

judgment

DISTRICT COURT OF THE HAGUE

Civil law section

case number / case list number: 351377 / HA ZA 09-3707

Judgment of 20 April 2011

in the matter of

the foundation
STICHTING PINK RIBBON,
established in Bussum, Netherlands,
attorney: H.J.A. Knijff of Amsterdam,
plaintiff in claim,
defendant in counterclaim,

versus

1. the private company with limited liability
GLOBALCITY B.V.,
established in The Hague, Netherlands,
attorney: J.A. Tuinman of Amsterdam,
2. the private company with limited liability
BRANDCONCERN B.V.,
established in Amsterdam, Netherlands,
attorney: formerly H. Eijer, currently no attorney,
3. the private company with limited liability
PRETECTION B.V.,
established in The Hague, Netherlands,
attorney: formerly H. Eijer, currently no attorney,
4. the private company with limited liability
COMMUNITYCHAIN B.V.,
established in The Hague, Netherlands,
attorney: formerly H. Eijer, currently no attorney,
5. WALTER JULIUS ALBERT SCHEFFRAHN,
residing in Amsterdam, Netherlands,
attorney: formerly H. Eijer, currently no attorney,
defendants in claim,
plaintiffs in counterclaim.

In the following, the plaintiff in claim, defendant in counterclaim will be referred to as the Foundation. The defendants in claim, plaintiffs in counterclaim will be individually referred to as Globalocity, Brandconcern, Protection, CommunityChain and Scheffrahn, and collectively

as Scheffrahn et al. (in the singular). The case was substantively dealt with for the Foundation by attorney M.L.J. van de Braak of Amsterdam and for Scheffrahn et al. by attorney H. Eijer of Zoetermeer.

1. The proceedings

1.1. The course of the proceedings appears from:

- the writs of summons dated 23 and 24 March 2009,
- the Foundation's deed for submitting exhibits with Exhibits 1-23,
- the statement of defence, with Exhibits 1-6,
- the interlocutory judgment dated 13 January 2010, ordering a personal appearance of the parties,
- the court record of the personal appearance on 24 March 2010 and the documents mentioned in this record.

1.2. Judgment was scheduled to be rendered today.

2. The facts

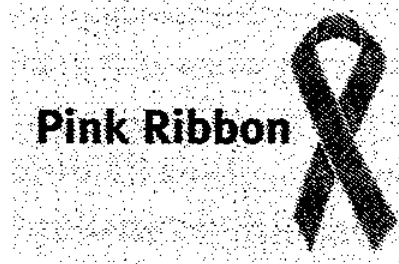
2.1. Around 1992, various projects were developed in the United States in the scope of the fight against breast cancer. In this scope, a *pink ribbon* was introduced as the symbol in this fight. Amongst others, cosmetic company Estée Lauder has handed out millions of pink ribbons in the United States.

2.2. As of 2002, projects in the scope of the fight against breast cancer have also been organized in the Benelux. As of that year, the *American Women's Club* organized Pink Ribbon Galas and Estée Lauder annually organizes a *Pink Ribbon Day* on which a building is illuminated in pink lights.

2.3. In 2003, the *American Women's Club*, Estée Lauder and the Netherlands Breast Cancer Foundation decided to join forces. The Foundation has been incorporated for this purpose.

2.4. The Foundation holds the following Benelux trademark registrations:

2.4.1. the word/pictorial mark PINK RIBBON displayed below, registered on 1 March 2004 under number 0742123 for fundraising services to support breast cancer awareness-raising campaigns in class 36 and various goods and services in classes 16 and 25;



2.4.2. the word/pictorial mark PINK RIBBON displayed below, registered on 19 October 2004 under number 0756726 for fundraising services in class 36, information regarding *inter alia* breast cancer in class 44 and various goods and services in classes 16, 25, 35, 41, 42, 44 and 45;



2.4.3. the word mark PINK RIBBON, registered on 7 February 2006 under number 0792329 for fundraising services in class 36, information regarding *inter alia* breast cancer in class 44 and various goods and services in classes 16, 25, 35, 41, 42, 44 and 45;

2.4.4. the word/pictorial mark PINK RIBBON displayed below, registered on 7 January 2008 under number 0831869 for fundraising services in class 36, information regarding *inter alia* breast cancer in class 44 and various goods and services in classes 3, 4, 5, 8, 9, 11, 12, 14, 16, 18, 20, 21, 24, 25, 26, 28, 35, 36, 38, 41, 42, 44 and 45;



2.4.5. the word/pictorial mark PINK RIBBON displayed below, registered on 7 January 2008 under number 0831870 for fundraising services in class 36, information regarding *inter alia* breast cancer in class 44 and various goods and services in classes 3, 4, 5, 8, 9, 11, 12, 14, 16, 18, 20, 21, 24, 25, 26, 28, 35, 36, 38, 41, 42, 44 and 45:



2.5. Scheffrahn is the sole shareholder and managing director of the private company with limited liability Scheffrahn Management B.V. Through this company he holds all shares in the share capital of Brandconcern and Infoconcern B.V. Scheffrahn Management B.V. is also the sole managing director of these two companies. In turn, Infoconcern B.V. holds all shares in the share capital of and is the sole managing director of Globalocity and CommunityChain. Moreover, Infoconcern B.V. is the sole managing director of Protection. The latter company has several shareholders.

2.6. In 2004, Scheffrahn conceived the idea to set up an international charity organization under the name PINK RIBBON International for the fight against breast cancer. This ultimately resulted in the incorporation on 23 June 2008 of the American legal entity Pink Ribbon, Inc.

2.7. Scheffrahn et al. has registered many domain names, including pinkribbon.org, pinkribbon.com and various national domain names (domain names with a *country code top-level domain*), including pinkribbon.be and rozelint.be. Scheffrahn et al. registered the domain name pinkribbon.be on 27 September 2004. A website is published under the domain name pinkribbon.org with the following *homepage*:

PINKRIBBON
International

Let's join together
A Breast Cancer Community

Donate Now

Pink Ribbon Day

Welcome

We at Pink Ribbon International are proud to welcome you to our new online community. We have done our best to create a user-friendly environment through our News Forum and calendar. We further provide information regarding breast cancer treatment, research, and support. In addition, we are privileged to seek an information source on health funds. Through the cooperation with Dr. Janet Sorell Scribner and Dr. Richard Bevilacqua we are able to provide you with new information regarding their investigation into the natural defense system and cancer. Their books, "and cancer: a new way of life" (Dec 2008), "Breast, Ovaries, and Prostate That Fight Cancer" (Dec 2008), and "Prostate That Fight Cancer" (Dec 2008) have shed a light on new ways to not only battle breast cancer, but also fight recurrence. For more information on their new quantum logic, visit the [Researcher's website](#).

Sincerely,
Walter Scheffach, MBA, MEd, SIA, LL.M.

Walter Scheffach

Director Pink Ribbon Inc./Pink Ribbon International
on behalf of The Pink Ribbon International Team

News

Breast cancer recurrence seen as low after 5 years

WASHINGTON (Reuters) 12th Aug 2008
Women who survive breast cancer for five years after treatment have a relatively low risk of the disease recurring, according to a U.S. study, published on Tuesday.

Breast cancer mortality increases with body mass index

NEW YORK (Reuters Health) - A higher body mass index (BMI) is associated with lower survival rates in women with breast cancer, according to a report in the July 10th issue of the Journal of Clinical Oncology.

Translation

Pink Ribbon International strives to create worldwide presence. We are searching for Certified Translators who are willing to support our cause by translating our website into other languages. Please contact us here.

Quick Poll

Health organizations are steadily decreasing their promotion of regular self-breast exams. Based on studies that suggest that breast self exams do not increase the chance of breast cancer survival, organizations are choosing to focus their advocacy on other means relating to breast cancer. Pink Ribbon International is wondering what you think. Should organizations continue to promote regular breast self exams?

Yes

No

Not sure

Orange You Not?

The following Internet page is published under the domain names pinkribbon.be and rozelint.be:



2.8. On 21 August 2007 a letter signed by Scheffrahn was written to the Foundation's attorney. The stationery includes the Pink Ribbon International Logo shown below (hereinafter: the Pink Ribbon International Logo):



The letterhead mentions the following:

Pink Ribbon™
Pink Ribbon International
Pink Ribbon International Licensing
New York
USA
www.pinkribbon.com / .org

Roze Lint®
Herengracht 23
1015 BA Amsterdam
The Netherlands
www.rozelint.nl / .be

2.9. Scheffrahn et al. has filed various Benelux trademarks. Based on a number of these filings, international registrations were filed for several countries. The Benelux trademark

filings are listed below, each time indicating the procedures conducted in response to those filings.

2.9.1 the word mark PINK RIBBON with urgent registration number 809606 (filing number 1120611) and filing date 10 October 2006 for goods and services in class 25, in the name of Globalocity.

On 25 December 2006, the Foundation brought an opposition procedure with the Benelux Office for Intellectual Property (trademarks and designs) (hereinafter: BOIP).

On 28 February 2007, the BOIP informed the Foundation that the opposition procedure would be conducted in French. On 11 May 2007, the Foundation filed the substantiation in the opposition procedure. Globalocity had to file its defence on 12 November 2007 at the latest. On 28 October 2007, Globalocity withdrew the filing.

2.9.2. the word mark PINK RIBBON with filing number 1120608 and filing date 10 October 2006, for goods and services in classes 3, 5, 8, 9, 14, 18, 20, 24, 28 and 33, in the name of Brandconcern.

On 25 December 2006, the Foundation brought an opposition procedure with the BOIP. On 28 February 2007, the BOIP informed the Foundation that the opposition procedure would be conducted in French. On 11 May 2007, the Foundation filed the substantiation in the opposition procedure. Brandconcern had to file its defence on 28 October 2007 at the latest. On 28 October 2007, Brandconcern withdrew the filing.

2.9.3. the word mark PINK RIBBON with filing number 1123695 and filing date 23 November 2006, for goods and services in classes 38, 41 and 44, in the name of Globalocity.

On 25 February 2007, the Foundation brought an opposition procedure with the BOIP. On 28 February 2007, the BOIP informed the Foundation that the opposition procedure would be conducted in French. On 10 August 2007, the Foundation filed the substantiation in the opposition procedure. Globalocity had to file its defence on 28 October 2007 at the latest. On 28 October 2007, Globalocity withdrew the filing.

2.9.4. the word mark PINK RIBBON with urgent registration number 813514 (filing number 1121155) and filing date 24 November 2006, for goods and services in classes 16, 35 and 36, in the name of Globalocity.

On 25 January 2007, the Foundation brought an opposition procedure with the BOIP. On 1 March 2007, the BOIP informed the Foundation that the opposition procedure would be conducted in French. On 22 June 2007, the Foundation filed the substantiation in the opposition procedure. Globalocity had to file its defence on 21 November 2007 at the latest. On 28 October 2007, Globalocity withdrew the filing.

2.9.5. the word mark RIBBON OF PINK with urgent registration number 827613 (filing number 1139699) and filing date 19 July 2007 for goods and services in classes 16, 25, 36, 41 and 44, in the name of Brandconcern.

On 31 October 2007, the Foundation brought an opposition procedure with the BOIP. On 10 March 2008, the Foundation filed the substantiation in the opposition procedure. On 13 May 2008, Brandconcern withdrew the filing.

2.9.6. the word mark PINK RIBBON INTERNATIONAL with urgent registration number 827573 (filing number 1140097) and filing date 26 July 2007, for goods and services in classes 16, 25, 35, 36, 41 and 44, in the name of Brandconcern.

On 31 October 2007, the Foundation brought an opposition procedure with the BOIP. On 10 March 2008, the Foundation withdrew the substantiation in the opposition procedure. On 13 May 2008, Brandconcern withdrew the filing.

2.9.7. the word/pictorial mark PINK RIBBON displayed below with urgent registration number 827548 (filing number 1140099) and filing date 26 July 2007, for goods and services in classes 16, 25 and 36, in the name of Brandconcern.



On 31 October 2007, Pink Ribbon brought an opposition procedure with the BOIP. On 10 March 2008, the Foundation filed the substantiation in the opposition procedure. On 13 May 2008, Brandconcern withdrew the filing.

2.9.8. the word mark PINK RIBBON with filing number 1161898 and filing date 23 June 2008, for goods and services in classes 1, 2, 6, 7, 10, 13, 15, 17, 19, 22, 23, 27, 29, 30, 31, 32, 33, 34, 37, 39, 40 and 43, in the name of Brandconcern.

The BOIP cancelled the filing on 19 August 2008 because the fees due had not been paid in time.

2.9.9. the word mark PINK RIBBON with filing number 1161900 and filing date 23 June 2008, for goods and services in classes 3, 16 and 45, in the name of CommunityChain.

The BOIP cancelled the filing on 19 August 2008 because the fees due had not been paid in time.

2.9.10. the word mark PINK RIBBON with filing number 1161901 and filing date 23 June 2008, for goods and services in classes 8, 9 and 25, in the name of Globalocity.

The BOIP cancelled the filing on 19 August 2008 because the fees due had not been paid in time.

2.9.11. the word mark PINK RIBBON with filing number 1161903 and filing date 23 June 2008, for goods and services in classes 14, 18 and 36, in the name of Pretecton.

The BOIP cancelled the filing on 19 August 2008 because the fees due had not been paid in time.

2.10. Scheffrahn et al. also filed the following Community trademark applications:

2.10.1. the word mark PINK RIBBON with filing number 5500517 and filing date 27 November 2006, for goods and services in classes 16, 25 and 36, in the name of Brandconcern.

On 5 November 2007, the Foundation brought an opposition procedure with the Office for Harmonization in the Internal Market (Trademarks and Designs) (hereinafter: OHIM). On 11 July 2008, the Foundation filed the substantiation in the opposition procedure. In response, Brandconcern has filed a defence; subsequently, the parties have filed a reply and rejoinder, respectively.

2.10.2. the word mark PINK RIBBON with filing number 5546775 and filing date 12 December 2006, for goods and services in classes 3, 5, 8, 9, 14, 18, 20, 24, 28, 33, 35, 38, 41 and 44, in the name of Brandconcern.

On 14 December 2007, the Foundation brought an opposition procedure with the OHIM. On 11 July 2008, the Foundation filed the substantiation in the opposition procedure. In response, Brandconcern has filed a defence; subsequently, the parties have filed a reply and rejoinder, respectively.

2.10.3. the word/pictorial mark PINK RIBBON with filing number 6013411 and filing date 18 June 2007, for goods and services in classes 16, 25 and 36, in the name of Brandconcern.



On 29 April 2008, the Foundation brought an opposition procedure with the OHIM. On 15 August 2008, the Foundation filed the substantiation in the opposition procedure. Brandconcern did not file its defence in time. In response, the OHIM declared the opposition valid and dismissed the application. Brandconcern appealed this decision. In the appeal procedure, both parties have filed statements.

2.10.4. the word mark RIBBON OF PINK with filing number 6114052 and filing date 19 July 2007, for goods and services in classes 25, 36, 41 and 44, in the name of Brandconcern.

Subsequently, Brandconcern has withdrawn this filing.

2.10.5. the word mark RIBBON OF PINK with filing number 6114771 and filing date 4 September 2007, for goods and services in classes 16, 25, 36, 41, 42 and 44, in the name of Brandconcern.

On 19 March 2008, the Foundation brought an opposition procedure with the OHIM. On 15 August 2008, the Foundation filed the substantiation in the opposition procedure. In response, Brandconcern has filed a defence; subsequently, the parties have filed a reply and rejoinder, respectively.

2.10.6. the word mark PINK RIBBON MAGAZINE with filing number 6140479 and filing date 18 September 2007, for goods and services in classes 9, 16, 25, 35, 36, 42 and 44, in the name of Brandconcern.

On 7 July 2008, the Foundation brought an opposition procedure with the OHIM. The OHIM suspended the opposition pending the procedures mentioned above regarding Scheffrahn et al.'s applications with numbers 5500517, 5546775, 6114771 and 6013411.

2.10.7. the word mark PINK RIBBON INTERNATIONAL with filing number 6139539 and filing date 26 July 2007, for goods and services in classes 16, 25, 36, 41 and 44, in the name of Brandconcern.

At the time of the personal appearance of the parties, the filing had not yet been published.

2.11. On the hyves.nl network site, a "Pink Ribbon International Hyve" site has been launched on which the Pink Ribbon International Logo is used. This Hyve site is presented as 'the official Hyve of Pink Ribbon International'.

2.12. Pink Ribbon International texts are on the www.wikipedia.nl and www.wikipedia.be websites. The Pink Ribbon International Logo is displayed with these texts.

2.13. In a judgment dated 24 September 2008, pursuant to a claim of the Foundation the summary trial judge of this District Court ordered Scheffrahn et al. – in brief – (i) to discontinue infringing the Foundation's trademark rights, (ii) to refrain from filing trademarks containing the word elements PINK and RIBBON, and (iii) to co-operate in a request to suspend opposition procedures.

2.14. On 23 March 2009, Scheffrahn et al. transferred the Community trademark applications mentioned in legal ground 2.10 to Pink Ribbon, Inc.

3. The dispute

in claim

3.1. The Foundation claims – in brief – (a) a declaratory judgment to the effect that filing and then withdrawing trademarks is unlawful in respect of the Foundation, (b) a prohibition on filing trademarks, (c) an order to co-operate in suspending the opposition procedures against the Community trademark applications, (d) a prohibition against trademark infringement, subject to a penalty in the event that these prohibitions and orders are violated and an order for Scheffrahn et al. to pay the legal costs in the sense of Section 1019h of the Dutch Code of Civil Procedure (hereinafter: Rv).

3.2. The Foundation bases its claims on the fact that the manner of filing and litigating by Scheffrahn et al. regarding the trademark filings constitutes abuse of authority. In addition, the Foundation contends that the use by Scheffrahn et al. of signs on its stationery and websites that correspond to the Foundation's trademarks infringes the Foundation's trademark rights.

3.3. Scheffrahn et al. has conducted a defence.

3.4. The parties' arguments will be dealt with in the following, in as far as relevant.

in counterclaim

3.5. Scheffrahn et al. claims – in brief – a declaratory judgment to the effect that the Foundation did not acquire the right to the PINK RIBBON word mark with its filing under number 792329 and to cancel the Foundation's trademarks mentioned in the writ of summons, with an order for the Foundation to pay the legal costs in the sense of Section 1019h Rv.

3.6. The Foundation has conducted a defence. The parties' arguments will be dealt with in the following, in as far as relevant.

4. The assessment

jurisdiction in claim and in counterclaim

4.1. This District Court has jurisdiction over the claims. To the extent that the claims are based on the argument that Scheffrahn et al. infringes the Foundation's trademark rights, this inter alia arises from the fact that the alleged infringements also occur in the district of The Hague (Article 4.6. (1) of the Benelux Convention concerning Intellectual Property (Trademarks and Designs), hereinafter: BCIP). For the rest the jurisdiction of this District Court in claim already follows from the fact that Scheffrahn et al. did not contest this jurisdiction (Section 110 Rv). The jurisdiction in counterclaim follows from Article 4.6 (4) BCIP.

in counterclaim

4.2. Since the validity of the trademark registrations on which part of the claims are based is contested in counterclaim, the District Court will first assess the counterclaims.

no customary signs

4.3. Scheffrahn et al.'s argument that the Foundation's trademarks solely comprise signs that are customary in everyday language in the sense of Article 2.28 (1) d BCIP is unfounded. Most of the facts that Scheffrahn et al. contended in this connection regard the use of signs outside the Benelux. The fact that those signs are customary in the Benelux cannot be based on this, since it has not been contended or shown that the relevant public in the Benelux was aware of that use. The only use in the Benelux that Scheffrahn et al. contended regards the Pink Ribbon Gala of the *American Women's Club* in 2002 and the *Pink Ribbon Day* that Estée Lauder organizes each year as of 2002. Those two activities are insufficient to conclude that the term PINK RIBBON or the image of a pink ribbon was customary in the Benelux as a symbol of the fight against breast cancer at the time the Foundation's trademarks were registered, let alone that the Foundation's trademarks were a customary indication of the goods and services for which the Foundation registered those trademarks at that time.

4.4. In addition, the Foundation contended unchallenged that from the registration of its trademarks, it has made a very intensive use of those trademarks in the scope of various activities and publications. As a result of that use, the trademarks acquired (additional) distinctive character. For this reason, as well, the Foundation's trademarks cannot be nullified as usual signs (Article 2.28 (2) BCIP).

no bad faith

4.5. Scheffrahn et al.'s argument that the Foundation filed the word mark PINK RIBBON (number 792329) on 7 February 2006 in bad faith because Scheffrahn et al. was already using that trademark on the date of the filing cannot succeed. In this connection, Scheffrahn et al. merely points out the fact that as of 27 September 2004, Brandconcern was the holder of the domain name pinkribbon.be and that this domain was used to link to the website under the domain name pinkribbon.com. In view of what the Foundation contended in refutation, this mere fact is insufficient to assume bad faith. The Foundation has contended that it was not aware and did not have to be aware of this alleged domain name use and pointed out that it was already using the words PINK RIBBON as a trademark before Scheffrahn et al. allegedly began using the domain name pinkribbon.be. According to the Foundation, this previous prior use by the Foundation was far more intensive than the prior use alleged by Scheffrahn et al. and was also combined with the registration of a Benelux trademark in which the words PINK RIBBON is one of the dominant elements, namely the word/pictorial mark described in legal ground 2.4.1, nor has Scheffrahn et al. challenged the absence of knowledge on the part of the Foundation or the difference in the renown and legal protection of the signs already being used by the Foundation and Scheffrahn et al. as such; this supports the Foundation's argument that no bad faith is involved in this case in view of the requirements stipulated for this in the case law (ECJ 11 June 2009, C-529/07, *LJN BI8974, Goldhase*).

4.6. To the extent that Scheffrahn et al. also meant to refer to prior use by Estée Lauder and the *American Women's Club* in this connection (in counterclaim Scheffrahn et al. appears to limit itself to its own prior use), this cannot lead to any other opinion. In that case, the claim of bad faith already fails based on the requirement stipulated in Article 2.28 (3) BCIP that the third party referred to in Article 2.4 f BCIP in respect of whom the filing was made in bad faith is a party to the proceedings. Estée Lauder and the American Women's Club are not a party to these proceedings. Moreover, the Foundation contended –

unchallenged – that Estée Lauder and the *American Women's Club* explicitly agreed to the trademark filings by the Foundation.

other grounds for nullity

4.7. To the extent that Scheffrahn et al. also wanted to invoke the grounds for nullity of Article 2.28 (1) b (devoid of distinctive character) and c (descriptive signs) BCIP (in counterclaim Scheffrahn et al. appears to limit itself to the claim of customary names and bad faith), this cannot lead to a different opinion regarding the validity of the trademarks.

Scheffrahn et al. bases its claim of lack of any distinctive character in the sense of Article 2.28 (1) b BCIP on the same circumstances as its claim of the customary nature of the trademarks in the sense of Article 2.28 (1) d BCIP; therefore this claim must be dismissed on the same grounds. To substantiate its argument that the Foundation's trademarks can serve to indicate the nature or characteristics of the goods and services in the sense of Article 2.28 (1) c BCIP, Scheffrahn et al. merely contended that the PINK RIBBON sign is descriptive for pink ribbons. In and of itself, this is correct; however, it is irrelevant since the Foundation's trademarks have not been registered for pink ribbons.

conclusion

4.8. Based on the above, Scheffrahn et al.'s claims must be dismissed. As the party ruled against, Scheffrahn et al. will be ordered to pay the costs of the proceedings in counterclaim. It is not in dispute that the case in counterclaim must be designated as a case regarding the enforcement of intellectual property rights in the sense of Section 1019 Rv and thus that the legal costs must be estimated based on Section 1019h Rv. For this reason, the court will start from this.

4.9. The Foundation claims a total amount of EUR 27,560.00 in attorney's fees for the complete proceedings. The Foundation has not distinguished between the work in claim and in counterclaim. In view of the fact that the Foundation did contend – unchallenged – that half of the work regards the abuse of rights contended in claim, the District Court assumes that the other half of the total costs regards the dispute regarding the infringement and validity of the Foundation's trademark rights; those costs will be equally divided between the claim and the counterclaim. This means that the District Court assumes that the Foundation claims an amount of EUR 6,890.00 ($\frac{1}{2} \times \frac{1}{2} \times \text{EUR } 27,560.00$) in counterclaim. In view of this,

Scheffrahn et al.'s argument that the costs claimed by the Foundation are too high fails, since the costs are lower than the court-approved scale of costs used by the court, even if it would be assumed that the case in counterclaim is a simple action on the merits.

in claim

4.10. The District Court concurs with the Foundation that the activities that Scheffrahn et al. conducted for its global Pink Ribbon International organization infringe the Foundation's trademark rights. In and of itself, the incorporation of a global organization to fight breast cancer is a commendable initiative, but in so doing it is not permitted to ignore the rights of third parties, such as the trademark rights of the Foundation in the Benelux. As will be explained below, this is what Scheffrahn et al. did by (i) using signs in the Benelux that infringe the Foundation's trademarks and (ii) making unlawful filings that conflict with those trademarks.

trademark infringement

4.11. The Foundation takes the position that Brandconcern and Scheffrahn infringed its trademarks by (i) using a website under the domain name pinkribbon.be, (ii) *inter alia* using the Pink Ribbon International Logo on stationery, (iii) *inter alia* using the Pink Ribbon International Logo on the Dutch and Belgian versions of wikipedia and (iv) *inter alia* using the Pink Ribbon International Logo on hyves.nl. The fact that these practices must be designated as trademark use against which the Foundation can object based on its trademarks has not been challenged as such. Thus, the District Court will also start from this.

4.12. Scheffrahn et al.'s claim of the nullity of the Foundation's trademarks fails. In claim Scheffrahn et al. has also contended that the Foundation's trademarks are invalid based on Articles 2.28 (1) d (customary indication), (1) b (devoid of distinctive character) and (3) b (filing in bad faith). This argument must be dismissed on the same grounds as the grounds on which the counterclaims are dismissed. For the substantiation of this opinion, the District Court suffices by referring to the previous findings in counterclaim.

4.13. Nor can the defence that the infringements mentioned by the Foundation are not acts of Brandconcern or Scheffrahn but of the legal entity Pink Ribbon, Inc., which is not a party to these proceedings, succeed. After all, it is established that infringements (i), (ii) and (iii) in

any event also occurred before the incorporation of Pink Ribbon, Inc. on 23 June 2008. With regard to infringement (i), Scheffrahn et al. itself contends that Brandconcern has used pinkribbon.be as of the time the domain name was registered on 27 September 2004. With regard to infringement (ii) it is established that the letter with the Pink Ribbon International Logo signed by Scheffrahn that the Foundation referred to in this connection dates from 21 August 2007. Thus, this letter cannot have been sent by Pink Ribbon, Inc. either. In that letter, Scheffrahn also mentions act (iii), putting the articles on wikipedia. In light of this, it must be assumed that it has been insufficiently refuted that Brandconcern and Scheffrahn infringed themselves.

4.14. Based on the above, the claimed prohibition on trademark infringements by Scheffrahn and Brandconcern must be awarded. To the extent that the claim regards infringement “by means of a legal entity/natural person directly or indirectly affiliated with these parties”, the claim must be dismissed. At the personal appearance of the parties the Foundation explained that this refers to infringements by (*inter alia*) Pink Ribbon, Inc. However, this latter party is not a party to these proceedings. Nor has the Foundation contended that Scheffrahn or Brandconcern as managing director and de facto director can ensure that Pink Ribbon, Inc. infringes or does not infringe the Foundation’s trademarks. For its part, Scheffrahn et al. explicitly – and as such unchallenged – contended that it does *not* have a decisive vote in the board of Pink Ribbon, Inc. In view of this, the relevant part of the claim cannot be awarded.

conflicting filings

4.15. It must be assumed that also the filings made by Scheffrahn et al. for Pink Ribbon International conflict with the Foundation’s trademark rights. After all, Scheffrahn et al.’s filings rank after the filings of the Foundation. The counter arguments contended by Scheffrahn et al. in this connection, namely that the words PINK RIBBON and the image of a pink ribbon should be “free trademarks” and that Scheffrahn et al. is allegedly a prior user correspond to its argument already dismissed above that the Foundation’s trademarks are invalid due to the general customary nature of the signs or a filing in bad faith and therefore cannot succeed.

4.16. The mere fact that Scheffrahn et al.’s filings conflict with the Foundation’s trademark rights is insufficient to assume that those filings are unlawful in respect of the Foundation. In

this case unlawfulness is involved because Scheffrahn et al. knew or should have realized that at the least there was a serious chance that its filings would not survive opposition by the Foundation and Scheffrahn et al. made the Foundation's legitimate opposition to those filings unnecessarily costly due to the way in which it filed the trademarks and its conduct of the case.

knowledge

4.17. It is not in dispute that at the time of its filings, Scheffrahn et al. was aware of the Foundation's trademark registrations existing at that time and of the fact that based on those trademarks, the Foundation would object to its filings. At the personal appearance of the parties, when asked Scheffrahn et al. confirmed that it did realize that the Foundation might bring opposition against its filings.

4.18. It must be assumed that Scheffrahn et al. also realized that the Foundation's objections to its filings were valid. After all, Scheffrahn et al. claims that it is a specialist in the area of trademark filings. Thus, Scheffrahn et al. can be expected to realize that there was a considerable chance that its filings would not survive an opposition procedure or invalidity procedure initiated by the Foundation. That it realized this is confirmed by the fact that Scheffrahn et al. did not conduct a defence in most of the opposition procedures brought by the Foundation, but instead has withdrawn the filings. Moreover, the fact that Scheffrahn et al. realized that the filings were untenable appears from a presentation by Scheffrahn et al. to which the Foundation referred in this connection and which includes the following text:

PRIL [Pink Ribbon International; District Court] CTM as well as national trademark registrations could violate existing registrations. However, cases should be solved in mutual understanding and benefit (at arm's length).

hampering opposition

4.19. It must be assumed that, knowing that there was a serious chance that the filings for Pink Ribbon International could not be upheld after opposition by the Foundation, Scheffrahn et al. chose to make the Foundation's opposition against those filings unnecessarily costly. This can be qualified as abuse of authority.

4.20. In this connection, the District Court understands that it is not in dispute that the costs incurred by the Foundation in the scope of the opposition procedures have not been (fully) compensated by Scheffrahn et al. and, based on the opposition rules, do not have to be (fully) compensated, even though those procedures ended because Scheffrahn et al. withdrew the relevant filing or had it nullified. In view of the following circumstances, Scheffrahn et al. abused that fact.

4.21. First of all, many of the filings applied for by Scheffrahn et al. – and withdrawn after the Foundation had brought opposition – bear no relationship whatsoever to the interest allegedly served by those filings according to Scheffrahn et al.'s own arguments, namely the incorporation of a worldwide Pink Ribbon International organization. In this connection, the Foundation referred to filings for – *inter alia* – firearms, incubators and carcinogenic substances, such as asbestos and tobacco. Scheffrahn et al. has not explained what interest is served by those filings, while it is clear that the Foundation did have a legitimate interest in opposing those filings and was forced to incur costs to do so.

4.22. Secondly, many of the filings applied for by Scheffrahn et al. – and withdrawn or cancelled after the Foundation had brought opposition – regarded the same trademark. Around November of 2006, Scheffrahn et al. applied for four different Benelux filings for the same word mark. Moreover, in June of 2008 Scheffrahn et al. again applied for four Benelux filings for this same trademark. Scheffrahn et al. has not explained what interest was served with this filing method. It merely contended that the filings applied for in June of 2008 were cancelled. Even apart from the fact that the filings were cancelled because Scheffrahn et al. failed to pay the fees after the Foundation had summoned Scheffrahn et al. in summary injunction proceedings, this fact does not explain why those filings were applied for. On the contrary, the cancellation appears to emphasize that no interest to be respected in law was served by those filings, while it is clear that the manner of filing was harmful for the Foundation because as a result, it had to conduct many different opposition procedures and thus incur extra costs.

4.23. Thirdly, Scheffrahn et al. applied for part of the filings – which were withdrawn after the Foundation had brought opposition – in French. Scheffrahn et al. did not explain what interest is served by this language choice, while it is clear that Scheffrahn et al. knew that the Foundation had to incur additional translation costs in its opposition to those filings.

claims

4.24. The claimed prohibition on applying for filings is a far-reaching measure given the statutory authority to apply for filings. Under the circumstances, the District Court nevertheless feels that this prohibition is appropriate. In addition to the above opinion regarding the unlawfulness of the manner of filing to date, it is relevant that Scheffrahn et al. itself declared that all activities regarding Pink Ribbon International have been continued in Pink Ribbon, Inc. According to its statements, Scheffrahn et al. is no longer involved in Pink Ribbon International and it has not been contended or demonstrated that Scheffrahn et al. has any other interest in filing PINK RIBBON trademarks. In view of this, a prohibition on filing trademarks containing the word elements PINK and RIBBON is not too extensive a limitation of Scheffrahn et al.'s powers.

4.25. The filing prohibition referred to above cannot be awarded in respect of any legal entities/natural persons other than Scheffrahn et al., since they are not a party to these proceedings and Scheffrahn et al. does not control such legal entities/natural persons (cf. legal ground 4.14).

4.26. The claimed penalty – which has not been refuted as such – will be attached to the prohibition.

4.27. The Foundation's claim for a declaratory judgment regarding the filing manner will be declared inadmissible. Without any explanation – which is absent – the District Court fails to see what interest the Foundation has in that declaratory judgment in addition to the prohibition to be awarded.

4.28. The order to withdraw the Community trademark applications with numbers 6139539 and 6140479 must be dismissed. It is established that at present Scheffrahn et al. is no longer the holder of those applications. Thus, Scheffrahn et al. cannot withdraw the applications itself. Nor can Scheffrahn et al. force the current holder, Pink Ribbon, Inc., to withdraw those applications because it has been established unchallenged that Scheffrahn et al. has no decisive vote in Pink Ribbon, Inc. The fact that Scheffrahn et al. transferred the filings to Pink Ribbon, Inc. pending these proceedings cannot lead to a different opinion. An order to fulfil an obligation must fail based on the fact that it is not possible to fulfil that obligation at the time the order is given, even if the debtor has put himself in the position in

which he is unable to fulfil the obligation (HR 21 May 1976, *NJ* 1977, 73). Now that the Foundation did not replace its claim by an order that can be complied with, the claim must be dismissed.

4.29. The order to co-operate in the suspension of the other opposition procedures pending before the OHIM must be dismissed for the same reason. Again, Scheffrahn et al. is unable to comply with the order because Scheffrahn et al. is no longer the holder of the relevant applications and does not fully control the current holder.

4.30. As the party primarily ruled against, Scheffrahn et al. will be ordered to pay the legal costs. In this regard, a distinction must be made between the part of the proceedings that relates to the infringements of the Foundation's trademark rights and the part that relates to the manner of filing. The rules of Section 1019h Rv apply to the part first mentioned. This does not apply for the part last mentioned. Scheffrahn et al. rightfully contended that those claims are not based on an intellectual property right, but on the abuse of authority doctrine. Thus, the legal costs of the part last mentioned must be estimated in accordance with the court-approved scale of costs.

4.31. The District Court has already ruled above that half of the total attorney fees claimed by the Foundation must be allocated to the part of the proceedings that involve the filing method and that the remaining part of the costs must be equally divided between the proceedings in claim and those in counterclaim (see legal ground 4.9). This means that the Foundation can claim an amount of EUR 6,890.00 ($\frac{1}{2} \times \frac{1}{2}$ EUR 27,560.00) for the part of the proceedings in claim that relates to the infringements; for the rest the Foundation can claim an amount of EUR 384.00 ($\frac{1}{2} \times$ EUR 384.00 x 2.0 points), plus EUR 262.00 for court fees and EUR 171.96 for the bailiff's costs.

5. The decision

The District Court

in claim

5.1. orders Scheffrahn et al. to refrain from applying for any Benelux or Community trademark filing containing the words “PINK RIBBON” or another combination of the words “PINK” and “RIBBON” with immediate effect after this judgment is served;

5.2. orders the defendant that acts in breach of the order mentioned under 5.1 to pay the Foundation a penalty of EUR 10,000.00 for every day (in which part of a day is counted as a whole day) or – at the sole discretion of the Foundation – every time this defendant acts in breach of that order or any part thereof;

5.3. prohibits Brandconcern and Scheffrahn from infringing the Foundation’s trademark rights mentioned in the writ of summons and orders them more specifically to discontinue and not resume every use in the Benelux of signs containing the words “PINK RIBBON” or another combination of the words “PINK” and “RIBBON” with immediate effect after this judgment is served;

5.4. orders the defendant that acts in breach of the prohibition mentioned under 5.3 to pay the Foundation a penalty of EUR 2,000.00 for every day (in which part of a day is counted as a whole day) or – at the sole discretion of the Foundation – every time this defendant acts in breach of that order or any part thereof;

5.5. orders Scheffrahn et al. to pay the legal costs, to date on the part of the Foundation estimated at EUR 7,707.96;

5.6. declares this judgment in claim provisionally enforceable to this extent;

5.7. declares the Foundation’s claim to render a declaratory judgment inadmissible;

5.8. dismisses all other or ancillary claims;

in counterclaim

5.9. dismisses the claims;

5.10. orders Scheffrahn et al. to pay the legal costs, to date on the part of the Foundation estimated at EUR 6,890.00.

This judgment was rendered by P.H. Blok and declared in public on 20 April 2011.