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Protection of look and feel



HEKS'NKAAS (Witches' Cheese) is a herbal cream/cheese dip and has been a hit in the Netherlands for years. When production is shifted from one party to another, the former producer launches a similar product under the name DIP&SMEER (Dip&Spread). However, the producer of HEKS'NKAAS has trademarked their packaging, both with and without the brand name on it. That turned out to be a smart move, because it makes a claim on the look and feel of the product. A lawsuit is filed against the very similar packaging of the newcomer. Their defense: the packaging is not a trademark and we clearly use a

different name. The court disagrees. There is a recognizable cardboard banderole around the transparent round plastic cup. The ingredients are displayed in a cartoonish style using shades of purple and green on a white background. This packaging is distinctive and consumers recognize this as a brand. The newcomer's packaging is visually similar, causing consumers to mistake as to the origin of the product. Because the former producer deliberately aims to take advantage of the original product's success a prohibition follows with a penalty payment of up to € 500,000, as well as litigation costs (approx. € 37,000).

European Designs

Claiming furniture design

Last year, the EU Court passed an important ruling on the relationship between design law and copyright. It was indicated that copyright does not always provide the same protection as a design right. Copyright can only be invoked if an intellectual creation is concerned. This seems to put an end to the ultra-low threshold that was applicable in the Netherlands and with this ruling the importance of claiming design through a design registration has increased considerably.

Spiegel Trading applied for design protection in 2019 for a new line of furniture, the Backbone series. Characteristics: the elegantly veneered brushed black oak, the wood-like structure,

narrow wood strips in a herringbone pattern and, the transparent appearance and the stainless steel piece that gives the impression to float. When Decor Living comes with a similar set (Black Gold), a lawsuit follows. The argument in defense that the design rights belong to the manufacturer does not hold. Spiegel holds the design registration and is therefore considered to be the party entitled. The defense that the furniture is not new is also rejected. The furniture deviates sufficiently from the state of the art. The model rights are valid. Decor furniture does not make a different overall impression. Result: the ban is fully upheld.



Spiegel Backbone

Decor Living Black Gold

Spiegel Backbone

Decor Living Black Gold

Michael Jordan right to a person's name

In the Benelux we do not know an exclusive right to our own name. If a company wants to claim a family name as its exclusive name, it will have to file a trademark registration. In the EU, it is sometimes possible to tackle name-hijacking, if it is clear that this name was registered in bad faith. In some countries, like China, that protection goes a bit further and there is such a thing as a right to a "personal name".

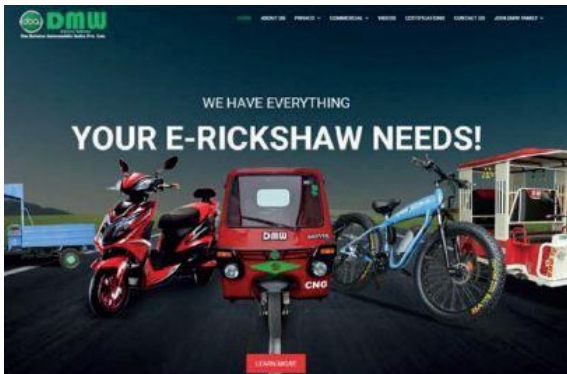


Michael Jordan has been fighting Qiaodan Sports for years. This company has registered approximately 500 trademarks with variations of names of the major NBA basketball players. In the same way a silhouette of a basketball player was registered with the name Qiaodan ("Jordan" in Chinese characters). The trademark was registered for clothing, shoes, etc. in class 25. The Supreme People Court (Chinese Supreme Court) holds that Michael Jordan is a well-known public figure with a huge reputation (well beyond the scope of basketball).

Jordan is known under the name Qiaodan in Chinese characters and is therefore entitled to this name. The Chinese consumer may think that there is a connection between the trademark owner (Qiaodan Sports) and Michael Jordan, or that he has licensed or given permission for this use. For that reason, the trademark registration is considered in bad faith.

BMW stops DMW Riskja

BMW has been around for almost 100 years, making motorcycles (since 1923) and cars (since 1928). The company has registered its trademark rights worldwide. In India, these rights go back to 1956.



When Balajee Automobile offers electrically powered rickshaws under the DMW brand in

2013, BMW objects to this. The company refuses to comply with the demand to stop this, so BMW is forced to go to court. The court is clear in its decision. The DMW and BMW brands are visually and audibly similar. The company tries to ride the coat-tails on BMW's reputation and goodwill. A ban is issued on the production, export, import, promotion and sale of these products.

Adidas's stripe saga

Adidas uses three parallel stripes as the distinguishing sign of its products. Characteristic is the number and the fact that the stripes are just as wide as the space between them. The design dates from 1949. To protect the goodwill of this brand, the company acts consistently against other sports brands that use stripes. The best known conflict is, we suspect, the series of lawsuits against Hennes and Mauritz that has been ongoing since 1997, over the use of the two stripes on fitness clothing.



After many court rulings, from first instance courts to Supreme Courts and even the European Court, there now seems to be a tipping point in this saga. The national Court of the Hague has come to the conclusion that the signs are not similar. The Adidas trademark is a repeating three-stripe pattern with equal spacing. The stripes at H&M look more like a thick stripe with a line between them (so significantly smaller spacing). In addition, the repetition is missing and this is not a pattern. The similarity therefore is low. Result: no infringement. Chances are (given the history) that Adidas will appeal the decision in cassation. However, this statement is particularly relevant. The scope of protection of a logo is limited if it consists solely of simple geometrical elements such as stripes, dots, circles or squares.

CrossFit vs CrossBox

Since 2006, the CROSSFIT trademark has been registered in the European Union for fitness training. This fitness program was conceived in America, using car tires and

sandbags. The concept and name are licensed to many gyms. When VES (an organization of independent gyms) starts offering a similar training under the name THE CROSS BOX, CrossFit objects to this. CrossFit is a well-known trademark and therefore enjoys wide scope of protection. The trademarks are similar and the services identical.



The court disagrees. The claim of a well-known trademark has not been well motivated, because the evidence submitted is focused on America and not the European Union. The CrossFit brand does not enjoy broad protection because it is deemed somewhat descriptive. CROSS is derived from Cross training (a mix of training forms) and Fit refers to Fitness. Using the word BOX creates sufficient distance. Slightly descriptive names are very attractive from a marketing perspective, but remember that the scope of protection is limited.

Tradename

Funder: limited claim trade name right

Many companies assume that the use of a trading name or a domain name is sufficient to make a broad claim on the exclusive right to that name. These assumptions can prove painfully wrong. Since 2016, a company named Funding Innovation (later "Funder Inc.") has been using the name FUNDR as a trade name and domain name. The company provides consulting services in the field of corporate funding and government grants.



To protect its name & goodwill, it later files a trademark for the name, but not for the logo. There is a risk in this, and this comes true when the trademark register refuses registration of the word mark, because this is seen as too descriptive.

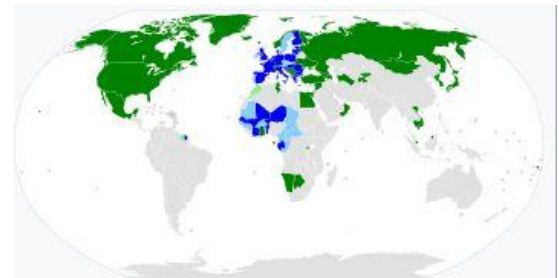
That same year, Rabobank launches an online credit application service called FUNDR. The bank files the logo as a trademark immediately. When Funding Innovation opposes this application on the

basis of its trade name, its opposition is rejected. Rabobank offers its services under the name Rabobank (therefore there is no trade name infringement). Rabobank uses the name FUNDR as a service mark. A descriptive trade name provides very limited protection. Both the services and the way in which Rabobank reaches out to its public are different. Result: the claims is rejected. At the end of the day, if Funding Innovation immediately would have applied for the combined logo as a trademark and not just the word mark, this case could have ended completely differently.

Designs

Cheaper design protection in Mexico

Many companies use the Madrid treaty's system to expand their trademark protection internationally. However, there is a similar system to claim product designs. Note that design protection is only possible if the design is new. For that reason, step-wise expansion of design protection makes no sense.



When design protection of a product is sought in several countries, this can be done via an International Design registration. Already 74 countries and territories are members of this "the Hague" treaty (including the European Union). Mexico has recently joined as well. Especially considering the lower costs, more and more companies choose this route.

Copyrights

Rumag and the gray space

Dutch TV host Arjan Lubach mercilessly exposed the practices of RUMAG last season. Rumag markets T-shirts with famous quotes translated literally, in ALLCAPS separated by dots instead of spaces. This firm's owner is quoted claiming that there can be no copyright infringement when translating quotes from others, as this would be gray space. Is this correct or is this really a bullshit story? The EU Court has ruled years ago that headlines consisting of eleven words can be considered as copyrighted. The criterion is that it must be a creation of the mind (in



short, that creative choices have been made and that it is not just a banal sentence). The fact that it is translated from English to Dutch makes no difference, neither do the dots between the words. So there is nothing gray about this.

Advertising law

Kingsday 2020: Balcony day?

Not only King's Day (*a Dutch national holiday celebrating the birthday of the sovereign*) celebrations were limited this year, also the number of follow-on advertising campaigns was scarce. Question is: what is actually allowed? A good example of this is the **Balcony day!** campaign sponsored by TicketSwap! The campaign calls for people us to raise their glass on their balconies (so at home, maintaining social distance) in honor of our King. The four most beautiful photos could win a TicketSwap voucher. The face in the advertisement resembles that of our King. Is this allowed?



It's not a problem to join a festivity. The Royal House's publicity department maintains the position that you can only congratulate or jubilate the Royal House. Making a commercial link is not allowed, but in practice that concept is flexible. The face used has recognizable features of our King. Celebrities basically have a popularity that can be monetarized. However, for politicians heads of state (including and Royals Family members) it is assumed that they do not monetarize their popularity. There is little case law on the use of photos and names of members of the Royal Family

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.

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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

in advertising. A hook, not aimed at direct sales, is therefore fine. Especially if there is a wink and no suggestion is made that the person takes part of it.

Online - internet

Facebook: worldwide removal of offensive content

In recent years, large social media platforms such as Facebook seem to be increasingly bound by rules. But to what extent can these large internationally powerful platforms be curbed? Eva Glaswischnig-Piesczek is an Austrian MP from the Green party. An article is posted on Facebook about minimum income support for asylum seekers, it is accompanied by her photo. Beneath the photo, the poster places several insulting comments using terms like: "traitor", "corrupt bitch" and "fascist".



As these unsubstantiated allegations are insulting and painful, Eva requests Facebook to remove them. Initially in vain. After a court order, Facebook removes this article so that it is no longer visible in Austria. Ultimately, the matter ends up at the EU Court. Because messages on social media spread lightning fast and well beyond national borders, the Court decides that Facebook should not only take down this message, but also messages that have similar content. The court decision should however describe very accurately what is to be removed. This is quite a vague concept. It is expected that Facebook will appeal this decision and that the Court will have to specify this further. The worldwide ban is also justified, because otherwise the same contact can be posted again by someone else from another location.

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