

Genuine Use on Social Media



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After five years, a registered trademark in Europe must be actively used. This use must be genuine, aimed at finding or maintaining a market, rather than symbolic. Otherwise, third parties can request its cancellation.

Nowadays, products are often promoted via influencers on social media and websites. Does this qualify as genuine use?

In a recent ruling, the EU General Court confirmed that it does. European authorities have often held that use on social media platforms (such as Facebook, Instagram,

YouTube, and Twitter) is not relevant because it does not reflect consumer perception and actual sales (market share). This is a flawed premise. The question is whether the overall use sufficiently demonstrates genuine use. Social media can be a relevant factor, especially if it is the primary channel for promoting such products.

This important ruling brings case law closer to reality. Social media and online usage are integral to the positioning of companies and products. We are pleased that European authorities are beginning to recognize this.

Trademarks/advertising law

Combating Greenwashing/ Environmental claims in trademarks

Consumers are increasingly influenced by environmental claims when purchasing products. Environmental claims (or sustainability claims) include terms such as 'green,' 'eco,' 'organic,' 'climate neutral,' etc. These claims suggest that the products are made from natural ingredients or are produced sustainably.

This spring, a new EU directive was enacted to better protect consumers against misleading environmental claims (implementation March 2026). The directive applies to all forms of communication, including trademarks. In summary, generic environmental



claims (such as 'organic' or 'eco') are prohibited unless they can be substantiated, and sustainability claims are only allowed if they are approved/certified by an independent third party. This has already had far-reaching

consequences for daily practice. If an environmental claim can be fully substantiated, a word mark will be refused because it is descriptive. If the claim cannot be substantiated, the trademark will be refused as misleading. As a result, trademarks like 'GREEN TRAVEL' and '100 percent green energy' have recently been refused. Existing trademarks with an environmental claim that do not meet the directive's standards can therefore be cancelled (because the claim is insufficiently clear). Anticipate on this and consider rebranding to retain the accumulated goodwill.

Trademarks

False hope for descriptive trademarks

From a marketing perspective, it is attractive to use a word for a new brand that directly conveys its essence. With such a descriptive mark, consumers immediately understand what the product represents. However, the drawback is that authorities refuse a trademark if it is descriptive. Sometimes, it is possible to register such a mark, but how reliable is this in case of infringement?

Since 2009, the plaintiff has rented waste containers under the name BOUWBAKKIE (little building container). In the past, authorities were somewhat more lenient in assessing whether a mark should be refused for being descriptive. This is also the case here; the BOUWBAKKIE mark is registered as a word mark in the Benelux and the European Union.



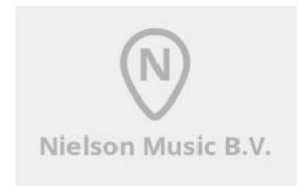
When the defendant starts renting storage containers under the name OPSLAGBAKKIE (little storage container), the plaintiff objects, arguing that the marks are too similar. A lawsuit follows, in which the defendant counters by claiming that the plaintiff's trademarks are descriptive and should be cancelled.

The court agrees. The words BAKKIE (little container) and the prefix BOUW (build) are common terms. The diminutive BAKKIE is not unusual and does not give the mark distinctiveness. The plaintiff argues that the marks have acquired distinctiveness, but there is insufficient evidence to support this. Consequently, the requested prohibition is denied, and worse, the trademarks in question are cancelled. Lesson learned: when branding a new mark, avoid descriptive marks and opt for a fictitious or at least a suggestive mark.

There is only one NIELSON

Trademark rights grant monopoly over the use of a name for specific goods and services. However in the EU, only one entity can use that name, which can be exploited but also has limits. NIELSON is a well-known singer-songwriter in the Netherlands. He broke through in 2012 and consistently scores hits. When he attempts to register his name for musician and composer services, he discovers that an older trademark was registered in 2013 for services including

those of a communication agency, musician, and DJ. The applicant uses the name for marketing activities and performs as Mister Nielson. The 'Mister' is a crucial part of the name, similar to Miss Montreal or Lady Gaga, where the full name is important for artists.



Using the name NIELSON for a marketing agency does not bother Nielson, but the claim for musician services is made in bad faith. The case ultimately reaches the Court, where Nielson prevails. He was already using the name as a musician and well known for this. The applicant does not use the name NIELSON but Mister Nielson, yet registered the mark for exactly the services (musician) for which it was not used. For this reason, the mark is cancelled by the Court for registration in bad faith.

Position mark yellow stitching on boots

A long-standing dispute exists between vanHaren and Airwair, the maker of Dr. Martens Boots with their distinctive yellow stitching. Airwair registered a position mark for the yellow stitching on a black welt, with the boot itself outlined in a dashed line to show where the stitching is located. The boot itself (and its color) are not part of the claimed trademark protection.



vanHaren was previously found to infringe this mark but did not accept the ruling. The case eventually reached the Benelux Court of Justice, where vanHaren argued that the entire application was improperly filed and invalid.

The yellow stitching inherently lacks distinctiveness. It can only become a mark through acquired distinctiveness (intensive use). Airwair presents extensive evidence to prove this. However, nearly all the evidence pertains to a black shoe. Acquired distinctiveness is proven for a black shoe with yellow stitching, but the positional mark was not filed this way.

The mark is declared invalid. Partial invalidity (retaining the trademark for the black shoe combination) is not possible, so Airwair will promptly file a new (correct) position mark.

Lidl logo – damage to reputation

The Lidl logo consists of a yellow circle with a red rim against a blue background, with the word LIDL in the center. The logo is registered in two versions: with and without the word. The wordless logo has been applied for multiple times (in 1995, 2002, 2005, 2007, and 2021).

Since 2020, Lidl has been in conflict with Tesco, which uses a similar logo for its discount program (clubcard prices). In the ensuing lawsuit, Lidl presents extensive documentation to prove that its logo is well-known and represents a low-price strategy.



Tesco's logo usage damages that reputation, potentially misleading consumers into thinking Tesco's prices are lower or comparable to Lidl's. After a round at the High Court, the ruling stands.

Tesco's arguments are noteworthy. The repeat filings are in bad faith to circumvent the use requirement, and Tesco wins on this point. Lidl lacks good arguments for the repeated filings, so these marks are cancelled.

Additionally, Tesco argues that the wordless mark has never been used and must also be cancelled. Here, Tesco fails. The mark is well-known, and both marks are very similar. Consumers recognize the wordless mark as Lidl's (as in the Specsavers case). Therefore, do not only register the full mark but also the dominant elements individually. Signs that consumers perceive as an indication of origin are protected.

Run on Nitro

PUMA has been granted a license to use the EU trademark NITRO (applied for in 1997) for running shoes. In 2021, the NITRO running shoe line was launched. One of its unique selling points is that the shoe's midsole is injected with nitrogen. This technique is also used by other brands, including Brooks, who is the market leader in this segment.

Originally, Brooks used the description "nitrogen injected" in its campaigns, but as from 2022, they promoted it as "Nitro-Infused Softness" with the slogan "Run on Nitro."



PUMA claims this is an infringement.

In the preliminary injunction, the judge dismissed this claim, stating that NITRO lacks distinctiveness and only indicates a feature of the shoe. The court followed this reasoning. As a trademark holder, you cannot prohibit others from using the sign if merely describes a characteristic of a product. However, descriptive use of a third party's registered trademark must be done appropriately. You cannot suggest a commercial connection with the trademark holder, latch onto the trademark holder's reputation, or portray them in a bad light. Brooks' use of the word NITRO is to indicate that the soles are softer because they are injected with nitrogen (nitro foam). Sometimes the word is combined with a small gas cylinder or the chemical 'N2' symbol. Nitrogen injection is the most modern technique and is used by many manufacturers. Brooks always uses the term alongside its own brand, Brooks, and explicitly states that it does not intend to suggest any link with PUMA. Brooks is the market leader, and PUMA is a newcomer in the market. The claim was rejected, and additionally PUMA was ordered to pay part of Brooks' legal costs.

Even if a trademark is registered, keep in mind that if it is a descriptive mark, the scope of its protection is limited.

Paris 2024 – Olympic Games

The upcoming Olympic Games in Paris have not gone unnoticed. The IOC has once again registered numerous trademarks and designs to tackle any unauthorized use of these symbols.



Moreover, in 2022 (perhaps under IOC pressure), special French legislation came into force to combat all possible ambush marketing activities (regional or otherwise). In short, nearly nothing is allowed. Do not use registered symbols, nor other signs that are not registered but refer to the Olympics.

MISSION
PARIS 2024

SUPERIOR

(Refused/withdrawn Union trademark)

This applies even if you sponsor an athlete. Only neutral mentions and images are permitted. To learn more, request our special Olympic Games newsletter with examples and all the dos and don'ts.

Design Law

Christmas with M&S and Aldi

At Christmas 2020, M&S introduced a new line of gin bottles. When shaken, edible gold flakes fall like snow. The bottle has an LED at the bottom to enhance the visibility of the falling gold flakes. M&S immediately registered the design of the bottle, including both the falling flakes and the LED lighting.



A year later, Aldi followed with its INFUSIONIST gin. A gin bottle with a similar shape, winter landscape, gold flakes, and LED lighting. M&S claims infringement, which Aldi disputes. The overall impression is entirely different, as a different brand is prominently displayed on the bottle, and the winter landscape with the Christmas tree is different.

A lawsuit ensues, and based on her design rights M&S wins on appeal. Key to the decision is the innovative design by M&S (there was no comparable bottle with lighting before). The Aldi bottle has the same shape, same stopper, a winter landscape, snow effect, and built-in lighting. Therefore, the Aldi bottle does not create a different overall impression. A significant blow to lookalike products. The ruling highlights the importance of design registration for an innovative design.

Online - Internet

Failed claim for snackje.nl

Claiming a domain name can be achieved through a simple administrative procedure (like an ADR or UDRP), but not always. In 2020, <snackje.com> was launched, an online shop selling various snacks and sweets. The company registered its logo SNACKJE (meaning little snack) in the Benelux and the trade name with the Chamber of Commerce.

SNACKJE

The defendant registered the domain name <snackje.nl> fifteen years earlier (in 2005). The domain name points to a pay-per-click website with links to other companies also selling snacks. The plaintiff claims infringement. As a settlement proposal, the defendant asks the plaintiff if they want to purchase the domain name for €10,000. Ultimately, the claim is dismissed. To prove infringement on a <.nl> domain name, you must demonstrate that the registration or use of the domain name is in bad faith. The domain name was registered much earlier, so this does not help the plaintiff. He must prove bad faith in current use. SNACKJE is an ordinary Dutch word. Therefore, linking to companies also selling snacks are not a form of bad faith usage. The defendant's offer to transfer the domain for €10,000 came only after the claim was filed, so it is irrelevant. The claim is dismissed. Lesson learned: for old or very descriptive domain names, do not assume they are readily claimable.

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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