

# Kennedy Van der Laan

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Practice area	Intellectual Property
Title of Article	<b>Red/White Color Trademarks Invalid but Still a Victory for Ajax</b>

## Summary

Ajax took legal action against a seller of a red/white hoody zip with three Andreas crosses and AMSTERDAM on it, *inter alia* on the basis of its red/white color trademarks. The color trademarks were declared invalid by the Court because they were not sufficiently clear. But in the end, Ajax still won the case.

## ARTICLE:

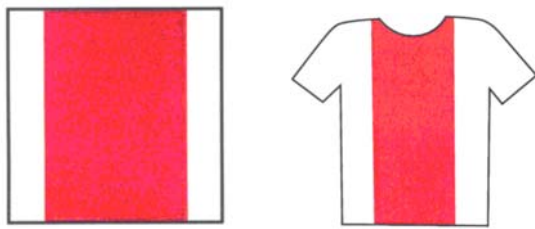
### Introduction

The Court of Amsterdam rendered a judgment on 29 June 2011 between Ajax and a seller of soccer and Amsterdam souvenirs. The hoody zip concerned looks as follows:



This AMSTERDAM hoody was sold from a handcart in the vicinity of the Ajax soccer stadium *Amsterdam Arena*. The sleeve contains the text 'pride of Mokum' and the price tag 'official licensed products'.

Ajax argued that this was a trademark infringement on the basis of its Benelux color trademarks red/white, as filed in 1996:





Furthermore, Ajax also holds a Benelux device mark with the picture of the Greek hero and two Andreas crosses as depicted here.

Ajax obtained an *ex parte* order from the Court in preliminary relief proceedings and also seized 21 samples of the AMSTERDAM hoody concerned. Although it might seem a manifest infringement, Ajax was not so successful in these proceedings on the merits.

### **Invalidity of the Red/White Color Trademarks**

In the counterclaim, the seller of the AMSTERDAM hoody claimed the invalidity of the red/white color trademarks. The Court assessed this claim on the basis of case law of the European Court of Justice ([Libertel](#), [Heidelberger Bauchemie](#) and [Sieckmann](#)) and allowed this claim. The color trademarks had been registered by Ajax before the strict requirements for color trademarks were set out by the European Court of Justice.

The requirements are, for instance:

- the graphic design must be precise and durable. To this end, the color must be referred to with an internationally recognized color identification code;
- the color or combination of colors must actually come across as a (distinctive) sign;
- the registration must contain a systematic arrangement that connects the colors involved in a previously determined and durable manner.

Because the color trademarks of Ajax do not meet these requirements – they do not contain any color codes – they are invalid as a trademark. Although the combination of red/white colors is clearly associated with Ajax, Ajax cannot rely on the color trademarks acquiring distinctiveness through use, because the precision of the color is a formal requirement.

It will, however, probably be possible for Ajax to file the combination of colors as a trademark once again, if the proportions of white and red are clearly depicted, and if the color codes are mentioned. The other requirements seem to have been met. Although more soccer clubs are using the colors red and white, it can be defended that the combination of colors of Ajax in the

specific proportion between the white and the red parts is so well-known to the public in the Benelux that it has (acquired) distinctive character and can function as a trademark.

### **The Outcome of the Proceedings**

Despite the fact that the color trademarks of Ajax are invalid, Ajax won the proceedings. The reason behind this were additional circumstances as a result of which the sale of the AMSTERDAM hoody is unlawful, according to the Court. For instance, other elements have been copied which are often used by Ajax, including the 'A' of its sponsor Aegon, the text 'pride of Mokum', the use of the designations 'official licensed products' and 'fansport, fanwear for fans'. To conclude, it was taken into account that the AMSTERDAM hoody was sold in front of the Ajax stadium. As a result, the impression was created among the public that the hoodies were traded under a license of Ajax and that they were official Ajax products. The seller thus profited deliberately from the reputation of Ajax and Ajax suffered damage (loss of income and damage to reputation).

In short, the requirements of an unlawful act have been met. The Court prohibited the seller from trading the AMSTERDAM hoody. Moreover, Ajax is allowed to destroy the hoodies already seized.

The invalidation of the color trademarks seems to be a nuisance for Ajax. However, all in all, Ajax's loss might be limited: it won the proceedings and may probably file a new red/white color trademark with the specific proportions and the color codes.