

**In dit nummer**

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limitation to tradename rights

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UDRP procedure

# Self-assembled Kitcar infringes Ferrari



Kitcars are self-assembled vehicles. A new body is built on an existing chassis, usually from a middle class car. Aside from being sold as ready-made cars, they are also offered as a kit. A company called Kitcar Collection collects and sells such kitcars. In 2018, this company imports a ready-built kit car from the United States. A logo featuring a prancing horse can be seen on the handlebars and in the center of the hubcaps. The Ferrari word-logo is attached to the front and boot of the car, but covered with black Duct Tape. When the car is offered for sale, Ferrari has it seized.

They demand a ban on the use of the trademarks and for the car to be destroyed, as it resembles a 1969 Ferrari Spyder too closely. The court agrees partially. This use of the trademark is not allowed, even when covered with Duct Tape, because a buyer can remove the tape. As a result of the differences in the between the cars' bodies, the overall impression of this kit car differs sufficiently from the Spyder. The claim of copyright infringement is therefore rejected. To have the entire car destroyed goes way too far, as an alternative, defendant is ordered to remove the trademarks within two days.

Trademarks/Advertising law

## Beer drinking toddlers

Misleading advertising is found all over the world. It often concerns use of words, but the deception can also involve matching packaging. Sometimes unexpected parties come to the rescue. Choc Milk Stout (from Howler's brewery) mimics the packaging of Milo chocolate powder from Nestlé. A nice touch, unless something goes wrong. A toddler accidentally mistakes the can of beer in the family fridge for chocolate milk, after which its parents file a complaint with the advertising authorities. This design is irresponsible. The brewery reacts indignified: *"We do not target*

*children with our beer and the use of this label does not lure children into consuming beer."*

The local advertising code for alcoholic beverages states that signs that appeal to minors should not be used. The beer packaging has the same label layout, brown type-font as well as the same green color as is used on the Milo packaging. The way the beer is promoted is against guidelines for the promotion of alcoholic beverages and can lead to irresponsible alcohol consumption. The manufacturer is requested to adapt the packaging.



## Trademarks

### Valid yellow colormark Kärcher

Ever since 1974, Kärcher has been using the color yellow for its cleaning devices. This same yellow color is also used consistently on their website, brochures, packaging, promotional material and all forms of advertising. In 1990, the company has registered the color yellow as a trademark. It has become clear in EU case law that a PMS or RAL code ought to be submitted with a color claim (only a description is considered too vague). For that reason, in 2012 a new application was filed for the color mark.



Varo sells pressure cleaners in the combined colors yellow/black. Kärcher claims this is an infringement and demands a ban. The central question is to what extent Kärcher can rightfully rely on both color marks. Court rules that the old color mark from 1990 is invalid. It has not been claimed with enough precision, as any color code is missing. The new trademark however has been submitted correctly. Color marks are often not immediately recognized as a trademark by the consumer, unless the color has become established through long and intensive use which is the case here. Kärcher has consistently used this specific tone of yellow as a distinguishing mark for decades and the marketing investment has been substantial. Market research shows that consumers recognize this tone of yellow as Kärcher's brand. Result: infringement, prohibition and payment of damages.

### Coin pocket valid positionmark

Diesel has a design for its jeans with a small pocket on top of the right front pocket, the so-called coin pocket. Diesel has applied a small diagonal stripe to this small pocket. Just as Levi's sees its red vertical tab as a trademark, Diesel uses this slanted strip as a vital part of its branding too.



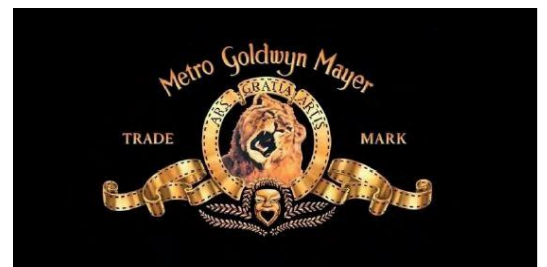
In order to protect the rights, it applies for a position mark. The validity of this position mark is central to a conflict between Diesel and Calvin Klein.



Calvin Klein argues that a simple stripe cannot be a trademark. The public sees this as banal decoration. The Court disagrees. This is not a simple stripe, but a strip that is applied in a special place. Such a strip can often be found on all other jeans, but then horizontally at the top. Due to the diagonal placement, the consumer will see this as an identifying mark. The trademark is upheld for Diesel. There is no question of infringement by Calvin Klein, because they (like the rest) use a horizontal stripe on their coin pocket. The marks are therefore not deemed visually similar.

### When can a sound be a trademark?

With the implementation of revised trademark treaty, the requirement that a trademark must be able to be represented graphically was abandoned. This has opened the door to new sorts of trademarks. Think of movie clips, animated images, position marks and of course sound marks. Before that, a melody could only be claimed as a mark, if the melody could be represented in a music-staff. Now that this new legislation is in place, a soundmark may also be submitted as an MP3 file.



However, not every application is accepted, as Ardagh learned. Is the sound of opening a canned soft drink, followed by a few moments of silence and then the sound of sparkling water acceptable as a trademark?

The answer is no; the consumer does not recognize a trademark in this. They simply hear the usual (functional) sound of a can opening and the fizz of carbon dioxide. For soft drinks, this cannot be a trademark. This sound mark does not meet the requirement of distinctiveness. Note that a soundmark no longer has to deviate significantly from a natural reproduction. The key is whether the consumer recognizes a trademark in the sound. Soundmarks such as the 20th Century Fox tune or the roaring MGM lion do meet this requirement.

### The importance of protecting a logo

The main rule is that a word-mark is optimally protected when registered in all-caps. In whichever way the word is used, the use then falls under the requested protection. However, with short wordmarks, small differences are often enough to distance oneself. In such cases filing a logo can provide extra protection.



Bodyfit Wellness sells and installs swimming pools. The company decides to change its name to WELSON in 2020. In order to protect the rights, not only the word mark, but also the new logo is registered as a trademark. Shortly after the national campaign has started, a competitor decides to change its name to WELLUX. Court rules that WELLUX does not infringe on WELSON. The first half is identical, but refers to wellness. The last parts, SON and LUX, are therefore the more distinctive parts and differ sufficiently. However, the logo does form an infringement. Both logos are visually very similar. They consist of six letters with a wave motion above it, a peak in the middle and the similar formatting. The logo may no longer be used.

### Coat tailing well known trademark

Well-known trademarks enjoy broader protection. Their trademark not only provides protection against similar products, but also against completely different types of goods. It is important that the consumer makes a link to the

well-known brand. Well-known brands therefore not only register the word mark, but also other (loose) distinguishing elements.



Red Bull is a well-known brand in many countries. The company has trademarked not only the name, but also the packaging, the color combination and the bulls clashing against the setting sun. If Bakewell Biscuits introduces a similar packaging for bars, a ban is ordered. Almost all distinguishing features have been copied. Use of the packaging irreparably damages the brand Red Bull.

### Advertisement law

#### Misleading advertisement - packaging

Everyone who has ever used Parodontax toothpaste knows that it has no equal. This toothpaste has a unique salty taste, does not foam and once you are used to it, you will never want anything else again. When Parodontax launches a renewed product, it doesn't only explode on social media, also a complaint is lodged with the Advertising Code Committee (RCC). The plaintiff argues that the new claims are misleading. The packaging says 'renewed taste', but also 'Parodontax ORIGINAL'. This is a completely new product with a different taste and a tingling sensation on the tongue. The use of the term ORIGINAL is therefore misleading.



GSK (the new owner) claims that ORIGINAL refers to the oldest version of Parodontax and that only its flavor has been modified. Both the advertising board and the board of appeal agree with the complainant. The combination of the words 'Original', 'renewed taste' and the familiar red packaging suggests a slight change. GSK admits that about half of the ingredients have been replaced. For example, the characteristic herbal extracts have been replaced by aromas.



If a manufacturer wants to renew an 'Original' in the way that GSK has done, the consumer (and especially existing users) ought to be informed about this appropriately in order to avoid false expectations.

Just reporting that the taste has been renewed is not enough. The claims are misleading. GSK is requested to use different claims on their packaging.

#### Trade names

### Victory comes from Alkmaar

Many companies register their trading name as a trademark. Reason: a trademark provides much broader protection than trading name law. Especially if services are offered locally, the scope of protection is too limited to inhibit fellow companies in other regions.



'Victoria Taxi' from Avenhorn finds this out the hard way when the company makes objections to the use of 'Taxi Alkmaar Victoria'. Court rules that, despite the two companies being only 20 km apart, there can be no risk of confusion as customers will take the local taxiservice. Due to the different area code, therefore, no confusion is to be expected. Would the plaintiff have had a trademark, the case would probably have ended completely different.

#### Online

### Insta Gram online coffeeshop

Domain name disputes can often be resolved through a simple administrative (UDRP) procedure. These cases often involve a domain in which the trademark of another party is part. Some companies trust that having their brandname as a domain provides sufficient protection. They often neglect to apply for trademark protection timely. This can have serious consequences.

### 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.

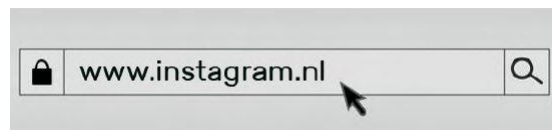
Suggestions for ABCOR's ABCHRONICLE may be sent to [info@abcor.eu](mailto:info@abcor.eu)

#### 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

The social media app Instagram was launched on October 6, 2010.

Almost three months later (on December 22, 2010) the domain name <instagram.nl> was registered by the defendant.



More than 10 years later, Instagram wants the domain name and starts a UDRP procedure. According to Instagram, the defendant seeks to take advantage of the successful app with this domain name. Defendant disagrees and claims that it has its own right to the name. At the time of their domain registration, Instagram was virtually unknown in the USA and certainly in the Netherlands.



Defendant was not even aware of the existence of this company. Defendant at the time intended to launch an online shop for the sale and home delivery of cannabis products. The services were to be offered under the name 'Insta Gram'. At that time investment in the start-up had already amounted to € 30,000 and discussions with investors were ongoing. However, due to legal red tape, things ran behind schedule. Defendant therefore has an interest of their own in this name.

In view of this defense, the failing documents Instagram's claim was rejected. This is not a simple matter of the sort UDRP is meant for, but for litigation. Note that Instagram only registered its trademark in the EU in 2011. If the trademark had been registered before the launch, this would probably have yielded a different decision. Therefore, don't rely on use, but apply for trademark protection in good time (well in advance).

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