

# CHIEVER

## QUARTERLY REVIEW

Chiever Quarterly Review contains an overview of striking, interesting and entertaining cases about trademarks, copyright, designs and trade names

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# Exterior of Empire State Building gets trademark protection

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Supermarket could lose Iceland

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Can you sell Champagne Sorbets?

Vlaams Belang doesn't infringe O<sub>2</sub>





## Empire State Building beats beer



The unsuccessful trademark for beer featuring the Empire State Building

**The owner of the Empire State Building in New York has successfully filed an opposition to the registration of a brand of beer featuring an image of the famous landmark on its label.**

### Trademark registration

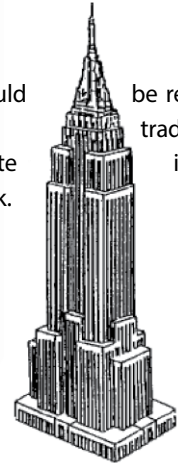
In June, the United States Patent and Trademark Office concluded that the beer brand infringed the trademark rights of ESRT Em-

pire State Building L.L.C., which registered a device mark for the iconic building in 2001.

### Risk of dilution

According to the US Trademark Office, the owners of the Empire State Building have been using the trademark, which is universally recognised, since 1931. And although it hasn't ever been registered for beer, there's still a risk of it being diluted, in that

the public would be reminded of the famous trademark and would associate it with the beer trademark.



US trademark registration no. 2429297

## Buildings as trademarks

**The design and external appearance of a building is initially protected by the architect's copyright. However, the dispute involving the Empire State Building has shown that even here, the issue of trademark rights can play an important role.**

### Added protection

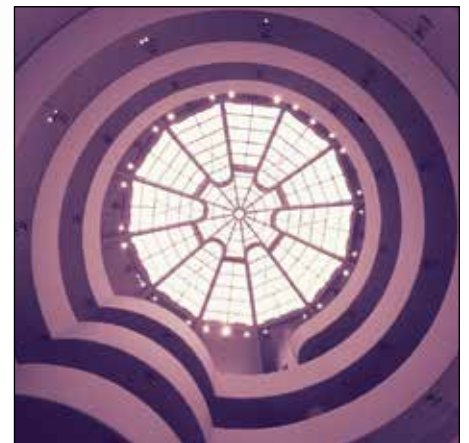
Buildings are frequently registered as trademarks in the United States. Doing so can give the operators or owners of these buildings added protection against commercial exploitation by third parties.

### Flatiron Building

In 1999, Newmark, operators of the well-known Flatiron Building in New York, crossed swords with Flatiron Partners, which wanted to depict the building in its company logo. Newmark owned a trademark registration to the building and therefore made Flatiron pay to license the image.

### The Guggenheim

Unusually, the Guggenheim museum has registered the interior of its premises in New York - the distinctive Guggenheim stairwell - as a trademark.

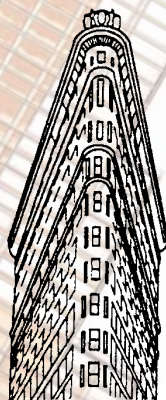


Trademark registration of the distinctive Guggenheim stairwell

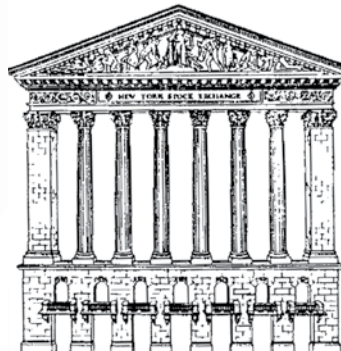
the US. In 1999 NYSE tried to prevent a casino in Las Vegas from displaying a replica of the building.

### BP station

And it's not just old buildings that are registered as trademarks: you'll also find new constructions in the trademark registers, such as this complete BP filling station, which is registered as a European trademark.



Left: Flatiron Building. Right: the trademark



### NYSE

The New York Stock Exchange NYSE has also registered its offices as a trademark in



# Iceland takes up cudgels against supermarket

Photo: Gian-Reto Tarnutzer / Unsplashd

The Icelandic government has threatened to file a suit against the British supermarket chain Iceland to cancel the latter's European trademark registration to the word 'Iceland'.

## Exclusive claim to Iceland

The government claims that in registering the trademark, the supermarket is trying to prevent companies from Iceland using the word on their products and packaging in Europe. According to the UK's *Telegraph* newspaper, it has already stopped several companies from doing so.

## Application made in 2002

The supermarket submitted its initial application in 2002, but this gave rise to so



many oppositions and objections that the registration was severely delayed until 2014. There's a good chance the supermarket may still be forced to relinquish it.

# WhatsApp vs WhosApp

The German firm WhosApp has failed to gain an EU trademark registration for the word WhosApp. According to the European Union Intellectual Property Office, the trademark's length and letter combination are too similar to the registered trademark WhatsApp.



# Trademark registration for packaging design



Chocolate producer August Storck has failed to win trademark protection for the blue and white packaging on its Knoppers biscuit.

## Insufficiently distinctive

Storck had applied for a European trademark registration for its packaging without

text or images. However, the EU General Court ruled that the design lacked distinctive capacity.

Right: trademark registration rejected



## Design registration

These days, the best way to protect this kind of packaging design is through an EU design registration, which doesn't require distinctive capacity. On the right you can see some examples of Nestlé's design registrations of the KitKat-packaging.

Right: EU design registrations for KitKat packaging



# Louis Vuitton wins



Left: Louis Vuitton 'On the Road'  
Right: LVL XIII



**Louis Vuitton needn't stop selling its 'On the Road' sneakers, since the District Court in New York has ruled that the fashion company is not infringing the rights of rival LVL XIII to sneakers with a rectangular metal plate on the toecap.**

#### Trademark rights

LVL XIII had filed a lawsuit against Louis Vuitton with the New York District Court in 2014, complaining that it was selling

shoes featuring a metal toe plate similar to its own and was therefore infringing its trademark rights.

#### Many shoes feature plates

The claim was however rejected in September, when the Court concluded that the plates lacked distinctive character given that many shoes featured metal accents. Furthermore, the metal plates on each company's shoe were different enough not to cause a risk of confusion.



## Champagner Sorbet?

**Can the German supermarket chain Aldi use the name Champagner Sorbet to denote a frozen sorbet dessert that contains 12% champagne? That's the question which has been troubling the European Court of Justice since June.**

#### German cookbooks

The Interprofessional Champagne Wines Committee (CIVC), representing French champagne growers, claims that the Champagner Sorbet concept infringes the rights on the name 'champagne', which is a protected geographical indication. When a German court allowed Aldi to use the name, the CIVC filed an appeal to it at the Federal Court (Bundesgerichtshof). The Bundesgerichtshof has now asked the European Court of Justice to decide whether CIVC can in fact demand such a ban, given that the words 'champagner sorbet' are also used in German cookbooks and 12% of the product consists of champagne.

# EU wins emblem dispute



**The German Bundes Patent Gericht (BPG) ruled in July that the German company Eurokurier cannot register its logo as a trademark because it's too similar to the flag of the European Union.**

#### Flags prohibited

The opposition to the trademark registration was submitted by the European



Union, which appealed under the terms of the Treaty of Paris, which states that flags and emblems of states can't be registered as trademarks.

#### Imitation

Since the logo features 12 five-point stars on a dark background, the BPG concluded that it could be seen as an imitation of the EU flag and therefore give rise to the impression that the company was an EU courier service.

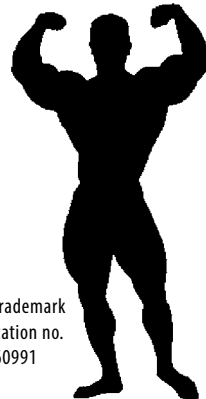


Eurokurier has now adapted its logo





# No trademark for bodybuilder



CTM trademark  
application no.  
013060991

In a judgement issued at the end of September, the European General Court ruled that a logo featuring the silhouette of a body-builder is not eligible for trademark protection as a designator for food supplements and fashion.

## Reference

The application was submitted by an American food supplement multinational which uses the image of a bodybuilder as its logo.

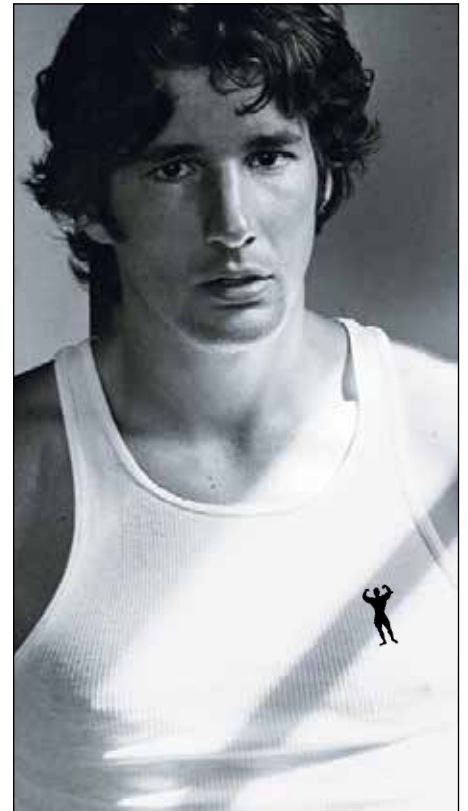
ference to body-building, and that such a trademark was not sufficiently distinctive as a designator for food supplements and clothing.

## Not sufficiently distinctive

The Court concluded that since the image shows the silhouette of a typical body-builder flexing his muscles, the average EU consumer would simply see this as a re-

## Clothing

More surprisingly, the trademark was also refused for clothing on the grounds that it could be seen as referring specifically to clothes for body-builders.



As far as Chiever is concerned, this would be a perfectly appropriate trademark for a fashion brand

# Row over Uggs

US shoe giant Deckers has taken Australian Leather to court for selling shoes under the name Ugg in the United States. Deckers has a registered trademark for Ugg in the US and claims that Australian Leather is infringing its trademark rights.

## Generic

The Australian company however argues that Deckers should never have been granted such rights in the first place, since the word 'uggs' - which was coined in Australia - is simply a generic name for shoes made of sheep's wool. Ugg boots were exported to the US long before Deckers applied for its trademark registration, say Australian Leather, who could end up getting the registration overturned.



## Heks ≠ Wit Wief

The owner of cream cheese dip Heks'nkaas has failed to overturn the trademark registration of Witte Wievenkaas. The Benelux Trademark Office concluded that the Dutch word 'Heks' [witch] refers to someone with magical powers, whereas Witte Wieven [will o' the wisp] denotes a ghostly apparition. There is therefore no similarity between the two and hence no trademark infringement.



# OK for Vlaams Belang to use O<sub>2</sub>

The far-right Flemish political party Vlaams Belang can continue to distribute its manifesto under the title *O<sub>2</sub> - Belgium: the Orderly Split-Up, oxygen for Flanders* - since the use of the abbreviation O<sub>2</sub> doesn't infringe the trademark rights of British telecom giant O<sub>2</sub>, the Brussels Court of Appeal recently ruled.

## No trademark infringement

The District Court in Brussels had originally banned the book in 2012 on the grounds that it infringed O<sub>2</sub>'s trademark rights. However, the Appeal Court has now concluded that Vlaams Belang did not use the word 'O<sub>2</sub>' on the cover as a trademark but merely as an abbreviation for 'oxygen', which also occurs in the title. The O<sub>2</sub> company therefore can't object to its use.



## Destroyed

Unfortunately the judgement came too late for the party and for the book's author Gerolf Annemans, since the entire stock of O<sub>2</sub> was withdrawn and destroyed in 2012.

# The latest refused trademark applications

If a trademark lacks sufficient distinctive character, the Benelux Office for Intellectual Property BBIE won't register it - sometimes justifiably, but sometimes not, in our opinion. Right or wrong, the rules are strict.

Trademark rejected:	Chiever says ...
	We think the BBIE is now being a bit too hard on pure device marks. Surely this thick blue P with its stylised lorry is sufficiently distinctive as a designator for parking services?
<b>ALLEEN JIJ BEPAALT WIE JE BENT</b>	'Only you can decide who you are'. This application was made by none other than the Dutch Ministry of Justice, but we reckon the refusal was a foregone conclusion.
	"OK, OK, so we'll resubmit it as an image," the Ministry probably reasoned. Wrong again. This type of minimal device element won't wash anymore.
<b>MAAK HET DIEVEN NIET TE MAKKELIJK</b>	'Don't make things too easy for thieves'. Perhaps not a great idea to keep on 'bashing' the Ministry of Justice, but it is after all our taxes that are paying for all these failed applications!
<b>TeamNL</b>	Device mark filed by the Dutch Olympic Committee for various kinds of goods and services. For us no surprise this trademark with its orange letters was refused.

Chiever advises companies on the national and international protection of their brands, trade names, copyright and design.

## USP's

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