

## Yellow stitching valid position mark

### In dit nummer

EUIPO: 25years EU trademark/  
registered community design

Nike vs MSCHF: adoptions to  
Nike Air Max 97

METCHUP vs MAYOCHUP;  
normal use in commerce

D-Reizen: assignment of IP-rights in  
a bankruptcy

Dairy Partners vs DOC Dairy  
Partners: descriptive trading names

Lego vs Lepin: the fight against  
counterfeiting in China

Meubelhallen Kolham: staff member  
depicted in commercial outing

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trademark renewal offers



Ever since the 1960s, Dr. Martens has been selling their boots. A signature element of their brand is the contrasting thick yellow stitching at the edge of the sole. Given the fact that the yellow stitching acts as an identifier (much like Louboutin's red sole or the red label on Levi's jeans), Dr. Martens has registered this as a position mark to be able to ward off piggyback riders. When Van Haren launched a similar shoe, a lawsuit ensued. Van Haren claimed that the yellow stitching cannot be registered, and filed a

cancellation procedure at the Benelux trademark registry against the trademark.

The court ruled that the chances of success are small, referring to many publications about the characteristic yellow stitching in fashion magazines since the 1990s. It became clear that the public now perceives this feature as a trademark, as opposed to an ornament, as Van Haren claims. It is irrelevant that Van Haren's stitching looks slightly more copper- or gold colored. The stitching constitutes an infringement. The result: a ban for Van Haren.

### Trademarks/Designs

## Babymilk blenders on bol.com

The Baby Bullet is a blender specifically for making baby food. The blender comes with little storage jars and a booklet containing recipes. A happy face is depicted on the accompanying measuring cup. In order to protect the design, the manufacturer has applied for a Registered Community Design registration for this feature.

OmniChannel promotes these blenders through home shopping channels on cable TV, while also offering these products through online sales platforms such as <bol.com>. An EAN code is linked to the product. Other providers at <bol.com> may also use that EAN code as long as it is for the same product. Offering

a different/similar product is prohibited by <bol.com>, but is it also legally prohibited?

When OmniChannel found out that its Baby Bullet blender is offered for sale on <bol.com> by an unknown seller, they place a trial order. However, they get a different product, the Happy Baby, which is also a blender containing a happy face. The Court ruled that offering a similar product for sale under the Baby Bullet name (and using their EAN) constitutes an infringement on trademark and design rights. Result: a total ban on offering this product through web shops and sales platforms as well as compensation of damages.



## Trademarks

### The success of 25 years EU trademark

This April 1<sup>st</sup>, it was 25 years ago that the first EU trademark was filed in the European Union. What is quite common now, was a sensation at the time. Until then, companies could only register their trademark rights nationally (so per country). The EU trade mark was launched to promote free movement of goods in the European Union. With one application, a trademark owner received immediate protection in all countries of the European Union.



It was a huge success right off the bat. Reason: on the one hand the relatively low cost and on the other hand the great advantage that an immediate ban could be demanded in all countries of the European Union, based on an EU trademark. Back in 1996 there were only 15 EU countries but now an EU trademark gives protection in no less than 27 countries. An ideal solution for companies that are active in several countries within the European Union.

### Ban on Nike Satanshoe

This spring, rapper Lil Nas X not only launched his new video, but also 666 pairs of "Satan shoes" (\$1,018), a joint project with artist collective MSCHF. Original Nike Air Max shoes were slightly modified for this. A pentagram was added to the laces, as well as a reference to Luke 10:18 (the fall of the devil) and a drop of human blood combined with ink on the sole.

← **Tweet**



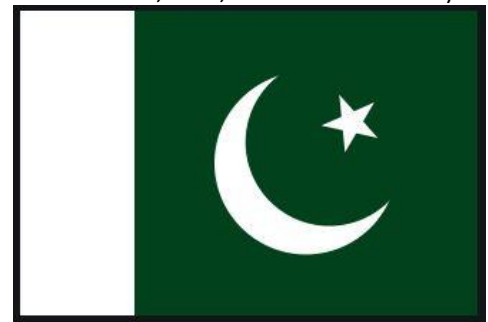
After the announcement on Twitter, the numbered pairs sold out in the blink of an eye. Not to the liking of Nike, but could they do something?

An original product may be sold on. A trademark owner cannot prevent this, as result of the exhaustion rule. The only exception being when the original product is altered, causing its condition to deteriorate. Additionally, there should be no suggestion of a commercial connection with the original seller.

This was the card Nike pulled as they had not been involved in the process and the modifications to the sole could even be dangerous to the user. Within several days it was announced that the case had been settled. All buyers could return the shoes to MSCHF and get a refund, Nike pleaded clean and Lil Nas X had had his fair share of media exposure.

### Pakistan enters International Registration

From May 24<sup>th</sup> onwards, it is possible to claim trademark protection in Pakistan through the International Registration. International Registration is a relatively cheap and easy way to register a trademark in a vast amount countries around the globe (such as China, USA, Brazil and Canada).



124 countries have now joined this system. Beside the fact that the application costs are much lower, maintaining the rights is more attractive.

### MetChup vs MayoChup

In 2007, Dennis Perry had registered the trademark METCHUP in the USA for ketchup, mayonnaise and mustard. Perry mixes these sauces in his own kitchen and sells this himself. Since 2010, he has sold 34 bottles.

When Heinz launched a similar product under the name MAYOCHUP in 2016, a problem arises. Dennis deemed that Heinz took off with his idea. At launch, a competition was held for a new brand-name. 95 suggestions were received, Metchup being one of the entries. At the end of the campaign, Heinz published an overview on their website with all suggested names depicted on sample bottles. Perry claims this is an infringement.

The court disagreed. Heinz sells the product under the name MAYOCHUP and not under the name METCHUP. Additionally, Heinz never used the name METCHUP in commercial context to promote its product.



But there is another aspect that plays an important role: if a trademark owner invokes a trademark that is subject to obligation of use, he must actually use it. The sale of 34 bottles in about 9 years does not, however, constitute use. For that reason, the Perry brand was cancelled on account of non-use. Registration is a good start to claim Trademark rights, but if you want to enforce them, keep in mind that in most countries one has to use a trademark normally. Otherwise you'll end up with nothing.

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#### **D-travel: bankruptcy and trademarks**

As a result of the pandemic last April, the curtain dropped for D-reizen (D-travel), one of the largest tour operators in the Netherlands. On March 12, however, all trademark rights were suddenly assigned to another entity, keeping the rights outside the bankruptcy.



Immediately the question arose whether this constitutes a fraudulent act (a transfer of assets that is disadvantageous to creditors)? Probably yes, given the fact that parties are facing each other in court.

The incident clearly shows that companies should not record such assignments at the last instant. Many companies consciously place all their IP assets, such as patents, trademarks and domain names, in separate IP Holdings. These IP holding companies then license the right to use the trademark to the operating company. So don't automatically register your IP in name of the operating entity. If part of the goodwill should be secured, ensure that it is held somewhere where it cannot be touched and do so in a timely and correct manner.

#### **Trade names**

#### **Dairy Partners - descriptive trade names**

For some years now (following recent case law of the Dutch Supreme Court) there has been discussion about the extent of the protection of purely descriptive trade names. Can a company with a descriptive trade name claim exclusivity to this name and subsequently prohibit other companies from using a similar word in their trade name?



DAIRY Partners and DOC DAIRY Partners are both dairy companies and active internationally. DAIRY Partners argues that the two company names are too similar, causing a risk of confusion and demands a ban. DOC states that the word dairy is purely descriptive of a dairy company. In that case, the likelihood of confusion is not sufficient to prohibit the sign in a company name, unless additional circumstances exist.

The Dutch Supreme Court shed light on this issue last spring, stating that additional circumstances are unnecessary, only considering the risk of confusion. All other circumstances of the case (including use) should then be taken into account. The public knows that companies often use descriptive names and are therefore less likely to confuse them with each other, so small differences are enough. The public will associate a descriptive trade name with a company only if that name has become well known due to extensive use. The scope of protection is therefore very limited for a descriptive trade name, while the scope of protection of a distinctive company name naturally is significantly larger.

## Copyright law

### Lego acting upon counterfeiting in China

Lepin has been selling imitations of Lego products under the LEPIN brand since 2015 (as well as having this trademark registered everywhere). Not only the products are exact imitations, the packaging as well. In two years approximately 4.25 million products were sold worldwide at a quarter of Lego's price. Lego has been combatting counterfeits for years. When the LEPIN trademark got cancelled in England in 2019, a ban was issued in China on production of the counterfeit products. At a police raid of Lepin's factory, 88 molds and 290,000 boxes were seized. In the following lawsuit, 9 people are sentenced to imprisonment. The main suspect was sentenced to 6 years in prison, as well as receiving a fine of approximately 14 million US dollars.



The Shanghai Court recently confirmed this decision, stating that copyright infringements are also harmful to the socialist market. In practice, enforcement of IP rights is on the rise in China. Courts can, by law, impose a fine of 100-500% of the profit gained or 50-100% of the total turnover (depending on the extent of the infringement/loss of the owner). Anticipate this and register your most important IP rights in China, especially if part of the production is placed there.

## Advertisement law

### Picture of own staff in company ad

If a person is photographed, he or she can object to the publication of that photo if the person has a reasonable interest in doing so. For celebrities this often comes down to financial interest. For ordinary people/staff, it is often about the right to privacy, protection of honor and reputation. In 2017, an employee of Meubelhallen

Kolham (Kolham furniture halls) was photographed for the company's advertising brochure. Less than a year later she switched jobs to a competitor. When Kolham re-uses one of the photos in a folder in 2019, the former employee objects, invoking her portrait right and claiming € 5,000 in compensation for the publication against her will, as she no longer wishes to be associated with her previous employer.



The court agreed with her. Seeing that the employee had given permission for the photo shoot, she had basically renounced her portrait rights. However, that permission was strictly limited to use in advertising during employment. As the employee started working for the competitor, the company should have checked whether the photos could still be used. As this was not done, the appeal to her portrait right is justified. However, the compensation is adjusted to € 500, because this concerns a limited use and the ex-employee is not a celebrity.

## General

### Levin Nyman – deceptive renewal offers

Many EU trademark holders have been approached by a firm named Levin Nyman & Partners recently. This Finnish company offers renewals of EU trade marks at excessive prices. If signed off, payment is demanded; even if the client changes his mind. The Finnish company is not registered with any Chamber of Commerce; in fact, the company is not located at the office address stated on the letterhead. The phone number (masked by a QR code) is not in use. So this reeks of a scam. Our advice: never react to any dubious offers. When in doubt: consult (and only pay) your authorized representative. As the registers are publicly accessible and there are ever more scammers, an additional piece of advice: report the plague to your government agencies for fraud prevention.

## 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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