



Paris, Saint-Tropez, Venice, ... Protecting the names of local communities

*Seeking trade mark protection for the names of
local communities*

*Regulating the use of local communities names
in trade mark law*

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Sui generis protection ?

No protection *per se* for geographical identifiers like city names :

- WIPO, Case No. D2002-0273, Land Sachsen-Anhalt
- WIPO, Case No. D2006-0778, Province of Brabant-Wallon

Main points

- 1. *The trademark vs/the local community name :*
Laguiole
- 2. *The local community name vs/the trade mark :*
Paris, Nice, Vergèze
- 3. *With a little help from the trade mark :*
Barcelona, St Tropez, Zermatt, Tenerife, Davos



The trade mark Vs/ the local community name **LAGUIOLE**

- Third parties are entitled to register geographical terms corresponding to city names
 - CTMR, art.4
 - Dir. 2008/95, art.2
- **TGI Paris, 13 sept. 2012, n° 10/08800, Commune de Laguiole**





The trade mark Vs/ the local community name The limits

- **Descriptive character**

- Dir. Art. 3, 1 sous c :

- *(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, **geographical origin**, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;*

- ECJ 4 May 1999, C-108/97, Windsurfing Chiemsee Produktions , §31, 33
- Trib. UE, 16 Sept. 2009, T-180/07, « Madridexporta »



The trade mark Vs/ the local community name

The limits

- **Deceptive trade marks :**
- Dir. Art. 3, 1 sous g ; CTMR. Art. 7, 1 sous g (absolute grounds for refusal) :
 - *« trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service »*
 - Paris, P. 5, ch.2, 21 déc. 2012, Sté Shanghai Ylangting, *« Beauvillon Paris »*



The trade mark Vs/ the local community name **LAGUIOLE**

- **Laguiole :**
 - People do not know that village
 - The trade mark is not descriptive or deceptive as the public ignores that it is an indication of origin
- TGI Paris 19 sept. 1984, Paris/St Laurent :
 - Famous indication of origin for perfumes
 - Use must remain collective



2. *The local community name Vs/ the trade mark* **PARIS, NICE, VERGÈZE**

- **Availability of the sign**
- Earlier rights : French IPC, Art. L711-4, h :
 - « *Signs may not be adopted as marks where they infringe earlier rights, particularly :h) the name, image or repute of a local authority* »
 - When there is a **likelihood of confusion** in the mind of the public : Cass. Com., 10 July 2012, Marmande, 11-21919 ; Cass.com. 23 June 2009, Sté Julou Compagnie , n° 07-19542 **TGI Paris, 6 July 2007, Ville de Paris/Assoc. Paris-Sans fil**



2. The local community name Vs/ the trade mark **PARIS, NICE, VERGÈZE**

- **Earlier rights** : the number of a department ?
- Cass.com. 23 juin 2009, Sté Julou Compagnie ,
n° 07-19542

2. *The local community name Vs/ the trade mark* **PARIS, NICE, VERGÈZE**

- Dir. Art.4, 4, b : « *Any Member State may...provide that a trademark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that : b) rights to... or to **another sign used in the course of trade** were acquired prior to the date of application for registration of the subsequent trademark... and that... other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark »*
- CTMR, art. 8,4 : « *Upon opposition by the proprietor of a non-registered trademark or **of another sign used in the course of trade of more than mere local significance**, the trade mark applied for shall not be registered. »*



2. The local community name Vs/ the trade mark **PARIS, NICE, VERGÈZE**

- **Earlier rights ?**
- ITALY, Codice de la propriet  industriale, Art.12, Novit 
- UK, Trade Marks Act 1994, Art. 5.4
- Spain, Ley 17/2001, Chap. III, Art.6



2. The local community name Vs/ the trade mark **VERGÈZE**

- CAA Marseille, 5^e ch., 14 Feb. 2013, Sté Nestlé Waters/Cne de Vergèze
 - Source Perrier
 - City Council is entitled to change the name of a spot in a locality

3. With a little help from the trademark BARCELONA, St TROPEZ

- The registration of the local community name as an **ordinary trademark** by the City Council
- Are third parties entitled to use the city name to inform people about their activity ?
- TGI Draguignan 21 August 1997, **Saint-Tropez**
- WIPO, Case No. D2000-0505, **Barcelona**



3. *With a little help from the trade mark* ZERMATT, TENERIFE, DAVOS

- **Limits**
- Dir. Art. 6, 1, b ; CTMR, art. 12, b : *A community trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade : ... b) indications concerning the kind, quality, quantity, intended purpose, value, **geographical origin**, ... or other characteristics of the goods or service. »*
- ECJ, 7 Jan. 2004, C-100/02, Gerossteiner Brunnen, §27 (Gerri/Kerry Spring) : *« the proprietor of the trade mark, pursuant to Art. 5 Dir., prevent the use of the indication of geographical origin only if that use is not in accordance with honest practices in industrial or commercial matters. »*



3. With a little help from the trade mark ZERMATT, TENERIFE, DAVOS

- Respondent may demonstrate rights or legitimate interests in the contested Domain Name
 - WIPO, Case No. D2007-1318, Zermatt ; Case No. D2000-0617, St Moritz ; Case No. D2003-0525, Tenerife
 - ADR.eu, 13 Aug. 2007, 04646, Davos
 - Versailles 13 sept. 2007, Sem Issy Média



3. With a little help from the trade mark New solutions : FRANCE

- New bills 2011-12 (AN, n° 4141, n°329, n° 262)
 - New IGP for products non alimentaires
 - Any applicant must inform the local community
 - A local community is entitled to oppose the registration of a sign corresponding to its name
- IPC L715-1 : Collective trade mark ?
 - Descriptiveness



Europe *Community collective marks*

- CTMR, Art.66 (2) : *In derogation from Article 7 (1)(c), signs or indications which may serve, in trade, **to designate the geographical origin of the goods or services** may constitute Community collective marks... A collective mark shall not entitle the proprietor to prohibit a third party from using in the course of trade such signs or indications, provided he uses them in accordance with honest practices in industrial or commercial matters...*