

The PUCH judgement

Judgement by the Danish Maritime and Commercial Court dated 09 January 2012 in Cycleeurope AB vs. Dansk Supermarked A/S.

Many of us who were young in the 80'ies become quite nostalgic when we hear the word PUCH. If one was not oneself the fortunate owner of a Puch Maxi moped, one surely knew someone who rode one. A recent judgement from the Danish Maritime and Commercial Court will surely take many by surprise:

Puch in use?

Dansk Supermarked had applied for registration of PUCH (word mark) for "scooters, bicycles, including electrical ones" in class 12. Via their licensee Cycleeurope AB, the owners of the "moped mark" PUCH, Magna Steyr AG & Co. KG, lodged an opposition against that registration on the basis of Danish trademark registration No. VR 1940 00169 PUCH (figure mark) in class 12. As a countermove, Danish Supermarked claimed revocation of that Danish trademark registration due to lack of use. Therefore, the case essentially concerned the issue whether the moped mark PUCH was

still in use in Denmark. Albeit hard to believe, and albeit 71 % of survey respondents knew the PUCH moped mark, the production of PUCH mopeds was discontinued in 1987. It is still possible to buy spare parts for old PUCH mopeds, but they come from small retailers who still have surplus stocks of them. The Court found that this is not actual use of a trademark and that the rights to the PUCH moped mark were to be cancelled.

Famous but dead

The judgement is an interesting one as it is concerned with the issue of being a well-known, but "dead" trademark. Some kind of goodwill may very well be associated with a dead trademark, but such goodwill cannot be converted into an asset to the trademark owner when the trademark right is dead. And when the trademark right is dead, the trademark can be acquired by others.

Value of Community Trademarks

The judgement also illustrates that it can be valuable to have a Community Trademark; as it is, it came up in the case that the "moped mark" PUCH is used as trademark for *bicycles* in Austria, Germany, the Benelux, and



France. If Magna Steyr had had a Community Trademark registration in respect of PUCH, they would have been able to enforce it in Denmark despite the fact that they used the trademark in said EU countries only. As it is, the compulsory use in the context of a Community Trademark is complied with when the trademark is used in one single EU country.

It remains to be seen whether the judgement is appealed to the Danish Supreme Court.

PCT Patent Prosecution Highway (PPH) extended

The European Patent Office (EPO), US Patent & Trademark Office (USPTO) and Japanese Patent Office (JPO) have extended the trial period for the Trilateral PCT-PPH pilot programme until 28 January 2014. For patent applicants this is good news.

To obtain protection in several parts of the world, it is most common to first file an international PCT application (PCT = patent cooperation treaty) with eg the EPO. The PCT application will be examined within 30 months during the so-called 'international phase'. The opinion of the EPO acting as the so-called International Search Authority (ISA) is, however, a non-binding opinion, and the PCT-application will not lead to a grant. For more information: [click here](#).

What's in a name? - Baby Beyoncé now the subject of a trademark registration

On January 7 the well-known singer Beyoncé and rapper/hip-hop singer Jay-Z had a baby girl. They named her Blue Ivy Carter.

Trigger

This was a trigger for savvy entrepreneurs to jump on the trademark bandwagon. In the US, the trademarks BLUE IVY CARTER NYC (deposited on 11 January, four days after the birth) and BLUE IVY CARTER GLORY IV (deposited on 20 January, but withdraw on 26 January) were registered by two entrepreneurs for baby clothes and perfume/ cosmetics respectively.

In the meantime, Beyoncé and Jay-Z have themselves also registered the name as a trademark for several products and services in particular for merchandising (like cosmetics, jewels, furniture, kitchenware, (baby) clothes and toys).

US law: permission required

There is every indication that the first two trademark applications will not be accepted, since US trademark law specifies that if a trademark consists of, or expressly mentions, the name of a private individual, written permission must be obtained from that individual before the trademark can be registered.

It doesn't look as though the owners of the aforementioned trademarks have been given that permission and it is also unlikely that Blue Ivy's parents will agree to give it to them.

Other countries: permission or not?

The requirement to obtain an individual's permission for their name to be registered doesn't apply in the Benelux and European Union, so it may be possible for third parties to register such a trademark. In such cases,

it is up to the individual whose name has been registered to take legal action if they wish. In some Europe countries, like Sweden, Norway and Denmark, however, an application to register a trademark containing an individual's name can be rejected under trademark law.



Trademark registration Beyoncé and Jay-Z

New generic Top Level Domains

From 12 January 2012 to 12 April 2012 ICANN is accepting applications to operate new generic Top Level Domains (so called gTLDs). The change will in principle allow anyone to apply for a new generic Top Level Domain and, trademark owners will be able to register and run their own brand as a new Top Level Domain (eg .apple, or .volvo.) For more information, visit our website: [click here](#)

Cooperation with Patentbüro Paul Rosenich AG

Zacco has started to cooperate with Patentbüro Paul Rosenich AG, a Liechtenstein based patent firm with an extensive international network and knowledge.

Patentbüro Paul Rosenich AG (PPR) was established in 1998 and has offices in Triesenberg in Liechtenstein and in Buchs in Switzerland. PPR consists of a highly skilled team with broad international experience. PPR today works with SME (Small and Medium size Enterprises) and large international companies within physics, mechanical and electro engineering, and

optoelectronics industries, areas where Zacco is also strong. In addition, Zacco in Germany is very strong in the fields of Chemistry and Pharma. We thus expect the cooperation to strengthen both firms' offering.

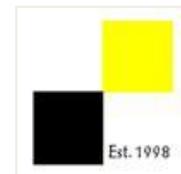
The founder of PPR, Paul Rosenich is also a renowned and respected teacher within the IP field. He has trained, and still is training, European IP Staff at several universities across Europe.

The training operations will within short be expanded which means that future patent

consultants, including Zacco's consultants, can be trained, in Triesenberg, before taking the European Qualification Examination.

- We are very excited about the cooperation with PPR. Together we will be able to serve our clients better. We will also have access to one of the industry's best teachers within the IP field, making sure that we are in the front line of the IP industry, says Hajo Peters from Zacco.

Should you have any questions regarding this cooperation, please do not hesitate to contact us on info.munich@zacco.com.



Beware of bogus invoices (acquisition fraud)

Owners of intellectual property rights such as trademarks and patents are still regularly being sent bogus invoices. These are usually official-looking invoices or bills which charge the recipient for 'inclusion in a register'. The senders have nothing to do with official registers or the IP authorities. From time to time we'll regularly alert you to this problem, which is officially referred to as 'acquisition fraud'.

The reason why these fraudulent organisations can get hold of your details is because the IP registers are legally accessible documents and this means that your address details are visible to all. This is necessary in order to check whether the claim that someone owns a trademark right is correct.

The bogus letters or invoices that are sent out can give the impression that they involve an official communication about your trademark or patent registration. However, if you study the small print you will find it's really just an offer. Other letters try to get you to renew or extend your registration or sell you a domain name.

EPTR EUROPEAN PATENT AND TRADEMARK REGISTER

REGISTRATION NUMBER: [REDACTED]
 REGISTRATION DATE: [REDACTED]
 FIGURATIVE ELEMENTS (VIENNA CLASS): 35 41 42 44

TRADEMARK REGISTRATION

REPRODUCTION OF MARK: [REDACTED]

| Pos. | Description | Curr. | Amount |
|-------------------------|----------------|------------|---------------|
| 01 | Filing Fee | EUR | 960,00 |
| 02 | Additional Fee | EUR | 0,00 |
| Total Filing Fee | | EUR | 960,00 |

PAYMENT:

BY WIRE TRANSFER:
 AMOUNT: 960,00
 BENEFICIARY: EPTR
 BANK NAME: WBK Bank
 IBAN: PLS1 1090 1711 0000 0001 1624 784
 BIC/SWIFT: WBKPLPP
 BANK ADDRESS: Rynek 9/11, 50-950 Wrocław, Poland

BY CHEQUE:
 BENEFICIARY - EPTR

W.O.I.P.

Please pay the amount, within 8 days by wire transfer or cheque. Don't forget to quote the registration number.

IOPR - Intellectual Office Property Register

Domain name hijackers

A more recent problem concerns domain names, in which misleading e-mails are sent warning you against domain name hijackers. Many of these e-mails are sent from Asia and claim that a third party has applied to register a domain name ('internet brand name' or 'keyword') consisting of your trademark and an Asian extension. The sender then offers to register this domain name on your behalf.

We strongly advise you under no circumstances to pay such invoices and not to respond to 'offers' from unknown correspondents. We recommend that all official correspondence concerning your trademark, patent or domain name should go through Zacco, where it will be in safe hands. If you have any doubts or questions regarding this, please don't hesitate to contact us.

Overview of these organizations

To help you avoid paying out for a worthless registration or service, we have listed the names of some of these organizations so that you can easily recognize them if you see them in the future. Please visit our website for an overview: [click here](#).

About Zacco

Zacco is a leading Intellectual Property Consultancy firm in Europe, with offices in Denmark, Germany, Norway, the Netherlands and Sweden (Albihns.Zacco). In addition to assistance in protecting intellectual property rights, Zacco also offers its clients strategic advice aimed at increasing their competitive edge through a professional exploitation of these rights. Visit www.zacco.com for further information.

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