

# ABCOR's ABChronicle

## Trademarks

### 4EVER: use of text message language in trademarks

Language continually develops. Due to the rise in social media symbols and numbers have gotten a new meaning. Abbreviations such as 4U (for you), 2day (today), and CU (see you) have become commonplace. Because these symbol can also be used in trademarks, this can lead to problems. In 1994 the Portuguese trademark 4EVER was registered for fruit juices in class 32. The trademark holder objects the application by a third party for FOREVER, applied for fruit juices mixed with aloe, a few years later.



Plaintiff claims that the trademarks are similar. The court agrees with this. The most important parts of the trademarks are the words. By used of text message language on internetfora, e-mail, blogs and online games, the number 4 is read and understood as FOR. Knowledge of English varies per country, but a large portion of consumers in Portugal is familiar with it. Because of this the trademarks are aurally and conceptually similar. Since the products are nearly identical, FOREVER will not be registered.

### Position mark – Astroturf car

In many companies the corporate identity is implemented in every fiber of the company. This often includes vehicles. In order to prevent coat tail riding from third parties, visual elements are often registered as designs. Since Fleetmarking has a special place and the consumer recognizes a trademark in their special use of astro turf, a trademark registration could come in handy.

English company Easigrass used a grass covered Smart car on her Facebook page.

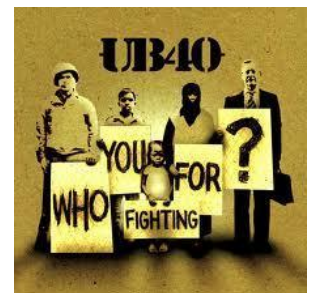


In order to prevent copying of this, a European Trademark application has been filed. One for a car covered in astro turf. A position mark. Although European authorities have the tendency to refuse these type of trademarks, it was accepted this time.

### Fight over name UB40

The famous British reggae/pop group UB40 was founded in 1978 by a few unemployed friends. In 2008 lead singer Ali Campbell and Mickey Virtue leave the band, after som disagreement with management. Duncan Campbell, Ali's brother, became the new lead singer. In the fall of 2013 (some days before their tour in the Netherlands) trumpet player Terence Astro also quits the band.

By the end of January it was announced that the three previous band members (Ali, Mickey and Terence) will launch a new album on the market under the name UB40. The remaining part of the "original" UB40 responded that they are hurt by what they see as an attempt to hijack the name UB40.

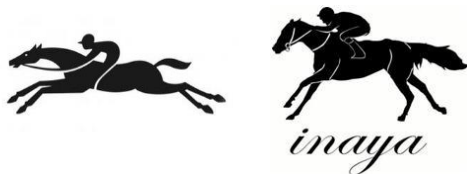


Many musical groups and artist register their name as a trademark, not only for protection, but also for merchandising opportunities. In UB40's case this was never done. A quick check in the register does show that Ali applied for the trademark in late 2013. The remaining band members are considering legal steps.

### Importance of registration logos

In clothing and fashion accessories logos play an important role. Consumers often recognize product not only by their name, but also by their labels. The visual element is therefore extremely important. If the logo is a clear and recognizable picture, it is advised to seek protection for this.

For example LONGCHAMP has not only registered its word mark, but also its logo with the galloping jockey (for leather and clothing).



When INAYA (with a galloping jockey) applies for trademark protection, LONGCHAMP successfully opposes this, based on her trademark. Both images contain a black and white depiction of a galloping horse, with a jockey that is bent forward quite steeply, with a hat on his head. The fact that the logo is normally used in combination with LONGCHAMP is not relevant. The comparison is between the trademarks are registered/applied. The older trademark is also registered for clothes. Consequences: for part of the goods INAYA's logo will not be registered.

### Who the f\*\*k is Chanel

In order to gain attention for your products with the general public it can be very attractive to align your products with the reputation of an existing trademark. However, if this is done too explicitly it can lead to problems. Fashion designer CHANEL (established in 1909 by Coco Chanel) has been doing well on the market since the arrival of Karl Lagerfeld. In order to protect their trademarks well (and act against counterfeit) both the word CHANEL and the logo (two mirrored Cs) have been registered as trademarks. When Glamorous introduces T-shirts on the market, Chanel immediately goes to court. The court is very clear in its verdict. Chanel is a famous fashion brand and enjoys a wide scope of protection. Images of

Coco Chanel and Karl Lagerfeld will align Glamorous with Chanel. Furthermore, the word CHANNEL (used in "who the fuck is Channel") is visually and conceptually highly similar with CHANEL.



Glamorous clearly wishes to take advantage of Chanel's reputation and ride the coattail of the well know trademark. By using the text in the way it was done, serious damage to the reputation of CHANEL could occur. Glamorous is prohibited to continue this infringing act. Furthermore, any profit made by use of this ad must immediately be transferred to Chanel. Any clothing remaining must immediately be destroyed and the legal expenses Chanel made reimbursed (a small E. 15,000). Aligning yourself with the market leader can be lucrative, but always check if there is no infringement in doing so.

### Trademarks in holding, curator left empty handed in bankruptcy

In 2013 over 13,800 companies went bankrupt. In case of a bankruptcy, however, a company's goodwill does not disappear. That is why a curator will always explore possibilities of a restart. Since 2004 a national competition has been organized under the name 'The Clash of the Cover Bands'. At the conception of the idea the "inventor" of the show registered the trademark on his own name. A foundation has been organizing the completion since 2011. This foundation filed for bankruptcy in June of 2013. A battle over the trademark rights emerges. The trademarks are still in the name of the original owner, the curator, however, claims that the trademarks have been transferred in 2011, since that is the year the foundation took

over the activities. The court does not agree. The foundation organized the competition, but that does not make it the owner of the trademarks.



Trademarks can only be transferred in writing, and this has not happened. Since the foundation has no trademark rights, the curator could also not transfer them to a third party for a restart. Sale by the original owner is valid. This case clearly illustrates that it is advisable to register intellectual property rights (such as trademarks and designs) in the name of a holding, and not the actual working company. In case of a bankruptcy of the working company the goodwill is secured.

### Copyrights

#### Round version infringes rectangular table

The shape of furniture (and other shapes of applied arts) can be easily protected with a design registration. This can be licensed to third parties and can be used in infringement cases. In case there is no design registration copyright law may provide a solution.



Detail Piet Hein Eek table round version

Piet Hein Eek graduated in 1993 from the Design Academy in Eindhoven with a demolished wood cabinet. His work has been displayed in the City Museum of Amsterdam and in Groningen. When one of his ex-employees offers similar furniture he starts a procedure. The judge assumes that the furniture Piet Hein Eek designed have copyright.

The rectangular table is made a lacquered tiles and certainly has an original and personal character. When a table is made in a different shape,

but maintains all the other characteristics there is an infringement of copyright.

### Advertising

#### Grandma's variation tips and Alzheimer

A new UNOX commercial has ruffled a few feathers. In the commercial a few daughters visit their mother for dinner. In a concerned tone one of the daughters asked her mother if she is okay as she seemingly uses the wrong ingredients for her dish. When the dish is finally served it turns out to be unexpectedly delicious. The mother replies by saying she got the recipe from Facebook, on Facebook/Unox.



Humor in commercials are always a dangerous combination in the Netherlands. The commercial has been nominated for the STER GOUDEN LOEKIE, which is a prize for the funniest commercial. However, there have also been many complaints with the Advertising Code Commission. The commercial would ridicule diseases such as Alzheimer. Unilever, owner of UNOX, claims this is not the case. Old age is not being ridiculed, on the contrary Grandma is the star of the commercial. The Advertising Commission agrees with this. People suffering from dementia or Alzheimer are not being ridicules. The commercial clearly has a different message and tone, the fact that not everyone can appreciate it does not change this.

### Internet

#### Dutch Advertising Code Social Media

Companies reserve an increasingly bigger portion of their marketing budget for Social Media campaigns. The disadvantage of Social Media is that users do not always know who the message is from. For this reason the new Advertising Code for Social Media January 1 came into force. Its alleged purpose is to increase transparency in Social Media. This is

possible by clearly indicating what the relationship is between the advertiser and the person spreading the message.

For example if someone claims something and is sponsored for this this should be indicated. Hashtags may be used for this, for example.

Furthermore, the advertiser has to make certain that the image that is given of a product is not misleading. Not a redundancy as the recent complaint about taxi service Uber illustrates.



Uber is an American alternative for a taxi service, that enables consumers and drivers to

connect via an app. A strikingly large number of positive tweets on Uber came from famous tv personalities. When a complaint was filed it turned out that these famous people received a discount of some sort at the launch of the company, however, irrespective of whether or not they would send a tweet on Uber. A case of unclear advertising. The advertiser is recommended to no longer use ads in this way. Using a hastag to indicate the relationship could have instantly removed any doubt.

### Prohibited hyperlink to Britt Dekker

Britt Dekker, a Dutch celebrity, was photographed by Playboy in 2011 for their Christmas Special. Two weeks later website GeenStijl received an anonymous tip (using an alias) that the pictures can be seen on the internet. A day later GeenStijl publishes a link to Britt Dekker's photograph. Sanoma, the publisher that works for Playboy, immediately send a cease and desist letter to GeenStijl. GeenStijl does not respond to this, but because of all the media attention this generated the photos are now all over the internet. In the court case that follows everything centers around the question whether or not placing a hyperlink to secret information on the

internet is an infringement (a non-admissible form of publication). The court states that the internet is a free, open and readily accessible communication network. Whoever publishes something first on the internet (in a way that is accessible), publishes according to the Copyright Act. Placing a hyperlink can therefore be seen as a footnote in a book, referring to works that have already been published. Because the photos have been put on the internet by a third party, the third party is infringing and not GeenStijl.



GeenStijl, however, is not without fault, because they knew that the prior publication of the photos was illegal. Someone under an alias had sent the link, and Sanoma pointed this out to GeenStijl. Without the messages and links of GeenStijl, the consumer would not have been able to find the photos. Placing hyperlinks and messages is therefore in this case illegal. Invoking a claim on freedom of speech does not provide an answer for GeenStijl. The hyperlink was used solely to satisfy the curiosity of consumers and not to discuss any opinion. Hyperlinks themselves are not the problem, but depending on the context their use may be.

#### Abcor BV

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)

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