ 250,000. The proprietor, however, wanted 30 million. Because the parties could not agree legal procedures are

now running (including a cancellation action).

Alternatively TESLA still argues that the Chinese proprietor has registered in bad faith. However, that is always very difficult to prove in China. Within the world of electric cars TESLA is a concept, but to show bad faith, the mark must be known to the average Chinese car driver and that is very doubtful.

The Chubby Checker app

Ernest Evans, better known as the rocker Chubby Checker, became world-famous in the sixties with his TWIST numbers. To protect his interests Evens registered his stage name CHUBBY CHECKER as a trademark in 1997. This year it came to a lawsuit against HP. Through the HP store (since 2006) it was possible to download the Chubby Checker app. An app that links the shoe size of a man with his genitals. The app is not a sales success (according to HP, approximately 80 units were sold). After the cease and desist from Evans HP immediately removed the app. For Evans, this was not enough, however, he also wants compensation for the abuse of his name.



HP claims not to be responsible for damage caused by third parties. Not HP but someone else offered the app in the HP store. The judge is disagreed. HP has strict requirements that an app has to meet and therefore should have known of trademark infringement. The court awarded Ernest Evans' compensation claim. In Europe and the Benelux many athletes and artists registered their name and likeness. Be forewarned not to use their name or portrait.

Copyrights

The battle for the UGG's design

UGG Australia is a worldwide success. In order to protect the shape of the boot, the American producer registers a design in the European Union in 2008. Typical elements of the boots include its quilted seams, the fold-over and the wool sticking out from the sides of the shoes.



Intermedium designs, produces and exports shoes in all of Europe. When she introduces a comparable shoe a legal conflict soon followed. The sheep skin boot has existed for several decades and is therefore not eligible for design protection. Intermedium claims that her shoe is sufficiently different from other shoes, and the similar seams have a mechanical function.

This argument does not seem to hold up in court, because seams can be placed anywhere on a shoe. In Intermedium's boot the seams, as well as the fold-over and the wool elements are in exactly the same place. This makes the overall impression the same as the UGG boot. The consequence: cessation of all sales, transfer of profits to UGG and payment of UGG legal costs (ca. 20,000 euro).

Audrey jack same overall

impression The Dutch company Avelon designs and manufactures clothing including a special jacket. The most special about the jacket: the combination suede leather and contrasting pink zipper that runs in a U turn. The jacket is a combination of tough and sporty. When LN Konfektion starts selling a similar jack (the Audrey jacket), a lawsuit follows. Because there are no design rights, the first matter is whether the Avelon jack is protected by copyright. According to the court, this is the case. It is new compared to what is in the market and there are clear creative choices.



In order to constitute infringement, the jacks must be similar. The protected characteristics from one jacket can clearly be seen in the other, giving it the same overall impression. According to the Court, the differences between the jacket are so small that the overall impression is pretty much the same. Resulting in a ban on the sale of the jacket with a penalty of up to 50,000 euros.

Advertising

MARMITE Rescue Unit

In England, a riot occurred surrounding the fantastic new commercial for Unilever's Marmite. The commercial has a report like layout. Rescue teams enter houses to save unused and neglected Marmite jars. Parents are admonishingly addressed and the jars are put in small cages as endangered animals. In the shelter (a kind of asylum), the jars regain strength until a place is found for a new owner (eater).



Within a month it received almost 500 complaints at the ASA (Advertising Code Commission). The commercial would be disrespectful to aid agencies. ASA dismisses the complaint, the commercial is not contrary to the good morals.

Internet – online branding

Google AdWords, trademarks as keywords

Marks & Spencer has bought the keyword Interflora with Google to

promote its website. The website was an alternative to the Interflora 's services, because M & S' floral department also delivers bouquets within a day. Interflora raised objections and after more than five years, the English court ruled this summer that M & S' use of the keyword is not allowed.



The European Court had previously indicated how to look at cases like these. Use of someone else's trademark is permitted under certain conditions. The advertiser must offer an alternative and this alternative may not be a fake product. In addition, it should be clear to the average Internet user from whom the advertisement originated.

In similar cases in the Netherlands the court has held several times that there is no infringement because consumers understand that alternatives are offered when using Google. The English court clearly choose a different route. Which states that the Internet user is always aware of which advertisement originates from the owner of the trademark and what does not. Consumers can therefore think that there is a relationship between M & S and Interflora. That is therefore misleading to consumers.

Trademark Clearinghouse – start sunrise Since March, the Trademark Clearinghouse (TMC) started. A database of trademark holders can register their trademarks. Its purpose is to enable proprietors to quickly and easily apply for an application in the sunrise phase at the launch of the new top-level domain names (like. SHOP,. CAR etc). After a very slow start, the applications are starting to increase. Currently there are some 10,000 registered trademarks.

It is expected that this fall the first (Chinese)



toplevels will be launched. Please note that registration in the registry only makes sense if the trademarks is also in use. Because proof of use must be submitted. The registration is not tied to a deadline, so this option is always open.

Talensshop.nl: suggestion of a commercial tie

Many retailers use the trademark of a manufacturer to indicate that they sell these products. There is nothing wrong with that, as long as that use is honest and there is no reason for the manufacturer to oppose this use. That makes sense because a seller must be able to make it clear that it sells these products. To promote sales, sometimes domain name, social media accounts (Facebook etc) are claimed as well, often in combination with words like SHOP, STORE, etc. Is this allowed?



Regarding the domain name TALENSSHOP.NL the Hague Court issued that this was not allowed. Use of the domain name and social media accounts is also trade name use. This use not only promoted the products, but the company of the owner and suggested a commercial relationship with the proprietor. The proprietor of Talens Shop had anticipated this and put a disclaimer on the website. In the opinion of the Court, this was insufficiently clear. The message "independent Talens dealer" to no avail. Result: infringement, domain name transfer and pay costs almost € 50.000, -.

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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

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