

/ Firm's latest news

Pierre Hoffman at the INTA Congress: Conference on May 19

On May 19, 2018, at the Sheraton Seattle Hotel, Pierre Hoffman will introduce a conference on "The Impact of Brexit on IP Law in EU" and represent the Bar Council of Paris.

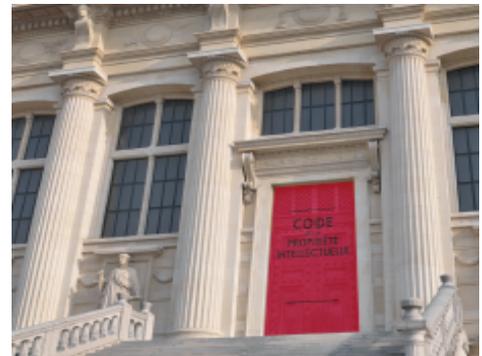
This conference will be composed of three round tables animated by intellectual property specialists who will discuss about the EU trademarks, the Unified Patent Court Agreement and the European Union internal market after Brexit.



Emmanuelle Hoffman on the Role of the Paris Court of Appeal in Intellectual Property

On May 24, 2018, Emmanuelle Hoffman will give an intervention on the choice of civil action and the role of Paris Court of Appeal in the cases of litigations concerning intellectual property or unfair competition.

The conference will be composed of four round tables animated by attorneys, judges or intellectual property specialists.



NEWS

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China : China Supreme Court rules in favor of Dior and Intellectual Property

Last month, Beijing, who currently wants to strengthen its credibility concerning intellectual property protection after having been criticized by Washington, stated that it wanted to establish punitive damages in cases of copyright infringements.

The Supreme Court of China also pronounced a judgment that proves the will of China to increase intellectual property rights protection.

Indeed, on April 26, the Supreme Court ruled in favor of Dior in a suit against the Trademark Review and Adjudication Board that rejected an application to register a trademark of its drop-shaped *J'adore* perfume bottle.



Cybersquatting : Increase of the number of complaints

UDRP

The number of complaints filed under the Uniform Domain Name Dispute Resolution Policy (UDRP) and submitted to the OMPI reached a record level in 2017, with 3,074 cases.

It represents an increase of 10 % over the previous year.

Three industries – banking and finance, fashion, and internet and IT – accounted for nearly one-third of all cybersquatting disputes.

Source: OMPI, Press release, Mars 14, 2018, PR/2018/815

Copyright in EU : Press editors in favor of a neighbouring right

In May, the European association that brings together the press agencies of 32 European countries welcomed the proposal to create a neighbouring right, similar to a copyright, that would allow press editors and agencies to get paid by Web giants.

The creation of this neighbouring right is under review in the context of the Directive concerning copyright in the European Union (Directive of the European Parliament and of the Council on copyright in the Digital Single Market).

The rapporteur, Axel Voss, supported this initiative by underlining that the financial and organizational contribution of press editors and agencies in the production of information shall be encouraged in order to ensure the availability of reliable information.



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Lionel Messi finally allowed to register his trademark

Facts

In August 2011, the footballer Lionel Andrés Messi Cuccittini asked the EUIPO to register the following EU trademark:



This trademark was supposed to be registered for distinguishing clothes, shoes, sport and gymnastic articles.

In November 2011, M. Jaime Masferrer Coma filled an opposition form against this registration, invoking a risk of confusion with the EU trademarks “MASSI” registered for distinguishing clothes, shoes, protective helmets, protective helmets and gloves (the rights for these brands have been transferred, in May 2012, to the company J.M. – E.V. e hijos.)

In 2013, the EUIPO accepted the opposition and Lionel Messi then brought an action against the EUIPO decision. In April 2014, the EUIPO rejected the appeal, concluding to a risk of confusion between the trademarks, stating that their dominant and distinctive elements were almost identical on the phonetic and visual plans.

After this decision of the EUIPO, Lionel MESSI made an appeal before the General Court of the European Union.

Solution

The General Court of the European Union cancelled the decision of the EUIPO. The Court considered that the elements composing the two trademarks have a medium degree of similarity on the visual plan because the dominant element of Lionel Messi’s trademark is “MESSI”.

The Court also confirmed that the two trademarks were very similar on the phonetic plan. But the Court deemed that the EUIPO made a mistake on the conceptual comparison of the trademarks while stating that Lionel Messi was only known by the people interested in sport and football.

According to the Court, Lionel Messi is a public figure and the average consumer who will buy sport articles will immediately associate the trademark with the famous footballer.

Appreciation

The Court concluded that, even though the trademarks were globally similar, the conceptual differences between them neutralized the visual and phonetic similarities. It is thus important not to compare two trademarks only in the visual and phonetic plans, there is also a need to take into account the conceptual elements (like the fact that a person is known by a very large public).

Industrial Designs and technical functions

Facts

The company DOCERAM owned several industrial designs registered for central rods of geometrical forms. It found that the company CERAMTEC manufactured and commercialized rods that were almost identical. DOCERAM thus brought an action for an injunction against CERAMTEC, arguing a violation of its industrial designs.

The defendant then initiated a counterclaim, stating that the industrial designs had to be cancelled because the products appearance was exclusively dictated by their technical function, thus breaching Article 8 of the Council Regulation of 2001 on Community Design.

The Court of Düsseldorf stayed proceedings and asked the CJUE if the existence of alternative industrial designs was decisive to know if the products appearance was exclusively imposed by their technical function.

Solution

The Court settled the debate by stating that the Council Regulation shall be understood in the sense that the existence of alternative industrial designs was not decisive to know if a product appearance was exclusively imposed by its technical functions.

In other words, the fact that some other products are conceived for the same technical functions but have a different shape is not sufficient to prove that the shape of a product is not imposed by its technical function.

Nevertheless, thee alternative industrial designs can be taken into account for the appreciation of the features of a product.

Appreciation With this decision, the Court clarified its position on the way to judge if the shape of a product is imposed by its technical function.

An interior design is eligible to copyright protection

Facts

The case opposed the former franchisee of a network of hair salon and the franchisor after the unilateral breach of the franchise agreement by the franchisee and the consequences of this breach.

The franchisor asked the Court to determine that the interior design of the hair salons shall be considered as architectural works protected by copyright pursuant to Article L. 112-2 of the French Intellectual Property Code and therefore, that the exploitation of this interior design after the breach of the franchise agreement constituted a counterfeit.

The franchisor thus asked for the modification of the contentious salon, and for an award of damages.

Solution

The Court was asked the question of whether an interior design could be considered as a work protected by copyright.

The judges, after a detailed examination of the salon, responded positively to this question by stating that the salons of the network were conceived as theater stages with an original segmentation in several distinct spaces. The salons distinguished themselves by a very large entrance, a lab space conceived as a tower, curves in the architecture... The Courts also underlined that soft shapes of the logo reproduced in the different elements were associated at these existing features. Also, the red color that constitutes the characteristic color of the salons and the style of the photographs add to the originality of this network.

All these elements lead the Court to conclude that the elements taken as a whole testified a creative work as well as an aesthetic tone that were not imposed by the technical function of the salon.

The Court thus stated that the interior design was protected by copyright and that the franchisee was guilty of counterfeiting.

Appreciation

The Court has deemed that an interior design could be protected by copyright. It is not the first time that a Court states that such a work was eligible for copyright protection. Nevertheless, this decision emphasizes the fact that the originality of the interior design is an essential condition for this protection, hence the precise description made by the Court that justifies the originality of the salons and their protection.

Appreciation of unfair competition

Facts

The company H&M commercialized a necklace with a pendant in the shape of a swan in the style of an origami.

The company CREATIVITY then brought an action for an injunction against H&M, arguing that H&M was guilty of unfair competition by manufacturing and commercializing this pendant that was very similar to one of their collection. CREATIVITY underlined that even though it could not claim a monopoly on this shape, the pendant commercialized by H&M had some features that were exactly identical to their pendants.

H&M was convicted in first instance and on appeal, and then filed an appeal in cassation.

Solution

The Court of cassation reversed the decision of the Court of Appeal and justified its judgment by evoking the principle of freedom of trade and industry and stating that a model that is not protected by a copyright could be freely reproduced as far as there is no fault. This fault can be constituted by the creation of a risk of confusion.

The Court of cassation, in its judgment, deemed that the Court of Appeal had not explained enough how the commercialization of this pendant by H&M could create a risk of confusion with CREATIVITY.

Indeed, the Court of cassation stated that the similarities between the jewelry, even if they are very important, were not sufficient to characterize the creation of a risk of confusion for the general public.

Appreciation

The Court of Appeal should have characterized the concrete circumstances that would explain the creation of a risk of confusion by integrating the circumstances of the case. The characterization of a risk of confusion, that constitutes a fault, thus goes far beyond the only appreciation of similarities between the products characterized by two companies. This case thus shows that it is very important for the applicant who brings an action in unfair competition to demonstrate fully the circumstances that create a risk of confusion.

Since 1963, Hoffman has been a leading law firm in the fields of IP rights and competition law, providing its clients with practical and efficient solutions.

With a team of highly experienced lawyers, the firm can offer its French and international clients both specialist and general legal support, whether through advice or litigation.

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