

ABCOR's ABChronicle

Trademarks

Accelerated procedure for infringement

Since two years, Dutch legislation has to comply with the new European rules on enforcement of IP rights. As a result, a new procedure has been introduced in the Benelux. If there is a clear infringement of existing IP rights (such as trademarks or designs), then the judge can immediately issue an injunction without the other party having to clarify its position.

For example, **Chiquita Brands** was able to quickly demand an injunction against the use of its logo on the porn site goedkopekutupullen.nl. (cheapworthless stuff.com)



The judge ruled that the logo on the website was an adaptation of Chiquita's globally known figurative mark and that the reputation of the brand was seriously affected.

There was a similar ruling two weeks earlier. **Chupa Chups** requested - and received - an injunction against the use of a very similar logo (spelling of the trademark) on the porn website chupatolly.com.



McDonald's repels McDrijf

For a number of years, it has been possible to object to a new trademark application before the trademark authorities in the Benelux. Through this route (the so called opposition procedure) it is possible to object to a similar trademark fairly cheaply.



Recently, McDonald's (relying a.o. on its trademark rights for McDRIVE) was able to stop the registration of trademark 'McDrijf' for catering services through this procedure. The fact that the name jokingly refers to a floating catering company was of no avail. The marks are similar and the products and services are largely similar, hence the mark was not registered for catering services.

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Oeps, mind the error

An objection can be made to a new similar mark based on an older mark. However, a trademark must be registered for the goods and services for which it is used, otherwise there may be unpleasant surprises. After five years, a trademark is in fact subject to use.

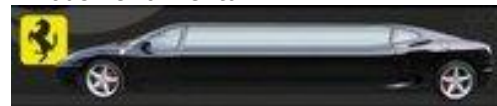
For example, the owner of the **SUNIGUM** trademark tried to stop the registration and use of the **UNIGUM** trademark.



The SUNIGUM trademark was registered in 1993 for plastic sheets, but in reality the factory makes a different product in powder form. The trademark had never been registered for these goods, hence the trademark rights had lapsed. Therefore, it is important to periodically check whether the trademark portfolio is still up-to-date and the registration extends to the products and services for which the trademark is used.

Rebuild your own Ferrari (not)

Stylelimousines built an extended Ferrari-Limousine, using an existing Ferrari ensuring they now own the fastest Ferrari limousine for rental.



When Stylelimousines starts renting out the new car, they receive a letter from Ferrari demanding that the logo be removed from the car. The use of the emblem of Ferrari is trademark infringement, because the car is no longer a real Ferrari. Is this really possible, seeing that the company had used a real Ferrari as a basis?

In this case Ferrari does have a point. By lengthening the car, the construction had to be changed. For that reason, Ferrari can state that the car no longer meets the high safety requirements that are set for a car at Ferrari.

A new color on the outside of the car is not such a problem, but rebuilding a car (and renting it out under the brand name) can be problematic if the trademark owner does not grant permission.

Designs

Design infringement – technical function

SEB and **Philips Electronics** were at discord regarding the production and sale of kitchen machines and food processors.

SEB markets a popular food processor under the TEFAL brand, among others. To protect its rights, SEB had the machine registered as a Community Design in 2004. After, Philips enters the market with its own food processor.



SEB foodprocessor



Philips HR 7620

The judge states that Philips does not infringe SEB's rights. It is important in this respect that comparable kitchen machines had already been on the market before. The SEB machine does deviate from this, but the reason for this different shape is a technical advantage (easier to produce and use). Indeed, shapes that are technically determined cannot be claimed through a design registration.

The only similarity between the machines were said technically determined aspects. Philips' machine distinguished sufficiently on all other points, so that for these other points there is a different overall impression.

Packaging

Camel dromedary misses the boat

The holder of the well-known **CAMEL** figurative mark did not succeed in preventing the registration of the **CAMELO** figurative mark.



The new packaging for **CAMELO** is used for coffee. In Spanish, the trademark **Camelo** has a different meaning. The matter appeared before the European authorities (Court of First Instance). It was stated that visual similarity exists between the marks. Both consist of a dromedary, three palm trees and a pyramid.

Nevertheless, it was ruled that there is no infringement. There is no detriment to the older trademark and there is no free ride on the reputation of the older trademark. It is important to note that the **CAMELO** trademark has a different meaning in Spanish and that the visual elements used are not considered to be particularly distinctive (referring to geographical products). It is hoped that Camel will take

this case to the Court to see if the Court agrees.

Portrait rights

Right to privacy

After Maxima and her children went to courts over having pictures published, Wouter Bos has now done the same after having pictures taken unwanted and being published without consent.



The photo published by 'Weekend' is clearly a private activity and does not contribute to any public debate. The right to privacy in this case therefore outweighs the

gratification of the curiosity of others. 'Weekend' is therefore (not surprisingly) ordered to pay damages.

Domain names

Typo- and cybersquatting

Mistakes are easily made when typing in a domain name. It is estimated that 15% of names are typed incorrectly. Companies earn large sums of money by registering misspelled trademarks as domain names in order to tap into the goodwill of a well-known brand.

Given the success of the popular site **KIESKEURIG.NL** (smartselect.nl), the arrival of **KIESKEURI.NL** was no surprise. The site provided an overview of sponsored links to consumer products.

KIESKEURIG.NL chose the offense, and won an arbitration proceedings at the

WIPO. It was ruled that use of the domain name

KIESKEURI.NL is an infringement of the trade name and trademark rights of the plaintiff. Thus, it constituted a prohibition on the use of this (and similar) domain names plus. Furthermore, a transfer of the domain name and an order to pay the costs (of € 3,250) followed.

Abcor BV

Abcor is an IP law firm, located in the Netherlands. Our specialty is consultation with regards to intellectual property matters, trademarks, designs 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.nl

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