

NEWSLETTER

News, practical information and case law relevant to protection of intellectual property

Brief News

Vuitton and Britney

French fashion house Louis Vuitton has accepted compensation of USD 150,000 from Sony BMG over the latter's use of products showing the Vuitton logo in a series of pop videos. One of these videos featured singer Britney Spears.



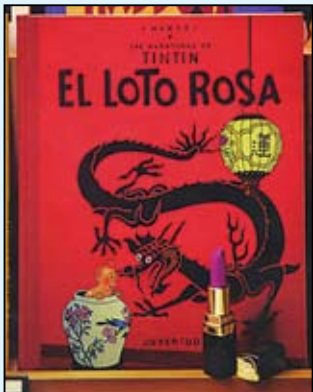
Cola bottle in Japan

Five years after receiving an application to register the shape of the Coca Cola bottle as a trade mark, the High Court in Japan has finally allowed the registration to go ahead. According to the Court the bottle shape is so well-known that it effectively can be considered as a trade mark.



No sex for Tintin

A Spanish court has banned a parody of the iconic cartoon character Tintin. In El Loto Rosa, a take-off of the boy reporter's adventure The Blue Lotus, Tintin compensates for his midlife crises by indulging in an active sex life.



European FIFA trade marks invalid

Five European trade marks registered by the international football association FIFA have been declared invalid.

According to a decision by the Board of Appeal of the EU trade mark office OHIM on 20 June 2008, the word marks – which include 'World Cup 2006' and 'WM 2006' – are descriptive and therefore can't be protected as Community trade marks.

Descriptive words

The case was brought in 2005 by Ferrero, a company that objected to FIFA being given trade mark protection for the descriptive words 'World Cup 2006', 'Germany 2006', 'WM 2006', 'World Cup Germany' and 'World Cup 2006 Germany'. The Board of Appeal's decision overturns a ruling by OHIM's Cancellation Division, which had originally allowed the trade marks to be registered.

Problems for merchandise?

Although the case no longer has any implications for the 2006 World Cup, it will affect future championships. After all, organisations need to own trade mark rights to the words and phrases used to promote their championships if they are to maximise their profit from sponsorship and merchandise. If this line is adopted, it will become difficult not only for organisations like FIFA but



FIFA loses trade mark rights to words like 'Germany 2006'. NB: the ruling obviously doesn't affect the logo.

also for the International Olympic Committee to claim trade mark protection for more general designations such as 'South Africa 2010', 'World Cup 2012' and 'London 2012'.

KPN loses right to green

Benelux trade mark registration no. 472806 for the shade of green used by Dutch telecoms giant KPN was declared invalid by a Court of Appeal in Brussels on 23 May 2008. This confirms a previous decision by the Chamber of Commerce on 24 November 2006.



KPN attacked with green, but lost to Mobistar.

Green for telecoms

The dispute over the trade mark protection of the colour green arose when KPN took legal action against its Belgian rival Mobistar, which also uses green.

Boomerang

Fortified by its 'green' legal triumphs in the Netherlands, KPN brought a similar case in Belgium. Unfortunately, this action had something of a boomerang effect. During the

summary proceedings and at appeal, Mobistar counterattacked by claiming that KPN's trade mark rights were invalid.

Acquired distinctiveness

In both cases, the court found in favour of Mobistar, ruling that a colour could only be registered as a trade mark if it had an acquired distinctiveness. In other words, if the colour is recognised by consumers as a trade mark due

to intensive and frequent use.

No use in Belgium

To be valid, this distinctiveness must apply throughout the Benelux as a whole. And that's where the claim fell down: KPN only operates in the Netherlands, not in Belgium or Luxembourg. In those countries, the colour green has no acquired distinctiveness. Exit Benelux trade mark registration green.

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Domain names

Mastercreditcard.com

Domain name hijackers are always coming up with new tricks. But when push comes to shove, they generally opt for the simplest ruse. Recently, a WIPO arbitration panellist ordered financial data provider Bankrate to transfer the name mastercreditcard.com to MasterCard because it was too similar to the well-known trade mark MasterCard.



Ianflemming.com

The heirs of Ian Fleming have successfully claimed the domain name ianflemming.com. Ian Fleming is the author who penned the world-famous James Bond 007 books. Fleming's descendants own the trade mark rights to the name Fleming and were thus able to force the hijacker to transfer the name to them.



Dhl.info naar DHL

The domain name dhl.info has to be transferred to courier company DHL. It had initially been registered by the Sri Lankan firm Renown SC. But a WIPO arbitration panellist ruled that it had been registered in bad faith and ordered Renown to relinquish it immediately. Renown did not mount a defence.



Crocs halts imitators

Crocs Inc., maker of the popular Crocs shoes, has successfully stopped a rival company from imitating its product.



Above: the real thing. Right: the imitation.



Copyright

On 29 May 2008, the District-Court Instance in The Hague ruled that Coert de Vos and Anita Musch were infringing Crocs' copyright through the sale of their plastic shoes. De Vos and Musch were told to

suspend sales of the shoes with immediate effect.

Design rights

In addition to copyright, Crocs also sought to protect its Community design rights.

However, the court refused to consider these since Crocs is still in dispute with the EU trade mark office OHIM concerning their validity.



No trade mark for Mozart

German chocolatier Paul Reber GmbH has been refused EU trade mark protection for its Mozart chocolate.

Following an objection by the Swiss chocolate-maker Lindt, the Court of First Instance of the Office of Harmonisation for the Internal Market (OHIM) ruled on 9 July 2008 that the name 'Mozartkugeln' was merely a descriptive word for chocolate bonbons in Germany and Austria. Nor could the name Mozart be used to specifically designate chocolate. So no EU trade mark protection for Mozart.

Bavaria opposition fails

Dutch brewer Bavaria has failed in a bid to halt the registration of the trade mark Hollander for a rival beer.



No infringement

In response to an opposition filed by Bavaria, the Benelux Office for Intellectual Property ruled on 30 June 2008 that Hollander did not infringe the trade mark rights of the device mark Hollandia, an older Bavaria trade mark.

Holland not distinctive

Although the words Hollandia and Hollander are clearly similar, the word 'Holland', which is a geographical designator, must be seen

purely as a descriptive word for which no protection can be claimed. According to the Benelux Office, the visual and conceptual similarity between the two trade marks is limited.



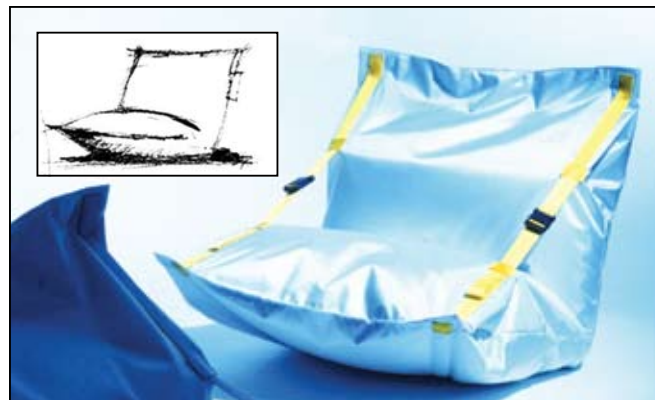
adidas defeat in Taiwan



Sports clothing manufacturer adidas has suffered a major setback in Taiwan. On 28 April 2008, a court in Taipei cancelled the registration of the distinctive three-stripe adidas trade mark. The court maintained that Taiwanese consumers could confuse the adidas trade mark with older, similar trade marks belonging to local company Lutong Enterprise, which also refers to clothing.

Fatboy, not 'The Original'

The manufacturer of the well-known Fatboy beanbag has been told it cannot stop rival Sitting Bull from marketing a similar product. The ruling was issued by the Court of Den Bosch on 17 June 2008.



According to the court, Fatboy, which advertises its beanbags with the tagline 'The Original', was unable to conclusively prove that it owned the copyright to

the beanbag design. During the case, it turned out that the initial sketches for the 1998 Fatboy design were in fact based on an

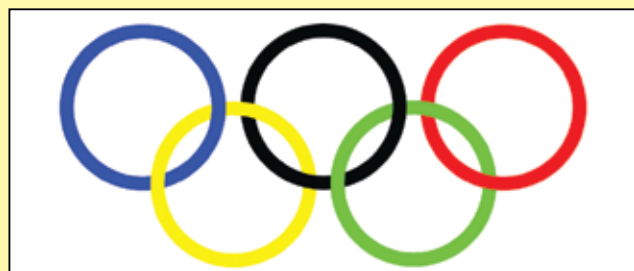
existing beanbag from 1997. Fatboy is lodging an appeal.

According to the court, the initial sketch for the Fatboy (insert left) was based on an earlier beanbag form 1997 (right).

The Beijing Olympics are now over. The event itself was a resounding success and went almost without a hitch. But how about the Olympic symbols? They certainly caused a few headaches in the run-up to the Games.

Rights of the IOC

In the Benelux, the International Olympic Committee and the Netherlands Olympic Committee own the trade mark rights not only to the image mark of the five rings but also to the words 'Olympisch' and 'Olympic'. They additionally hold the copyright to the five-ring image mark.

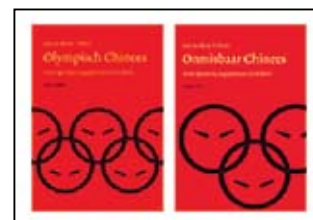


Olympic Chinese dictionary

Dutch author Kees 't Hart and his son Jan published a book entitled *Olympisch Chinees* (Olympic Chinese) a few months prior to the start of the 2008 Games. Intended as a Dutch-Chinese pocket dictionary for 'Olympic sportsmen and women and supporters', a complimentary copy was sent to the Netherlands Olympic Committee (NOC) in a polite gesture.

Trade mark rights to 'Olympisch'
Unfortunately, the NOC didn't appreciate the use of the word 'Olympisch' in the book's title. They also objec-

ted to the inclusion of the five Olympic rings on the cover. The NOC complained that 't Hart had infringed its trade mark rights. 't Hart therefore gritted his



Left: infringement? Right: the new version.

teeth and issued a new version minus the five-ring symbol, entitled *Onmisbaar Chinees* (Essential Chinese).

Darfur 2020

The Olympic Committees don't restrict their legal rights simply to commercial use of the Olympic symbols. The Belgium University of Gent has also fallen foul of the Olympic Committee.

In spring 2008, UGent launched a political campaign in aid of Darfur with a poster showing the Olympic flag accompanied by the words 'Darfur 2020' above the Olympic rings.

got in touch with the university and asked it to withdraw the posters. Under pressure from Rogge, who drew the university's attention to the IOC's trade mark and copyrights, UGent halted distribution of the posters.

Jacques Rogge himself

IOC president Jacques Rogge, who is Belgian, personally



Freedom of expression

The question of course is whether the IOC acted within its rights. After all, this wasn't a commercial undertaking, which means that the IOC's insistence on protecting its trade mark rights and copyright could conflict with freedom of expression.



Odd

What is odd, though, is that the IOC didn't try to halt the World Association of Newspapers' anti-Olympics campaign, which showed the five rings as handcuffs and barbed wire. Perhaps that's because the IOC was unsure of the legal validity of its claim.

Olympic pudding no go

Dutch dessert manufacturer Mona cleverly cashed in on the Olympic craze in August 2008 by launching an 'Olympic pudding'.

Infringement?

Unfortunately, this fell foul of the Dutch Olympic Committee, which immediately ordered Mona to withdraw its TV

commercial for the pudding. Mona complied in quick time, since this might well have constituted an infringement of the committee's extensive



claim to the word 'Olympic'.

ARE YOU PLANNING TO WATCH THE NEXT OLYMPIC GAMES?

HERE'S ONE THING YOU WILL NOT SEE

In August 2008, the Olympic Games will for the first time be held in China. It promises to be a splendid event, followed by hundreds of millions of people around the world.

One thing that the Chinese authorities are keeping very quiet about are the journalists - more than 30 - who are currently serving prison sentences in the country.

Not because they did something wrong, but because they had the courage to tell the truth and break news that the government tries to conceal.

There is Zhu Wensiang, for example, who received a ten-year prison sentence when his paper dared to report on the protests of villagers over government seizure of their land.

Or Li Yuanlong, who received a two-year prison sentence for posting articles on the internet in which he criticised living standards in China.

And there is Shi Tao, who received a ten-year prison sentence for informing foreign websites about how the Chinese authorities forbade the media from commemorating the 15th anniversary of the Tiananmen Square massacre.

At least 30 other journalists are in jail for similar "crimes".

Do you feel comfortable with the thought of the Olympic Games taking place in a country that imprisons its own journalists for telling the truth?

If not, join our campaign and send a message to the Chinese authorities, calling on the release of all imprisoned journalists ahead of the Olympic Games. You can make a difference.

To visit our campaign website, go to:

www.wan-press.org/china

World Association of Newspapers

Amusing foreign trade mark gaffes

Companies that take their trade marks onto the global market would be well advised not just to have them legally screened but also to run them past a language check.

A 'language screen' will tell you whether a trade mark or name has an undesirable or negative meaning in another country.

NSB

One notorious example is that of the British cigarette manufacturer that wanted to launch a product called 'NSB' in the Netherlands. What they didn't realise was that NSB is the acronym for a Dutch political party that sided with the Nazis during the Second World War.

Croma

Another well-known case is that of Fiat Croma. The proposed launch of the Fiat Croma

raised a few eyebrows due to the fact that in the Netherlands, 'Croma' is the name of a popular cooking gravy. Not really something you want to associate with a luxury car.

Soa

'Avec Soa, ça va changer' ('Everything will be different with Soa') is the slogan with which a new milk drink Soa was proudly launched in France this summer. Apparently the brand was not only due to



be sold on the home market but also in a number of other European countries. Let's hope they bypass the Netherlands, where the initials 'SOA' stand for 'sexually transmitted disease'.

Shag

In 2005 there was some consternation when a Dutch



brewer wanted to market a brand of beer in Australia under the trade mark Shag.

The accompanying advertising slogan - 'Fancy a Shag?' - in particular went down the wrong way down under.

'Rogues gallery'

We're always interested in photos of amusing trade mark gaffes. Send us your favourites and we'll add them to our own fairly substantial 'rogues gallery'.

New at Shieldmark.Zacco

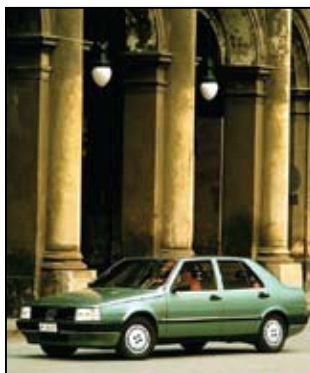
Marleen Splinter

Marleen Splinter joined Shieldmark.Zacco on 1 September as EU trade mark attorney. Before this, Marleen spent over six years performing a similar role at another trade marks agency.



Marleen Splinter.

Our new secretaries Marleen Lodder and Janine de Jong joined Shieldmark.Zacco at the same time as Marleen.



Above: The Fiat Croma.
Left: Croma is also the name of a popular cooking gravy in Holland.

ISO 9001

In the next issue of our newsletter we will inform you about our ISO 9001 certification process, which took place in 2007 and 2008.



About Shieldmark.Zacco

Shieldmark.Zacco is the leading agency for international intellectual property rights in Europe. Our professional sphere of activity begins with providing legal advice during the development of intellectual property. We then assist with the trademark search report and legal protection, we provide portfolio management and lend legal assistance in the case of disputes.

Products & Services Shieldmark.Zacco

- Trademark search Benelux
- Trademark search worldwide
- Worldwide trademark registrations
- Management of trademark portfolios
- Legal assistance
- Assistance with patent protection
- Dispute arbitration
- Legal and strategic advice
- Assistance with creating a name
- Assistance with creating a trademark

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