



Demonstrating reputation - a long winding road for trademark owners

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By:

It is globally recognized that well known and famous trademarks enjoy a broader scope of protection which goes beyond the specialty principles governing trademarks. The European trademark reform adopted in late 2015 strengthened the protection of trademarks with reputation, notably by providing that such trademarks may validly serve as a basis for opposition or cancellation (through an action for invalidity) directed against an identical or similar mark applied for or registered at a later date, "irrespective of whether the goods or services for which it is applied are identical, similar to or not similar to those for which the earlier mark is registered".

Well known and famous trademarks are usually defined as trademarks known by a large portion of the public and that can be immediately recognized as relating to the products and services for which they are used.

A recent French case law reminds us that defending trademarks with reputation is far from being an easy task and that courts are not particularly complacent about trademark owners' reputational claims. Trademark owners have to demonstrate, with clear and convincing evidence, that their trademark benefits from a high level of awareness among the relevant public – in particular, by providing proofs of the market share held by the trademark; the intensity, geographical extent and duration of the mark's use; and the size of the investment made in promoting it in the relevant country. It must also be taken into account that reputation may vary over time and that this can have an impact on the outcome of the actions.

In a perfect example of the difficulties trademark owners may face in demonstrating reputation, on February 8, 2017, the French Supreme Court rendered an important decision in a case involving the CHRISTIAN LACROIX trademark. In this decision, the Supreme Court held that trademark owners cannot rely only on past reputation – indeed, reputation must be constantly nurtured.

In this trademark infringement case, the Christian Lacroix company was claiming reputation of its CHRISTIAN LACROIX trademark in the fashion and haute couture areas against a company selling furniture bearing the mark "designed by Mr. Christian Lacroix". To dismiss the CHRISTIAN LACROIX trademark reputation claim, the Supreme Court noted that, at the time the mark "designed by Mr. Christian Lacroix" was used (i.e., in early 2011), the CHRISTIAN LACROIX trademark was no longer being used for haute couture clothing. It was essentially being exploited, via licensing abroad, for lingerie and accessories. The Supreme Court also took into account that the trademark did not have the same reputational aura it had enjoyed in the past and was no longer immediately associated with the haute couture.

The reputation the trademark CHRISTIAN LACROIX formerly had when used for haute couture was therefore held to be insufficient by the Supreme Court, because the Christian Lacroix company failed to demonstrate that the reputation of its trademark had remained strong at the time when the contested mark was put into use.

This decision is a reminder that everything comes with a price. With greater protection comes a greater burden of proof. Trademark owners who intend to claim reputation must be ready to afford it, not only by providing actual evidence but by doing the longterm brand-building work to maintain and promote an appropriate level of awareness in the public mind. Without being tended, a powerful reputation can fade away, and so can the protections it confers.