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ADVERTISING LAW & INTELLECTUAL PROPERTY

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Mathijs Peijnenburg promoted to *advocaat*



Following a successful student internship at our office, Mathijs Peijnenburg has stayed on as a legal assistant with Hoogenraad & Haak. He has quickly made himself indispensable in that position. Mathijs will continue his career as an *advocaat* with our firm from 2019. He will be working across the full range of our practice areas. Mathijs studied in England, the Netherlands and Australia. He worked for a number of law firms while he was studying and also gave courses in pleading at Leiden University. In his spare time, Mathijs enjoys turning out on the hockey field.

Menarini v Biofarma: high level of attention to trademark for painkillers

In trademark law, the public's level of attention is often critical. For instance, when buying luxury products (cars or watches, say), the public generally pays more attention than when making everyday purchases in a supermarket



(dishwasher tablets, lighters). This difference in levels of attention means that a risk of confusion is more likely to arise between two brands of dishwasher tablets than if there were a similar conflict between car brands.

But what about the level of attention for painkillers? Is it higher than average because the products are important to our health, or lower because they are everyday products? This was

one of the key issues in proceedings between two pharmaceutical companies, Menarini and Biofarma. Menarini had applied for the trademark SKUDEX for painkillers. Biofarma filed an opposition against the trademark application based on its earlier trademark FLUDEX, which had been registered for an antihypertensive. Was there a risk of confusion? The Benelux Office for Intellectual Property (BOIP) assumed there was and accordingly refused to register the Menarini trademark in the trademarks register.

Menarini appealed against this to the Court of Appeal in The Hague and one of its most significant arguments was that the BOIP wrongly assumed that the public's level of attention would be merely average. The Court of Appeal [found in favour of Menarini](#): the public's level of attention for painkillers was above average. Painkillers are of course widely available but the public is extra vigilant because these products have an impact on health and making mistakes with drugs can entail risks to health. The decision also balanced out in Menarini's favour for other reasons. Biofarma's opposition based on FLUDEX foundered; Menarini's trademark for SKUDEX was indeed registered.

Menarini was represented in this case by Maarten Haak and Bram Duivenvoorde.

Making the earth happier...

A brochure for a sustainable solar boiler contains an environmental claim. In summertime, the solar panels heat the solar boiler. For the winter months, a log fire helps to heat the water in the solar boiler, reducing gas consumption by 70%.



The brochure's text is enthusiastic, with a quip: *"This makes the whole Dutch environment, even the earth, happier"*. The complainant found this unacceptable: logs give off particulates and are therefore harmful rather than environmentally friendly. A full debate ensued. The advertiser relied on the fact that Brussels was a proponent of timber fuel as a responsible alternative to coal-

fired power stations. Wood burners and pellet-fired power stations received government subsidies in the Netherlands. The advertiser qualified the objection based on particulates: logs account for just 0.5% of particulate emissions in the Netherlands.

And what did the Dutch Advertising Code Committee (*Reclame Code Commissie*, RCC) think? Logically enough, [the RCC ruled](#) that this was an environmental claim. "The earth being happier" may well not have been an absolute claim, but it still presented too rosy an image. Even if the volume of particulates was only around half a percent of total Dutch emissions, burning logs still contributed towards this.

I think this ruling is really quite severe. The claim is qualified: 'happier'. It's not an absolute claim. And why did the RCC say nothing about the European and Dutch policies of encouraging wood burners as an alternative to coal-fired power stations? Particulates are also primarily a health issue, perhaps more than an environmental one? The RCC could maybe have looked at this slogan a bit more happily.

Ebba Hoogenraad

Food choice logos under full development

Do you remember them? The blue and green tick marks on food packaging. These symbols have been in use since 2006 to help consumers choose healthier products. The party was over after 10 years: the tick marks were about to disappear gradually from the shelves. Products can no longer be produced with



the tick marks after 18 October of this year. The aim of the tick marks remains just as relevant.

Consumers can still use a helping hand to make a responsible choice, as is clear from a [survey](#) by the *Consumentenbond* (Dutch Consumers' Association) earlier this year, showing that consumers truly

appreciate a logo that incorporates traffic light colours, like the French Nutri-score. There are similar initiatives ongoing in other Member States too, like the keyhole system in Sweden and the traffic light system in the UK.

It's not easy to introduce a logo of this type. This is because communications on the benefits of foods are subject to strict conditions in terms of the European Claims Regulation. There has been intense debate on the matter at a European level this year. The European Commission is calling for a collective European approach, despite a range of divergent initiatives in different Member States. A report will be issued at the end of this year containing the most significant conclusions.

France, in the meantime, is in pioneering spirit: Nutri-score has been in use for a year now. This summer, Belgium joined them and a third country, Spain, embraced it in mid-November. The Netherlands and other EU countries may well follow soon. I expect that the Netherlands will await the report from the European Commission before it jumps in.



Sarah Arayess

On copyright without flavour

When you sit in a restaurant, you're surrounded by copyright protected works: the art on the walls, the restaurant's logo on the menu and in some cases even the dining tables and chairs. But what's the situation with copyright protection of the



most important thing in that restaurant - the flavour of the food and drink? This question has led to a lot of scratching of heads in IP land recently. The EU Court of Justice made its [pronouncement](#) on the matter on 13 November: flavour is not protected by copyright. The ruling shows once again that the copyright "work" concept is harmonised across Europe.

What was the case about? Levola, the manufacturer of Heks'nkaas [Witches' cheese], charged the manufacturer of Witte Wievenkaas [White Women's cheese] with a breach of its copyright on the flavour of Heks'nkaas. This was an unusual claim: it was entirely unclear whether copyright could be imposed on the flavour of a food. The District Court of Gelderland dismissed the claim, while leaving the key matter of principle unanswered. The Court of Appeal of Arnhem-Leeuwarden asked the European Court of Justice some questions of interpretation.

The European Court of Justice stated clearly that a copyright "work" must be identifiable with sufficient accuracy and objectivity. In other words, the work must be perceived clearly in the same way by those who had to issue any findings on copyright protection (judges), competitors and consumers. Because the experience and perception of flavours was subjective and to some extent arbitrary – there are good reasons for saying that "tastes differ" – they cannot be subject to copyright.



So, are differences in flavour now banned from the courts altogether? Probably not. Ads often contain flavour comparisons. Do you still remember the "Tasty too" campaign by Lidl?

Mathijs Peijnenburg

Don't use a brand as a generic name

Shall we take an Uber (taxi)? That celebrity definitely used Botox (a toxin to treat facial wrinkles from Allergan Inc)! I gave my daughter a Barbie for her birthday (doll). It's so easy for these terms to creep in. You come up with a new product or service, it's a great success and, before you know it, the *generic* product or service comes to be designated by that brand name. A fine compliment, of course,



because you've set a proper trend. Some marketeers aim for this quite deliberately; it's an easy way of communication and consumers then often use it. But this can be hazardous to the very existence of the trademark itself, because a trademark that the trademark proprietor has worked at turning into a generic name can be

found to have lapsed. It no longer distinguishes the product or service from an identical service provided by others, but has become synonymous with the product or the service itself. And then you've lost control, or at least the trademark can no longer be invoked successfully against third parties. And it's not just a present-day problem. Do you still remember Xerox, Tupperware (plastic storage containers) and the Walkman? And have you ever used Tipp-Ex (correction fluid)?

Most of all, the trademark proprietor itself absolutely mustn't use the trademark as a generic name. Set a good example and always add a clear, generic term. Don't use "a" or "the" followed by the trademark, but talk about an Uber *taxi*, a Spa *sparkling water* or a Tikkie *payment request*, so you make a distinction between the trademark and the product. The trademark proprietor is also expected to take reasonable steps to combat any generic use of the mark by others. Anyone writing about a cornetto will get a letter from Unilever telling them that this is a trademark. So it's *either* a Cornetto ice cream *or* a cone of another brand, but not 'a Cornetto'. The trademark proprietor also has to take reasonable steps in licensing arrangements to protect the trademark. The licence agreement should contain suitable terms and the trademark proprietor must ensure (to a reasonable degree) that the licensee actually observes those terms.

Maarten Haak

PR agency: hefty fine for breach of ban on drugs advertising

There is a ban against advertising drugs to the general public. The Dutch Ministry of Health, Welfare and Sport (VWS) takes strong action and imposes fines of up to €450,000 per infringement. [The District Court of North Holland](#) imposed a fine,

EXTRA | Het beste van De Telegraaf

Verlaging van bloedsuiker via urine bij type 2-patiënt

Nieuwe pil voor diabetici

Door ARIANNE MANTEL
01 nov. 2013 in NIEUWS

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Een pil die bij diabetespatiënten op een totaal nieuwe manier de bloedsuiker verlaagt, is vanaf vandaag beschikbaar. Het middel werkt op de nieren en zorgt ervoor dat het teveel aan suiker wordt uitgeplast.

not on the drug manufacturer but on the PR agency that represented the manufacturer's interests. PR agencies and advertising agencies should take note! The background to the ruling was an email from the Edelman PR agency to a journalist at *De Telegraaf* about a new drug for diabetics. Edelman attached to this email a press release that was intended for the medical

professional press. The journalist at *De Telegraaf* wrote a supportive article: "New pill for diabetics". The VWS regarded this as being banned drugs advertising and imposed a fine of €33,250 on Edelman. But should the email be classified as drugs advertising? And can a fine be levied on the PR agency, or should the VWS have charged the manufacturer? The judge classified this email as being undoubtedly a drugs advert: the apparent aim of the press release was to promote sales of the drug. The PR agency was legally responsible for this. According to administrative law, the infringing party' includes whoever "physically performed" the banned action, i.e. in this case the Edelman PR agency, which sent the email to the journalist at *De Telegraaf*. The court attributed the infringement to the PR bureau. It did not agree that Edelman was not itself responsible because it was acting on the instructions of the manufacturer. In this case, the manufacturer actually issued a clear instruction: the press release was intended exclusively for the medical professional press. The conclusion: PR agencies (and advertising agencies!) must pay careful attention that the advertising rules enforced by the government are not infringed. This applies to drugs advertising, but also for instance to tobacco advertising and health claims for foods. Infringements not only risk fines for the customer but also for the agency itself.

Bram Duivenvoorde

The right actor(s) for the part?

Shawshank Redemption without Morgan Freeman, or *Forrest Gump* without Tom Hanks? Unthinkable! In most films, there's only one person who can play the lead to perfection. But things are different in the theatre industry. In musicals it's quite



normal for not just the widely acclaimed Tony Award winner to play the lead, but also what is termed an *alternate*. But not everyone knows this. And this led to an audience member at the musical "*Was getekend, Annie M.G. Schmidt*" [filing a complaint with the Dutch Advertising Code Committee \(RCC\)](#).

The complainer had gone to see the show and felt misled when it turned out that Simone Kleinsma was

replaced by her *alternate* in the role of Annie M.G. Schmidt (a famous Dutch writer). The complainer had inferred from the newsletter and the website that only Simone Kleinsma would be playing the lead. One reason for this was that these had announced that the role of Annie suited her beyond anyone else, so that she was the actress to play the part. Stage Entertainment, the producer, took the view that it was a generally known fact that *alternates* are used in large-scale productions. Also – according to Stage Entertainment – this was not concealed because there was a notice to this effect on the cast page of its website. Stage Entertainment further argued that the musical was being sold as a global experience and not as a solo programme revolving around Simone Kleinsma.

The RCC disagreed with Stage Entertainment. The average customer will understand that a lead role will be played by someone else in unforeseen circumstances, to avoid having to cancel the show. The average customer would not, however, expect this to happen in *other* circumstances as well. The musical's success in the advertising for it was largely attributed to the fact that Simone Kleinsma was playing the part of Annie M.G. Schmidt. The chance that she would be absent from the stage would therefore be *essential information* that the customer needs before deciding to buy a ticket. This information had to be made clear in the ads themselves; a notice on the cast page was not enough. The RCC therefore classified the ads as misleading and dishonest.

Mathijs Peijnenburg

Charlie Dobra and the Chocolate Factory

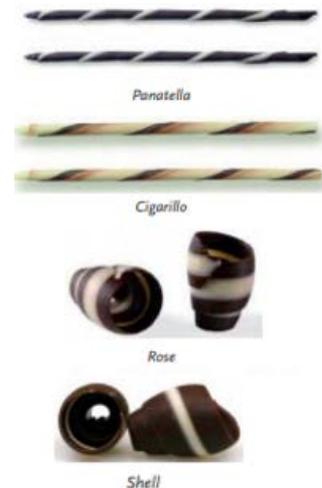
Chocolate can be obtained in many shapes, sizes and flavours. In principle, the shape can be copyright protected, provided that it has its own original character and bears the personal stamp of the maker. This was what was behind a case between the competitors 'Dobla' and 'Chocolate King' about two-tone chocolate sticks and curls. There was also a claim connected to the alleged breach of company secrets.

According to Dobla, Chocolate King's strongly similar creations infringed its copyright and one of its former employees had breached his duty of confidentiality. Dobla took the case to court.

Dobla's claims were dismissed at the first instance. And the [Court of Appeal](#) also held that the shape of the chocolates was not copyright protected (copyright for the taste was not argued – see the item on Heks'nkaas!). According to the Court of Appeal, there had been candy sticks and chocolate decorations that strongly resembled these products for many years. This meant that little or no creative choice on the part of the maker could be discerned. As regards the curls (inspired by a shell), the Court of Appeal found that there was, to some extent, an original choice at play (in the combination of the colour pattern and the precise shape). But, given the *Umfeld*, the Court of Appeal said that the scope of protection was so limited that there was no infringement here. In relation to the breach of confidentiality, the Court of Appeal held that an expert team could readily have made the Chocolate King products by means of 'reverse engineering' the Dobla products. Also, there appeared to be major differences between the machine configurations of the two competitors. The Court of Appeal therefore also swept this claim aside and upheld the District Court's decision.

Despite the low threshold for copyright in the Netherlands, copyright protection of chocolate products is not straightforward, due to of the many types of chocolate products already on the market.

Moirra Truijens



Hoogenraad & Haak is an independent boutique law firm in the Netherlands, highly ranked by *inter alia* Chambers, Legal 500, WTR1000 and Best Lawyers. We are specialists in:

- advertising
- intellectual property
- health, beauty & food
- commercial contracts

We litigate and advise in complex matters, often with cross-border aspects. We 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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