

24 Sep 2020 'Sea of reptiles' found to infringe Lacoste's crocodile mark

Netherlands - [Hoogenraad & Haak, Advertising + IP Advocaten](#)

- The case involved two children's underwear shirts, which were sold by HEMA together as a set and displayed either a single or several crocodiles
- The Court of Appeal of The Hague, contrary to the preliminary injunction judge, found that there was a substantial likelihood of confusion
- The market surveys submitted by Lacoste presumably contributed to its success in this case

On 11 August 2020 the Court of Appeal of The Hague [ruled](#) that HEMA's grey and blue children's underwear shirts (sold together as a set), which displayed either a single or several crocodiles, both infringed Lacoste's EU and Benelux figurative trademarks consisting of a crocodile. The ruling may have come as a surprise to HEMA, as the preliminary injunction judge had decided at first instance that neither of the shirts was infringing.



Background

At first instance, the preliminary injunction judge [ruled](#) that the use of reptiles on the grey set (shirt and underwear) - viewed by the relevant public as a 'sea of reptiles' - could not be considered as use of a trademark due to their decorative nature. The blue shirt, which bore the image of a single crocodile, did not violate Lacoste's trademark either. Even though the image was not purely decorative and the sign was reasonably similar to Lacoste's trademark from a visual and conceptual point of view, there was no likelihood of confusion because, among other things, the blue shirt was sold in a set with the non-infringing grey shirt. There was also no chance of post-sale confusion given that the shirt is not visible from the outside (as it is worn as underwear). This meant that the public would not be confronted with the design.

Decision of the Court of Appeal of The Hague

On appeal, Lacoste provided the court with three market surveys to support the claim that:

- the relevant public would not view the crocodiles used by HEMA as purely decorative but, instead, would consider such use as trademark use; and
- the grey and blue underwear sold by HEMA would cause confusion with Lacoste's figurative trademark.

The court paid great attention to the formulation of the questions and the conclusions drawn in the surveys. Given the court's U-turn compared to the ruling of the preliminary injunction judge, the market surveys presumably contributed to the favourable outcome for Lacoste in this case.

The blue shirt showed a high degree of visual and conceptual similarity to Lacoste's trademark. Both the image on the blue shirt and the trademark consisted of a single (stylised) crocodile in an active position, depicted from the same side view with an open jaw revealing the teeth of the crocodile. The more childlike appearance of the HEMA crocodile did not detract from the likelihood of confusion. The results from Lacoste's market surveys supported this conclusion.

The grey set consisted of six different types of crocodiles placed on the front and back of the garment. Lacoste argued that the public was used to this so-called "repetitive trademark use". The court followed Lacoste's argumentation and did not deem it likely that the public would perceive the 'sea of crocodiles' as being purely decorative - even more so as Lacoste's trademark has a reputation. The likelihood of confusion was based on the conclusion that two of the six crocodiles were highly similar to Lacoste's figurative trademark, while the other crocodiles were considered

to be somewhat similar visually, and highly similar conceptually. Based on the market survey that showed that the public consisting of parents (and grand-parents) and the general public presumed that the grey set was by Lacoste, the court concluded that there was a substantial likelihood of confusion.

The ruling of the preliminary injunction judge was thus annulled, and HEMA was issued with an EU-wide injunction preventing it from selling the underwear set at issue.

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