

Country correspondents

The Country correspondents section of *World Trademark Review* is a feature in which leading firms from countries across the globe take a detailed look at a specific topic affecting trademark owners

Well-known and famous trademarks

In this issue the correspondents consider how well-known and famous trademarks are protected by statutes and case law

Australia

The protection of well-known marks in Australia 62
Baker & McKenzie
Ross McLean

Benelux

Protection of well-known marks in Benelux 64
SteinhauserHeeziusRijsdijk Advocaten
Paul Steinhauser

European Union

Famous and well-known trademarks in EU law 66
Clifford Chance LLP
Vanessa Marsland

France

Well-known and famous trademarks in France 68
Inlex IP Expertise
Franck Soutoul and Jean-Philippe Bresson

Germany

Evolution of German law on well-known marks 70
Jonas Rechtsanwaltsgesellschaft mbH
Kay-Uwe Jonas and Catherine Pröm

Italy

Well-known and famous trademark protection in Italy 72
Jacobacci & Partners SpA
Sergio Mulder

Mexico

The difference between famous and notorious marks 74
Uhthoff Gómez Vega & Uhthoff SC
Marcela Bolland González

United States

Protection of famous marks under new dilution act 76
Oblon Spivak McClelland Maier & Neustadt PC
Jeffrey H Kaufman and Kyoko Imai

Well-known and famous trademarks in France

Protecting trademarks that enjoy a reputation is a sensitive aspect of trademark law practice and doing so in France is no exception. A review of both the statutes and case law is needed to draw a clear picture of the French approach

French trademark law refers only to “trademarks with a reputation”. However, case law frequently uses the terms ‘reputed’, ‘well-known’ and ‘famous trademarks’ interchangeably and barely makes distinctions between the levels of recognition attributed to each type. Considering this approach, this article focuses on:

- how to prove that a mark is well known in France;
- the possible basis of actions and relevant jurisdictions; and
- the specific protection offered by Article L713-5 of the Intellectual Property Code.

Acceptable evidence

Unlike Finland or Japan, among other countries, France has no specific registry for well-known or famous trademarks. The well-known or famous character of a mark must thus be demonstrated each time it is used as the basis of an action. Whether a mark is famous or well known is assessed by the courts on the basis of evidence that is the same whatever the nature of the action.

Opinion polls and market surveys are the most suitable evidence. They can stand alone if providing information about:

- the degree of knowledge of the mark;
- its market share;
- its position in the market;
- the status and degree of independence of the entity conducting them; and
- the reliability of the applied method.

For instance, on March 7 2007 the Paris Court of Appeal found the mark MONOPOLY to be famous on the sole basis of a survey establishing that Monopoly is the best known of all board games ever made.

Earlier decisions that recognized a trademark as well known or famous have a high probative value. They are binding on

the French courts and the French Trademarks Office without any need for the mark owner to provide the evidence presented in the earlier decisions. Such earlier decisions must be recent enough to dispel any doubt as to the current well-known or famous character of the mark.

Press articles and publications have a high probative value if they are written by independent professionals and/or made objectively. Publications which are covert promotional matter have a low or no impact considering that, like all promotional material, they give little information about actual trademark awareness. Our experience shows that articles or publications always need to be combined with evidence of another nature to be efficient.

Sworn statements, annual reports, company profiles, company history information, turnover, sales, advertising, invoices, order forms, distribution and sponsoring contracts, samples of correspondence with clients, suppliers or associates are generally regarded as not proving reputation alone. Consequently, they need to be combined with each other or with other elements.

The extent and level of pertinence of the evidence before the Trademarks Office is lower than that requested before the courts. For questions going beyond the strict comparison of trademarks and products and services involved in an opposition proceeding, the appreciation of French examiners is rather material. Small amounts of evidence can be relevant if they clearly and obviously mention or present the mark as well known, whereas a lot of evidence may produce no effect if a deep analysis is required from the Trademarks Office.

The extent and level of pertinence of the evidence showing a trademark to be well

known or famous before the courts is lower than which the Office for Harmonization in the Internal Market (OHIM) and the EU courts require. On March 14 2007 the Paris Court of First Instance held the marks BOSS and HUGO BOSS famous on the basis of:

- the length of time for which the marks have been in existence;
- the 2003 and 2004 sales figures for products bearing the marks;
- the plaintiff’s advertising budget; and
- a survey.

OHIM examiners would probably have considered these four elements as insufficient to prove that the mark was well known.

The French approach remains traditional as the overall assessment is made by taking into account the efforts and investments of trademark owners. French judges have only recently started to consider strategies of co-branding and brand extension in the defence of trademarks enjoying a reputation. The impact of sponsorship in the defence of well-known or famous trademarks as held by the European Court of First Instance in *TDK* (Case T-477/04) remains without equivalent in French case law for the time being.

Grounds of actions and forums

The well-known or famous character of a mark can be raised before either the courts or the Trademarks Office in opposition and trademark infringement proceedings. The claim then relies on the likelihood of confusion generated by the identity or similarity between the signs and between the products and/or services, which is reinforced by the well-known or famous character of the mark. In other words, the well-known or famous character of the mark does not create the likelihood of confusion, but adds to it.

Specific provisions were introduced in

1991 to comply with the First Trademarks Directive (89/104/EEC). These provisions are codified in the Intellectual Property Code at Article L713-5. The first part of the article states that “any person who uses a mark enjoying repute for goods or services that are not similar to those designated in the registration shall be liable under civil law if such use is likely to cause a prejudice to the owner of the mark or if such use constitutes unjustified exploitation of the mark”.

This specific protection applies to registered well-known or famous marks against dissimilar products and/or services. It is a ground of action only before the courts. The Trademarks Office rejects any opposition either that is based directly on this provision or that indirectly requests the rejection of a trademark application because the earlier registered trademark is well known but covers dissimilar products and/or services. The office justifies this position by stating that a well-known or famous trademark cannot be regarded as an exception to the specialty principle, which it applies without exception.

The second part of Article L713-5 relates to the protection of non-registered well-known or famous trademarks against later trademarks covering identical or similar products or services. It provides that “the foregoing paragraph shall apply to the use of a mark that is well known within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property referred to above”. This provision can be raised before either the courts or the Trademarks Office. In practice, oppositions based on this provision are extremely rare. This may be due to the limited extent of appreciation that examiners would make in such circumstances, as they would probably reject the opposition unless the well-known character or fame of the mark were immediate and obvious.

Case law

From 1999 and until recently, French case law considered that Article L713-5 applied only to signs that are identical to well-known or famous trademarks. However, the Supreme Court ruled on October 31 2006 and February 20 2007 that an imitation of a well-known or famous trademark also falls under the provisions of Article L713-5. These decisions bring the French practice into line with that of the European Court of Justice following the *adidas* decision (Case C-408/01).

Another requirement for the application of Article L713-5 is the presence of prejudice to the owner of the mark or, alternatively, of



Franck Soutoul
Partner, Inlex IP Expertise, Paris
fsoutoul@inlex.com

Franck Soutoul co-founded Inlex in 1996. He is a European trademark attorney, involved in trademark law, industrial design, domain names, EU IP matters and unfair competition. He regularly lectures in marketing and advertising awareness and contributes to French and English-language publications. Mr Soutoul is a member of various professional associations including MARQUES.



Jean-Philippe Bresson
Senior legal expert, Inlex IP Expertise, Paris
jpbresson@inlex.com

Jean-Philippe Bresson is a European trademark attorney and a senior legal expert at Inlex. He started his practice at the IP department of car manufacturer Renault. He later moved to publishing company Hachette and joined Inlex in 1998. Mr Bresson specializes in trademark, design and copyright law. He provides strategic counselling and advice on OHIM practice on highly sensitive matters. He is the author of numerous articles in IP matters and is the editor in chief of Inlex's newsletter *IP Talk*.

an unjustified exploitation of the senior mark. Some courts adopt an extensive reading of this provision by making a finding of damage or unjustified exploitation of the senior mark after the well-known character or the fame of the senior mark has been evidenced.

The Paris Court of Appeal ruled on March 7 2007 that the reproduction of the main graphical elements of the Monopoly game constituted an unjustified exploitation of the well-known MONOPOLY trademark. The same court ruled on the same day that the registration of the domain names 'hotel-meridien.fr' and 'meridien.com' and their commercial use through auction sales constituted unjustified exploitation of the well-known marks MERIDIEN and LE MERIDIEN.

With regards to damage caused to the mark owner, the Paris Court of First Instance considered on March 14 2007 the negative image associated with a rap singer who holds a registration for the mark BOSS while the products sold under the marks BOSS and HUGO BOSS are known for their luxury and classical character. The Paris Court of Appeal also considered on May 11 2007 the negative effects that the association of an imitation of the RICARD logo with degrading messages on clothing could have on the brand and its owner Pernod-Ricard.

A well-known or famous trademark cannot, however, prevent a third party from using the sign in its usual meaning. On February 20 2007 the Supreme Court held the use of DECATHLON on the defendant's website was not liable to cause prejudice to the well-known trademark DECATHLON (for the resale of sporting goods), insofar as that word was used in its usual meaning of a sporting event.

Conclusion

The qualification of a trademark as well known or famous follows from an analysis of the evidence available and of the nature and basis of the action at issue. Basing a defence strategy exclusively on the well-known character or fame of a trademark should be restricted to limited cases where the mark enjoys a particularly high level of recognition. Our experience shows that for most marks that enjoy a reputation, bringing up the well-known character of the mark at a second level of argumentation following a trademark infringement claim remains the most efficient defence strategy. [WTR](#)