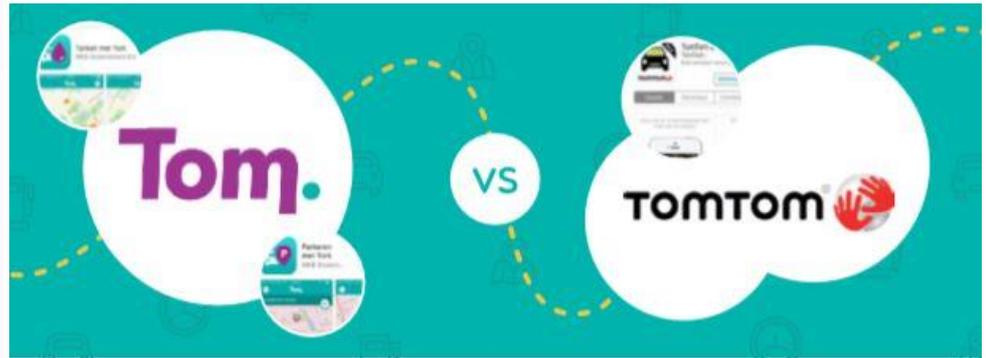


Ban on name change to TOM



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A Dutch chain of petrol stations has been using a fictional character named “Tom de Ridder” in its radio commercials since 2009, in order to promote its payment card and parking services. In 2015, the company decides to change the name to TOM. To prevent problems, the company discusses the plans with TomTom (the well known car navigation brand). The TOM logo is modified and a coexistence agreement signed. In this agreement it is stated that only the logo shall be used and not the word TOM. No provisions are made for the use of TOM as a trading name. The company launches a radio campaign introducing the new trade name TOM. On social media, the

slogan "TOM HELPS YOU DISCOVER NEW ROADS" is used. This use is in conflict with the agreement, so TomTom protests. Parties end up in court. By provisional ruling the use of the name is prohibited. In appeal the court comes to the same conclusion. The agreement has been rightfully dissolved by TomTom. Since an agreement no longer exists, any use of the logo or word mark constitutes an infringement. TomTom is a well-known brand and TOM is similar. Navigation and (travel) information equipment are complementary or at least similar to mobility services and travel information. The public may assume that the companies are linked. The result: prohibition of the use of TOM as a brand and trade name.

Domain names

EasyGroup misses the mark

EasyGroup (established in 1995) uses a wide range of Easy names, such as EasyJet, EasyHotel and EasyCar. EASYJET was registered as a European trademark in 2015. When other companies try to register any names containing EASY, the company almost always takes immediate action. Since 2007 Easy Fly Express (from Bangladesh) has been offering air cargo services in Asia. The internet domain <easyfly-express.com> was registered in January 2014. The logo of the freight company is suspiciously similar to that of EasyJet (matching color, layout and font). Reason for

EasyGroup to start an URDP procedure and demand transfer of the domain name.

The arbitrator rejects the claim. EasyGroup fails to convince that the domain name has been registered and is used in bad faith. EasyJet is not really known in Asia. The air-cargo company has been operating under the name Easy Fly Express since 2007. EasyJet’s trademark is of a later date. The company is active in other parts of the world and consumers are not being misled. The conflict is more of a trademark issue. It seems EasyGroup is barking up the wrong tree.



Repeated filing **MONOPOLY** in bad faith

A trademark is under obligation of use five years from filing. Since proof of use can be difficult to collect (see BigMac –Abcors ABC-no. 35), companies re-file their most important trademarks every five years (so-called repeated filing). For a long time it has been questioned whether this was allowed. After all, by a repeated filing the term in which use has to be proved is extended artificially. As the concept of bad faith is not further elaborated in the EU Trademark Directive, a definitive rule should be formed by case law.



Hasbro registered the MONOPOLY trademark three times in the European Union with slightly different goods & services. The existing registrations have been consistently renewed. EUIPO's board of Appeal has now decided that this is to be considered as bad faith. A repeated filing, claiming protection for some additional items, is not intended to circumvent the obligation of use. For the items are the same or similar, the applied trademark has to be considered as bad faith and the items are therefore removed. This is painful, as trademark holders can no longer rely on a repeated filing in order to circumvent the obligation of use. Very disappointing for the pharma sector, in which product development (or clinical study) often takes over five years.

Ion Maiden becomes Ion Fury

When choosing a title for an online game it is wise to check whether this name can be used freely. 3D Realms, developers of Duke Nukem, learned this when it announced the name of its new game Ion Maiden. British heavy metal band Iron Maiden has registered its name (and logo) in many countries (including the US) to prevent coat-tail riding.



There is only one letter difference and the typography of the game logo also resembles. The main character name, Shelly Harris, also bears a

lot of resemblance with the name of the bands songwriter, Steve Harris. A lawsuit was filed in California demanding a ban of the name whilst claiming damages. Reason enough for 3D Realms to change the name to Ion Fury this summer. The game was launched in August, however the logo has largely remained the same.

Cheaper brand protection in Brazil

Following Canada (this summer) it is also possible to claim trademark protection for Brazil via the Madrid system of International Trademark Registration from 2 October. Through the International Registration it is reasonably cheap and much easier to claim protection in many countries worldwide.



121 countries have now joined this treaty. In addition to the fact that the application costs are considerably lower, maintaining the rights is much easier.

Fack Ju Göthe – public policy and accepted principles of morality

When examining a new trademark application, the authorities also assess whether the trademark may be in breach of public policy and the accepted principles of morality. The Benelux authorities are very liberal on this point. The European authorities are a lot stricter. Many applications are refused, relating to drugs, politics, religion and sex. As soon as the F-word is in it, you can assume that the trademark will be refused. But is this justified? Should a trademark actually be refused on this ground?

In Germany, the comedy Fack Ju Göthe is a huge success. Reason for the producer to claim trademark rights for the title. But the application is refused because it is considered to be offensive for the writer Goethe (who died over 200 years ago). The producer appealed the refusal and the case is now before the European Court. The Advocate General has given an opinion on this (this is often followed).

He indicates that actually two separate assessments ought to be made. Public policy incites objective boundaries, such as violating laws, policies and official statements. The accepted principles of morality have a different angle, here the views of society are important.



The film is very popular in Germany and there has never been any controversy about the title. So there's a fair chance that social norms are not violated and that the trademark is therefore not in breach of good moral. That would indicate a unjust assessment by the European authorities. Hopefully the Court adheres to this view.

Copyrights

Ban on wave shaped shoe display

Copyright does not only apply to Art with a capital "A". Products of applied art are also often seen as a creation. If this is the case, then a work is protected by copyright and slavishly copying it is not really sensible. MVSA, an architects office, designs a shoe display wall for Shoebaloo. A vertical surface from the ceiling to the floor, constructed from wave shaped layers of wall panels with the same thickness. By altering the wave shape, plateaus on which a shoe can be placed are created. This is done with translucent materials, so that the shoe can be illuminated from underneath.



When Invert opens a similarly decorated store in Antwerp, MVSA objects. The question that arises is: is copyright applicable, since playing with wavy shapes may be just a trend and this was already

applied in other buildings?

Court seems to think it is. Many creative choices were made with this design. The interior of Invert has copied the characteristic features of the design. The wall is constructed in the same way, with the same waves, the same thickness and illumination from underneath. Regarding the question of trend/style: the implementation of MVSA is clearly original. Conclusion: the shop layout must be removed within three months and Invert is ordered to pay damages as compensation for the loss in license fees.

Design law

Published promotional video lethal to Community Design

Petsbelle designs, produces and markets scratching posts. In order to protect the design of its products, the company applies for European design protection. There are two important requirements for a European design registration. A model must be novel and have its own character. Novelty is often a problem. Many companies first want to test the waters before incurring the costs to claim their rights. In the European Union it is therefore possible to claim design rights up to twelve months after first disclosure. However this grace term is hard.



When a competitor launches a similar scratching post, Petsbelle demands a ban based on a design registration, filed on March 30th 2018. However, the competitor argues invalidity of this model, as a promotional video of this product was posted on Facebook on 22 March 2017. The application was therefore submitted after twelve months and eight days of disclosure. Novelty is not about the date of first sale, but about the first disclosure. The ban order based on the registered community design is rejected, because the EU model is invalid due to the promotional video. There's a lesson to be learned here.

No matter how enthusiastic one may be about a new product, beware of online publications before a product is brought to market. Premature publication can prove disastrous when the rights still have to be protected.

Advertising law

Misleading advertising by Lidl

Comparative advertising is allowed, in fact: comparative advertising is good for competition. However, there is a limit to this. One of the most important requirements is that the advertising must not be misleading.

Lidl sells a facial cream under the name Cien Cellular. In the commercials, Lidl compares its product with the creams from La Prairie (a cream with patented ingredients). Lidl states that her cream: "contains the same ingredients as the La Prairie Cellular Radiance Cream, which costs almost € 550!".



To substantiate this, Lidl refers to articles in the Flair and The Sun. However, these are based on a press release by Lidl UK. Besides, Cien face cream only contains 31 ingredients and the one by La Prairie 81. In the advertisements no mention is made about the quality or effect of the cream. It is not allowed to suggest that it is the same type of cream, selling at € 500 less. This is misleading. If comparative advertising is done, ensure that the statement can be substantiated by an independent investigation. Clearly state what exactly is being compared and disclose this in the advertisement.

Online - internet

Online infringement and court competence

AMS Neve manufactures and sells audio equipment in the United Kingdom. The trademark 1073 is registered in the European Union for recording equipment in class 9. AMS Neve files a lawsuit in England against Heritage Audio from Spain, for selling counterfeit equipment under the mark 1073. As proof, twitter messages and e-mails directed at English consumers are submitted. Heritage Studio states that the



claim should be rejected. Heritage Studio is based in Spain and the company does not advertise in England. Standard rule for (online) infringement cases is to start proceedings in the country where the company is located, where it advertises or where it offers items for sale and where the follow-up actions take place. In addition, the court is competent in the country where the infringement takes place. The European Court has now ruled that the place where the infringement takes place also includes the country in which the target audience lives, on which the advertisement is focused, even if the infringing advertisement is sent from another country. So this is good news for holders of an EU trademark, because based on this ruling, proceedings can be diverted to a court in any other EU country.

Abcor news

New at Abcor

Sezen Sümer joined Abcor's team. She wrote about the problems that arise as a result of the introduction of the certification mark and its consequences for previously registered trademarks, since these now are vulnerable to (partial) cancellations.

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

Sources:

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