

**The battle of Porsche versus P@RSCHÉ**  
**Netherlands - Hoogenraad & Haak, Advertising + IP Advocaten**

**Cancellation**  
**National procedures**

January 17 2017

On October 26 2016 the District Court of The Hague rendered its judgment in a case brought by Dr Ing HCF Porsche Aktiengesellschaft against , an unnamed Dutch individual. Both parties had met previously in court in 2012, when it was ruled that the defendant had filed a trademark application for the word PORSCHE in bad faith. That registration was revoked and Porsche was granted an injunction to register the trademark PORSCHE.

Porsche was established in 1931 and is widely known for the production of luxury sports cars. It owns an EU trademark for the words PORSCHE DESIGN for goods and services in Classes 9, 12 and 28 and a EU word mark for goods and services in Classes 9, 12, 28 and 42 for the word PORSCHE.



In these proceedings Porsche requested cancellation of the Benelux trademarks for the sign P@RSCHÉ, which the defendant had registered for Classes 9, 12, 28 and 42 (on March 17, April 11 2014 and May 10 2014, respectively), together with a twofold injunction regarding the registration of the trademark P@RSCHÉ or a similar trademark and an injunction regarding the infringement of Porsche's rights. Subsequently, Porsche claimed payment for penalties amounting to €75,000 with regard to the injunction from the earlier case and full reimbursement of legal costs.

According to Articles 2.28(3)(a), 2.3(b) and 2.45 of the Benelux Convention on Intellectual Property, the proprietor of an earlier trademark may seek the invalidation of a new registration that is similar to its earlier trademark and is registered for similar goods and services where a likelihood of confusion among the public exists.

The defendant argued that the trademarks were not similar because the PORSCHE trademark was a figurative mark and because there was no aural, visual or conceptual similarity between the marks. In addition, he stated that he did not actually use the sign P@RSCHÉ.

The court held that the fact that the PORSCHE trademark was registered as a figurative trademark was an administrative matter which – in this case – did not influence the scope of protection. The trademark as registered was the word mark PORSCHE, stylised in a simple manner. This meant that the distinctive character derived mostly from the word component. In addition, there was strong aural and visual similarity due to six identical letters. Moreover, the trademark PORSCHE had a distinctive character and enjoyed a reputation in the Benelux. This led to the conclusion that a likelihood of confusion existed between the trademarks P@RSCHÉ and PORSCHE. Whether a trademark is actually used in the course of trade is irrelevant to a cancellation action on the grounds of Article 2.3 of the convention. Use is presumed even if there is no intention of use.

Porsche's request for cancellation of the P@RSCHÉ trademark was granted. However, the injunction relating to the infringement was denied as Porsche had failed to demonstrate an existing threat of actual infringement. As the defendant claimed to have registered the trademark solely in order to sell it, this would have been a logical step, according to the court. As there was now no actual threat of infringement, the request for an injunction was refused. The request for payment of penalties was also denied, because the previous injunction related only to the identical word PORSCHE. The injunction against registering a similar trademark in the future was accepted to the extent that the defendant is not allowed to register P@RSCHÉ or any other trademark in which the 'o' is another sign or letter.

*Stephanie Reinders Folmer and Moïra Truijens, Hoogenraad & Haak, Amsterdam*

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