benoliel avocats
INTELLECTUAL PROPERTY BOUTIQUE

Post BY b.a

> *This edition of our Newspaper offers a retrospective on various intellectual property topics that Benoliel Avocats discussed during the first half of 2024.*
> *We hope you will enjoy reading it!*

Procedural issues • Limits to the Bailiff's powers

Copyright • Originality of wallpaper

Trademarks • Use in a modified way does not necessarily alter the distinctive character of a registered trademark

Designs • The presumption of ownership of a design rests with the applicant

September
2024

Procedural issues - Limits to the bailiff's powers

Cour de cassation
20 March 2024
N° 22/22406

Presence of the bailiff during the opening of a parcel at the plaintiff's counsel's office - Nullity of the bailiff's purchase report (NO)

A bailiff who records the purchase of a product in a shop, oversees its unpacking by a third-party buyer and photographs it, carries out purely material observations without any active involvement

A company specializing in the design and marketing of toy vehicles, holder of a European patent designating France for a children's tricycle, sued two operators for patent infringement after they sold a product that allegedly reproduced the claims of the patent. The product's purchase had been recorded by a bailiff.

The nullity of the purchase report was at stake before the French Supreme Court (Cour de cassation), on the grounds that a bailiff who opens a parcel at the plaintiff's counsel's office, while in the presence of said counsel, exceeds their powers and moves beyond mere material observations to engage in active evidence gathering.

The French Supreme Court dismissed the appeal and thus confirmed the validity of the purchase report:

➔ The bailiff had recorded both the in-store purchase of the product by a third-party buyer and its subsequent transport by the same person to the plaintiff's counsel's office.

➔ The third-party buyer unpacked the product in the presence of the bailiff, who then photographed it before sealing it.

➔ Accordingly, the Court of Appeal correctly deduced that the bailiff had limited themselves to carrying out purely material observations without taking any active steps.

b.a's eye

It is worth recalling that, under the terms of an old 1945 ordinance, bailiffs are authorized to make purely material observations, exclusive of any opinion on the factual or legal consequences that may ensue. This is exactly what the bailiff did in this case, by merely attending the premises, recording the purchase of the product and photographing it without any unpacking.
It should be noted that the status and inde-

pendence of the third-party buyer do not appear to be called into question in this case (on this point, see our article on the case law related to the presence of a trainee from the applicant's law firm - https://urlr.me/JHQFx).

Copyright – Originality of wallpaper

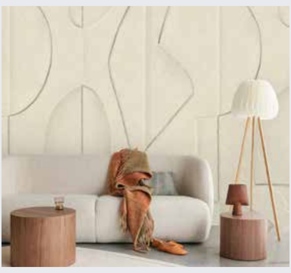
Paris Court of First Instance
25 April 2024
N° 23/04554

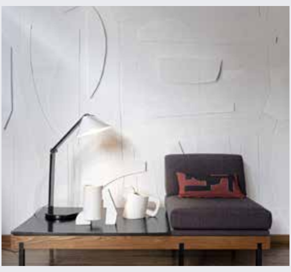
Copyright infringement - Originality of wallpaper (YES) / Infringement (NO)

Wallpaper can be considered original due to the impression it gives, but it will not be considered similar to a decorative panel that does not give the same visual impression

A visual artist claimed copyright on wallpaper designs including a wall decor entitled "White Spirit".

After finding out that her distributor was offering for sale similar wallpapers, commercialized by the company Eijffinger, the artist brought an action for infringement against the latter before the Judicial Court of Paris.


Original wallpaper


Alleged copy

The originality of the claimed wallpaper was recognized by the judges:

- The artist had arbitrarily chosen to create an overlay of monochrome modules or graphic shapes cut out of paper with a cutter (rather than drawn in pencil), in order to reinforce the impression of depth in the angles. These choices gave the whole a three-dimensional visual appearance.

- Although the artist cannot claim a monopoly on a style involving the overlaying of paper collages, the combination of the aforementioned characteristics transcends mere ideas or technical know-how and reveals an innovative work on volume that ultimately reflects creative work.

- The optical illusion created by the emphasis on cut-out geometric shapes and shadow effects evokes the representation of a paper sculpture, resulting in a very singular aesthetic for a wall tapestry.

On the other hand, the Court rejected the infringement claim:

- The disputed wallpaper is indeed a large decorative wall panel depicting graphic shapes. The monochrome aspect is also present, even though the plaintiff offers a broader range of colors.

- However, the decor does not represent a layering, on different levels, of graphic shapes or modules cut from paper and stacked to restore a visual impression of depth in three dimensions.

- On the contrary, the lines are reminiscent of a potter's needle in clay or a carving in stone, representing shapes that differ from those featured in the claimed work.

- As a result, the particular realistic rendering of the material in the artist's work is not found in the same way in the defendant's creation, which was created using a software program.

b.a's eye

It should be noted that, although the artist sought copyright protection for other wallpaper patterns, the Court refused to recognize their originality. The Court stated that the claimed characteristics merely demonstrated technical proficiency and described a non-appropriable style: the juxtaposition of geometric shapes in different colors, largely inspired by abstract art or cubism.

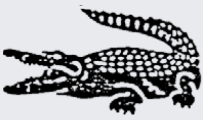
The decision is not definitive and may be appealed.

Trademarks – Use in a modified way does not necessarily alter the distinctive character of a registered trademark

Paris Court of Appeal
26 April 2024
N° 23/04609

Cancellation of the Lacoste trademark (NO) – Proof of use of the “crocodile“ from a different angle

The use of a very similar crocodile trademark, appearing from a different angle than the one registered, does not alter its distinctive character



A Chinese company sought cancellation of a French semi-figurative trademark owned by Lacoste, depicting a crocodile with its head turned to the left and registered on October 19, 1994.

The INPI accepted that the trademark had lapsed for a number of goods/services. However, the trademark was upheld for goods/services relating to clothing, accessories and cosmetics.

Before the Court, the applicant requested total revocation of the trademark, including for these products/services.

More specifically, it was argued that the mark was a “defensive” trademark, the filing of which characterized a strategy to obstruct all competition. The applicant added that Lacoste now uses the crocodile image from a different angle, with its head turned to the right, which constitutes a modified use altering the distinctive character of the contested trademark.

The Paris Court of Appeal confirmed the INPI’s decision:

➔ It pointed out the irrelevance of the fact that the sign now used by Lacoste has been subject to separate trademark registrations, and that some of Lacoste’s registrations have been cancelled for bad faith.

➔ Many elements demonstrate that Lacoste has been using a sign depicting a crocodile in profile, with its head turned to the right, either alone or in conjunction with verbal elements, primarily the LACOSTE name.

➔ Although the crocodile representation is inspired by nature, it is nonetheless distinctive with regard to beauty products, clothing, watches, optics and eyewear, leather goods, household linen or sporting goods and patronage services. This representation of a reptile has particular features, notably the animal’s raised tail, which is unusual in this field.
The Court emphasized that the sign’s distinctive character is further reinforced by its broad public recognition.

➔ Lacoste provides evidence of the use of a sign very similar to the contested trademark: a crocodile in profile facing right, with one front leg and one rear leg visible, an open mouth, a tail raised above its back and dotted like the back to represent the scales. The fact that this sign appears from a different profile angle does not alter its distinctive character, as it is easily identifiable.

The association of the LACOSTE word sign cannot be criticized either, as several trademarks can be affixed to the same product, each retaining its function as a guarantee of origin.

➔ The sign used by the Lacoste company is a guarantee for consumers of the origin of the goods and services. The same applies to its representation in other colors (such as red or green) which does not eliminate the essential characteristics of the crocodile, the latter retaining its distinctive elements.

Designs - The presumption of ownership of a design rests with the applicant

Infringement action brought by the owner of a design who acquired the design prior to its registration: admissible

Cour de cassation
31 January 2024
N° 22/20-409

The owner of a design does not have to prove the transfer of ownership of the design to benefit from it.

A company that owned a design for prints representing rosettes, registered with the INPI, was declared inadmissible in its infringement action by the Bordeaux Court of Appeal. The Court ruled that the company had failed to prove the transfer of rights to its advantage, as it had acquired the design from a third party before registering it with the INPI.

An appeal was lodged with the French Supreme Court (Cour de cassation), which quashed the ruling in its entirety.

The Supreme Court's decision serves as a reminder of the following:

➔ The presumption of ownership attached to the registration of a design and resulting from Article L. 511-9 of the French IP Code can only be rebutted by the natural person(s) who created the design and who claim ownership over it.

➔ The owner of a design does not have to justify anything else than their registered title to bring an infringement action. In particular, there is no requirement to explain any prior assignment of rights or to proceed with the publication of this assignment in the national design register.

➔ In this case, the design holder sufficiently justified their standing to sue and should therefore have been declared admissible in their infringement action.

b.a's eye

This solution is not new (the French Supreme Court refers to a ruling of April 7, 1998), but it is a welcome reminder.

The Supreme Court's decision has been published in the Bulletin, which is a clear sign of its importance.