

Brief News



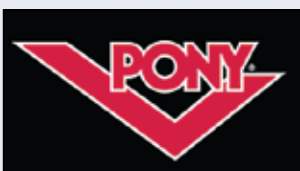
No ® for CCCP

The German Trademark Office has refused the registration of the mark CCCP for clothing. According to the office this symbol for the former Soviet Union must still be regarded as a geographical indication. Such signs must be kept free in the opinion of the Trademark Office.



Pony vs. Nike

Shoe manufacturer Pony is on the offensive against sports gear giant Nike (above). According to Pony Nike is infringing the trademark rights of the Pony logo in its advertising campaign with famous stars such as tennis player Raphael Nadal and footballer Sergio Agüero. The Pony-logo is a V-shape figurative mark. Pony is now threatening legal action.



Tommy Hilfiger loses opposition

The clothing group Tommy Hilfiger was not successful in preventing the European registration of the figurative mark TH of the Italian fashion company Modaticosmoda. On 7 April 2009 the Opposition Division of the European Trademark Office OHIM ruled that there was no danger of confusion between the various Tommy Hilfiger marks and the TH figurative mark of the Italians.

Four older marks

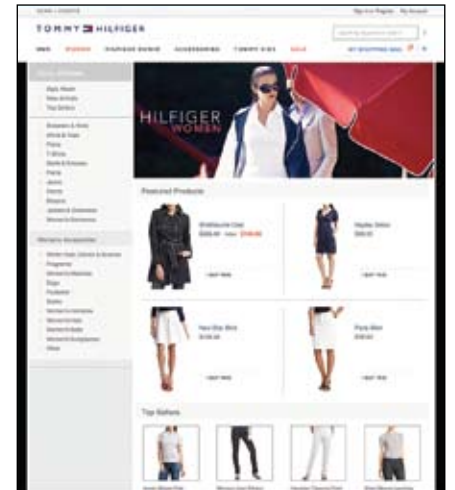
Tommy Hilfiger is of the opinion that Modaticosmoda's mark, with the letters TH as most eye-catching element, too closely resembles the world-famous trademarks of Tommy Hilfiger. To stop the European registration of the mark, Hilfiger filed an opposition based on 4 older European trademark registrations.

Sufficient distance

In its decision of 7 April 2009 the Opposition Division of OHIM compares each of the Hilfiger marks to the TH mark applied for and reaches the

conclusion that the marks differ sufficiently. In particular the addition of the texts Hottime and Parigi Milano to the TH mark ensure sufficient distance. The opposition was dismissed and Tommy Hilfiger was ordered to pay the costs. The company has the option of lodging appeal against the decision.

Middle: The trademark applied for by Modaticosmoda.
Below: The older mark registrations on which Tommy Hilfiger based its opposition.



Pirates aground

On May 17 2009 a Swedish Court gave its decision in the much debated and internationally noted Pirate Bay case. The four founders of the Pirate Bay site were each sentenced to one year in prison and shall together pay the all time high damages of SEK 30 million.

Copyrighted material

The file sharing site The Pirate Bay, started in 2004, is considered one of the largest in the world. The site, which contains links to so called torrent files, makes it possible to



download copyrighted material from other computers. The activities of Pirate Bay has attracted a great deal of attention internationally and infuriated the film and music industry and copyright organizations.

Infringement

The proceedings against the founders of the file sharing site was preceded by a

search where the servers of The Pirate Bay were confiscated. All this was filmed by the pirates and later appeared on the Internet. In January 2008 the owners of The Pirate Bay were prosecuted for copyright infringement. Two of the prosecuted were also suspected of other crimes, such as drug related crimes and computer theft.

Not the end

The prosecution against The Pirate Bay has been discussed with animation among pirates and anti-pirates and also been

criticised a good deal. Mention has been made of pressure from the government of the USA with threats of trade sanctions against Sweden, leaders of the preliminary investigation who have left the police to work in the American film industry, and challenge to one of the judges. An appeal against the verdict has been filed in a higher court, so the end has not yet been reached.



Domain Names



Angry Angels

The Hells Angels will take legal action to claim some 20 domain names from Fawn Myers, a lady from California. Mrs Myers registered names like ha-mc.com (which happens to be the abbreviation of Hells Angels Motor Club) and offered them for sale via e-Bay. The Angels are pleading that this woman is infringing their trademark rights.



Toys.com: \$ 5.1 million

The American toy company Toys 'R' Us bought the name toys.com for \$ 5.1 million at an auction. This domain name formed part of the insolvent The Parent Company's bankrupt estate. In doing so, Toys 'R' Us scored points off the advertising agency National A-1, which was 'only' prepared to go as far as \$ 5 million.

Jenniferlopez.net

Having instituted arbitration proceedings at WIPO, pop star Jennifer Lopez managed to get hold of the domain names jenniferlopez.net and jenniferlopez.org. Lopez owns trademark rights to her own name. The arbitrators ruled that the domain names had been registered in bad faith.



Fake Hermès: US\$7.5 million

The French fashion house Hermès will receive an unprecedented amount of damages due to counterfeit bags. A court in Taiwan ruled on 26 March 2009 that ex-employee Joyce Lee must pay US\$7.5 million for the sale of 4 fake Birkin bags.



Extremely sought after
According to Hermès the Birkin crocodile bag is an extremely sought after item. The waiting period for a real Birkin bag can sometimes

amount to 10 years. A number of years ago Lee sold four fake bags for \$15,000 each.

Factor 500

In the event of infringement the trademark law of Taiwan gives trademark owners the option of claiming damages of 500 to 1500 times the price for which the counterfeit product was sold. In this case the Court took things easy. It chose factor 500:
US\$ 15,000 x 500 =
US\$ 7.5 million.

Obama as European mark

The European Trademark Office OHIM has received an application for registration of the mark Obama, inter alia for clothing and financial services. The applicant is a Spaniard called Maria Ortega.

Press release OHIM
Although the application still has to be dealt with, the OHIM has surprisingly already issued a press

release. It seems that OHIM wishes to indicate that it shall accept the mark Obama.

Prominent persons

'Names of individual persons are usually distinctive and the same is true for names of prominent persons, including head of states... They will no longer be considered as deceptive or contrary to public policy', according to OHIM.



Incidentally around ten years ago the mark Bill Clinton was refused by OHIM.

Playmobil vs. German priest

The German priest Markus Bomhard is at loggerheads with toy manufacturer Playmobil. On his website the priest depicts Playmobil figures which he adapted himself in Biblical scenes. He thinks this is a good way to familiarise children with the faith.

Glue and hairdryer
Bomhard created the Eve figure by affixing breasts with glue and used a hairdryer to affix a Playmobil figure to the cross for the crucifixion.



Copyright infringement

Playmobil believes that the priest is infringing its copyright and also objects to the use of the name Playmobil. In May 2009 Bomhard decided to take down the site.



Lacoste fights for crocodile

The clothing brand Lacoste is fighting for its famous crocodile. Lacoste always goes on the offensive if competitors bring clothing onto the market with a mark which is similar to the word crocodile and often the company is successful.

Opposition Europe

On 7 April 2009 the Opposition Division of the European Trademark Office OHIM ruled that the mark Crocodilino for clothes cannot be registered. Lacoste had filed an opposition not only based on its figurative mark with the famous crocodile but also based on a word mark Crocodile that Lacoste has registered and also uses in several countries. Due to the great similarity with Crocodile the registration of Crocodilino was refused.

Alligator in England

Shortly before this the English trademark office had already found for Lacoste in an opposition against the registration of the mark Alligator for clothing in England. According to the English office the word Alligator is terminology wise too similar to the world famous Lacoste logo.

Opposition to Putin posters

The posters made by the company Amsterdam Partners to attract foreigners to Amsterdam on Queen's Day have unleashed a storm of protest. The manipulated photos show famous statespersons such as Obama, Hillary Clinton, Sarkozy and Berlusconi. As soon as the first posters appeared in the streets of Amsterdam the French ambassador demanded that the advertising campaign be stopped.

"It's ok"

A spokesman for Amsterdam Partners announced in the Dutch newspaper, *Het Parool*, that the responsible advertising agency had assured them that it was ok



'as long as we do not do this actively abroad'. The latter is obviously an



issue however, because foreigners such as Obama and Sarkozy can appeal to

their portrait rights even in the Netherlands if they have a 'reasonable interest' to object towards the publication.

Kiss me, I'm drunk

Remarkably enough Amsterdam Partners did not comply with the request by the French, but after slight pressure from the municipality of Amsterdam did remove the posters of Obama and Putin. Evidently the company had not realised that the photo of the teetotaler Putin in particular, dressed in a shirt with the text 'Kiss me, I'm drunk' was not at all appropriate.

Crocs suffers sensitive loss to Makro



The American company Crocs Inc. cannot prohibit the Dutch wholesaler Makro from selling shoes that strongly resemble the famous Crocs shoes. This was the ruling of the Dutch Court in The Hague on 18 March 2009 in proceedings initiated by Crocs.



No copyright basic form

According to the Court, shoes with the design which Crocs also uses have been put on the market before. These elements are not original and therefore do not fall under the protection of Dutch copyright.

Technical determinations

The same applies for elements which are technically determined such as the holes and heel strap. Such details determined by the technique also do not fall under copyright protection.

€ 28,000 costs

Crocs not only lost the case but was also ordered to pay the costs of the proceedings of € 28,000.



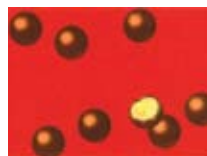
Above: Crocs shoe. Middle: Clogs of Makro. Below: older similar design of the Italian Birki.

Mars loses case and its registration

Mars, owner of the well-known Maltesers chocolate, must tolerate the red packaging of KitKat's chocolate balls, a Nestlé trademark. This was the ruling of the Antwerp Court of Appeal on 9 April 2009 in appeal proceedings filed by Mars. Mars had already lost the case in first instance at the District Court.

Floating balls

Mars based its offensive on a Benelux trademark registration for red packaging without text (and therefore without the brand name Maltesers) but showing the floating chocolate balls. According to the Court this registration is invalid however because the image lacks distinctiveness.



The void registration of Mars.

It is just an image of some floating chocolate balls against a red background, a colour that is used frequently in the chocolate industry.

"Marketing consideration"

According to the Belgian



court the figurative mark is nothing more than a "marketing consideration" showing the appearance of the product. For these reasons the mark registration was declared void and Nestlé can continue to sell its KitKat balls.

Defeat after all for G-Star

Jeans manufacturer G-Star has lost its opposition proceedings against the brand G-Star. After the Opposition Division of the European Trademark Office had found for the jeans brand in first instance, the Board of Appeal decided that the computer trademark G-Star can be

registered as a European Trademark despite G-Star's objections.

Differences

According to the Board the previous decision of the Opposition Division, which prohibited G-Star, was not properly substantiated. The Board believes that there are many differences

between the figurative mark G-Star and the mark G-Star, in particular in a visual sense. This means it is improbable that the public shall believe that there is a link between both marks. In addition the Board finds that the products - clothes and sunglasses as opposed to computers - are completely different.



Above: Crocs shoe. Middle: Clogs of Makro. Below: older similar design of the Italian Birki.

Patent infringement by Blokker



Above: the Bragel Bra.



The Dutch chain store Blokker is infringing the patent of the US company Bragel International with its Natural Bra. Not only must Blokker reimburse Bragel's damage but the company will also have to come up with around € 26,000 in legal costs. That was the ruling of the Court of The Hague on 25 March 2009.

Breast enhancement

Bragel's invention, which it has a patent for, consists of two connected breast moulds, filled with silicone gel, which enhance the size of breasts. The system also replaces a normal bra.

Bragel's invention is not sufficiently inventive. Blokker also alleged that other than Bragel's bra, the Blokker Bra can be worn together with a normal bra.

Inventive step

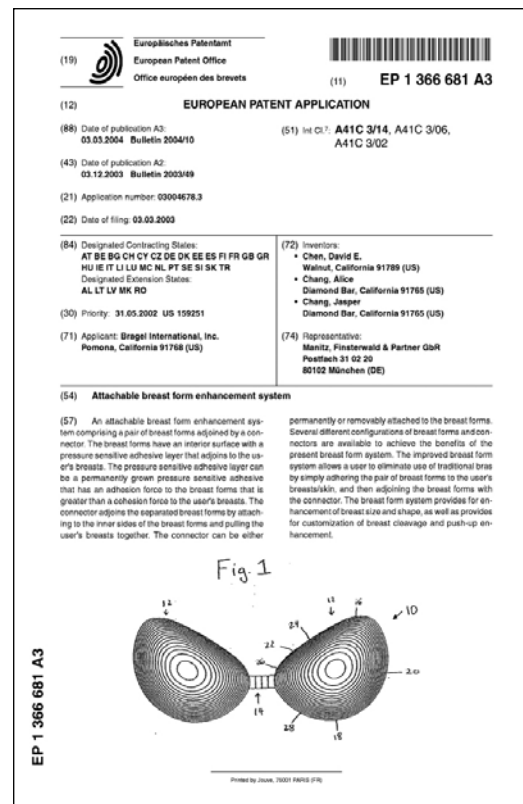
In an attempt to undermine Bragel, Blokker had had a report drawn up with the aid of patent specialists, which according to Blokker would prove in particular that

Valid patent

The Court however was of the opinion that the report submitted could not back up Blokker's conclusions and that Blokker moreover does offer its bra as a replacement for a normal



bra. Bragel's patent is therefore valid and Blokker must immediately cease the sales of this bra and transfer the remaining stock of bras to Bragel.



Middle: the Natural Bra of Blokker. Right: the European patent as applied for in 2003 by Bragel International.

We hope you will find this newsletter interesting, enjoyable and informative. As ever, any feedback, comments and suggestions are most welcome. Please send them to: Bas.Kist@zacco.com

About Zacco

Zacco is a leading European intellectual property consultancy with offices in Denmark, Sweden, Norway and the Benelux (Shieldmark.Zacco).

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Denmark
Copenhagen
Hans Bekkevolds Allé 7
DK-2900 Hellerup
Tel +45 39 48 80 00
Fax +45 39 48 80 80
info.denmark@zacco.com

Århus
Åboulevarden 17
DK-8000 Århus C
Tel +45 86 20 22 22
Fax +45 86 20 22 10
info.denmark@zacco.com

Norway
Oslo
Haakon VII's gt. 2
P.O. Box 2003 Vika
NO-0125 Oslo
Tel +47 22 91 04 00
Fax +47 22 91 05 00
info.norway@zacco.com

Trondheim
Havnegata 9
P.O. Box 1279 Pirsenteret
NO-7462 Trondheim
Tel +47 73 54 61 85
info.norway@zacco.com

Sweden
Stockholm
Sveavägen 151
P.O. Box 23101
SE-104 35 Stockholm
Tel +46 8 729 95 00
Fax +46 8 31 83 15
info.sweden@zacco.com

Skellefteå
Expolaris Center
SE-931 78 Skellefteå
Tel +46 910 585 980
Fax +46 910 88 510
info.sweden@zacco.com

Malmö
Nordenskiöldsgatan 8
SE-211 19 Malmö
Tel +46 40 30 36 00
Fax +46 40 30 39 03
info.sweden@zacco.com

ZACCO
www.zacco.com

The Netherlands
Shieldmark.Zacco
Overschiestraat 61
P.O. Box 75683
NL-1070 AR Amsterdam
Tel +31 20 5111 888
Fax +31 20 5111 800
info@shieldmarkzacco.com

SHIELDMARK.ZACCO
www.shieldmarkzacco.nl

Colophon
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Bas Kist (editor-in-chief), Lone Prehn, Toril Melander Stene, Bengt Eliasson.
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