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Tony’s Chocolonely Sweet Solution



Tony Chocolonely recently started a campaign in order to expose slavery and child labor in the world of cocoa. The goal is to end this sort of abuse. By offering chocolate bars in wraps very similar to the trade dress of competitors, these companies suddenly and unintentionally find themselves in the spotlight. The look and feel of the used packaging will immediately be recognized as Twix, Toblerone, Kitkat and Ferrero Rocher. Is this allowed? Well, no... at least in principle. Courts in the Netherlands sometimes accept this kind of campaigning if the goal is to expose a social abuse, based on freedom of speech. In such cases the use of someone else's trademark is sometimes permitted. It is important to consider whether with the real objective of the use of

another brand is to promote one’s own product or not. That makes a big difference here, because a competing product is promoted here. Hence, in my view, Tony’s competitors should be able to successfully object to this use. This use amounts to piggyback riding on the well-known brand and besides consumers could also be lead to think that there is some kind of collaboration between the two companies. But would that be smart? Should they take action? The answer is No! There is a fair chance that the public opinion will turn against the trademark owners. Especially if the major players have to explain extensively whether or not the chocolate is made “slave free”, in court, on public record. Our advice is to sit still, if only to prevent loss of public image, and switch to slave and child labor free resources for chocolate as soon as possible.

Designs

Dish brushes with feminine shapes

The Spanish company Casa Vigar designs all sorts of household products, including dish brushes. This brush was protected with a Community Design Registration (requirements: novelty and individual character). Characteristic features are the long bristles as a hairstyle, the long neck and the distinct feminine shape: a bust and waist. When Edco starts offering a similar brush, Casa Vigar demands a ban. Edco argues that the design registration is invalid. The design is not novel, because there had already been comparable brushes in the market. The court disagrees. The prior articles lack the feminine shape (its convex bulges) and the clothing is

simply drawn on. The design of Casa Vigar deviates sufficiently from this and therefore the CDR is valid. The dish brush from Edco also has a feminine figure with a long neck, a tight evening dress and a brush head for hair. The differences (different face drawing) are insufficient. This is deemed an infringement because the Edco brush does not make a different general impression. Surprisingly the copyright claim is rejected. Casa Vigar could not properly prove that it held the copyright. So here’s another major advantage of registering a design, as its validity is assumed by courts.



Trademarks

Klinsmann – Panini: 2-1

When Jürgen Klinsmann seeks trademark protection of a silhouette image of his bicycle kick in the match against Bayern Munich for print, clothing and beverages, Panini objects. Panini has been using a three-dimensional image of a "flying soccer player" as a trademark logo for the sale of its soccer pictures and -albums for years. But are the two images similar?



EUIPO initially says so, but Klinsmann wins at the Board of Appeal. The Klinsmann logo is abstract so that it is not clear if an arm or leg is shown. Is this a handball player or a football player? The result: the trademarks are visually nor conceptually similar. Additionally, the Board of Appeal emphasizes that "descriptive" logos offer limited protection (the image of a soccer player for soccer pictures or sportswear). If you want to claim broad protection for your logo, choose a more distinctive image.

Champagne stops Champaws

Within trademark law we are familiar with the protection of Designations of Origin. These are terms that can only be used by companies if they meet certain strict conditions, for example, the ingredients should come from a certain area and the product is made in a certain way. This also applies to the term CHAMPAGNE. The name is protected and projects an image of luxury. This protection is not limited to sparkling wine but goes far beyond that.



When a company launches a new brand for animal food and a dog beverage under the name CHAMPAWS, the Champagne interest group (CIVC) successfully objects. The packaging resembles a champagne bottle and the visuals clearly link to the luxury image of Champagne, which is detrimental to the reputation of the Champagne name. The European authorities refuse the trademark. Be advised that the CIVC fiercely protects "Champagne" in all its forms.

For example, Unilever could remove the celebratory "Andrelon Champagne shampoo" from the market earlier and this winter Homeland Brewery had to recall its people's-champagne (beer).

Opposition lost as a result of Brexit

Brexit became a fact at the end of 2020. The consequences of this work in all directions. EU trade marks were automatically split in a national UK trademark (implicating double maintenance costs for the applicant). English lawyers are no longer entitled to act as representative and file EU trade marks (this must be done by a lawyer within the EU). But it also has big implications for pending issues.

La Vie En Rose®

The UK based Alliance Wine Company had objected to the EU trademark application for a logo "La Vie En Rose" for wine, based on an older English word mark LA VIE EN ROSE. It seemed like a clear cut case, (identical sign + identical goods). However, as a result of Brexit, a UK trademark registration is no longer a valid ground to successfully object to an EU trademark application. This is only possible based on EU trademarks or a national trademark in one of the 27 remaining EU countries. The result: the opposition was rejected at the very beginning of January 2021.

The risk of restyling a logo

Bullsonne markets automotive cleaning and maintenance products. In South Korea, the company has a market share of 90%. An aggressive bull features as their logo. Red Bull is one of the best known brands of energy drink. Their logo depicts 2 bulls charging against each other. In 2011 Bullsonne decided to change its logo. When Bullsonne prepares to enter the Austrian market, Red Bull starts a lawsuit demanding a ban on the Bullsonne logo in the European Union.



The new logo mimics the well-known Red Bull brand. Bullsone argues that the products are very different. However, Red Bull is also a sponsor of many sporting events. To freeride on a well-known brands reputation, it is sufficient for the public to establish a link between both brands, even when different products are concerned. Even more so if a similar logo is used. Therefore if you decide to restyle the logo, always check (with a simple logo search) if you come too close to existing well-known logos, even if they are used for completely different products.

Transliteration Chinese trademarks

The Chinese market now consists of 1.4 billion consumers. China is not only a production country, but is also an attractive market for more and more companies. When a product is launched into the Chinese market, please also apply for the trademark in Chinese characters. When this is not done properly, chances are that an automatically generated translation emerges, that sometimes has a negative connotation, which can be harmful to the brand image. This way Quaker got nicknamed "Lǎorénpái" (老人牌) which literally means "old man".



You should anticipate and register (and use) a Chinese variant. You can go for a literal translation, but this only makes sense if a brand has a really clear meaning. It is more attractive to make the conceptual link with that translation. Look for a combination of characters that projects a positive message, such as the new Coca Cola logo, referring to "let your mouth enjoy". Always check with a local contact what the association and meaning of the intended brand is.

Trade names

Limited protection of a company name

Many companies seem to think that listing the company's name in the commercial register at the Chamber of Commerce or having the internet domain provides

sufficient protection against third parties from acting under a similar name.

Unfortunately quite often that is not the case. A trademark registration on the other hand gives a better chance of claiming the company's name exclusively.

Since 2015, home care organization "de Zonnestraal" has been providing home care services in the city of Tilburg. The corresponding domain name "homecare-dezonnestraal.nl" is used by them since 2016. In 2017, another provider called "De Zonnestraal" starts its operations in Hoofddorp, at the other side of The Netherlands, using the domain name "homecaredezonnestraal.com".



The Tilburg company summons the new company to change its name because they are too much alike. The court decides that if a company operates only regionally, its registered trade name is only protected locally, not nationally, regardless of a national top level domain being used. Home care is a regional activity by definition. The cities Hoofddorp and Tilburg are 130 km apart, so chances of customers changing over are unrealistic. The claim is rejected and the Tilburg company is ordered to pay the legal expenses also for the other party (€ 9,000). Lesson learnt: If you want nationwide exclusiveness, in order to expand to other regions, register a trademark for the company name.

Copyright law

Miffy with ducks beak

An online row occurred in China about an exhibition of Feng Feng's paintings. Stylized rabbits with a duck beak, strongly reminding of Dick Bruna's Miffy. The artist rejects accusations of plagiarism because commercial symbols are part of the public domain. How would we regard this in Europe?

Works of visual art are protected by copyright. The threshold for copyright protection is that it must be an intellectual creation of the author (creative choices have been made). When asked whether this is plagiarism, one checks whether protected characteristics were copied.

For the overall impression is considered if sufficient distinction has been taken from the original work. There is no "inspiration" here, this is plain plagiarism in my opinion.



Then only one escape remains, namely the parody exception. The ECJ has ruled that there must be a clear difference from the original and that the parody ought to be humorous / mocking. Miffy has previously run into a parody defense at the Amsterdam Court. This court ruled that a coke-snorting Miffy was allowed. That was clearly a parody because of the great contrast with Miffy, tantalizing text and because as a whole it inspired laughter. The humor is not obvious to me this time, but maybe I am a little too attached to Miffy.

Online - internet

Adword use of competitor's trademark

When is it allowed to use your competitors / market leaders brand as an Adword in an online campaign? In a recent case defendant carried out a comparison test of his own water softener (Aquamag7000) and the Amfa4000 from competitor 24Man. The comparison is positive for the defendants product and the company wants to generate publicity with this result. If the search term Amfa4000 is entered in Google, ads appear with headlines like "Amfa4000 vs Aquamag 7000 - read this before your purchase". This advertisement links to a website on which the test results are featured along with the conclusion that the Aquamag7000 is twice as

powerful while being cheaper than the Amfa4000. Man24 objects to this.



Rule is that it must be immediately clear to the average internet user from which party the advertisement originates. If both brands are directly featured in the page header, it will be clear that this is a comparison test of two products (one of which is from the competitor). It is irrelevant that the affiliated company sells more products as a result of this. This is allowed. There was also an ad that only featured the competitor's brand. That is not allowed. In this way it is unclear what the relationship is between the advertisers company and the competitor's brand. So you may use a competitor's brand, but should do so with care.

Abcor news

Abcor listed in 2021 World Trademark Review WTR1000

Every year many rankings of trademark agencies are published. These are important of course for us as an office and for companies seeking representative. The WTR1000 is regarded worldwide as the most important overview of trademark offices and companies in the field of trademark law. We are therefore proud and honored to be included in this year's list of leading representatives in the Benelux. And with praise from our customers!



ABCOR BV: *Filing, prosecution and worldwide portfolio management are the bread and butter of contemporary boutique and WTR 1000 newcomer ABCOR. As most team members have previously held in-house positions, the side has an insider's perspective on business needs and challenges. Leading the nine-person outfit is founder Theo-Willem van Leeuwen: "proactive, reliable and hands-on", he thinks outside the box to build efficient brand management strategies with the greatest skill and care."*

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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