

Presentation by Ms Sylvie Mandel

Genuine use of trademarks

My presentation will focus on the problem of revocation of trademarks and especially on two topics : genuine use of a trademark on the Internet and genuine use of the trademark as registered in order to avoid revocation.

It being said that I will refer to the ECJ case-law and to a recent case rendered by my chambers: the Commercial Chambers of Cour de cassation, the French Supreme Court if you will.

As a preliminary observation under the CTM regime and in most of the European Countries, registration is indispensable to exercise trade mark rights.

The case submitted to the French Supreme Court concerned the Abercrombie trademarks (Cass.com February 16th 2010, n° 0821 079 A& F Trademark Inc v Société Hello Paris) The American Company A&F Trademark who is the owner of the Abercrombie trademark has a certain number of French trademarks and two CTM. A&F sued a company for infringement but the defendant opposed that the trademarks were not put to genuine use in France within the previous five years in connection with clothing (goods in respect of which the ABERCROMBIE marks were registered). I shall mention that curiously Abercrombie even though it grounded its action on CTM limited the debate to the use of her trademarks in France and did not claim that the CTM trademarks were put to genuine use in another country such as United Kingdom (a store had just opened in London)

A&F Trademark does not have any store in France, nor does it advertise in France. It offers products only on its website www.abercrombie.com and not .fr , and the site is written in English . Nevertheless the French consumers are able to purchase Abercrombie products through the Internet and those are delivered in France.

Can such a use be qualified as genuine use of the French trademark in France ?

The French Supreme Court did not decide expressly on this issue since the question submitted to its review was essentially that of the family of trademarks as I will explain next.

Nevertheless, as regards the use on the Internet, under which circumstances is the owner of a trademark using it in relation with the goods designated in its registration?

If one refers to a report of WIPO October, 2001: should the website be written in French? The welcome pages or the whole website? or with a link to a French website ? Is the invoicing by the US exporter made in US dollars or in euro or another currency in the EU? are the products

delivered in France ? Is it possible to get a contact in France such as a telephone number or an address? From my own point of view all these kinds of elements might be taken into account in order to establish whether the use of a national trademark on the Internet can be considered as put to genuine use in the country where the mark is registered.

On the one hand, the danger is to try to escape the principle of territoriality, but on the other hand we need to be realistic, to take into account the evolution of business-e-commerce is a reality and we have to deal with it.

I submit such questions to the audience.

But let us consider the second issue, that is the use of the mark as registered.

We should consider here two sub-questions: first sub-question what happens, if the trademark in question is modified or used with additional elements?

The ECJ in the case *Bainbridge* C 234/06 of September 13th 2007 and the CFI in case *Coloris Global Coloring versus Esber* T 353/07, of November 30th 2009 stated that it is possible to consider a registered trademark as used where proof is provided of use of the mark in a slightly different form from that in which it was registered, provided that the alteration or modification does not affect the distinctive character of the trade mark.

Examples : ‘COLORIS’ with the words ‘global coloring concept’ written smaller and positioned below the word ‘coloris’ + the figurative element of a globe do not affect the distinctive character of the word mark ‘COLORIS’

‘Ivresse’ with a ‘Y’ instead of a ‘I’ for a perfume of Yves Saint Laurent

On the opposite, the French Supreme Court approved the Paris Court of appeals when she considered that the use of the trademark ‘86’ with some figurative elements or additive words such as Body, Moto Cross, Lucky altered the distinctive character of the sign (the Cour de cassation held as is often the case that such determination was made by the trier of fact in its own discretion, the Cour de cassation never reviews a point of fact as opposed to a point of law)

Second sub-question: what happens in case of a family of trademarks?

In the case *Bainbridge* C 234/06 of September 13th, 2007, the ECJ held that while it is possible to consider a registered trademark as used where proof is provided of use of that mark in a form slightly different from that in which it was registered, it is not possible to

extend, by means of proof of use, the protection enjoyed by a registered trademark to another registered mark, the use of which has not been established, on the ground that the latter is merely a slight variation on the former.

In this case two trademarks were involved: ‘bridge’ and ‘the bridge’.

Each trademark has to be used, each trademark gets its own protection and its own regime. The notion of ‘defensive trade mark’ to which the opponent referred in this case does not exist under the CTM regulation.

In the quoted case ‘Abercrombie’, the American company made in a way the error to ground its case for infringement on 3 French trademarks ‘Abercrombie’ and ‘Abercrombie & Fitch’ and on two CTM ‘Abercrombie’ and ‘Abercrombie & Fitch’. Following the ECJ case-law, the French Supreme Court approved the Court of appeal which had stated that proof of genuine use has to be provided for each trademark. The French Supreme Court in this case reversed its case-law since before this decision she used to consider that it was sufficient in order to avoid revocation to establish that the mark put to genuine use differs slightly from the registered trademark even if the altered trademark is itself registered (Cass.com, March 14, 2006).

Conclusion: I noticed when I was Chair of the First BOA at OHIM and when I was sitting with the Court of appeal that too often companies prefer to ground their action for infringement on several trademarks, but it happens that it can be dangerous. It is wiser to ground an action on one trademark, and in case the mark in question is a word mark but used with a figurative element, to be sure that this element does not alter the distinctive character of the word element.