

# Recent case law in France Trademarks

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# Intro

- Validity of non-traditional trademarks
- Misuse and infringement of the trademarks
- Breach of a settlement agreement

# Paris First Instance Court, July 8, 2016 3D trademark

- A 3D trademark representing a pouch was cancelled on the basis of a lack of graphical representation: the court held that the image as filed did not provide an objective, precise and clear identification of the shape, leading to an insufficient level of representation.

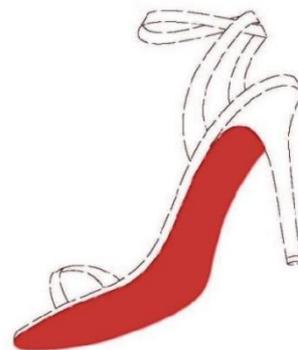


- Beyond the specificity of the case, this decision raises the following questions:
  - Are the criteria for assessing the validity of 3D trademarks really the same as for traditional TM?
  - Will the solution remain the same after the implementation of the new Directive which abandons the requirement of graphical representation?

# Paris First Instance Court, March 16, 2017

## Positional trademark

- In reply to an allegation of infringement, KESSLORD filed a nullity action against CHRISTIAN LOUBOUTIN's French trademark.



- **Decision:**
- The graphical representation is composed by the shape of a high-heeled shoe's sole thus presenting a clear camber, in a color that is clearly and precisely identified in the description.
- Contrary to KESSLORD's claims, the trademark is clear and constant as:
  - The representation unambiguously reveals a precisely defined color which recovers all of the external sole of the shoe, except for its borders and the front part of the heel which is not visible.
  - The shape is objectively, precisely and clearly identified and is also constant in its localization as it is the shape of a high-heeled shoe's sole which therefore adapts to the shape of the foot.
- The sign does not imply any possibility of variation or declination which would make it unclear or fluctuant.

# Supreme court com., March 1<sup>st</sup>, 2017 Misuse

- **Facts giving rise to the dispute:**
  - The word MECCANO (a registered trademark designating toys) was repeatedly used by the weekly magazine “LE POINT”, in a generic sense without any connection with the products covered by the registration.
- **Decision of the CoA**
  - Paris CoA, October 21<sup>st</sup>, 2014 : in the absence of any indication that the sign is protected, the average well-informed reader will not necessarily know that it is registered and may be incited to believe that it can be used in a common and generalized way.

**=> Misuse of the trademark**
- **Decision of the Supreme court (cancellation):**
  - The user of a registered trademark, in a common way, cannot be held liable if this use is not likely to provoke the dilution of this trademark.
  - The lower courts must characterize how a metaphorical use, which does not aim at designating goods and services, could lead to its dilution.

# Paris First Instance Court, April 20, 2017

- Facts giving rise to the dispute:

- The UEFA, owner of the semi-figurative trademark “FRANCE 2016”, filed an infringement action against Mr. William Lavi for the use of the words FRANCE 2016 on socks.

FRANCE 2016

- Judgement (non infringement):

- Even if on a phonetical standpoint the trademark and the sign FRANCE 2016 are identical, the conceptual differences are essential. Such differences result from the non-use of the soccer ball instead of the “0”.
- FRANCE 2016 may refer to any event taking place in France in 2016.
- Affixing the sole terms FRANCE 2016 only presents a decorative function as such a sign does not provide any information on the origin of the product.

## Paris First Instance Court, January 6, 2017 (1) Supreme court., July 5, 2016 (2) Limitation in consequence of acquiescence

- The issue at stake is to determine the criteria according to which a court will presume a use as known.
- Decisions:
  - (1) At start, the sign was majorly used on the Internet and in specialized press. It was not obvious that the claimant could have known it, notwithstanding the acts of the holder to obtain the referencing of its website.

### **=>Admissibility of the claim**

- (2) The fact that both holders are competing companies and that the second trademark has been regularly used since its registration, in several European countries, leads to consider that this use was known with a sufficient degree of certainty.

### **=> Non admissibility of the claim**

# Supreme Court com., May 24, 2017

## Consequence of a settlement agreement

### ■ **Facts giving rise to the dispute:**

- Considering that IBM France breached their obligations deriving from a settlement and coexistence agreement, TRANSLATIONS filed an action on the grounds of contractual liability.
- The agreement included TRANSLATIONS abandoning any infringement claim against IBM provided that the latter stopped using the terms “translation” and “translations” for any software related to translations, education or periodic information. *French translation of “translation” is “traduction”*
- Both First Instance and Appellate Courts granted the requests of TRANSLATIONS.

### ■ **Decision (appeal rejected):**

- The Supreme Court rejected the competition argument considering that as the settlement agreement contained TRANSLATIONS’ renunciation to any claim based on any infringement by IBM and as it only concerned the prohibition of a software’s commercialization under the names “translation” and “translations”, no distortion of competition rules could be observed.
- IBM was not forbidden from describing the functions of the software and only had to adapt the commercialization conditions in France, as it was specifically settled in the agreement.

**Thank you for your attention**