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Camper: TWS and TWINS are not contradictory

Camper may continue to trade its famous TWS shoes. That follows from a **decision** in interlocutory proceedings between the Spanish Camper and the Dutch Van Gastel shoes, both shoe manufacturers. Camper has been using the



TWINS brand for years for its "twin shoes" concept: shoes that resemble each other but are not quite the same. A thorn in the side of Van Gastel, holder of the older brand **twins** in the Benelux. That is why Camper replaced TWINS with TWS, which stands for "The Walking Society". But Van Gastel thought that TWS was too close to TWINS and demanded a ban.

Camper drew the long straw. TWS does not infringe on TWINS. Visually speaking there are major differences between both brands

(number of letters, calligraphy, the transected letter "i"). They sound different and TWS does not mean the same as TWINS. "Only if one were aware of the history between parties could the idea arise that TWS possibly refers to TWINS." Danger of confusion amongst the public is therefore not plausible.



Kim Braber

Maarten Haak and Kim Braber handled this case for Camper.

Pletterpet stickers and pimping up: permitted

Heineken brings out an orange gadget for every football World Cup and European Cup. After the Orange Hat (EC2000), Speaker Hat (EC2004), Hunter's Hat (WC2006) and the TRUM-PET cap (EC2008), this year it was the turn of the *Pletterpet* cap – a jolly variation on the "Makaraba" worn by the South African football fans.



The Netherlands Alcohol Policy Institute (STAP) filed a complaint about the Pletterpet with the Advertising Code Committee (RCC). According to STAP the Pletterpet was specifically targeted towards children. That is not allowed according to the Advertising Code for Alcoholic Beverages (RvA). STAP objected to the sentence *"Pimp je Pletterpet met het Pletterpet Alfabet"* (*Pimp up your Pletterpet with the Pletterpet Alphabet*). This is supposedly youth language. The complaint also addressed the Pletterpet alphabet itself (a sheet of sticker letters to decorate the Pletterpet with). STAP argued that using stickers for alcohol advertising is prohibited by definition.

The RCC dismissed the complaint. An appeal was made for Heineken to inter alia the [Genootschap Onze Taal \(Our Language Society\) website](#) and the [use of language by minister Hirsch Ballin](#) (search with ctrl-f for pimping), making it plausible that *"Pimp je Pletterpet"* (*Pimp up your Pletterpet*) is not youth language.

The RCC's opinion on the Pletterpet alphabet stickers is interesting. In the explanation on the RvA it is remarked that *"using premiums for promotions which are specifically targeted at children such as (...) stickers (...)"* is prohibited. This formulation appears to show that stickers would indeed always be prohibited as being specifically targeted at children. Now this literal interpretation appears to have been dropped. The RCC agrees with Heineken that the actual Pletterpet stickers are not targeted towards children and only serve to decorate the actual premium: the Pletterpet cap. Stickers in advertising for alcoholic drinks are not a *no-go* by definition.

Ebba Hoogenraad and Daniel Haije handled this case for Heineken.

More news about AdWords (Portakabin/Primakabin)

Traders in second-hand brand goods may use the sold brand as an AdWord. This was confirmed by the Court of Justice in its [judgment of 8 July 2010](#) in the Portakabin/Primakabin case. It must be clear that second-hand goods are



concerned and the brand may not be replaced by another own brand of the trader, or the brand owner may prohibit the brand AdWord. It is important that the brand AdWord may also be used in an advertisement for a sales site where *other* products besides the second hand brand products are also traded. The trademark owner may still prohibit the brand AdWord if the volume, the presentation or the bad quality of

these other products are detrimental to the repute of the brand. The Court of Justice also imposed regulations on AdWords in the [Google/Louis Vuitton](#) and [Bergspechte](#) cases (see also our [NEWS 02/2010](#)):

- There may not be any danger of confusion or deception.
- It may not be difficult for the "average internet user" to ascertain from the advert with link whether the advertiser has an "economic link" with the trademark holder, for example a licensing agreement. This criterion leads to great discussion; in practice it must become apparent how strictly this will be applied.
- Moreover if it concerns a well-known trademark, the use of the AdWord may not give the advertiser any "unfair advantage".



Maarten Haak

Black screen! 30 second rectification commercial from Tele2



The black sheep in the Tele2 advertisement was too rash. The price comparison with cable companies Ziggo and UPC is misleading. Tele2 is a new player on the market of cable television to the consumer. In a fierce price comparison with Ziggo (previously Casema) and UPC, Tele2 calls on the consumer to switch: "Holland, choose your cable", with a life-size blue €5 in the image. "Combo package now available from €5 per month." Tele2 forgot to add that this combo package is not free of charge but costs more than €40. It was not sufficient that these costs were explained on the website.

Tele2 was the fall guy with a heavy sanction: the feared rectification commercial on radio and TV. It is interesting that the interlocutory court judge recognised in his [judgment of 13 August 2010](#) that this seldom takes place. That is why "turning black" has a lot of effect on the consumer. Result: a one-off rectification at *prime time* (8 p.m. on TV, 12 p.m. on the radio) on all broadcasters where the wrongful advertisement had been transmitted. During the commercial break the viewer suddenly saw a white screen with a black text that Tele2 had made a misleading comparative offer for cable television; instead of €5 it cost €44.95. The order was: "easily understandable, read out by a neutral male voice". Anyone hearing the rectification knows that Tele2 practised for a long time to have the obligatory text read out extremely fast and as toneless as possible, just avoiding any penalties.

Click [here](#) to hear the rectification commercial.

Ebba Hoogenraad

May Barbara Becker register her name as a trademark?

Opinions are divided. On 19 November 2002 Barbara Becker applied for a Community Trademark for the wordmark BARBARA BECKER for goods in class 9 (electrical equipment and instruments). Harman International Industries Inc. has an older Community Trademark for BECKER for the same goods. Thus, Harman filed opposition because of danger of confusion with the public. In the [ruling of 24 June 2010](#) the Court of Justice provides assessment criteria based on which the General Court (which is also part of the Court of Justice, deciding questions of fact) can make a reassessment.

There is no question that the brands BARBARA BECKER and BECKER look the same and sound the same. The issue is whether the conceptual similarity between the brands (meaning) is such that a risk of confusion with the public is at stake. The meaning of the family name "Becker" must therefore be compared with the full name "Barbara Becker" to see what the effect is of the first name on the combination of first name + family name.



The consumer may find the family name "Becker" more distinctive than the first name "Barbara" meaning that the element "Becker" takes an independent distinctive place in the brand. In that case the brands BARBARA BECKER and BECKER are conceptually similar. However, using this reasoning, *any* combination of a first name and a family name would clash with a family name brand. As a general rule that is going too far. The

Court of Justice made it clear that this must be assessed separately in each specific case and that had not taken place here.

The family name "Becker" is rather common in Germany. This affects the distinctive character of the element "Becker". In addition the fame of Barbara Becker has an effect on the perception of the brand by the public. The brand will first be seen as a brand of Barbara Becker; possibly no connection will be made with the older BECKER brand.

The General Court shall now assess whether BECKER and BARBARA BECKER are compatible using these guidelines.

Eva den Ouden

No portfolio right

Is there such a thing as a portfolio right of a professional photographer?

This issue came up in a court case between a professional photographer and SpecialSauce - a company specialised in culinary photography.

The dispute concerned photos that the photographer had taken in the period 1996-2008 as part of his work for SpecialSauce. The photographer had put these photos on his website and on [Flickr](#). SpecialSauce in turn used the photographer's work on its website. According to SpecialSauce it had the copyright to the photos because the photos had been taken for it.

Gesponsorde links

[Culinaire fotografie](#)

SpecialSauce

check het portfolio op de website

www.specialsauce.nl

The photographer did not agree. Special Sauce only employed him in 2006. Before that he worked *on assignment* for the company. The copyright of photos taken during employment accrues to the employer but the copyright of photos taken on assignment outside of employment accrues to the contractor - in this case the photographer.

In proceedings the photographer claimed that SpecialSauce should stop using the photos that were under his copyright. The photographer won his case in this aspect. But he also wanted to show on his own website the photos to which SpecialSauce held the copyright - the photographer invoked a so-called "portfolio right". This was because of his special link to the photos he had taken. The District Court of Amsterdam did not agree with this in the [interim decision](#) and its [final judgment of 21 July 2010](#). The law does not provide a basis for any such right. A photographer cannot exhibit photos he has taken if the copyright belongs to someone else. Consent is still required.

The same applies with regard to creative work of employees of an advertising agency. If the customer holds the copyright it is a good idea to make proper agreements about exhibiting the portfolio.

Daniel Haije

F1 energy drink infringes the Formula 1 brands

Imax may not use the brand "F1" for an energy drink. It is too similar to the brands of Formula One licensing (FOL), the Dutch branch of the Formula One organiser, responsible for operation and promotion of the world championship Formula One. In its [judgment of 14 July 2010](#) the District Court of The Hague has prohibited Imax from putting the energy drink F1 (bearing the Imax logo) on the market and using the F1 brand on its website.



'F1' is the most dominating component in both the FOL brands (above) and the Imax logo (left). The brands are visually and aurally similar. The public will



conceive 'F1' as short for the races organised by FOL. FOL uses its device mark intensively for races and merchandising. The Imax logo also shows the pattern of a start flag in the form of a car tyre and the word racing refers to car races. Therefore the court holds that the FOL brands and the Imax logo are conceptually similar as well.

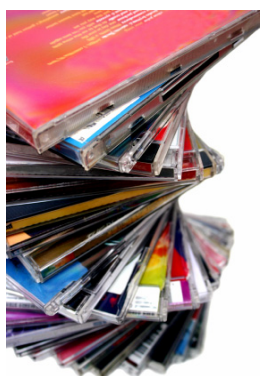
The court also assumes a risk that the consumer assumes a link between Imax and Formula One because the consumer knows that sport-related brands are often licensed for merchandise goods.

Imax argued that the name F1 is actually a description for the sport car races, just like football, tennis and hockey, and that the device brand F1 therefore enjoys limited protection. However 'F1' cannot be used so freely. The court holds that the public will easily make a link to the Formula One races so that risk of confusion is assumed. The race organiser and multimillionaire Bernie Ecclestone will have to keep his eyes open for followers such as Imax.

Eva den Ouden

Customs seizing large number of counterfeit brand goods

In 2009 EU customs deterred billions of counterfeit products during 43,500 checks at the outer borders of the European Union. The Commission revealed



this at the end of July in its [annual report](#) on the maintenance of intellectual property rights by the EU customs. Last year customs mainly seized cigarettes, clothes and brand goods. Often these were goods for daily use that may – if not genuine – constitute a danger to public health, such as shampoo, toothpaste, toys, medicine or household equipment. This again shows that it is meaningful for entitled parties to act proactively: warn customs if counterfeit goods are expected. If customs know which products are concerned and how to distinguish between counterfeit, customs can delay suspicious containers and warn the trademark holder who can then have the items seized.

Maarten Haak

Licensee: register the trademark license!

A trademark licensee may be in for an unpleasant surprise if the trademark holder suddenly transfers the underlying trademarks to a third party. This third party is not automatically bound by the license. But if the license is registered in the trademark register, it can also be invoked against the new trademark holder.

This “third party working” is already assumed in literature but has now also been applied by the court in interlocutory proceedings of the District

Court in The Hague in a [judgment of 8 July 2010](#) on the Diadora trademark.

The issue of whether a trademark license also withstands the bankruptcy of the trademark holder has not yet been decided on. In general it is assumed that the liquidator may terminate the license in principle. In any case it is a good idea for the licensee to register the license in the trademark register.

Maarten Haak



Publication of the first batch of health claims?

The actions of the European Commission in the planned meeting of mid-October 2010 are being awaited with great suspense. The first batch of health claims approved and rejected by EFSA are to be handled then. It is not yet known whether this will immediately lead to a publication of the list of claims by the European Commission. There is still a great lack of clarity and possibly lack of unity about the wording of the claims which is to be established. The course of time and the timing are very important. As soon as the first batch has been published, the transitional period of six months will commence for any use of the prohibited claim as well as similar expressions.... From that time onwards national bodies will have to make a ruling on them.



Ebba Hoogenraad

Faster is not better: the effect of headache painkillers

Advil Liquid Cap 400 has compared itself to paracetamol for years: acts twice as fast. When the Advertising Code Committee (RCC) received a complaint from a consumer about another aspect of this advert, the RCC used this to ban the



commercial after all: faster effect for the consumer means: better effect. The Medicines Act prohibits superiority claims for medicines concerning the *effect*. But is this really the right interpretation? Both the court as well as the KOAG/KAG inspection council and the Code Committee for Medicine Advertising have ruled for years that the *time* a medicine takes to work says nothing about the actual

effect. For a while it seemed as if the Dutch Advertising Code Foundation was going to take a different route. But the Appeals Board has now ruled that the term "effect" in the Medicines Act must be interpreted most restrictively. The fact that legal action was never taken against Wyeth by the government for all these years that the claim has been used is a sign that this interpretation is the correct one. Advil Liquid Cap 400 may act faster but it is not necessarily better.

Ebba Hoogenraad

Hoogenraad & Haak, advertising + IP advocaten is an independent boutique law firm in the Netherlands, recommended by a.o. Chambers and Legal 500. 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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