

## Trademark no more: I want to get rid of my car

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Dealerdirect Global operates a website <ikwilvanmijnautoaf.nl> which would translate into **Iwanttogetridofmycar.com**. A competitor uses this Dutch phrase meaning 'I want to get rid of my car' on its website. The parties agree that 'I want to get rid of my car' has no distinctive character for trading in used automobiles. Plaintiff states, however, that through its intensive use in advertising I WANT TO GET RID OF MY CAR has become a trademark, in other words: it has acquired distinctiveness. Abcor represents the defendant in the procedure that follows at the Benelux trademarks authorities. A market research report is submitted revealing that consumers perceive the phrase "I want to get rid of my car" as a descriptive

message, not a brand. With that in mind, a procedure requesting revocation of the trademark is filed at the Benelux office and this is granted. Dealerdirect appeals against this decision at the Benelux Court of Justice. Can the Office revoke a trademark previously accepted based on acquired distinctiveness? The Court rules it can! In these proceedings, new evidence has been submitted by both parties with regards to the acquired distinctiveness. Court (in line with Office) rules that on the basis of this evidence acquired distinctiveness can no longer be supported. This is partly due to the poorly conducted market research on the part of claimant. The revocation is upheld in Court.

### Design protection

## Ferrari bonnet unregistered design?

Mansory Design sells tuning kits with which the appearance of a 'normal' Ferrari 488 GTB can be transformed to look like a FXX-K, a rare race car of which only a few exist. Main characteristic of the latter is the V shape of the bonnet (hood). Ferrari has not protected the appearance of this car as a registered design however it opposes the sale of the tuning kits, relying on an unregistered design. This normally applies to the entire product. Can Ferrari rely on a part of such a design? Court holds that this is possible but

only if the part has been clearly recognizable during the first public showing. This leaves plenty of ground for discussion. It is therefore questionable whether the court will accept Ferrari's claim. This usually does not hold true for ordinary consumer products. Lesson learned for producers: if you aim to claim the design of a product as a whole or in part, go for a registered design. This allows you to indicate very precisely that you also want protection for a certain part in addition to the entire model.



## Trademarks

### Wendy's local David versus global Goliath

A feud dating back to 1997 has been ongoing between the American fast food chain Wendy's and a local diner in the Netherlands. The local diner trademarked their company name in 1995 for the Benelux. The American chain did previously have a trademark in the Benelux, but that had expired as a result of non-use. When the American chain files for trademark protection in 2015, the Dutch trademark holder successfully objects. For some people this sounds almost incomprehensible. How can a local diner stop a multinational chain like Wendy's by simply invoking a Benelux trademark?



In response, the international fast-food franchiser launches a cancellation action against the Benelux trademark for lack of genuine use in commerce. Their stance: trademark rights can only be maintained if there is more than one outlet, one local diner is not enough. Court disagrees. Many neighborhood diners exist in the Netherlands. This local diner has an acceptable turnover, its name and logo are featured on the store front, packaging, take-away bags, cash register receipts and for sponsoring and advertising. The use of the trademark is therefore not symbolic and will retain its protection. The foreign fast-food chain is banned from using their brand name in the Benelux.

A logical outcome in itself but it remains surprising that the American Wendy's chose this approach. If they had sought an amicable approach, it would have probably been settled immediately. The American company may continue to use its name for the corporate holding in Amsterdam. Corporate holding services and financial services are not similar to the services of a diner. There's no infringement.

### Jägermeister's Hubertus deer

Les Bordes Golf Club uses a silhouette of the head of a Hubertus deer for their logo. When they file EU trademark protection for this sign, Mast-Jägermeister opposes, invoking its registered logo. This has been registered for a wide range of identical products and services. The EUIPO initially rules that the trademarks

don't infringe, but Jägermeister appeals successfully at the EUIPO's Board of Appeal.



LES BORDES

The silhouette is almost identical to the shape of the head of the Hubertus deer and this constitutes the dominant part. The circle and the cross are mere decoration. The added verbal element LES BORDES is deemed insufficient to compensate for this similarity. As the golf club logo has been requested for identical goods and services, there is a possibility of confusion. The trademark is therefore refused.

### China accedes to The Hague treaty

Often companies claim trademark protection abroad through the International Registration (the so called Madrid Treaty & Protocol). There is a similar route for design protection, through the International design registration (The Hague Convention). There is a big difference between designs and trademarks however, a claim for protection can only be successfully made if a model is new (i.e. not after a few years). Recently



China acceded to this treaty. This is particularly important because, on the one hand many products are made in China, but on the other hand many products are sold B2B via online platforms such as Alibaba. To claim design protection in China, a registered design actually is quite essential, because copyright claims are very difficult (and expensive) to substantiate. So design protection can now be achieved much more cost effective. In addition to China, protection can also be applied for in 76 other countries via the International design, including the entire European Union.

## Copyrights

### Protection of an idea

Many people think that they obtain copyright protection for an idea by putting it in writing and submitting this to an online register like CC Proof. Unfortunately, that is often not the case. An idea must have materialized for something to become 'a work'. If the work is also an intellectual creation, it may be copyrighted. An online "registration" of the idea can never be more than a piece of evidence.



Claimant submitted his idea, being 'clothing with real money (banknotes) stitched onto it' with CC Proof. He submits a drawing of a cap with a banknote on it together with the tagline: "Money rules the world". When defendant organizes a raffle where a T-shirt can be won with a five-hundred Euro bill stitched onto it, claimant argues that this constitutes an infringement of his copyright, based on the drawing registered with CC Proof. Court deals with this quickly. A mere idea cannot be protected and the submitted drawing has not materialized sufficiently. That does not constitute a copyrighted work. The claim is rejected.

## Advertisement law

### Marks & Spencer The Perfect match

Flo Broughton starts a chocolaterie named 'Choc on Choc' with her father back in 2003. Ever since 2015, they have been selling matches made out of white Belgian chocolate. The words 'Perfect Match' are pressed into the chocolate.



Marks & Spencer launches an almost identical product with Valentine's Day this year, leaving Flo not amused. When she contacts M&S through the usual channels, a deafening silence is her part. Reason for her

to share her frustration on Instagram. This quickly goes viral, prompting M&S to pull all the plugs in order to calm the online storm. M&S's spokesperson states that they hold IP rights in high regard. Choc on Choc is lifted onto the shield as a fantastic company and it will launch a special line of chocolate products together with M&S around Mother's Day and Easter. Lesson learned on product launches. First carefully check the playing field. If a complaint arises, take it seriously. A social media post can really spin out of control.

### Zeeman and functional nudity

Dutch discounter Zeeman always features a segment of its offerings in their 'it can be that simple' campaign. After socks and men's underwear, a new commercial runs on women's underwear. Different women in underwear briefly flash on the screen focusing on the buttocks, making it clear that the featured underwear is comfortable and good looking. A complaint is filed deeming the commercials' imagery negative, tasteless, misogynist and sexist.



The Dutch Advertising Board disagrees. The fact that buttocks are visible does not make the commercial inadmissible. There is a clear link between the product being advertised (women's underwear), the images and the text in the commercial. No sexist or misogynous message is conveyed. The commercial is not in breach of good taste or indecent.

This is in line with earlier rulings this year. For example, another complaint against an advertisement titled 'Safety all-through winter without skid marks' featuring a picture of a lady lowering her bikini bottom, promoting winter tires, was honored. Nudity is allowed, as long as it's functional.

## Online

### Spido: use og Google Adword competitor

The ECJ has already passed rulings on the question whether one can use the competitor's trademark as Google Adword, a number of times.

Rule of thumb is: it is allowed unless the origin function of the trademark is impaired. The advertisement must clearly show if there is a relationship between the advertiser and the trademark owner or not.



Spido offers boat-cruises in and around the port of Rotterdam. River Cruise, a competitor, uses, among other words, SPIDO as an Adword. The word SPIDO does not, however, appear visibly in the advertisement that is listed. River Cruise claims that it is clear to site visitors that River Cruise is a different company. In the preliminary relief proceedings court disagrees. It is unclear to users if there are economic ties with Spido or if it concerns a competitor. Even more so since River Cruise is a descriptive term. End result: prohibition of use and a court order to pay the costs of proceedings.

### Abcor: tracing online counterfeit

The global pandemic has accelerated the shift in the offering of counterfeit products via traditional stores to online marketplaces and web shops. As a result of the closure of physical stores, counterfeiters have started looking *en masse* for online sales channels (see, for example, the recent ruling on the sale of fake Audi parts). Anticipating this,



Abcor launched a new service: online brand monitoring. Focused on business (B2B) sales via online marketplaces (1,250 marketplaces worldwide) as well as to consumers (B2C) via stand-alone websites and, of course, the use on social media platforms. This integrated approach (with monthly reporting) makes it clear how big the infringement is, which parties are behind it and how many infringing articles have been removed.

### About Abcor

#### New Arrivals

Zoeloe van der Linden (above) and Louis Keijzer (below) have recently joined team Abcor.



Zoeloe has previously worked at Novagraaf for 6 years, ever since graduating from law school. Within Abcor, Zoeloe will focus as a Benelux and European Certified Trademark Attorney on large SMEs and international customers.



Louis started his journey at Abcor as a paralegal, straight out of law school. He wrote his final thesis based on a research into the IP protection of graphical user interfaces.

### 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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