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TDK: the famous trademark after Intel

The owner of a famous trademark would also like to be able to prevent a *look-alike* being used for other types of goods or services. Since the *Intel* ruling of December 2008 by the Court of Justice (ECJ) this mark owner must provide double evidence: the economic behaviour of the average consumer of his products must have changed or be very likely to change in the future, and the change must be a consequence of the look-alike use. This evidence is certainly not easy to provide.



This rule of evidence seems to have been somewhat toned down by the ECJ in the *TDK* ruling of 12 December 2008. It need not be clearly proven that the free-rider shall take unfair advantage in the future, that the distinctive character or the repute of the famous trademark is affected. According to the ECJ the mark holder must only make it plausible that there is a *risk, which is not hypothetical* of such advantage or detriment to the mark. A 'risk, which is not hypothetical'

appears to be more prevalent than a 'serious risk' as mentioned in *Intel*.

With this subtle distinction holders of famous trademarks seem to have a good position after all. In practice however it shall have to be come apparent whether *Intel* really has been toned down.

Maarten Haak

ELLE for clothes shops: No infringement of famous mark WE

WE is a famous mark in the Benelux. To keep the mark exclusive the WE clothing group consistently acts against the use of marks along the lines of *I-you-he-we-they*, also outside of the clothing industry. For instance a few years ago the new broadcaster 'ME' was forced to hastily rename itself YORIN.

WE's action focused attitude is infamous in the fashion world. For that reason many stay far away from personal pronouns. But the publisher of fashion magazine ELLE set up a franchise chain for clothes under the name ELLE. WE thought that it could prohibit this because WE used to trade under HIJ (*HE*), ZIJ (*SHE*) and YOU. According to WE, ELLE is just another variant of 'she' which fits directly into its chic series. Moreover ELLE was supposedly taking advantage of the reputation of the WE mark. Hence an ELLE clothes shop was also infringing WE's mark and tradename rights.



On 27 January the Amsterdam Court of Appeal ruled that the ELLE franchise chain could continue. Maybe the public does see ELLE as a translation of 'she', but that is not enough for a risk of confusion, certainly not since ELLE is a famous mark. ELLE is associated in the first place with the fashion magazine and not with the WE company or its older trade names HIJ, ZIJ and YOU. WE could also not prove that ELLE was taking unfair advantage of the famous WE mark. WE does not have a monopoly on personal pronouns to distinguish clothes shops.

But in March WE got what it wanted anyway: the ELLE fashion chain was declared insolvent due to the recession.

Maarten Haak

Vodka in a bison fleece: complaints about alcohol advertisement

Can a bottle of Grasovka vodka be packed in a bison fleece? The Alcohol Prevention Foundation (STAP) did not think so. The argument: because of the fleece you cannot see that it is alcohol. And moreover because of 'the cuddly toy image and the high strokability factor' a bottle like this in a bison fleece could be attractive to minors.



This is about the interpretation of the new, tightened article 10 of the Advertising Standards for Alcoholic Drinks (RvA): advertising may not be specifically targeted towards minors. The article provides a summary of prohibited items in alcohol commercials, such as soft toys. The Advertising Standards Committee decided that this packaging could not be seen as a soft toy. The fact that the packaging may also be attractive to minors does not change that. The word vodka can be clearly

seen on the bottle, even with the fleece around it. Since anyone knows that vodka is strong drink, this complaint was dismissed.

The man-woman relationship is often a topic in advertising, also in alcohol advertisements. The alcohol industry has therefore made a mutual agreement. No causal link may be made in alcohol advertisements between drinking alcohol and sexual or social success, including the *suggestion* of drinking alcohol. This is an excellent agreement. However the wording of this rule was not entirely clear. Literal interpretation of article 8 RvA could give the impression that any image of a man/woman is prohibited. Obviously that was never intended. Fortunately the Advertising Standards Committee has taken a clear point of view: it is prohibited to give the impression that there is a causal connection between drinking alcohol and sexual or social success. STAP has also acquiesced in this vision.

The Advertising Standards Committee also gave green light for the Amstel action where the winner will be attending a European football classic as a VIP. In the Amstellovitch TV commercial the main character was surrounded by beautiful women. This also complies fully with the alcohol advertising rules.

Ebba Hoogenraad and Maud van der Leeuw counsel a number of manufacturers and importers of alcoholic drinks.

'Life without arthritis': advertising or information?

Sometimes the key question is whether a text is 'advertising' or 'information'; Advertising is subject to strict rules, whereas information may be freely distributed. This is often the case with medicines and also for health products.

Advertorial

"Een Leven zonder gewrichtsontsteking"

Professor Vicente Micol:

Nieuw voedingsupplement met MPC4 effectief bij reuma, gewrichtsslijtage en RSI

Nieuwe behandeling van gewrichtspijn beschikbaar

Opzienbarend onderzoek

Een van de onderzoeken die professor Micol deed naar de werking van MPC4 in combinatie met omega-3 vetzuren, betrof een groep van 24 patiënten met gewrichtsklachten. De patiënten waren tijdens het onderzoek naar de effectiviteit van MPC4 niet onder behandeling en kregen geen andere medicatie.

planen van MPC4 en omega-3 vetzuren. Geen van beide groepen wist wat ze kregen. Iedere week werd getoetst of de klachten waren afgenomen dan niet toegevoerd in vergelijking met de meting die aan het begin werd gedaan. Al snel tijdens het onderzoek bleek dat de klachten bij de groep die MPC4 (omega-3) kreeg toegenamen of de toegenamen. In de andere groep bleef het klachtenniveau onveranderd of nam het zelfs licht toe. Na vier weken bleek dat de klachten bij patiënten die het supplement met MPC4 (omega-

De Telegraaf ran the advertisement 'living without arthritis', which looked like information. A Spanish doctor spoke about favourable results with a nutritional supplement for rheumatic pain containing the active ingredient MPC4. The text contained all kinds of references to diseases (medical claims). This is allowed for normal information but not for advertising for nutritional supplements. The Dutch Rheumatism Fund submitted a complaint to the Advertising Standards Committee.

The facts: MPC4 cannot be bought separately on the Dutch market. Only one product on the Dutch market contains the active ingredient MPC4. A Google search for the word 'MPC4' brings one directly to the name of the product, Cartixan. For this reason the Advertising Standards Committee considered the advertorial for MPC4 to be an advertisement for Cartixan. This meant curtains for this advertisement.

The advertiser PK Benelux had no scientific reports to substantiate the claims. Therefore this applies as a dishonest trade practice on the black list of the Dishonest Trade Practices Act: dishonestly alleging that a product can cure illnesses, defects or disfigurements is *always* prohibited. PK Benelux did not appeal. Due to the seriousness of the offence and the range of the advertisement, the Advertising Standards Committee published the decision in the press. >>>

The decision does not answer the question of how the phrase from the statutory black list 'dishonestly' alleging that a product can cure illness' must be interpreted. Is 'dishonestly' alleging a stricter requirement than 'merely' misleading? Does there have to be a case of an intentionally incorrect statement and is it only dishonest if the advertiser knows very well that he is wrong? Or does any misleading text on curing a disease automatically fall under this black list irrespective of how minor the deception is? Who can say! You will most certainly hear more from us on this.

Ebba Hoogenraad

How much of the environment? Art in public spaces

Sculptures and buildings in public spaces may sometimes be depicted without the consent of the copyright holders. That freedom is not infinite however, as apparent from a ruling from the Arnhem Court of Appeal. Free local paper *Typisch Enschede* had used a sculpture by artist Guusje Beverdam in its permanent lay out.



This was a stone yellow bench called 'Bench (1996)' which Beverdam had made in assignment of Rabobank. The sculpture is next to the town hall of Enschede. *Typisch Enschede* had used it in a collage with a few objects that are characteristic of the city of Enschede. Stichting Beeldrecht, a foundation defending visual artists' rights, successfully acted on behalf of the artist. The Court of Appeal ruled that *Typisch Enschede* had infringed Beverdam's copyright. The court ruled that the bench in the collage had been used in isolation and that the environment where the bench is situated had not been depicted. Therefore *Typisch Enschede* could not appeal to the legal exception for art in public areas. Also the fact that the bench formed part of a collage along with typical buildings, works of art and other items distinctive for Enschede did not change that. >>>



This ruling seems a correct application of Section 18 of the Copyright Act, which contains the 'public spaces exception': sculptures and buildings on the street may be depicted if shown *in the context of their environment*. In this case the environment of the artwork was not shown. But it is difficult to draw a line. There have not been many court cases on this.



In 2008 there was a case on a photo of the *Leguaan flats* (Iguana Flats) in an ad of Friesland Bank for mortgages. These flats were sufficiently visible from the public space, which was also shown on the photo. The Court of Leeuwarden ruled that pursuant to Section 18 Copyright Act the copyright had not been infringed. This billboard showed enough of the environment.

In general a photo of a building or a work of art in public space can be used without problems if the environment is shown properly. In any case cutting out and photoshopping are not allowed. Whoever meets this guideline is covered by the text of the Copyright Act.

Incidentally the 'Iguana' case did have an extraordinary aftermath. The court did rule that Friesland Bank had not violated copyrights. But it had not clearly stated on this advertisement *what the idea was behind the flats*. To be precise: "*the inherent concept of these flats is bio-ecological awareness*". The only awareness that Friesland Bank wanted to obtain with this campaign would be financial advantage. This meant the concept had been violated and that would be unlawful.

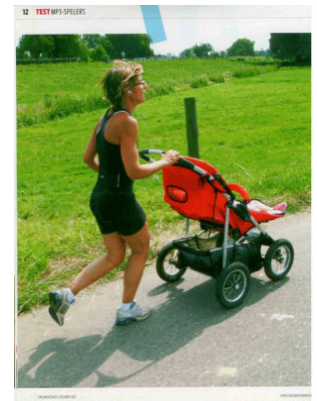
This decision is remarkable. It is generally accepted that in principle creative concepts and ideas are not protected. Only their concrete elaboration can be protected by copyright and then only if sufficiently elaborated. The Court seems now to be protecting concepts via unlawfulness (tort). The question arises whether this decision would have survived an appeal. Unfortunately both parties decided to drop the matter. For the time being advertisers are advised in the interests of certainty, besides copyright to also take any underlying 'concept' of a building or image in the public space into account.

Maud van der Leeuw

No infringement portrait right jogging mother

Should *Hollandse Hoogte* remove the stock photo of a jogging mother from its photo database? According to the Amsterdam Court of Appeal it does not infringe her portrait right. *Hollandse Hoogte*'s interest in provision of information is greater than the woman's privacy interest. According to the Court of Appeal such an innocent photo of a coincidental passer by is permissible as editorial illustrational material.

Hollandse Hoogte had included this photo of a jogging mother wearing headphones pushing a pushchair in its database. The Consumers' Association obtained a licence for the photo from *Hollandse Hoogte* and printed it full-page in the Consumer Guide next to an article on mp3 players. The running mother was unpleasantly surprised. She demanded that the photo be removed from the database immediately.



For commercial use, in principle, the person portrayed always has a 'reasonable interest' to object to publication. In this case the Court of Appeal did not deem the inclusion of the portrait in a photo database as 'commercial'. *Hollandse Hoogte* offers the photo on its website for editorial purposes. It is not using the photo to recommend a product or service. The Court of Appeal considers this to be editorial use of the portrait, so the privacy interest must be weighed up against the interest of freedom of information. The Court of Appeal deemed *Hollandse Hoogte*'s interest for provision of information as greater than the woman's privacy interest.

According to the Court of Appeal, reporting may be accompanied by illustrational material, such as real photos. Photos of "coincidental passers by" such as this "innocent" and "not harmful" one for the running woman are unavoidable. Her privacy was not infringed in such a way that the right to publish the photo had to give way. In an additional consideration the Court of Appeal remarks that printing the photo in the Consumer Guide does not infringe the woman's privacy, even if the Consumers' Association was not a party to this case.

The jogging mother got what she wanted though: *Hollandse Hoogte* removed the photo from the database in view of the woman's personal arguments.

Kim Braber

Gaspedaal.nl: a ban on dedicated search engines?

A dedicated search engine can infringe the database rights of the websites it searches. A search engine can make a targeted search of online databases. The party entitled to the database may prohibit this use according to a ruling of 11 February 2009 by the Court of The Hague.



This case was about the collective site Gaspedaal.nl. It shows one overview of advertisements from a few second hand car sites, always with a deep link to the source advertisement. The website (and database) Autotrack.nl is also searched. Each time that a certain type, colour, construction year and such like is searched via Gaspedaal.nl the dedicated meta search engine of

Gaspedaal.nl searches the selected sites. *"The cumulative effect of the large number of searches performed via Gaspedaal.nl is that a substantial part of the Wegener database is made available to the public"* says the Court. Gaspedaal.nl must cease this use or request consent from database owner Wegener (read: pay).

The ruling is an important win for database owners. The substantial investments in their databases can only be earned back if the site attracts enough visitors. Anyone searching with a targeted search engine is surfing on the search engine's website. This means the extra advertising income accrues to the search engine. Wegener only earns extra income if an advertisement on Autotrack is clicked through to.

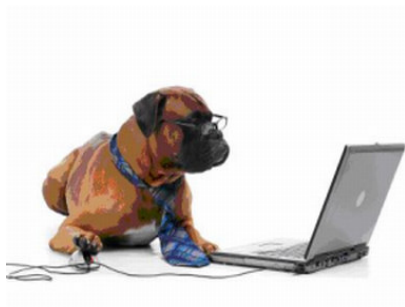
Database owners will be pleased with this judgment. Sites which provide an easy overview (such as jaap.nl or zoekallehuizen.nl for instance) cannot licitiously latch onto the endeavours (investments) of initiators such as Wegener. But it remains to be seen whether this ruling shall be taken over in other proceedings between entitled parties and search engines. If this trend proceeds, this could also apply to Google and other search engines. The internet would be seriously hindered. Will a search even be possible?

Maarten Haak

'Tell-a-friend' allowed after all

Tell-a-friend systems are allowed under certain conditions. The Dutch Independent Regulator of Post and Electronic Communications (OPTA) and the Data Protection Board (CBP) announced this at the end of last year.

In a tell-a-friend system a website sends an e-mail on the initiative of a user without the recipient's prior consent. This actually falls under the prohibition of sending unsolicited e-mails (spam). The OPTA and CBP have set clear conditions for 'tell-a-friend'.



On paper the possibilities for tell a friend systems have been expanded. But there is a troublesome limitation for organisers of promotional games of chance: there may not be any opportunity for reward for sending the e-mails to friends. Allowing participants to take part in a prize draw by passing on the e-mail addresses of a few friends is still not allowed.

The OPTA and CBP allow 'tell-a-friend' under the following conditions:

- Communication takes place at the internet user (or sender)'s own initiative. There may not be any opportunity of a reward for the sender.
- It must be clear to the recipient who sent the e-mail so that he can indicate if he does not want to receive such mails.
- The sender can see the entire text of the message. This means he can also take responsibility for the personal content of the message.
- The e-mail addresses and other personal data will not be used or kept for any other objective than **one-off sending** of a message by the sender. The system must also be protected again abuse, such as automated sending of spam.

Kim Braber

Unsolicited text messages? Complain, complain, complain!

We've all been through it at some time: you receive SMS ringtones, weather reports, recipes or other news by text message that you read and sometimes use. The monthly bill from the mobile provider shows that they were not free at all, on the contrary!

Often these foreign organisations send unsolicited text messages to countless consumers based on a subscription which was never taken out. Can anything be done about it? Yes, certainly.

The *Code of Conduct Provision of SMS Services* now provides good guarantees. As soon as a consumer lodges a complaint because unsolicited SMS costs have been debited from his bank account, the SMS service provider must prove within three days that a valid subscription was taken out. If that evidence is lacking (or is submitted too late) then it will be assumed that a subscription was never taken out. The provider must reimburse the consumer with the SMS costs.

The provider can recover these costs from the SMS service provider. A special Complaints Board deals with complaints from providers against SMS service providers who cross the line.

The first case attracted a lot of publicity. Vodafone and T-Mobile tackled Netsize. The result: Netsize had to reimburse all duped customers. They had to place advertisements in a nationwide daily paper to refer the consumer to the possibility of claiming damages. This ruling is a clear warning to not send unsolicited paid SMS messages. The financial consequences and negative publicity are huge.

And the consumer? He only needs to do two things: check the phone bill and if unsolicited SMS messages (even if they were fun) have been automatically charged, **file a complaint** with his provider immediately. This will set everything in motion. This time therefore, complaining is the motto.

Ebba Hoogenraad



Healthy roots: medical claim for foodstuffs?

In 2005 *Gezond Nu* ('Healthy Now') published an article 'Back to the roots' about roots full of healing power. The article discussed the medicinal working of a number of natural products: valerian (relaxing), asparagus (diuretic) and curcuma (anti-inflammatory). For each root examples were given of brand names for various nutritional supplements and foods, which contain these natural products.



The Food and Consumer Product Safety Authority (CPSA) fined the publisher of the magazine €680 for making prohibited medical claims about foodstuffs (in violation of Section 20 of the Commodities Act). The publisher objected. After lengthy proceedings the District Court of Rotterdam answered a number of fundamental questions in its ruling of 5 March 2009:

- Are publishers liable for making medical claims for foodstuffs? The Court's answer: Yes.
- Does freedom of opinion exceed the prohibition on medical claims? No. According to the Court the prohibition carries more weight.
- Is there a clear difference between a prohibited medical claim (referring to curing a disease) and an admissible health claim (an allegation on the favourable effect with regard to maintaining good health)? The Court believes there is.

However, the Court has reversed the fine decision because the CPSA only acts against medical claims in magazines if a concrete brand product is referred to.

All magazines and books referring to the health effects of plants and herbs without mentioning a brand name are left alone. The Court sees a kind of arbitrariness in the fine imposed on *Gezond Nu*, which violates the rules of sound administrative law.

There is no other option but that in time this ruling will have to lead to a policy change at the CPSA.

Ebba Hoogenraad



Hoogenraad & Haak, advertising + IP advocaten is an independent boutique law firm in the Netherlands. We are specialists in advertising, intellectual property and product information (labelling, ingredients). We are creative litigators and advisors, who think along, with legal profundity and with human understanding. Allow us to present a creative solution at an early stage (*how can it be done?*).

This news letter contains general information and does not provide a full review of the topics covered. If you have any questions on a particular subject, we recommend that you seek specific legal advice. © Hoogenraad & Haak, advertising + IP advocaten

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