

CABINET REGIMBEAU

Propriété Intellectuelle

Conseils en Propriété Industrielle

European Patent and Trademark Attorneys

Intellectual Property Rights - France

Session 7: 2.00pm – 3.30pm

AIDV Annual Conference « Agreements between
Producers and Suppliers »



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Which IP rights may be protected?

■ Trademarks

- France: First to file system, no recognition of unregistered rights.
- *Words, phrases, family names, geographic names (except for AOC or 'indications de provenance'), slogans, pseudonyms, letters, numbers, logos, labels, designs.*
 - Difference between *indications de provenance* and geographic names

■ Copyright

- No need to register – automatic protection (70 years after the death of the author)

Protecting these rights

- Filing a trademark application.
 - Cannot register an AOC: Public right, not private.
 - *A name constituting an AOC or any other mention evoking the AOC can never be employed for a similar product.*
 - Cannot use for trademarks, mentions of products or on the products accompanying their sale, a trading name or sign, business name, or as a domain name.
 - Romanée Conti
 - Château de Marcillac Vallon (24 Nov 2008).

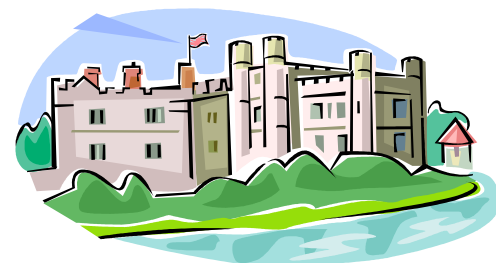
What cannot be registered ... ?

- However, a trademark containing an AOC may be registered, where the other elements of the TM are distinctive.
 - NB. No disclaimers in France.
- Not possible to register the name, image or repute of a local authority.



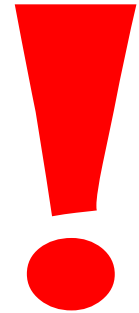
What cannot be registered ... ?

- It is forbidden to use, in respect of wines, the words *Clos*, *Château*, *Domaine*, *Tour*, *Mont*, *Côte*, *Cru*, *Monopole*, *Moulin*, *Camp*, unless the wines to which the words are to be applied :
 - benefit from an AOC; and
 - originate from an agricultural exploitation in real existence, and where there is a place, exactly qualified by these words or expressions.



Some risks ...

- Refusal by Trademarks Office
- Oppositions
 - Owners of prior rights
 - Loi Evin
- Actions for Nullity
- The importance of clearance searches!



The importance of *using* a TM

- An owner who, without good reason, has not put his trademark to genuine use in connection with the goods and services for which it is registered during an uninterrupted period of five years, shall be liable to revocation of this rights.
 - Use which is use of the trademark as registered
 - Use a trademark and not as a trade name
 - Non-descriptive use
 - Authorised use
 - Use in respect of the goods or services to which the registration relates.



What can this mean?

- CONTRACTS!!!
- Regularising the situation
 - To whom do the rights currently belong?
 - Copyright : Identify the author of the works?
 - Has there been an assignment? What does the assignment cover?
 - Take care: Assignment prior to filing of trademark, where an image, or a label containing an image is filed.

EXAMPLE CLAUSE: The Assignee shall have the right to assume, takeover or pursue, on its own behalf, at its risks and for its benefit, as plaintiff as well as defendant, all rights, pending cases, proceedings or action relating to the Trademarks, including the right to sue in the event of any past or future infringement of the Trademarks.

Trademarks and Contracts

- Address the question of trademark ownership at a contractual level – Acknowledgment of rights
- To whom do the rights belong?
 - Vigneron, Viticulteur, Wine cooperative, Union, Dealer/Distributor
- Who has the right to use the trademarks?
 - Trademark owner? Licensee? Both?
- Who has the right to file the domain name?

Non-Challenge Clauses

- Non-Challenge clauses
 - No filing of oppositions, challenges to validity of registrations.
 - No filing of similar trademarks in respect of similar goods or services



Warranties

- Warranties
 - That the owner is the true owner of the rights.
 - To the best of the owner's knowledge, there is no infringement of third party rights
 - That the owner has the right to license/assign the rights
 - Risks associated with co-ownership agreements

EXAMPLE CLAUSE: The Licensor warrants to the Licensee that:

- (a) It has full right and title to the Trademarks
- (b) To the best of its knowledge, the use by the Licensee of the Trademarks will not infringe any trade mark, copyright or other intellectual property rights of any person;
- (c) That it has not entered into any agreement or arrangement involving the sale, mortgage, granting of options or any other rights relating to its rights, title and interest in the Trademarks.

Protecting the Trademark

- Guarantee by the licensee that it will use the trademark:
 - As a trademark
 - Non-descriptive use
 - In form as registered
 - Graphics chart?

EXAMPLE CLAUSE: The Licensee agrees to use the Trademark in a form identical to that which is set out at Schedule A to this Agreement.

EXAMPLE CLAUSE: The Licensee undertakes, for the entire duration of the Agreement, to use the Trademark as it has been filed, in an effective, serious, loyal and continuous manner, and in a manner which does not damage the reputation of the Licensor.

Maintaining the Trademark

- Maintaining the trademark
 - Prosecution of application?
 - Payment of renewal fees, attorney fees?

EXAMPLE CLAUSE: The Licensor undertakes, for the entire duration of the Agreement, to maintain in validity the Licensed Trademarks.

The Licensee agrees to execute all documents, provide all assistance to provide all assistance, and to do all acts as may be required to maintain in validity the Licensed Trademarks.



Rights of action

- Rights to take action:
 - In response to an opposition, or to file an opposition
 - In response to a challenge to validity
 - For infringement of rights
 - Do these rights accrue to the trademark owner or the party using the trademark?
 - How are the costs to be borne?
 - Which party will benefit from the award of damages, or settlement monies?
 - Does one party have the option to take action where the other does not wish to do so?

Rights of action

EXAMPLE CLAUSE: Infringement actions against third parties will be brought by the Licensor in its own name and at its own expense, with the technical assistance of the Licensee, except where the Licensor does not wish to intervene and expressly authorizes in writing that the Licensee may act alone, on its behalf and at its own expense.

EXAMPLE CLAUSE: In the event that the infringement action is to be undertaken jointly, all costs, risks and benefits resulting will be supported and benefited from equally by the Parties.

Other relevant clauses

- Protection of goodwill established by distributors
 - Goodwill – not recognised in France.
- Option to purchase trademark at the termination of the contract?
- Termination clauses ...
 - Delays for disposing of branded stock

Thank you!

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