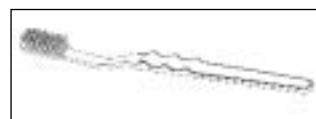


New in 2003: European protection for designs

As from 1 April 2003, it will be possible to apply for European protection for designs (Community design). Shield Mark answers here a number of frequently asked questions.



What is a design?

The exterior shape of an object, a packaging, or a graphical symbol. In short: a very broad concept, ranging from tables to bottles, from bicycles to glasses, and from logos to founts.

What are the requirements?

Two of the conditions for the protection of the Community design is that it has to be 'new', and that it has to have an 'individual character'.

Published: Brand Management

Brand Management has been written for all who wish to get an insight into the development, management and protection of trademarks and trademark portfolios. The author of Brand Management is Rik Riezebos. Shield Mark has written the legal chapter of this book. Brand Management has been published in Dutch and in English. Merkenmanagement, Wolters Noordhoff. ISBN 90 207 3208 0

Brand Management, Pearson Education Ltd. ISBN 0273 65505 1

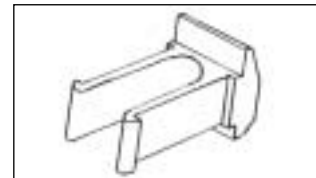


Where will the design be protected?

A registration will protect the design in all 15 countries of the European Union.

What is the duration of the protection?

5 years with the possibility to renew for 25 years.



Do I have to register before I enter the market?

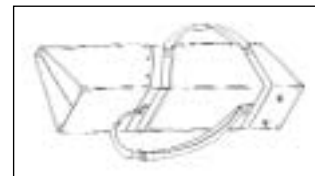
No, that was in the past. Nowadays, you have a period of 1 year after the first introduction for registration. After that, the design can no longer be registered.

How long does the registration procedure take?

Relatively short. In principle, a design has to be registered within 3-4 months.

Does this new protection for Community designs have its uses?

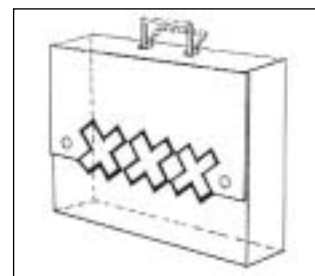
Yes, in our opinion it has a number of advantages compa-



red with existing regulations such as copyright, for instance.

Do I have to register all my new designs in Europe at once?

No. We give the advice to make a comparative assessment for each design. Sometimes, copyright can offer sufficient protection. It is also important to know that, apart from the registered designs, there is also a regulation for non-registered designs.



For more information about costs and possibilities, as well as for advice, please contact one of the Shield Mark trademark (also design) advisors: +31 20 5 111 888.

Developments at Shield Mark

Joint practices

Shield Mark has worked with joint practices for some time now. This means that two trademark advisors are jointly responsible for a certain group of clients. Each client has, of course, his or her own fixed contact, but because of the joint practice, in the absence of the fixed contact there will always be an advisor available who is acquainted with the client's trademark portfolio.

A random sample carried out among a limited number of clients shows that joint practices are very much appreciated.

Other languages on the Internet site

In our previous newsletter, we had mentioned that we were working on putting information in other languages on our Internet site. For some weeks now this information has also been available in Chinese, Japanese, Korean, Spanish, Italian, German, French and, of course, English.



Brief news

Obelix vs Mobilix

A German court has decided that the computer company with the name Mobilix infringes on the trade mark rights of the name Obelix. Obelix is a registered trade mark of Les Editions Albert René, the editor of the well-known Asterix comics.



The Doors

More than 30 years after the breaking-up of The Doors, a dispute has arisen concerning the use of the band's logo. Drummer John Densmore claims damages from the other two Doors members for using the logo for their own band.

According to the drummer, the rights of the group are jointly held by all three ex-members of the band

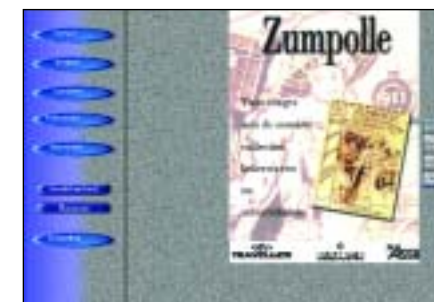


Aribel

The Brussels police have seized 17,000 kg of washing-powder. The washing-powder was packed in cardboard boxes with the brand Aribel. Procter & Gamble, the proprietor of the trade mark Ariel, seems also to be involved in the case.

The Hague and Amsterdam go to Court

Zumpolle.nl and 'Domain Sharing'



Entirely independant
from Zumpolle The Hague
there is a Zumpolle
Amsterdam: www.zumpolle-store.nl

The domain name zumpolle.nl can remain in the possession of the company Zumpolle in The Hague. Thus the Court of Appeal in The Hague has ruled in proceedings between two companies with the same name Zumpolle: Zumpolle The Hague and Zumpolle Amsterdam, with both shops selling leather goods.

The Zumpolle shops have the same origin. As result of an inheritance, however, the shops ended up in different hands years ago. That did not cause any problem till the moment the domain name zumpolle.nl was registered by Zumpolle The Hague. Zumpolle Amsterdam, the proprietor of the trademark rights of the name Zumpolle in the Benelux countries, refused to accept it. The District Court in

The Hague ruled that both companies are equally entitled to the use of the style Zumpolle and, as a result thereof, to the domain name.

The District Court ruled therefore that Zumpolle The Hague had to state clearly on its site that there was also a Zumpolle Amsterdam, and it had to provide a link to the Amsterdam branch. A nice example of forced domain sharing.

Two parties, equal rights

In appeal, the Court of Appeal in The Hague, however, rejected this ruling. The Court of Appeal decided that Zumpolle The Hague is entitled to use the style Zumpolle without any limitation. The parties have obviously accepted that there may be a danger of confusion. This means that the domain name zumpolle.nl may also be used without limitations. In cases as the present one, where both parties are equally entitled to the same name, the rule applies that 'first come first served'. Zumpolle The Hague has permission to use the domain name on its own as before.

Other cases of 'Domain Sharing'

There are more instances when two parties can claim the same domain name. Sometimes this leads to a, voluntary or forced, sharing of the name. Well-known examples are Scrabble.com and Playtex.com.

And Gaston... what can they win?



The Amsterdam District Court has decided that the use of the sentence 'And Gaston ... what can they win?' in a publicity campaign of the company BK-GAS is wrongful. The proceedings before the District Court had been instituted by Gaston Starreveld, a well-known co-host of Dutch game shows such as *Wheel of Fortune* and *Lottery Show*.

In said shows, the principal host regularly asks: 'And Gaston... what can they win?' Thereupon co-host Gaston

Starreveld lists the prizes in a loud voice. BK-GAS, which used the sentence for a special price campaign, had omitted to ask for Starreveld's permission.

The District Court agreed with BK-GAS that Starreveld has neither an exclusive right on the name Gaston, nor on the sentence 'What can they win?'

However, by using both elements combined, BK-GAS did zero in on Starreveld's fame and popularity. This is wrongful as Starreveld normally asks money for his cooperation in similar commercials, according to the District Court.

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Smell mark rejected

The doors of the Lamborghini

New: European protection for designs



Leading in Europe

Shield Mark is the leading agency for international intellectual property rights in Europe. Our professional sphere of activity begins providing with legal advise 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 Shield Mark Trademark Agency

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

Partners

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Domain Names



Lamborghini.biz
The domain name Lamborghini.biz is back where it belongs: with the Italian company Lamborghini. The name had been name-jacked by the Englishman Andrew Dawson. In arbitration proceedings it was ruled that Dawson had registered the name in bad faith.

33 domain names for AOL

The American media concern AOL Time Warner has taken 33 domain names from John Zuccarini in one single lawsuit. Zuccarini, a man who had already been given a rap on the knuckles several times, had mainly registered typos (names with typing errors) such as cartoonnetwork.com, cartoonnetwor.com, cartoonnetwok.com, natscape.com, nestcape.com and netscap.com.



Cheap-Marlboro-Cigarettes.net

Cigarette manufacturer Philip Morris has succeeded in claiming the domain name Cheap-Marlboro-Cigarettes. The name had been registered by a certain Eddy Fitch. Fitch used the name for the site on which he offered tax-free Marlboros for sale. According to the arbiter, the domain name was used in bad faith.

Use of the Red Cross symbol

In 2002 much attention was paid in the Dutch media to the film Ja Zuster Nee Zuster. Not only because it was an amusing new film but also because in the film and in the promotional material for the film the symbol of the Red Cross was frequently used. The Red Cross protested against it.

Finally, the case was settled with the producers. A disclaimer with an explanation of this special sign preceded the use of the Red Cross symbol in the film itself, and in all the promotional material the red cross was painted into a blue cross.



No trademark rights

In this case, trademarks did not play a role. The Red Cross invoked the protection of the Geneva Conventions of 1949 and also the Dutch Code of Criminal Law. In the Geneva Conventions, an article is included that lays down that each signatory is held to take measures so as to prevent misuse of the symbol. The Convention even lays down that all signatories – about 190 – have to include a prohibition in their legislation for

third parties to use the Red Cross symbol. In the Netherlands, this has been laid down in the Code of Criminal Law (Art. 435 c).

What exactly is prohibited?

The use of the Red Cross symbol, or its imitation, by organisations or persons not entitled to do so is prohibited. This includes, for instance, the use of the symbol in Ja Zuster Nee Zuster but also its use by a doctor or pharmacy. What is also forbidden is including the Red Cross



symbol, adapted or otherwise, in one's own logo.

In an international brochure, the Red Cross shows what is not permitted.



The purpose of these rules is maintaining the uniqueness of the Red Cross symbol that offers protection in times of war and makes the activities of the Red Cross known all over the world.

Whoever doubts whether the use of a certain sign is permitted would be well-advised to contact the Red Cross.



New .nl domainnames

On 29 January 2003, the rules for registering .nl domain names were drastically changed. The most important changes are:

- foreign enterprises can register a .nl domain name.
- registration in the name of private persons is permitted.
- disputes about .nl domain names are settled by arbitration.

As participant of the SIDN, the Dutch Registry of .nl domainnames, Shield Mark can render assistance with the registration of domain names. We also advise and assist our clients in arbitration proceedings.

Cup-a-Soup



Well-known Dutch singer Ria Valk has withdrawn her new carnival song. The refrain of the song is: 'Just give me Cup-a-Soup, and throw the rest on the stoop.' Unilever, the owner of the well-known trade mark Cup-a-Soup, says it wants to decide itself how the trade mark is communicated.

When the average consumer is asked what he considers to be a trademark, chances are that he answers: a word, or a logo. It seems out of the question that the consumer will think of 'a scent' or 'a sound'. However, such signs are being discussed in the legal word in connection with trademarks.

Olfactory mark rejected

In Europe, the discussion about non-conventional trademarks, such as scents and sounds, is very much alive. In December 2002, the European Court of Justice rejected the registration of an olfactory mark (Sieckmann ruling C-273/00).

According to the Court, the documents submitted to the Trade Mark Office by the German Sieckmann could not lead to the protection of the scent as a trademark. The filed chemical formula was insufficiently clear. The description of the scent, too: 'balsamically fruity with a slight hint of cin-

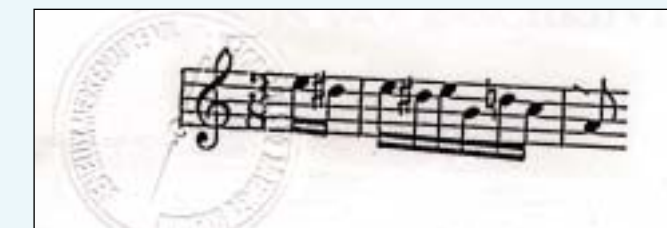


namon', was not clear enough in the opinion of the Court. And the scent sample (in a bottle) was rejected in advance, as it is not a 'graphic representation' of the trademark (a requirement stipulated by the European trademark law). It can be concluded from this ruling that the protection of scents is practically impossible, simply because one cannot represent them graphically. Earlier filed descriptions, such as 'The smell of fresh cut

grass' as a trademark for tennis balls, have lost their former value as a consequence of this decision.

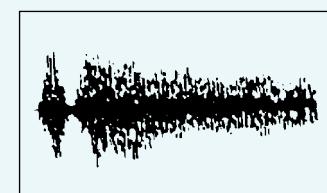
Sound trademarks

Whether there is still any room for sound marks after the Sieckmann ruling is to be seen. In the near future, the Court of Justice will have to decide on the registration of a note bar in proceedings instituted by Shield Mark ('Für Elise'). In



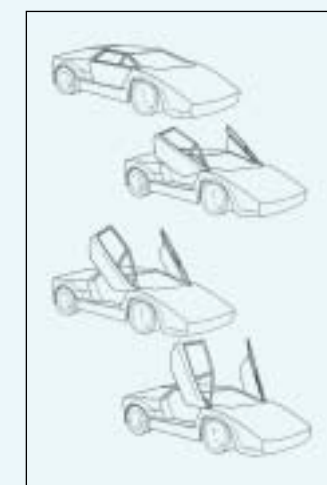
Other non-conventional trademarks

Apart from scents and sounds, many more non-conventional trademarks can be found in the trademark registers. Shield Mark had a look and found a number of nice examples that were each of them registrations of signs one would not call a 'trademark' from the first.



A lion roaring

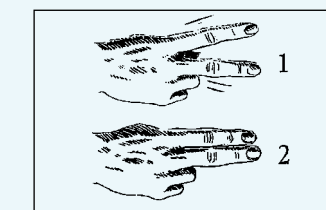
This sonogram has to depict the roaring of a lion. It is a sound mark that the movie producer MGM uses to distinguish its goods and services. The European Trade Mark Office OHIM has provisionally refused the trademark, but MGM has instituted appeal against this ruling. MGM has protected its sound mark in the USA, though, by way of a description: 'The mark comprises a lion roaring'.



Moving marks

A trademark need not always comprise a static situation. A trademark may move. In the European Trade Mark Register, a moving mark of Lamborghini can be found.

The trademark consists of an image of a Lamborghini car with the description: 'The trademark refers to a typical and characteristic arrangement of the doors of a vehicle. For opening the doors are 'turned upwardly', namely around a swiveling axis, which is essentially arranged horizontally and transverse to the driving direction.'



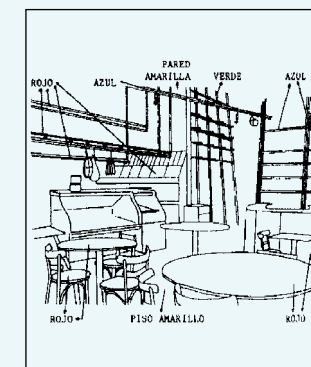
Gesture mark

We do not know whether the gesture of cutting fingers so as to distinguish the chocolate bars of Twix is internationally known. In any case, in the Netherlands it is 'world-famous'. When a Dutchman is asked what he thinks of



our opinion, a note bar is so easy to read and interpret that it meets the requirement of clearness as stipulated in the Sieckmann ruling.

when seeing two cutting fingers, he will doubtlessly say: Twix. So the trademark proprietor Mars BV has registered this gesture as a trademark.



Interior

The layout of an office, a restaurant or a shop can sometimes be very recognisable. Examples are known of layouts for which registration has been sought. A nice example comes from Argentina, where the colours and layout of a restaurant have been registered by way of a picture. We think it doubtful whether such a complex entity can function as a trademark.

Trademark infringement?

Each day, the European Trademark Office has to determine whether trademarks are too much alike. If they are so close to each other that a 'likelihood of confusion' exists, then we talk of a trademark infringement. The most recent trademark will then have to make way in favour of the older registration. In this feature we will show you how such decisions are reached in trademark conflicts.

Mountain Biker vs Mountain



As the word Mountain in the former trademark refers to a person who rides a certain sort of bicycle (a mountain biker) and the latter trademark just to the concept 'mountain', the trademarks are sufficiently different as to their concepts, and there is no question of an infringement.

Daria vs Dario

These trademarks are very similar, both visually and phonetically. Only the last letter is different. In short: an obvious infringement.

Shaperite vs Shaper

Consumers often pay more attention to the beginning of a trademark. Similar parts in the beginning of two trademarks are therefore remembered more easily than the dissimilarities in the rest of the trademarks. This is in particular the case when the second element - as in this instance 'ite' - is not very distinctive. An infringement.

Barnet vs Barnett

In spite of the fact that there is a T difference between both trademarks and moreover they are accompanied by different devices, the similarity is such that there is a danger of confusion. It is an infringement.

