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A number of large supermarkets seems to almost enjoy offering products that are very similar to well-known brands. Until recently, the emphasis was mostly on the packaging. Nowadays they are not reluctant to tie in with the actual brand name either. The idea is simple. Consumers are familiar with the quality of a well-known brand. By choosing a trademark that is very similar to this brand consumers may be coaxed into buying the private label more easily. The question remains, however, whether this is always allowed? Actually, it is usually not. Well-known trademarks have a wider scope of protection. A

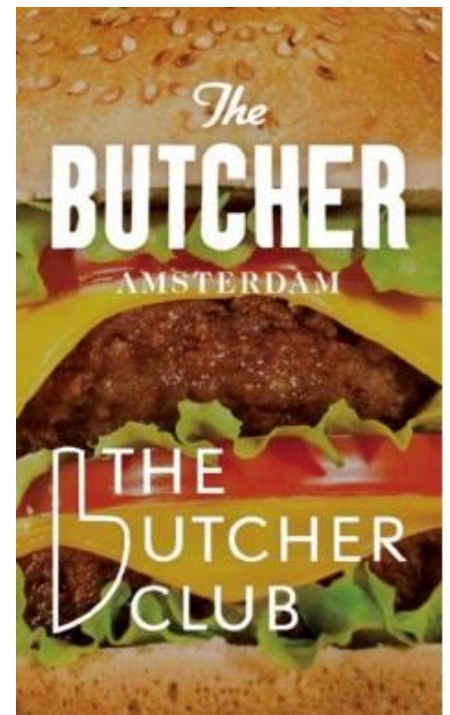
trademark holder may effectively prevent coat tail riding on the basis of its trade mark rights. However, in reality this does not always happen. Supermarket chain LIDL sells licorice under its own trademark BROMMER DROP (which means moped licorice). A name (and packaging), which – probably not coincidentally – is very similar to the well-known AUTO DROP (car licorice). Since this action was rather successful they now introduced VLUGGE JAPIE (Quick Japie), which is conceptually very similar to its competitor. It remains to be seen whether the proprietors of the well-known trademarks will take

Tradename and trademarks

The Butcher stops The Butcher Club

In 2012 The Butcher opens her doors in Amsterdam. A new culinary concept based on high standard hamburgers, which are prepared with fresh ingredients. The hamburger meat is on display so the consumer can actually see what they are about to eat. In order to protect its rights the company registered its name as a trademark. This is clever because trademarks give a larger scope of protection than mere tradenames. A trademark registration would enable the owner to stop other companies from using the name in cities far beyond Amsterdam.

In Rotterdam a new restaurant was opened under the name The Butcher Club. It claimed that BUTCHER was descriptive and that it could therefore not be a trademark. The court did not agree with this. A butcher is different from a restaurant and therefore BUTCHER is a perfectly distinctive trademark for a restaurant. Since the offered services were identical THE BUTCHER won the case. BUTCHER changed its name into The Meatclub and had to pay the legal costs of THE BUTCHER.



Trademarks

Puma devours Poodle

German artist Thomas Horn is the creative mind behind the new clothing line PUDEL. The logo shows a black silhouette of a jumping poodle. The word PUDEL is written in the same font as PUMA's. The trademark was used to sell T-shirts to which PUMA reacted. Horn claimed that his expression of PUDEL was protected by his right to freedom of speech. The trademark was a parody on PUMA and should therefore be allowed.



The court did not agree with him. The new logo is suspiciously similar to PUMA's and is being used for the same goods. This means there is trademark infringement. In trademark law there is no such thing as a parody exception. A claim to freedom of speech is therefore misplaced. The logo is used in such a way that it profits from PUMA's reputation. Of course PUMA fully agreed with this. Use of the logo in a satirical magazine is not a problem, commercial use however is a leap too far.

Strength of referring logos

In 1999 New Zealander Geoff Ross introduces a new pure vodka under the name 42BELOW. Bacardi buys the company eventually, after the product turned out to be a great success, most notably in the United States in 2008. In 2009 the company registers the logo as a trademark in many countries in Europe via an International Registration.



Earlier registered mark



new Vodka 42 mark

One year later Czech company Granette files an EU application for her name VODKA 42,

Bacardi immediately opposes this. Granette, on the other hand, claims that the number 42 is descriptive. It refers to the alcohol percentage in its vodka, which is 42%. Bacardi's product has a lower alcohol percentage. In this context 42 has a different meaning, and the logo is different as well, which according to Granette would exclude any chance of confusion. The European Court disagrees with this. 42 is the dominant element in both trademarks and only a part of the target consumers will see it as a referral to the alcohol percentage. The graphic differences are minimal. Granette's application is therefore denied protection in the European Union. This case clearly demonstrates that even trademarks that have a referring character should be registered.

Red Bull misses

A trademark enables a company to stop other from using trademarks for similar and identical goods. Some trademark owners, however, try to stretch their rights to the very limit. Red Bull is a company known to act against any trademark application that contains the word RED or BULL. Recently the court in Germany had a chance to look into such a matter.

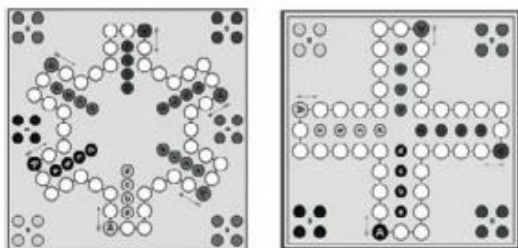


After launching the much bespoken "Fucking Hell" beer in 2010, German drinks manufacturer Hans-Jörg Schaller decided to file an application for the name FUCKING RED for wine. Red Bull opposed this application, but lost in both first- and second instance. The court decided that the trademarks are not sufficiently similar to cause any confusion. Important in this procedure was the fact that the goods, energy drinks and wine, were also not similar. There was therefore no infringement. A wise lesson for trademark owners: Check in advance whether or not a case is viable before taking any definitive legal steps.

Board game or trademark?

Through trademark law a sign may be protected. Many different signs are

accepted, for example: logos, packaging, pictures of buildings, comic book characters etc. However, there is a minimum requirement that the sign should have distinctive character. Because of this not everything is open for protection. Schmidt Spiele (known for their game Rummikub) is confronted by this limitation, when she tries to register the layout of the board of the famous board game “Mens Erger Je Niet”. This application was refused because, according to the trademark authorities, a consumer would not see the design of the board as a trademark.



The European Court of First Instance rules that the trademark authorities were correct in their assessment. The consumer will not see the layout of a board game’s board as an indication of origin, but as a mere board on which a game is played. The board is merely a referral to the nature of the game. This ruling makes sense. If a company wishes to protect the look of a new product, they should protect this through a design application. Please be mindful that the design is new and not already made available.

Copyright

Copyright on taste?

Copyright gives companies the ability to act against unwanted copies of their creation. In most cases these are traditional creations such as books, movies or music. It does entail a lot more than that, though. Our High Court decided that scent of perfumes may have a copyright as well. Now there is a comparable case regarding the taste of HEKS’NKAAS, a cheese spread. HEKS’NKAAS was created in 2007 by an amateur chef. The product proved to be very successful. In 2013 it was for sale in all the major supermarkets in the Netherlands. A competitor suddenly introduced Magic Cheese, which tastes the same. HEKS’NKAAS acts against this product claiming it infringes its copyright. The court rules in favor of HEKS’NKAAS and claims that taste can

indeed be subject to copyright. Determining factors are whether 1. The creation is open to human perception and 2. That the creation is original and has a personal touch by its maker.



HEKS’NKAAS certainly has that last requirement, since the creator had to make certain decisions out of possible ingredients to come to the taste of the product. The product has a unique taste and cannot be confused with other cheese spreads. The case therefore centers around the question of whether or not the taste of the products is open for human perception. The spread is unique in its taste and not based on any existing product. The case further focuses on the question what constitutes the taste of a product and how this is perceived by the consumer. The ingredients themselves are not more than a guideline. Only by actually tasting the product can it be established. An expert is called upon to taste and compare both products. His conclusion is that MAGIC CHEESE is a one-on-one copy. For the court this is more than enough. Taste (in this case the taste of HEKS’NKAAS) may be protected through copyright. Magic Cheese’s product is very similar. The producer of HEKS’NKAAS may therefore confiscate all of Magic Cheese’s products to prevent the inventory from suddenly disappearing. To be continued.

Advertising

Competitor’s trademarks as Adword

Google often offers trademarks from competitors as Adword, however, does this mean you may actually use them too?



City Box offers (temporary) storage space for goods. The company has registered her logo and the word CITY BOX as a trademark in the Benelux. Boxaround is a competitor.

Through the internet this company also offers storage space for rent. In order to promote its services online Boxaround starts a campaign with Google. The words CITY BOX and CITYBOX are purchased as Adwords in order to promote the online campaign. If a consumer uses the word CITY BOX or CITYBOX when searching on Google he would encounter the following ad: "City Box – boxaround.nl www.boxaround.nl/city+box Boxaround 24/7 availability. Now 30% Discount." City Box objects to this use on the basis of its trademark rights and is supported by the court's decision. The trademark (CITY BOX) does not belong to Boxaround and is being used as a Google Adword to promote Boxaround's products. In this case it is difficult for the average internet user to ascertain what the relationship is between the trademark and the party that uses it. After all, why is the Adword CITY BOX used? Is Boxaround affiliated with City Box, or are the companies in some way connected. That impression is magnified by the use of CITY BOX in the ad itself. The court therefore decides that there is an infringement. Use of the trademark CITY BOX as Google Adword is prohibited and Boxaround has to pay a portion of City Box's legal expenses.

Internet – online branding

Coca Cola Twitter #trademarks

Social media is becoming more important in communication. Some companies anticipate on this. Coca Cola (2 million followers on Twitter), for example has recently filed two trademark applications for her slogans in combination with a hashtag: #cokeandpics and #smilewithacoke.



With these registrations the company wishes to secure her social media campaign.

However, we believe that this is only possible if the slogan itself can be registered. The trademark authorities will not give extra value to the #. If a slogan cannot be registered as a trademark, simply because it is no more than a mere appraisal, adding a # will not be a solution (a logo would). If the slogan is used in this form (on cans or in order to generate traffic on social media), a #-registration may be a good idea.

25 million for .APP

Up until now there has not been much attention for the launch of the new domain name extensions in the Benelux. Worldwide, however, there is a true war going on where only the strongest win. Important new alternatives for the .COM extensions are .APP, .ONLINE, .STORE en .SHOP.



Because multiple companies would like to use the .APP extension, there has been an auction. This auction was won by Google with a bid of \$ 25 million. When the .APP domain names may be registered with Google is yet unknown.

Launch .AMSTERDAM

The extension .AMSTERDAM was launched last March. From June 1 to August 14 companies may register for a domain name. If they are the only applicant the domain name will be granted. Should there be other applications there is a certain ranking to decide who gets the extension. Important in this is that everyone who is located in Amsterdam is ahead in the ranking. Should there be multiple entities with the same ranking an auction will be held. Many generic domain names have a special tariff. Starting August 15 anyone may register their domain name on a first come first served basis.

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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