

/ Firm's latest news

Hoffman Law Firm in Barcelona (May 20th – 24th)

The whole Hoffman law firm's team will be in Barcelona on the occasion of the International Trademark Association's 139th annual meeting.



APRAM : Pierre Hoffman conference on seizures

Pierre Hoffman, partner at Hoffman Law Firm, gave a lecture as part of APRAM (Trademarks and Design Law Practitioners' Association).

The topic was seizures, and especially attorneys-at-law's place in such procedures.

Hoffman Law Firm & Paris Bar School



As previous years, several lawyers from Hoffman Law Firm gave lessons to trainee lawyers from the Paris School Bar (EFB) about IP matters such as IP rights infringement.

Emmanuelle Hoffman at the Luxury Law Summit

Emmanuelle Hoffman, partner at Hoffman Law Firm, participated at the Luxury Law Summit in London on the 16th of May 2017.

The Luxury Law Summit is an event which provide a mix of luxury business leadership experience and legal expertise.



NEWS

- FIRM P1
- INTERNATIONAL P2
- CASE LAW P3-6

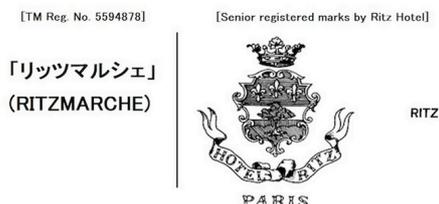
RITZ : Japanese IP Office invalidates “RITZMARCHE” trademark

Ritz Hotel Ltd. which is a world-famous hotel management company, asked the Japanese IP office in order to get the invalidation of the verbal trademark “RITZMARCHE”.

Indeed, the litigious trademark has been registered in class 35 (retail services or wholesale services for foods and beverages).

The main motivation of the Japanese office to invalidate the trademark was that “RITZMARCHE” was confusingly similar to senior trademark registrations owned by Ritz Hotel Ltd.

The office did not need to follow the applicant’s argument which was that “RITZMARCHE” was likely to cause confusion with Ritz Hotel due to the remarkable reputation of the hotel brand.



Facebook sanctioned by the CNIL



On the 16th of May, the CNIL (French Commission for informatics) decided to impose to Facebook a 150.000 euros fine.

The Commission complains that the social media’s leader did not respect French law about personal data.

The French authority spotted, notably, a massive combination of personal data (without authorization) operated by Facebook for advertising targeting.

Facebook defends herself by arguing she respects UE regulation about data. The blue logo company says to be ready to cooperate with the Commission to emerge.

Paris Saint-Germain : legal fight to obtain a slogan

The Paris Saint-Germain will have to wait until the 6th of July to know if trial judges of Paris have been convinced by its arguments.

Indeed, an association of supporters registered the slogan “ICI C’EST PARIS” on its behalf.

In facts, the football club already uses this slogan on by-products, but wants to use it as a trademark. The club tried, in vain, to register the slogan.

On the contrary, the association doesn’t use the slogan in the course of trade, and refused systematically offers made by the club.

That’s why the Paris Saint-Germain football club sued the association to obtain the slogan by the legal way (forfeiture).

The main argument exposed by the football club is that the association doesn’t use the slogan, to what the association respond that it’s the fault of the club who has done everything he could to block that using.



Geometrical figures and UE trademarks

Facts

A Chinese company (ANTA) filed an application for registration of an EU trademark. The figurative sign represented two lines forming an acute angle:



Classes covered by the application were 18 (leather etc.), 25 (clothes including footwear) and 28 (sporting articles, included in this class golf bags).

By his decision of May the 8th 2015, the examiner rejected the application for registration of the EU trade mark for all the goods concerned, pursuant to Article 7(1)(b) of Regulation n° 207/2009 (lack of distinctiveness). By decision of March the 9th 2016, the Board of Appeal of EUIPO dismissed the appeal against the aforesaid decision.

ANTA brought the matter before the General Court in order to contest the Board of Appeal's decision. According to ANTA, the Board of Appeal failed to assess correctly the relevant public and the overall impression created by the abovementioned trademark.

The applicant asserted that for 25th class of goods (clothes, shoes, headgear...), the public's level of attention is generally higher as the public usually inspects and tries on these items before purchasing them; as for goods of the 18th class (leather bags, travel kits...). Moreover, some of the goods from the 28th class are specialised goods intended for specific athletes or consumers who usually choose these goods with particular care (golf bags...).

Regarding the overall impression of the trademark, ANTA company highlighted some graphic elements which, in her opinion, were catchy, as the irregular aspect of the lines, the unusual angle made by the aforesaid lines. Also, the applicant said that the interpretation of the sign by the public was ambiguous.

Solution

The General Court dismissed the appeal filed by ANTA. Indeed, even if it was possible that certain consumers paid more attention when undertaking some purchases than others, it was not the same for other consumers.

It could not be presumed, therefore, that the whole relevant public would be particularly critical in its analysis of the goods purchased or place importance on the reputation of brand images and labels in the market.

Regarding the overall impression, the General Court affirms the sign in question does not represent a basic geometrical figure, but that circumstance, as such, does not suffice to support the view that it has the minimum distinctive character necessary for registration as an EU trade mark.

In fact, there must also be certain characteristics of the sign that can be easily and instantly memorised by the relevant public and would make it possible for that sign to be perceived immediately as an indication of the commercial origin of the goods at issue.

Appreciation

The General Court, by answering the applicant's queries, assess the relevant public and the overall impression created by the sign applied after a factual and objective analysis. This decision reminds the problematic linked to trademarks representing geometrical figures (General Court, 12/09/2007, ref. T-304/05).

Precisions about the right of information

Facts

The City Court of Prague condemned ALLTOYS company (Slovakia) due to counterfeit acts against NEW WAVE company's trademark (Czech). This jurisdiction refused to allow NEW WAVE to modify his queries. Indeed, the applicant wanted ALLTOYS to provide all information related to the goods concerned in order to evaluate his financial compensation.

NEW WAVE launched a new procedure before the aforesaid jurisdiction seeking for ALLTOYS to be ordered to communicate all information on the counterfeiting goods. But, the court considered that a claim to a right of information could not be brought by an application submitted independently, since Czech law provides that such a right may only be asserted by an application to the court "in proceedings" concerning infringement of a right.

An appeal was made against the decision, and the Court of Appeal of Prague altered the judgment at first instance by ordering ALLTOYS to provide NEW WAVE with the information requested.

ALLTOYS appealed on a point of law against the appellate court's decision before the Czech Supreme Court. The Court said there was a difference between the wording of the national Czech law and the wording of Directive 2004/48. While the national law says the applicant can obtain information "in proceedings for infringement of a right", the directive says "in connection with proceedings for infringement of an intellectual property right".

In those circumstances, the Supreme Court decided to stay the proceedings and to refer to the Court for a preliminary ruling about the interpretation of Article 8(1) of Directive 2004/48.

Solution

The Court of Justice recalls that the expression 'in the context of proceedings concerning an infringement of an intellectual property right' cannot be understood as referring "*solely to proceedings seeking a finding of an infringement of an intellectual property right*".

Article 8(1) abovementioned says that the obligation to provide information is directed not only at the infringer of the intellectual property right in question but also at 'any other person' mentioned in indents (a) to (d) of that provision. Those other persons are not necessarily parties to the proceedings, so the article cannot be interpreted as being applicable only in such proceedings.

In addition, the Court explain that the right to information is a specific expression of the fundamental right to an effective remedy guaranteed in Article 47 of the Charter of Fundamental Rights of the European Union. Indeed, the Court adds that "*without full knowledge of the extent of the infringement of his intellectual property right, the rightholder would not be in a position to determine or calculate precisely the damages he was entitled to by reason of the infringement*".

For all of these reasons, "the exercise of the right of information provided for in Article 8(1) of Directive 2004/48 must not be limited to proceedings seeking a finding of an infringement of an intellectual property right".

Appreciation

This interpretation of the Court of Justice is clearly in favour of trademarks owners as the application scope of the right to information is widely recognized. Actually, it is allowed to assert his right to information even after the infringement one.

INPI, 17/03/2017, decision of the Director about an opposition to the registration of a trademark

PHARMACITY is an imitation of the trademark « CITYPHARMA »

Facts

In 2012, the Company CITYPHARMA applied for the European trademark “CITYPHARMA” and the EUIPO registered it for pharmacy products.

On the 4th of July 2016, the Company « PHARMACIE GRESSE » filled a French trademark application for the sign “PHARMACITY”.

On the 27th of September, CITYPHARMA Company opposed to this application.

She said that the pharmacy products of the application were the same as the services and products of her former European Trademark and that the applied sign was an imitation of the former Trademark.

Solution

The Director of the National Institute for Industrial Property told that the opposition was justified.

The inversion of the sequences “CITY” and “PHARMA” was insufficient to avoid risk of confusion between the verbal elements because of the same global impression resulting of the specific association of these two sequences.

The visual differences composed of colored and figurative elements in the former Trademark, without phonetic incidence, couldn't delete the risk of confusion. Indeed, the main part of the sign is composed by the word CITYPHARMA, presented in big colored letters, which remains immediately visible.

The INPI concludes that the visual, phonetic and intellectual similarities give to the signs same global impression and that the sign PHARMACITY is the imitation of the Trademark CITYPHARMA. Since the products are identical or similar, there is a global risk of confusion about the origin of these signs for the consumer. French Office in charge of the Trademarks, Design and Patents registration

Appreciation

This solution of the INPI is in accordance with recent precedents and gives a strong protection against the imitation of a Trademark by the inversion of the same elements' order in a sign.

Paris Court of appeal, 12th April 2017 (N°16/14994) :

Appeal after an opposition decision against the registration of “LA DEMOISELLE D’HAUT-PEYRAT” as a Trademark.

Facts

The Company CHATEAU TOUR FOURTHON applied to register the sign “MA DEMOISELLE D’HAUT-PEYRAT” as a French Trademark on the 24th September 2015. The application was made for “*wines*” in class 33.

VRANKEN-POMMERY PRODUCTION Company opposed to this application with her former verbal Trademark “LA DEMOISELLE”, registered in class 33 for “*French origin wines, that is to say Champagne*”.

The INPI Director decision of the 16th June 2016 said that the opposition of VRANKEN-POMMERY PRODUCTION was justified because the sign was an imitation of the former Trademark and the consumer could consider it as a declination of this TM.

DOMAINE CHATEAU TOUR FOURTHON appealed this decision, asking for cancellation of the INPI Director’s decision.

Solution

The Paris Court of Appeal’s decision of the 25th April 2017 canceled the INPI Director’s Decision.

The Court said that “*wines*” and “*French origin wines*” were similar as members of the same main category of wines, products of same nature, sold in the same shops and shelves to the same clients, who give them the same origin.

However, the court considered that the signs were different because of the very perceptible final element “HAUT-PEYRAT” in final position. The large differences between the signs were visual, phonetic and conceptual.

The Court judged that the signs gave a different global impression.

Appreciation

This solution is uncommon in the sense that the Court of Appeal of Paris rarely overturns INPI’s decision.

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.

HOFFMAN
ATTORNEYS AT LAW

www.cabinet-hoffman.com
contact@cabinet-hoffman.com

26 avenue Kléber - 75116 Paris

T : +33 (0)1 45 00 75 75

F : +33 (0)1 45 01 83 87