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### Hoogenraad & Haak: Advertising Law Firm of the Year 2010

International magazine Corporate INTL has named us Advertising Law Firm of the Year 201 in the Netherlands. This award is given annually as part of the *International Legal Awards for Practice Excellence* and will be announced soon by Corporate INTL. The prize confirms our leading position as advisor to the advertising sector and advertisers. Last year based on peer review Best Lawyers also chose us as top listed firm for advertising law in the Netherlands.



We would like to thank our clients for continuing to bombard us with challenging questions at the interface of advertising law, intellectual property and product information. Clients for whom we can quickly find a solution as well as those who want to go to extremes. This combination is what makes our work fun. Thank you!

## Tempur – another person's brand as AdWord

Market leader Tempur sells pillows and mattresses containing the rather mysterious "memory foam". Energy+ and Medicomfort (two competitors of Tempur) buy "tempur" as AdWord. Any Internet user entering "tempur" in a search engine will see the "sponsored links" adverts by Energy+ and Medicomfort. The Tempur mark is not used in the adverts. Energy+ does not even mention its own name in the advert although Medicomfort does.



tempur Zoeken

Ongeveer 8.480.000 resultaten (0,06 seconden) [Geavanceerd zoeken](#)

**TEMPUR Matrassen**  
 Vraag nu het informatiepakket aan en ontdek zelf de TEMPUR matras!  
[www.Tempur.nl/Tempur](http://www.Tempur.nl/Tempur)

- ▶ Homepage
- ▶ Informatiepakket
- ▶ Speciale najaarsactie
- ▶ Hoofdkussens

[Toe aan een Nieuw Matras?](#)  
 Bestel Medicomfort Matras. Tot 40% Goedkoper dan de andere Topmerken!  
[MedicomfortMatras.nl](http://MedicomfortMatras.nl)

Advertenties

[Drukverlagend topmatras](#)  
 Doorslapen tot de ochtend. Mogelijk met drukverlagend kwaliteits matras  
[www.Energy-Plus.info/Matras](http://www.Energy-Plus.info/Matras)

[Medisch traagschuimmatras](#)  
 De hele nacht doorslapen? Dat kan. Medi-Active drukverlagend matras  
[www.Medi-Active.nl/Matrassen](http://www.Medi-Active.nl/Matrassen)

Tempur views this AdWord use of the Tempur mark as trademark infringement. The District Court of The Hague deems the use of a third party brand as AdWord as a form of comparative advertising, to our best knowledge the first time in Dutch case law. This is significant: if the rules for permitted comparative advertising are followed properly there is no trademark infringement.

Energy+ does not clearly distinguish between its own products and those of Tempur in its advert. In that case, the Court assumes a goodwill transfer. This



vagueness gives Energy+ an unfair advantage which is not allowed according to the comparative advertising rules. Therefore, Energy+ is infringing on Tempur's trademark right. The Court's considerations have given rise to discussion: it seems more logical if a risk of confusion had been assumed,

and for *that* reason an infringement. In another case Medicomfort escaped unhurt because it *is* clear in its advertisement. This means there is no goodwill transfer and therefore no unfair advantage. And no risk of confusion.

In the Medicomfort case an appeal has been lodged. We will keep you informed.

*Daniël Haije. The combined commentary by Professor Charles Gielen, Ebba Hoogenraad and Daniël Haije on these rulings will appear in the next issue of IER.*

### Darfurnica: ex parte prohibition on artwork?

The protection pursuant to design law can be far-reaching, as apparent from a decision of the District Court of The Hague on the work of art *Darfurnica* by the Danish artist Nadia Plesner – freely adapted from Picasso's work *Guernica*.



Plesner condemns the fact that celebrities and their expensive things are given full attention whereas humanitarian disasters such as those in Darfur only make the margin of the newspaper. In the middle, she has painted an African child with a Louis Vuitton lookalike bag. Recently, the image of the child, with the bag, was



used as a billboard for an exhibition of works by Plesner (left). However, Louis Vuitton has a registered design right to the design of the bag (right). Initially design law was mainly intended to prevent counterfeit designs. The current Community Design has a very wide scope of protection; there is no parody exception as in copyright. Vuitton thinks that the child should have had a diamond ring or a shiny car instead of a Vuitton bag. Vuitton has nothing to do with Darfur. The mark claimed and obtained an *ex parte* infringement ban for the design. Previously a ban had also been given in France for the child-with-bag on T-shirts.

The Court did not take a position on whether freedom of expression (Article 10 ECHR) is a valid reason for use of the design. Such a reason would not be plausible for advertising and merchandising own work, the court holds. It is not clear whether the court views the actual work as infringement. I believe that the billboards and not the actual painting are concerned but the ban is much wider. In addition, for this reason the ruling has caused quite a stir: an artist is being silenced! Plesner will appeal the ruling.



*Maarten Haak*

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### Domain name with link: not a trade name but still unlawful!

Since 1999 Thuisbezorgd.nl has been using the domain name [Thuisbezorgd.nl](https://www.thuisbezorgd.nl) (meaning: "delivered at home") for a group site where you can order food from local restaurants. Competitor Just-Eat used domain names which also ended with 'thuisbezorgd.nl', such as [amsterdam-thuisbezorgd.nl](https://www.amsterdam-thuisbezorgd.nl) and [sushi-thuisbezorgd.nl](https://www.sushi-thuisbezorgd.nl). Just-Eat is no longer allowed to do this. Just like the District Court, the Amsterdam Court of Appeal has ruled that Just-Eat has acted unlawfully.

The Just-Eat domain names link to [Just-eat.nl](https://www.just-eat.nl). According to the Court of Appeal, this linking is not trade name use and hence does not infringe on the trade name rights of Thuisbezorgd.nl. The fact that Just-Eat's logo dominates on the websites was taken into account and this is why the Court of Appeal does not think that Just-Eat is "participating in commerce" under these domain names. The public will also not see the domain names as an indication of Just-Eat's business.

Unfortunately for Just-Eat this is not the end of the matter. The Court of Appeal does think it is plausible that the public will be confused about the identity of the provider of the online service. The public might think that it concerns part of Thuisbezorgd.nl that is focused on a city or a certain menu choice. The Court of Appeal holds that Just-Eat is latching on to the success and public profile of Thuisbezorgd.nl and that exceeds the limits of fair competition.

According to Just-Eat, [thuisbezorgd.nl](https://www.thuisbezorgd.nl) is the generic way to describe its services and should also be available for it. This defence was unsuccessful: the Court of Appeal thinks it is more important that confusion is prevented. The Court of Appeal finds that the domain names constitute an actual threat to commercial functions of the trade name Thuisbezorgd.nl and must be transferred.

Caution must still be employed when using domain names similar to another company's trade name to link to the company page. Even though it is frequently ruled that there is no case of trade name use it may still be unlawful.

*Kim Braber*



### Figurative mark BEST BUY: no distinctive character

A mark can only be a mark if it has some *distinctive character*. This seems to be a somewhat elastic concept. Often a descriptive word is registered as a mark if a (to some extent distinctive) figurative element is added to it. [The Court of Justice](#)



[\(ECJ\)](#) ruled on the lower limit in January 2011 (linked judgment in German). The figurative Mark BEST BUY has no distinctive character and therefore was rightly refused as a Community Trademark. The words BEST BUY are a general English description of the relation between the

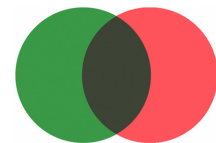
price of a product or service and its market value. The graphics are too simple to give the mark any distinctive character. BEST BUY has long been referred to by OHIM as an example of indistinctness. This example has now finally been confirmed by the highest court.

*Eva den Ouden*

### Quick handling of RCC complaints with chairperson's decision

A quick decision is important says the Advertising Code Committee. For that reason the "chairperson's decision" will be used more frequently. After receiving the response from the advertiser the chairperson of the Advertising Code Committee can decide directly to give an "unus iudex" decision. The advertiser can appeal the decision within 14 days; in that case the complaint will be dealt with by the full Advertising Code Committee (again). The complainant who is found against by the chairperson will have to pay a small amount. This is refunded if the complaint is allowed. The first decisions of 2011 clearly show that the chairperson is giving Chairperson's Decisions more frequently than previously, even in situations which go further than "order of the day" complaints. We will keep you informed of developments.

*Ebba Hoogenraad*



**STICHTING  
RECLAME CODE**

### AH Lowest price guarantee, nowhere cheaper: misleading omission

Sometimes sharp price reductions are just too sharp. The largest Dutch supermarket Albert Heijn jubilantly communicated the *Lowest Action Price Guarantee* (LAPG): the recognisable red purse in advertisements indicates that this offer for an A brand is cheapest at Albert Heijn. And if you do find it cheaper elsewhere you will get your money back. That sounds great for your wallet but when push comes to shove there appear to be many restrictions attached to this price guarantee: only offers from other supermarkets near the Albert Heijn branch count. Department stores and toyshops are excluded. Anyone finding the same product cheaper elsewhere but in a different flavour or fragrance does not get their money back. The Bonus Leaflet says that “*none of these A brand offers are cheaper anywhere else*” but the price guarantee still only applies to some of the products. The Advertising Code Committee thinks that this is misleading. Essential restrictions have been left out. “Nowhere cheaper” is too absolute. The comparative advertising cannot be permitted. AH must make the purse text less ambiguous.



### ... and sponsored magazine *Allerhande* is acknowledged as advertising

However, in another important case Albert Heijn was found for: texts in the sponsored magazine *Allerhande* are easily recognisable as advertising according to the Advertising Code Committee. The various columns about products do not have



to display the word “advertisement” or “advertorial”. The public understands full well that Albert Heijn wishes to bring its selection to their attention. This was decided in a complaint about a text in *Allerhande* where three people over 60 are tasting port. The complainant also had the remarkable objection that the three connoisseurs are elderly and therefore should not be the subject of alcohol

advertising. Fortunately for all elderly connoisseurs that part of the complaint was obviously dismissed.

*Ebba Hoogenraad*

## Use of marks in domain names: a practical arrangement for disputes

A domain name is easily applied for even if it uses someone else's mark. Often the entitled party can do something about this: there is a fast track procedure for disputes for most *top-level domains* (.nl, .com, .eu, .org, .net). For those who are not familiar with the so-called UDRP rules, an outline is given.

After written explanation from the complainant and the domain name holder an independent panelist will decide who gets the domain name, often within two months. The complainant only has to make it plausible that:

- The domain name is *confusingly similar* to an older right (trademark, trade name). This requirement is usually met if the mark appears in the domain name. For example <herbalifebestellen.nl> and <herbalife-discount.nl> because they include the mark HERBALIFE.

### HERBALIFE®

- The holder has no *right or legitimate interest* in the domain name. Anyone trading in online brand products may well have a legitimate interest but then they may not sell any other products from different brands via the same domain name. Using this argument Herbalife was able to obtain the domain names <herbalife-bestellen.nl> and <herbalife-discount.nl>. A legitimate interest for linking to commercial sites of competitors of the trademark owner is also absent. For that reason the domain names <anwb-auto.nl>, <anwb-camping.nl> and <anwb-kampioen.nl> were transferred to the ANWB in January 2011.
- Finally, the claimant must demonstrate that the holder of the domain name has registered and used the domain name *in bad faith*. For .nl and .eu domain names the threshold is even lower: the complainant only has to prove bad faith on registration *or* in use and that is quite readily assumed.



Hence many entitled parties opt for this quick and practical UDRP procedure. Another advantage is that the costs are clear in advance: parties bear their own costs. Losing does not mean extra costs. Precisely the combination of a quick and simple procedure with large predictability of costs is seen as a great good.

*Maarten Haak and Daniël Hajje represented Herbalife in these disputes about a series of .nl domain names.*

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## The newspaper Het Parool and the portrait of P.

Dutch press tends to be very cautious about publishing photos of suspects and convicted persons. Newspaper Het Parool published a recognisable photo of a suspect. Is that allowed?

In 2009, a [Spirit](#) shelter home located at Weesperzijde in Amsterdam was the backdrop of a drama. P. had recently moved in and following a fiery discussion with his supervisors he flipped and stabbed three of the care providers with a knife. A 38-year-old woman did not survive. P. fled but was arrested that very same evening. In June 2010, he was sentenced to 16 years in prison.

Het Parool kept a close eye on the case. In an [article](#) of 19 September 2009, the newspaper referred to the television documentary "Vrije Radicalen", which had portrayed P. in 2007. Next to the article was a photo of P. taken from the documentary. P. was not happy with the publication of his photo. He asserted that Het Parool had acted in violation of portrait law and started proceedings. Suspects and convicted persons may only be depicted in case of crimes which have seriously shocked the entire society – according to P.'s lawyer.



In its [ruling of 29 December 2010](#) the District Court weighed up P's privacy against the freedom of the press of Het Parool. All particulars of the case were taken into consideration. P. did not win, also because he had cooperated with the documentary in 2007. According to the court, this meant that he had exposed himself to attention in relation to the violent crime at the shelter. Also considered was the fact that the photo had a clear function in the article.

Whether or not a recognisable picture of a suspect or convicted person may be used always depends on the specific case. Ferdi E. successfully prevented publication of his photo in 1994 at the Supreme Court. With this ruling in mind, the freedom of the press seems to have won some ground.

*Daniël Haije*

## Tagatose, the sweetener

In an advert in Allerhande for the brand Tagatose we read that tagatose *'is a sin-free sweetener without sugar'*. Tagatose's benefit is that it promotes good bowel function and digestion. See here the subject of legal discussion. This is after all a



health claim and the Claims Regulation applies. The Advertising Code Committee has made a comprehensively explained decision on this advertisement. Step by step it verified whether the claim has already been assessed by EFSA (yes), whether the European Commission has yet published the list of article 13 claims (no). Therefore as part of the transitional arrangement these kinds of health claims may be used as long as they are not harmful to public health. But there is more: the Advertising Code Committee points out that the nutrient which is being advertised must be sufficiently

present in the product to actually do what is being claimed. That is why the advertiser was given a proof assignment: it had to demonstrate for all the different Tagatose products in the advertisement that each type contains a significant amount in order to cause the effect. A possibly unexpected turn of events.

Advertisers watch out! The Advertising Code Committee uses an active policy to assess the accuracy of product information and health claims, even though the Claims Regulation for the article 13 health claims is not yet effective. Undoubtedly to be continued...

*Ebba Hoogenraad*



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Hoogenraad & Haak, advertising + IP advocaten is an independent boutique law firm in the Netherlands, recommended by a.o. Chambers, Legal 500 and Best Lawyers. We are specialists in advertising law, intellectual property and product information law (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?*).

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*This quarterly NEWS 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. You have our permission to forward our NEWS to anyone who is interested. A free e-mail subscription can be obtained through [www.hoogenhaak.nl/newsletter](http://www.hoogenhaak.nl/newsletter). Personal data are solely used for distributing the NEWS. © Hoogenraad & Haak, advertising + IP advocaten 2011.*

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