

## JOHN IS ON – ON LEMON persistence

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To prevent third parties from using the name and heritage of John Lennon, Yoko Ono has registered the name as a trademark. The word mark JOHN LENNON is registered for a wide range of goods and services, including soft drinks. When soft drinks are offered using the name JOHN LEMON, advertised depicting, inter alia, the iconic glasses of John Lennon, she objects successfully. The parties reach a settlement. The soft drink is renamed, holding sufficient distance from the name John Lennon. Less than one month later, the

drink is relaunched under the new name ON LEMON - JOHN IS ON. To promote the soft drink, the old name is used occasionally on Facebook and Instagram, as well as on shipping boxes. Is this infringement? Yes it is. The names JOHN LEMON and JOHN LENNON are similar and are used for identical products. In addition, the new brand ON LEMON - JOHN IS ON is similar to the infringing JOHN LEMON and is used in combination with it. It is precisely because of that persistence that the new trademark is not allowed. A European-wide ban follows.

### Copy rights

## Catfight over baskets

Copyright does not only apply to art with the capital A. Also daily used articles are covered by its protection. However, the product (a work) must be an original creation. In short, creative choices have to be made. If another company launches a very similar product, this can be a copyright infringement.

A Dutch wholesaler creates a special kind of cat basket. A basket made of straw in the shape of a teepee. Another Dutch company launches a virtually identical basket, the Boony basket. According to Boony, that is no problem, because

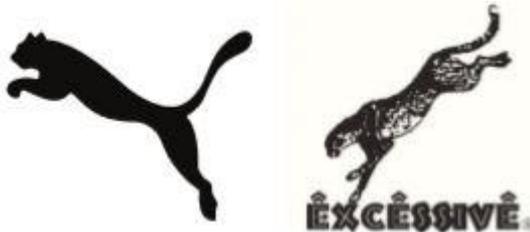
a pet basket cannot be protected by copyright. The court disagrees. Never before have there been cat baskets in a teepee shape made out of straw. This basket therefore is a copyrighted work. Both the original and later Boony basket have a teepee shape, are made of rattan and the color is identical. This makes the overall impression the same.

Consequence: infringement, a sales ban and a product recall (in addition to the paying legal costs of claimant, amounting to almost € 13,000).



### Puma & cat like predators

Well-known trademarks enjoy extensive protection. This is actually necessary to prevent other companies from free-riding on the coat-tails of their success. Many free-rider companies think they can get away with this by using a similar logo, but with a different brand name. However, that doesn't stick.



Puma has been manufacturing sports attire for well over 65 years and it is present in more than 120 countries. The iconic leaping puma is one of the important distinguishing marks of the brand. When the company discovers that the brand EXCESSIVE offers sports clothing via Facebook and internet for sale with a cougar jumping downward, Puma starts an injunction. The judge awards all claims. The logos are clearly similar. There is a risk of confusion and the consumer may think that the products originate from the same company. Consequence: a total ban on the mark's use. And should a webpage be caught online after two days from the ruling, the company faces € 2,500 damages (per page found).

### MEXX a boy's name?

In 2017, Mexx International acquired all IP rights of the former lifestyle brand Mexx. In doing so it became owner of the many MEXX trademarks for clothing and bed linen. The mark had been sublicensed for bedding until 2015.



Globa Sleep has taken over the estate and assets from the bankrupt Mexx Bedding. Globa Sleep offers box spring and mattresses through Facebook and LinkedIn pages of the former company and the website <mexxbedding.nl>. After a summoning of Mexx International to stop this use, Globa Sleep states it will change the trade name and domain. But after a few months there is still plenty to be found online, so a lawsuit is quick to follow. All claims hold up in court. The counter-

argument that Mexx is a boy's name is irrelevant. Globa Sleep doesn't use it as a boy's name, but for selling similar products. Advertising via Facebook and LinkedIn must also stop. The fact that the social media accounts are held by former employees is for the account of Globa Sleep. It has bought the estate including all goodwill and e-mail addresses. For that reason Globa Sleep is liable for all online use. The court assumes that the company can claim the relevant former employees' profiles to put an end to this.

### Scent marks & non traditional marks

Earlier this year Hasbro was granted trademark protection for the smell of its Play-Doh clay by the US trademark office. The mark had been filed for: *'a scent of a sweet, slightly musky, vanilla fragrance, with slight overtones or cherry, combined with the smell of a salted, wheat-based dough'*. The product is made with this characteristic scent since 1956 and it is sometimes referred to in advertising too (campaign 2013: Stop and Smell the PLAY-DOH). Hasbro shows (with a great amount of evidence) that the fragrance has acquired distinctiveness and therefore is granted trademark protection.



But would this also work in Europe? For almost a year, non-traditional trademarks can be filed at the European trademark authorities. For example holograms, patterns, film-clips and multimedia marks. Last year our intern Romy has conducted research on this and wrote her bachelor's thesis on the subject. Her thesis shows that, in addition to pattern marks, film-clips with sound and video are particularly popular. However, scent marks are not yet available. The reason for this is (put shortly) that an odour can't be described and displayed specifically enough. The European Court has decided in a similar case that only a description in words and a chemical formula would be insufficient. It will therefore take some time before scent marks are accepted in the EU. However, for patterns, movie-clips etc. the doors are wide open.

### Bayern Munich settles the score

As opposed to the match in the Champions League, Bayern Munich did end up on top in the competition for its logo this year. In 2002, the FC BAYERN MÜNCHEN logo was registered in black and white in the EU as a device mark for almost all goods and services. A smart move, because that way the logo can be turned for profit. Many of the club's sponsors (including a beer brewer) bring products to the market with the logo, riding along on the popularity of the team. The logo consists of the name with the pattern of the Bavarian flag in the middle. When another Bavarian brewery comes up with a similar logo, the football club objects. In first instance the suit is lost, but in appeal the football club takes the win after all.



The figurative marks are similar, certainly for the non-German public in the EU. The argument in defence that Bayern (Bavaria) and Munich are geographical names is pushed aside because in many languages the regions have a different name (such as Bavaria and Monakovo). Because the logo is registered in black and white, a non-German consumer will fail to recognize the Bavarian flag in it because it is blue. The layout is more or less the same. Consequence: the trademarks are similar.

### Not every tulip belongs to Ilja Gort

This summer Ilja Gort, a well-known Dutch writer, musician and wine maker, made his way into court again. This time, the question was whether the brand "Dutch Tulip Vodka" is an infringement of the trademark rights of Mr Gort's "La Tulipe" wines. Parties had not been able to reach a settlement, neither outside the court nor in chambers, so in the end the court has to decide this case. The Vodka company is found to be right, there is no infringement in this case. Reason is that the word Tulip and the image of a tulip are used as an indication as to what this vodka is made of. Normally vodka is distilled from wheat or potatoes, but this particular vodka is made from pure tulip bulbs. Companies must be permitted to mention

this. This is descriptive use of an ingredient and no trademark use.



The judge feels supported in this, because of the fact that the Benelux trade mark office had previously refused registration of the wordmark, on grounds of descriptiveness for vodka of tulip bulbs. There is also no question of free-riding on the well-known brand La Tulipe. For vodkas it is customary to prominently display the taste or the main ingredient. In addition to this, the bottles are marketed with its' trademark Clusius on the bottle and the design of the label, as well as the way the tulip is depicted, are very different. Ilja's claim is therefore rejected.

### Copyrights

#### Commissioned drawing of Santea Claus

A professional illustrator is commissioned by a Dutch broadcasting company to make a silhouette drawing of a Santa-Claus figure seated on horseback. A few years later, this image (be it mirrored or not) finds its way onto gift-wrapping paper (beside other drawings). The wrapping paper can be purchased online. The vendor also claims having the copyrights on this design.



Because the image was used without permission and because of the unjust copyright claim, this forms an infringement of the copyright and personality rights of the original creator. The damage is estimated at € 5.000, -. So far it's a simple / clear case. However, the paper vendor had itself commissioned a design studio to make these designs (costing €600, - per design). For that reason, the damages claim is transferred onwards to the design studio.

Is that right? The judge finds it to be. The paper vendor was entitled to assume that the designs could be used freely, not infringing on the rights of third parties. The design studio was immediately informed when the illustrator first reported and should have taken action in order to prevent the case from escalating. As a consequence: the design studio has to pay over € 10,000 in compensation for unauthorized use and litigation costs.

#### Advertising law

#### ASN & the insulted neck-tie wear

When consumers are bothered by the content of advertising, they can file a complaint with the RCC “the Dutch Advertising Code”. This is easy and free of charge. Fortunately, complaints are first assessed by the committee’s chairman, so most foolish complaints are quickly rejected. The new ASN commercial ‘*habitual animal*’ received a lot of praise. The commercial discusses banking from a very different perspective and is executed simply brilliantly. For years, ‘habitual animal’ has been doing its banking business with ‘the same tie’. When he discovers that ‘tie’ makes money on things that are bad for nature and animals, he switches to ASN.



It’s a brilliant animation, but apparently not for everyone because a complaint is filed. According to the complainer, the commercial stereotypes tie wearers, being a form of discrimination.

The chairman is quickly finished with this. The reference in the commercial to ‘the tie’ is not stereotyping men with a tie, but a reference to competing banks. Tie stands for banks that make money from animal suffering and things that are bad for the environment. The commercial offers an alternative bank and is not aimed against men with a tie. There is no question of discrimination, the complaint is rightly rejected.

#### Online - internet

#### Mediawebshop.nl domain name claim through court or UDRP?

Domain names are registered on ‘first come, first served’ basis. This created a new phenomenon called: domain name hijacking. Quickly register domain names with names of famous people or famous brands with the aim of selling them for a lot of money. To stop this, the UDRP was invented, a quick and cheap procedure to reclaim a domain name. The UDRP is still very popular, but sometimes not the best route in a conflict, as became clear by the case of <mediawebshop.nl>.



The plaintiff and defendant have worked together for years. When parties separate, turmoil arises over the domain name. The defendant produces all kinds of WhatsApp messages from the past (that he had to record the domain name) and about the troubles regarding to the termination of the cooperation. According to him, the plaintiff’s claim is not based on the truth at all. The UDRP dispute resolver is clear. This conflict has nothing to do with domain name hijacking, but the disentanglement of a cooperation. It’s a commercial dispute with complex facts. So a case for the judge. The case is therefore not taken into consideration.

#### 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](mailto:info@abcor.eu)

#### Sources:

Adformatie, BIE, BMM, Boek9.nl, Class46.eu, Domjur.nl, Elsevier, GPD, IER, IE-Forum.nl, INTA bulletin, Nu.nl, OHIM.eu, PCM-newspapers, Quote, SIDN, Trademark Reporter and WIPO

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