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## Forgetting to register your trademark time for a rebrand!



VS



Dung Young Food Services started a wholesale store specializing in Asian products in 1957. Since 2011, they have been selling more than 150 different products under the private label AKAYA in six countries. However, the company forgot to register its trademark.

Bidfood is a global online wholesale distributor. Since 2018, they have been selling Asian food products under the private label AKARI. Bidfood did register its brand. When in 2019, after eight years, Dung Young decided to finally register their brand, Bidfood successfully objected. The trademarks were deemed similar and applied for identical products. As a result, the AKAYA trademark application was

rejected. But that's not all!

Bidfood also demanded a ban on further use in court, and this request was granted. The argument of prior use in good-faith did not hold up. Trademark rights are obtained through registration, not through use. Bidfood's trademark registration was not considered to be in bad faith because it was developed by a sister company in Australia in 2016. When the brand proved successful, they decided to expand into the European Union. The trademark is valid and a European ban on the use of the AKAYA brand follows. If you use a brand, make sure to register it!

### Trademarks

## HERMES vs. HAIRMES

Dog Diggin Design sells products for dogs, such as dog beds, dog pillows and dog toys. When the company applies for trademark registration of the word mark HAIRMES, Hermes objects. Hermes argues that the other party is trying to piggyback off of the reputation and goodwill of the world-renowned fashion company. The similarity between the HERMES and HAIRMES trademarks is reinforced by Dog Diggin adopting the look and feel of Hermes in its packaging, colors and designs. The authorities follow this argument.



HERMES is a well-known fashion brand worldwide. However, the brands were deemed phonetically and conceptually dissimilar. Visually, there is some degree of similarity between the marks in that both marks begin with the letter H and the last four letters are similar (RMES). In addition, the company uses virtually the same colors, designs and packaging to promote the dog toys/bedding. It is clear to the trademark authorities that Dog Diggin Design intends to use the reputation of Hermes. Therefore, the trademark application is refused.

## Trademarks

### Refusal 'PUT PUTIN IN'

In Europe trademark law operates on the first-come, first-served principle. Some individuals (and companies) attempt to register trademarks linked to tragic events in order to try and make a financial gain from extremely sad events (e.g.: JE SUIS CHARLIE). The war in Ukraine seems to evoke similar actions. Until now, such marks have often been refused because of a lack in distinctiveness. The signs are so widely known that no one recognizes an indication of origin in them.

The EUIPO, as well as some national offices, are now changing their course. Recently the mark PUT PUTIN IN has been refused for the reason that the sign violates morality. This often involves signs that are racist, blasphemous, discriminatory, offensive or that promote the use of drugs.



The EUIPO is now adding a new rule to this: It is also against morality for the applicant to use tragic events for commercial gain (even if the public sees the sign positively). The war in Ukraine has led to a flood of refugees and countless of death. PUT PUTIN IN refers to Putin's role in this war. The mark has been denied. The Zelensky brand for vodka was refused in several countries for a similar reason.

### HART – the importance of trademark research

Last summer, Museum Hermitage Amsterdam announced its name change. The museum no longer wanted to be associated with Russia. The new name HART however, did not go down well with the Belgian art magazine HART. In 2006, the company had registered the logo for printing, advertising, cultural activities and magazine publishing.

The Hermitage argued that the two trademarks could coexist perfectly well, since each of the companies are active in the visual arts in their own different ways.

Nevertheless, the case was settled just before the summary proceedings. The Belgian art magazine will continue under the new name GLEAN.

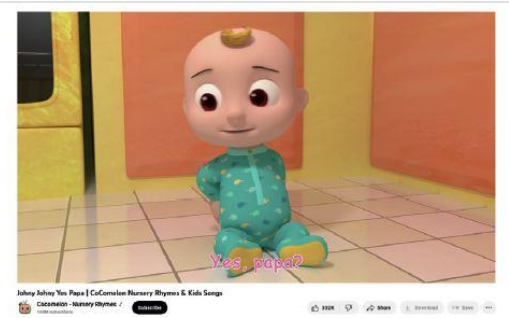
# HART MUSEUM

The logo for HART, featuring a stylized 'H' inside a circle, followed by the word 'art' in a lowercase, bold, sans-serif font.

Nothing may be disclosed about the agreement, but let it be clear: the Belgian party was probably paid particularly handsomely given their strong position. Not only are the characters very similar, the goods and services are similar. The Hermitage has also taken over the rights to the older trademark. Smart, considering the many other registered HART marks in Class 41. A lesson for everyone though: avoid problems like this and conduct trademark research before launching a new trademark.

### Sound mark – children's song

When people think of brands, they often only think of word marks and logos. However, there are many types of trademarks, such as multimedia marks, position marks and, of course, sound marks (think, for example, of the lion's cry from film company Metro-Goldwyn-Mayer). However, not every sound can be claimed as a trademark. If the sound is very short (two identical tones), consumers will not be able to recognize a trademark in this (but rather judge this as a ringtone). Very long sound marks can also encounter problems or their own.



(Source image: EUIPO decision 22.318)

The EUIPO recently rejected a 39-second sound mark based on the well-known children's song *Johnny Johnny Yes Papa*. The reasons given by the authority include the long duration of the sound mark, the fact that there is not an easily recognizable

melody line, the sound mark is based on a well-known children's song, and no other distinguishing marks appear. Keeping in mind the earlier judgement of the James Bond tune, actually the most important prerequisite is the easily recognizable melody line. A long tune does make this more difficult.

### Russian copycats

It seems as though an increasing number of copycat trademarks are being filed in Russia, especially copying large corporations that decided to cease or suspend operations there. Will these applications all be approved now?



When Jägermeister ceased operations in Russia, the Russian distillery Kristall filed the Alter Heiler trademark for herbal bitters. The look and feel is the same. To prevent the trademark from being registered, Jägermeister has filed a letter of protest with the Russian authorities citing its Russian trademark registration. As a result, the applicant withdrew the trademark.

### TOP40 for Dutch expats

Trademark rights are territorial. If another party uses a similar sign in another territory, is it possible to take action against it? The Dutch Top40 Foundation has registered its trademarks ALARMSCHIIF, TIPPARADE and the TOP40 logos in the Benelux.



An online radio station located in Spain and in the USA, aimed at Dutch expats, uses these marks on social media and on its online channel. Infringement, the foundation argues. The defendant disputes this. The online channel does not use the trademarks in the Benelux. The channel only targets expats abroad. This is evident, among other things, from the advertisements. The court

follows this reasoning.

To establish infringement, it is important which country the station targets. The fact that a station is available to listen to in a country is insufficient for this. Among other things, the defendant has an American phone number, a logo with USA in it, the broadcast times are in American times and their Facebook page states that the channel targets expats in the region. Therefore the channel targets Dutch and Belgians abroad, which does not fall under the scope of the Benelux trademarks. Those rights stop at the border. The ban is rejected.

### Design law

#### Ferrari unsuccessful with unregistered community design

Mansory Design sells tuning kits. These allow the appearance of an "ordinary" Ferrari 488 GTB to be transformed into a particularly expensive Ferrari FXX-K model. The distinctive features of this FXX-K model are the V-shaped hood and front spoiler. Ferrari did not file a registered design application for this, but nevertheless wanted to stop these tuning kits and therefore invoked an unregistered community design.



In 2021, this issue came before the European Court. The Court stated that even a part of a total product can be qualified as an unregistered design. However, that part must be clearly recognizable from the first disclosure of the design. For example, by being clearly delimited by an outline, colors or special texture.

It's up to the local authority to judge this.

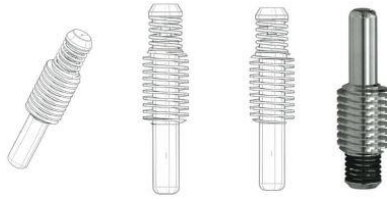
And that's where things took a turn for Ferrari. The Oberlandesgericht Düsseldorf rules that the part in question (the V-shape that overflows into the spoiler) is not clearly identifiable and delineated at all.

Consequence: the claim (as we wrote earlier) does not hold up. If you want to claim a part of a design, simply apply for a design registration for it on time.

#### Electrode product or component part?

The design of a product can be protected as a design if it is novel and has individual

character. Some products are composed of many different parts. This is known as a composite. With composites there is an additional rule, namely that this part must be visible in normal use. But what exactly is a component part of a complex product? The European General Court provides clarification in a case concerning the use of Hypertherm electrodes in welding torches.



The following aspects are of importance. (1) The component has to be a consumable that must be replaced frequently and (2) it can be replaced quickly and easily by the end user without taking the whole device apart. (3) If the item and the part are both for sale separately (if it is missing, the buyer will not immediately think the device is broken). (4) Also important: if the part is interchangeable with other products/electrodes, this interchangeability is also a good indication that it is not a part of a composite product, but its own product for which design protection can be claimed.

Online

### Competitor registers domain name

The one who first applies for a domain name, gets that domain name. Even if it contains a trademark of another company. Through a UDRP procedure, a trademark holder can fairly easily try to repossess such a domain. With Dutch domain names, you have to prove that the domain name is (virtually) identical, that the defendant has no right of its own pertaining to that name and that the domain name was registered or used in bad faith.

The ruling on domain name <rbcz.nl> is a good example. The plaintiff has been operating under the name 'Stichting HBO Register Complementaire Zorg' since 2007. In 2012 a trademark application was filed for RBCZ. However, the domain name was

registered two years earlier by Civas, a competitor. The domain name was not in use. Had the trademark been registered directly in 2007, the plaintiff would have had an easier time proving the defendant's bad faith. Now it has to do so through a detour. In 2021, the domain name was transferred to the defendant. The defendant was the director and sole shareholder at Civas until 2020. The defendant did not explain why he chose exactly these four letters. It is plausible that the domain name was registered by the defendant in bad faith and should be transferred to the claimant.

Online

### Reimbursement domain name transfer

As of September 1<sup>st</sup>, 2023, Monique Granneman has transferred to Abcor European Trademark and Design Agency. With her arrival, Abcor is even better able to serve the growing customer base.

Monique has been working as a Benelux and European trademark attorney for 27 years, of which more than 20 years at market leader Novagraaf, and therefore has a wealth of experience in the field of trademarks, designs, trade names and copyrights.



She is very driven and customer-oriented, with a hands-on mentality. When it comes to IP strategy, Monique sees the bigger picture and comes up with creative solutions for both the short and long term. In addition, she will provide guidance for the younger generation of attorneys and thus also raise the team of the future to a higher level. She is recommended in the annual World Trademark Review rankings (2021 and 2022) as, "*She takes a proactive role in the management of portfolios, providing strategic and holistic advice.*"

### 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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