

In dit nummer

Hema VS Lacoste: decorative use or trademark infringement?

HelloFresh vs Linea Nivnice: "HELLO" distinctive?

Yohana Agurto vs Mel Gibson: how to instigate trademark infringement?

SUGARBEAR vs BEAUTY BEAR: influencers and brand awareness

Ritter Sport vs Milka: chocolate bar a valid shape mark?

Washington Redskins becomes Washington Football Team

Max Verstappen vs Picnic: use of look-a-like in advertising

Benelux trademark now accepted for Amazon and Bol.com brand registry

The importance of logos in fashion



Logos are very important in fashion. Consumers usually have the first glance at clothing hanging or lying in the store shelves and they recognize the brand immediately by the neck logo. So the question is how important that logo is when determining whether a brand is similar?

When Fake Duck applies for trademark protection for its logo for clothing and bags, Save The Duck opposes this application based on its older logo, which was registered for identical products. Fake Duck initially loses, but it doesn't leave it at that. Ultimately, the case reaches

the ECJ (European Court of Justice). This court first checks whether the trademarks are similar. Both signs consist of a black silhouette of a duck and contain the word DUCK. The signs are visually and conceptually similar. The auditory similarity even more so, as FAKE and SAVE sound quite alike. The average consumer knows the difference between FAKE and SAVE. But is this enough? SAVE THE DUCK is a well-known trademark in Italy however. As a result of its intense use it has a highly distinctive character and the products are identical. Conclusion: there is a risk of confusion. The FAKE DUCK trademark is refused despite the different words.

Production in China and brand protection

China's trademark register works on a "first-to-file" basis. This allows trademark hijackers to quickly claim a foreign trademark, in the hope of selling it to the trademark owner later. Some hijackers go a step further and even seize products that are ready for shipping. An exception to this has been developed in case law. If products are only produced in China for export, then this cannot be a trademark infringement (the so-called OEM exception), as the Chinese consumer does not have any interaction with these products.

In addition, the trademark holder must have a registration in the importing country.

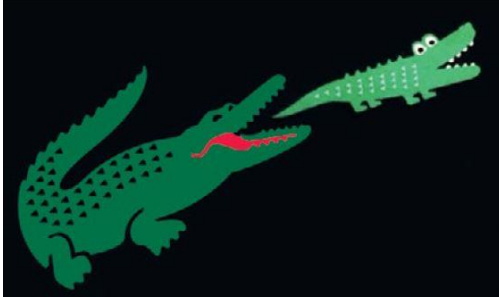
Recently the Chinese Court broke with this in its "HondaKit" ruling. HONDA is a well-known trademark in China. It has been registered there since 1988. The company objects to the production of HONDAKit branded products, meant for export to Myanmar. The argument brought in defense, that this only concerns goods for export, doesn't hold. Court rules that production just for export also implies trademark use. This is a blow to the trademark pirates. However, for trademark holders it is now all the more important to have a trademark registration in China, even if they only produce there for export purpose.



Trademarks

Hema crocodile infringes on Lacoste after all

There is a sequel to the case concerning Hema's underwear. The question was if crocodile decorated kids underwear constitutes an infringement on the Lacoste logo. At first, the court ruled it was not. The picture is purely meant as a decoration, the consumer does not see a trademark in it.



In the appeal, the coin lands on the other side. Market surveys play a major part in both court cases. Lacoste's claim was initially rejected, partly because the market survey was too suggestive. The new survey has been carried out correctly.

This one demonstrates that the consumer perceives the image as a trademark, namely Lacoste. Conclusion: A trademark infringement after all. The ruling clearly shows the importance of registering one's logo separately (besides the name). Exactly to address this "decorative" use. And since it is an EU trademark, the court in The Hague immediately issues a ban for the entire European Union.

No logo HelloFresh

The trademark application for the HelloFresh logo has been opposed successfully by the Czech company Linea Nivnice. It argued that the HelloFresh logo is confusingly similar to its word mark and logo HELLO.



The Board of Appeal agrees with the European trademark authorities. But how is that possible? Can a company just claim to own a general word like HELLO?

The average (Czech) consumer perceives the word HELLO as a greeting. HELLO is therefore not descriptive for food and drinks. Even though it's a commonly known word, for fruit it is distinctive (fruit doesn't say HELLO when you squeeze it). This is different for the FRESH element. The average consumer will understand that it applies to fresh fruit, so this is deemed descriptive. Both trademarks begin with HELLO and are therefore

similar. It concerns identical products, so the logo is refused. This ruling once again demonstrates the importance of claiming protection for trademarks and logos in time. Even if the sign consists of commonly used words.

Surviving with Miel Gibson

In February, Chilean teacher Yohana Agurto lost her job. Being a single mother of four, her situation got even worse when Chile went into lockdown due to the Corona outbreak. But all of a sudden she had a brilliant idea when she saw a picture of Mel Gibson somewhere online. She still had a lot of organic honey in her basement. A new brand was born: Miel Gibson ("miel" being Spanish for honey). A picture of the actor taken from the movie Braveheart was used on the label. Sales were not booming, but it paid the bills and the kids could eat, so she told the New York Times.



However, Mel Gibson's lawyers also got the word. So a letter followed ordering a cease & desist of the unlawful use of the name and image. For a moment Yohana thought about giving up, but then how would she feed her children? The alternative was to seek publicity online in the hopes of settling the case. And with success, she was allowed to continue using the name, only Mel Gibson's face could no longer be used. Often companies tend to respond to any infringement with a standard Cease & Desist or go in with full body armor. Our word of advice, first check exactly who you are dealing with.

Beware that public opinion can swing against you, even if you are legally right. A more humane approach often works much better, having the same effect and not damaging the brand holder's public image.

Washington Redskins the story continues

For years people have been fighting against the name WASHINGTON REDSKINS. In 1993, the National Congress of American Indians stated that the club name is derogatory and racist to Native Americans. For that reason,

a request to cancel various Redskins trademarks was granted in 2014. However, the club's owner, Dan Snyder, was unwilling to even consider changing the name. In light of all the events of the past year, the tide now seems to be turning. Main sponsor FedEx threatened not to pay the remaining amount of the sponsorship deal (45 million) and PepsiCo, Nike and the Bank of America also started to raise the issue.



Reason enough to change the name to Washington Football Team. This gives the club the opportunity to look for a new name, a name without negative associations and which can be used freely.

Influencers and well-known brands

Advertisers are keen on using influencers to promote their products on social media. Some vloggers' reach is immense and they are ideal for pushing a product into the attention of the target group. Does this now also have trademark law consequences? SUGARBEAR is a brand for vitamin preparations and objects to the launch of a competing product BEAUTY BEAR. They argue that the signs are similar and the products identical. But most importantly: the SUGAR BEAR brand is known to the target group due to the very successful social media campaign in Europe.

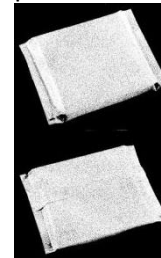


SUGAR BEARS Instagram account has 1.6 million followers. Influencers like Kim Kardashian (and many others with millions of followers) have previously promoted the brand and products on their own Instagram and YouTube. Many articles about this very successful online campaign are submitted in support of the claim. The trademark authorities therefore come to the conclusion that the SUGARBEAR brand is well-known within the target group. It is not enough that the first words are different. The BEAUTY

BEAR brand has been rightly refused.

Milka misses the mark: valid shapemark

Shapemarks are not uncommon in the chocolate industry. Think of Toblerone's triangular shape, Tony Chocolonely's unevenly spaced blocks and last but not least the famous KitKat bar. Ritter Sport has been making square chocolate-bars since 1932: a small square piece of chocolate that fits perfectly into a sports jacket without breaking. The product has long been successful and to prevent imitation, the company had the shape of the packaging registered as a trademark in 1993. When Milka comes up with a comparably shaped bar in 2010, a conflict arises. Milka is fighting it in every way possible. Ultimately, the case revolves around the question of whether a shape can possibly give substantial value to a product.



The German court ruled that the square shape does not give substantial value to the product. This question can arise with a certain type of products, if the shape has an artistic value, the shape differs vastly from what is usual, if there is a big price difference or if there is a clear marketing campaign to emphasize certain artistic aspects of the design. This case involves a plain white square packaging, which is not expensive and has no value. The shape mark is therefore valid. Milka is no longer allowed to use the square shape.

Advertising law

Max still loses to Picnic

As an introduction of the brand Picnic, the company launched a viral parody of the Jumbo commercials featuring Max Verstappen. Celebrities popularity can be monetized. For that reason Max started legal proceedings against this use. Court agreed with Max and sentenced Picnic to total damages of € 150,000. Picnic successfully appealed against this. The Court in review rejected the claim. Reason: it is abundantly clear that this is a look-a-like. Nobody will think this is Max Verstappen or that he supports this.

There is a chance that the case will make it to Supreme Court, because a portrait does not necessarily concern the famous person himself. It must be a recognizable representation (so we expect a follow-up).



In addition, according to the Court of Appeal, the use of a look-a-like is not unlawful with regards to Max himself (this may be different for the Jumbo). Reason: Max's honor is not affected and the statement is not offensive to his good name. His reputation is not at stake. It is clear to everyone that this is parody and no one will think that he actually supports Picnic's services. As a result, the claim is still rejected. Freedom of expression takes a win this time. For advertisers this opens possibilities to use parody with regards to celebrities.

Online - internet

Brexit .eu domain name and trademarks

The British government and the European Union have still not reached an agreement on how Brexit will take shape, by December 31. However, it appears that UK companies will no longer be allowed to hold a <.eu domain name> after December 31st. These domain names must therefore be transferred in good time to a sister organization or distributor on the continent.



Regarding trademarks and designs, please note that UK attorneys may no longer be

allowed to represent applicants at EUIPO in conflicts. If necessary, we can take over representation (free of charge of course). The transition may be postponed again by 1 or 2 years. To be continued!

Benelux trademark now accepted for Amazon and Bol.com brand registry

Many businesses sell products online through platforms such as Amazon and Bol.com. If a potential customer is looking for the product online, it is preferable that ends up with the right seller. But what if another company also sells these products under (almost) the same name? Bol.com and Amazon have created special procedures to protect trademark owners. For example, to prevent consumers from receiving incorrect product information or ending up with the wrong seller. Companies can register their brand in the brand registry (Amazon) or partner platform (Bol.com).



However for the above mentioned protection it is required to have a valid trademark registration. Until recently, a Benelux trademark registration was not accepted. Fortunately, that has changed now. Amazon has recently adjusted its policy and now also recognizes claims based on Benelux registrations. Bol.com now also allows a Benelux trademark registration. Is this good news? Very much so, because a Benelux trademark registration can be had within a couple of days from filing, using the accelerated procedure!!!

Given the great importance of selling through online marketplaces, is it essential for companies to check that all brands are trademarked? If not yet so, protection via a Benelux registration is a cheap *and fast* option!

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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