



Newsletter
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▶ A new law proposal to modernize the fight against counterfeiting

Confronted with the lack of adequacy of our anti-counterfeiting legislation to the opening of borders and online trade, a law proposal aiming at modernizing it was submitted on June 15, 2021 to the National Assembly. It comprises several themes divided into 4 chapters, for a total of 23 articles.

The first chapter is devoted to strengthening the involvement and coordination of public actors in the fight against counterfeiting. To this end, the proposal provides for the creation of an interministerial delegate and a national anti-counterfeiting coordination unit. The proposal also strengthens the analysis role of the French trademark Office (INPI) with regard to counterfeiting.

Chapter 2 aims at facilitating and optimizing the action of those involved in the fight against counterfeiting, in particular through the creation of various measures intended to tackle the infringement of a trademark owner's rights on the Internet. For example, as summarized in the introduction to the proposal, "*several measures to warn or facilitate the blocking of pages or websites offering counterfeiting products for sale*".

Chapter 3 proposes to strengthen the intervention capacities of customs by creating a customs reserve inspired by the reserves of the gendarmerie, the army and the police.

Chapter 4 finally proposes other means of fighting counterfeiting, in particular various experiments: report on the acquisition, by the municipal police, of manufactured tobacco products sold in the street, class action for consumer defense associations, or creation of a jurisdictional chamber dedicated to disputes relating to online trade. Finally, it proposes a mechanism for evaluating the various experiments.

To be continued...

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\\ The authorization of the photographed person is required as soon as his/her image is captured

The French Supreme Court, in a decision of June 2, 2021, recalled that *"the right that the person has on his/her image covers its capture, its conservation, its reproduction and its use and that the mere finding of an infringement opens the right to compensation"*.

In this case, magazine LUI had published a photograph of Leonardo DiCaprio, taken without authorization on a beach "in a leisure time".

The actor sued magazine LUI and the agency KCS Presse which had taken the photograph. The Court of Appeal dismissed his claims on the grounds that *"in the absence of any proof of the marketing of this photograph to company LUI, it is not demonstrated that company KCS Presse committed a fault with regard to Leonardo Di C."*

The Supreme Court, on the basis Article 9 of the Civil Code and Article 8 of the Convention for the Protection of Human Rights and Fundamental Freedoms, censured this interpretation.

This decision is in line with case law of the ECHR, according to which *"As a person's image is one of the characteristics attached to his or her personality, its effective protection presupposes (...) obtaining the consent of the person concerned at the time the picture is taken and not simply if and when it is published"*.

\\ On the importance for influencers to warn their community when their content is advertising

In January 2018, French influencer Nabilla *"promoted trading training services offered by a website specialized in the sale and purchase of bitcoin"* in a story on the social network Snapchat, failing to specify that such advertising was paid for by the companies operating the website at issue.

According to the Directorate-General for Competition, Consumer Affairs and Prevention of Fraud (DGCCRF), the failure to indicate the advertising nature of Nabilla's publication constitutes a misleading commercial practice that could lead her subscribers to believe that this promotion is the result of a positive and disinterested personal experience. This is all the more true since Nabilla praised the many advantages of this service in the same "story". Such statements were, according to the DGCCRF, *"likely to mislead the consumer as to the characteristics of the service and the results expected from its use"*.

Nabilla agreed to pay the €20,000 fine proposed by the DGCCRF.

Guerlain is granted registration of its three-dimensional trademark consisting of the shape of a lipstick

In a judgment of July 14, 2021, the European Union General Court overturned the EUIPO's decision rejecting the application for a European Union trademark on a three-dimensional sign. The relevant public with a medium to high level of attention "*will be surprised by this easily memorable shape and will perceive it as diverging significantly from the norm and habits of the lipstick industry in a position to indicate the origin of the products concerned*".

The Court recalls that a three-dimensional trademark "*must necessarily diverge significantly from the norm or custom of the sector concerned in order for it to have a distinctive character*".

The Court points out that the fact that the shape in question has a good design does not necessarily mean that a trademark consisting of that shape is to be distinguished from those of other companies. However, that aesthetic aspect may be taken into account, "*provided that that aesthetic aspect is understood as referring to the objective and uncommon visual effect produced by the specific design of that mark*".

In this case, the Court retains the distinctive character of the trademark, considering that the shape for which Guerlain applied for registration, similar to that of a ship's hull or a bassinet, is "*uncommon for a lipstick and differs from any other shape existing on the market*", most often adopting cylindrical and parallelepiped shapes.