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«Trademarks in Paris”: when signs cannot be used by anyone but the French State»

Nomos

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Paris Court of appeal, Pôle 5, Ch. 2, 22th September 2017; Paris Court of appeal, Pôle 5, Ch. 2, 13th October 2017

If there is a plenty of signs that can be registered at the French trademark Office (“INPI”), some of them, according to the article L 711-3 of the French intellectual property Code (“the Code”), may not be adopted as a mark or an element of a mark, such as those excluded by article 6ter of the Paris Convention for the Protection of Industrial Property (“the Convention”) or the signs contrary to public policy.

The article 6ter of the Convention sets out some prohibitions concerning State Emblems and Official Hallmarks, among other things. It provides that the Countries of the Union agree to refuse or invalidate the registration and to prohibit the use, without authorization by the competent authorities, as a trademark or as element of trademark, of State emblems, official signs and hallmarks indicating control and warranty adopted by them.

Likewise for designs or models, those cannot be protected if they are contrary to public policy (article L 511-7 of the Code). In that case, according to article L 512-2 b) of the Code, the filling shall be refused too.

As a consequence, for the French judges, a domain name, a trademark, a design or model could be quashed or rejected by them or the INPI, if those signs reflect an element of the French State.

The judgment of 22 September 2017 of the Paris Court of appeal (“the Court”) states that a trademark containing the expression “France.com” has to be invalidated, since the name “France” is like a surname of natural person for the French State, even if in the French Constitution of 4 October 1958, the official name of “France” is the French Republic. Therefore, a semi figurative trademark with the name “France” or ‘France.com” and a design of the French hexagon will be identified by the public as emanating from the French State or from a service warrants by its.

In this particular case, an US company owned since 1994, a domain name “France.com”. In 2009, a Dutch company registered at the INPI several trademarks with the expression “France.com”. The first company assigned the second in fraudulent trademark filing. Both parties entered into a settlement, after which the Dutch company divested the contentious marks to the US company. However, the French State intervened voluntarily in the case in order to establish the violation of its rights on its territory’s name and to obtain the transfer of the trademarks and the domain name. Then, the State asked the judges to invalidate those trademarks.

The Court has acceded to the requests of the State.

Furthermore, the judgment of the 13 October 2017 of the Court states that a design depicting a Marianne - a French emblem which shows a woman in profile wearing the Phrygian cap of liberty - is contrary to public policy.

In this case, an association filed a design at the INPI, which has been rejected by the Director of the Office. The latter refused to register the design, as it depicted between blue and red marks, a woman's profile wearing a Phrygian cap in a blue cockade, which gives the impression that the use of that kind of Marianne is linked to or warranted by the French State.

The association stated that there can't be any confusion between its design and the hallmark of the French State, as the colors used and the graphic design of its website, among other things, contributed to avoid any misunderstanding.

Yet, according to the judges, if there are several portrayals of Marianne, the one in the contentious design resumes, in the same way, elements of the cap and the hair of the one used by the French State. Moreover, since the Director of the INPI rejected the filing based on public policy, a criteria such as the newness is ineffective.

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