



# FAMOUS MARKS IN THE WINE SECTOR AND THEIR ENFORCEMENT

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# FAMOUS MARKS IN THE WINE SECTOR AND THEIR ENFORCEMENT



Novagraaf

## DEFINITION OF A FAMOUS TRADEMARK

- Marks with reputation
- Well-known marks

## HOW TO PROVE THE FAMOUS CHARACTER?





## DEFINITION OF A FAMOUS TRADEMARK

- **Marks with reputation**

Art. 8.5 EUTMR: “Upon opposition by the proprietor of a **registered** earlier trade mark (...), the trade mark applied for shall not be registered where it is identical with, or similar to, an earlier trade mark (...), where, in the case of an earlier EU trade mark, the trade mark has a **reputation** in the Union or, in the case of an earlier national trade mark, the trade mark has a **reputation** in the Member State concerned”

→ Necessary condition = registration



## DEFINITION OF A FAMOUS TRADEMARK

- **Well-known marks**

Art. 8.2 EUTMR: “earlier trade mark means:

(c) trade marks which, on the date of application for registration of the EU trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the EU trade mark, are **well known** in a Member State, in the sense in which the words ‘well known’ are used in Article 6bis of the Paris Convention.”

Art. 6bis PC: “a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention”

→ No legal definition



## DEFINITION OF A FAMOUS TRADEMARK

- **Well-known marks**
  - Requirement of registration serves to mark the border between Article 8(5) EUTMR and Article 8(2)(c) EUTMR
  - However, neither Article 8(2)(c) EUTMR nor Article 6bis of the Paris Convention stipulate expressly that the well-known mark has to be a non-registered mark
  - But results indirectly both from the spirit and the ratio legis of these provisions



## HOW TO PROVE THE FAMOUS CHARACTER OF A MARK?

- **Marks with reputation**

Judgment of the Court - 14 September 1999 – “CHEVY”  
General Motors Corporation v Yplon SA.

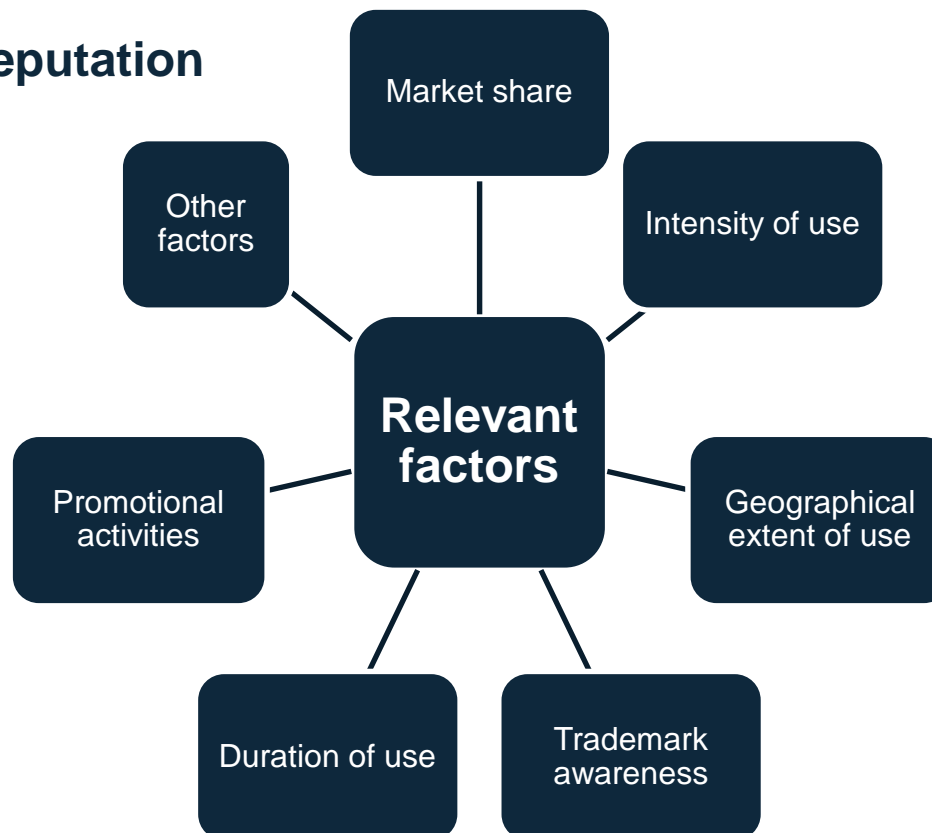
- implies a certain degree of knowledge of the earlier trade mark among the public
- principally assessed on the basis of quantitative criteria
- any qualitative aspects

➔ A sign does not enjoy any reputation inherently, for example, simply because it refers to a renowned person or event, but only for the goods and services it designates and the use that has been made of it



## HOW TO PROVE THE FAMOUS CHARACTER OF A MARK?

- **Marks with reputation**





## HOW TO PROVE THE FAMOUS CHARACTER OF A MARK?

- **Well-known marks**

Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks

→ take into account any circumstances from which it may be inferred that the mark is well known

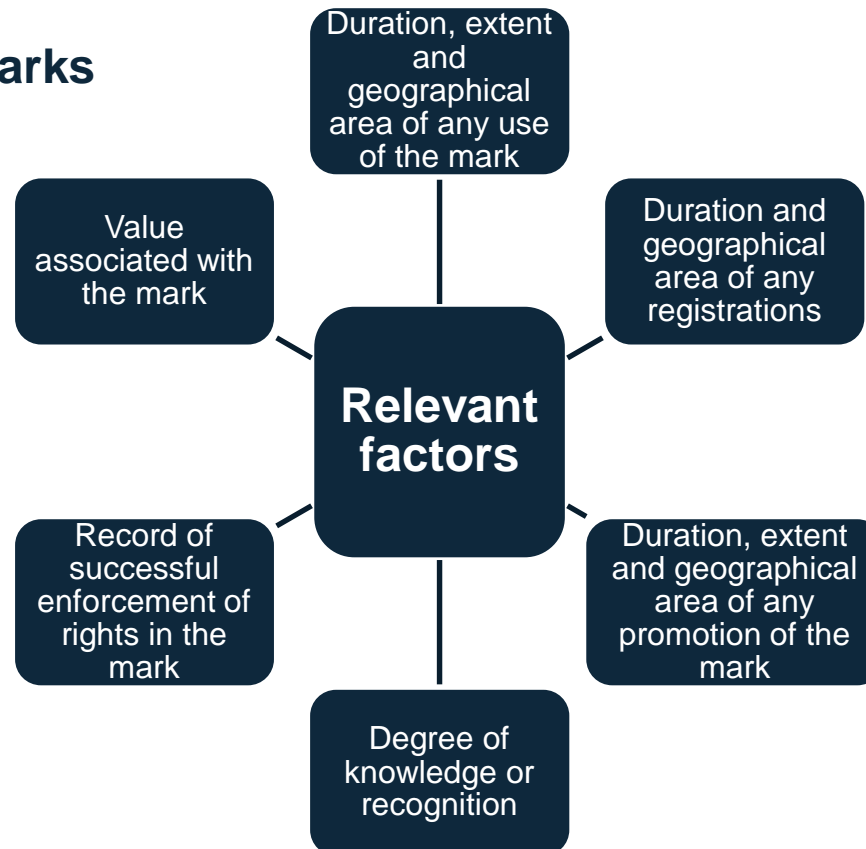




## HOW TO PROVE THE FAMOUS CHARACTER OF A MARK?

- **Well-known marks**

Relevant factors:





## HOW TO PROVE THE FAMOUS CHARACTER OF A MARK?

- The threshold for establishing whether a trade mark is well known or enjoys reputation will usually be the same
- Substantial overlap between them

Judgment of the Court - 14 September 1999 – “CHEVY”

a “...nuance, which does not entail any real contradiction ...”

# FAMOUS MARKS IN THE WINE SECTOR AND THEIR ENFORCEMENT



- Repercussions on the grounds of opposition or invalidation action
- I. The famous marks and the protection of the public
- II. The famous marks and the protection of their owner





## I. THE FAMOUS MARKS AND THE PROTECTION OF THE PUBLIC

### I. The recognition of the risk of confusion

- ❖ The famous character of a trademark may **enhance the distinctiveness** of marks with little or no inherent distinctiveness or those that are inherently distinctive (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18)

Earlier mark	Contested sign	Case No.
CRISTAL		17/11/2003, R 37/2000-2

“[the Board] considers that a highly distinctive character of the mark CRISTAL on the French market had been shown”



## I. THE FAMOUS MARKS AND THE PROTECTION OF THE PUBLIC

### I. The recognition of the risk of confusion

OPPOSITION NO: 628/2013 - 26-01-2016 – PETRUS v PETRO (Italy)

“As evidence of those facts, a series of articles and photographs of the products extracted from the Internet was attached to the brief. For these reasons, together with the fact that there is no reference between the previous mark [PETRUS] and the products it protects, the same must be regarded as having an increased distinctiveness.”



## I. THE FAMOUS MARKS AND THE PROTECTION OF THE PUBLIC

### I. The recognition of the risk of confusion

- The famous character of a trademark may **allow a protection for non-registered trademarks** (art. 6bis Paris Convention)
  - Useful especially in China, regarding the protection of the non-registered Chinese translation of famous trademarks



## I. THE FAMOUS MARKS AND THE PROTECTION OF THE PUBLIC

### I. The recognition of the risk of confusion

EUIPO Opposition No. B1898751 YELLOW LABEL

→ the evidence filed shows that the earlier mark, 'YELLOW LABEL' was well-known by the relevant sector of the public within the relevant period of time in relation to the goods in Class 33: AOC wines (wines with protected appellation of origin), namely Champagne.



## I. THE FAMOUS MARKS AND THE PROTECTION OF THE PUBLIC

### II. The limits to the recognition of the risk of confusion

- ❖ The difficulties to prove the famous character of a trademark
  
- It is up to the person claiming it to prove the famous character of a trademark (see supra)





## I. THE FAMOUS MARKS AND THE PROTECTION OF THE PUBLIC

### II. The limits to the recognition of the risk of confusion

- ❖ The difficulties to prove the famous character of a trademark

Ex.: Important market player in some countries, such as the United Kingdom, not relevant in itself. No indication of the degree of knowledge of the sign in Switzerland by the consumer in relation to wine. No surveys presented. No indication that the trademark has been intensively advertised in Switzerland or that the Swiss recipients have been aware of intensive use of the trademark abroad (IPI 18/01/2016, 14520 ACCOLADE WINES v L'ACCOLADE)



## I. THE FAMOUS MARKS AND THE PROTECTION OF THE PUBLIC

### II. The limits to the recognition of the risk of confusion

- ❖ The difficulties to prove the famous character of a trademark

Ex.: Even if the notoriety or reputation of the wine brand has already been recognized by administrative or judicial decisions, it is preferable to continue to make investments in advertising, sponsorship or patronage, in order to be able to establish that the notoriety or reputation has been maintained among the public (Venice Court of Justice, n. 2355/2018, 31/10/2018, MHCS / Moët Hennessy Italia v Masottina SpA, champagne Veuve Clicquot).



## I. THE FAMOUS MARKS AND THE PROTECTION OF THE PUBLIC

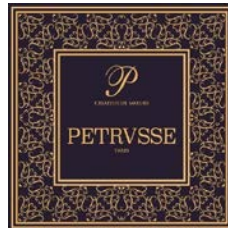
### II. The limits to the recognition of the risk of confusion

#### ❖ The limitation to similar goods and services

→ Recognition of a famous mark may extend the recognition of similarity to more distant goods or services

→ However there still must exist a link between the goods and services

Ex.: PETRUS v



→ Accepted for vinegar

→ Refused for Coffee or Tee



## I. THE FAMOUS MARKS AND THE PROTECTION OF THE PUBLIC

### II. The limits to the recognition of the risk of confusion

- ❖ The famous character of a trademark involving a lack of risk of confusion

UIBM n. 161/2015, 16/07/2015, CHATEAU AUSONE v AUSONA ITALIAN WINE PASSION : The differences between the trademarks are sufficient to exclude any risk of confusion due to:

- Different categories of consumers: consumers who like great wines vs. general public
- The public can perceive the difference in the origin of the products (important in terms of wine)

Another trend is that the consumer is not an expert in the sector.  
Everyday consumer product = audience of average attention



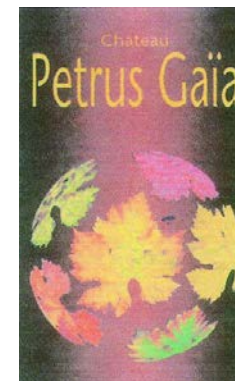
## I. THE FAMOUS MARKS AND THE PROTECTION OF THE PUBLIC

### II. The limits to the recognition of the risk of confusion

- ❖ The famous character of a trademark involving a lack of risk of confusion

Bordeaux, 21/11/2015, PETRUS v PETRUS GAIA

“the worldwide reputation of Château PETRUS, which produces wines with AOC POMEROL, is in itself such as to avoid any risk of confusion in the mind of the consumer with a trademark applied for wines with AOC BORDEAUX SUPERIEUR”





## I. THE FAMOUS MARKS AND THE PROTECTION OF THE PUBLIC

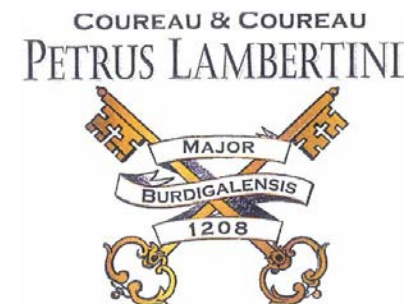
### II. The limits to the recognition of the risk of confusion

- ❖ The famous character of a trademark involving a lack of risk of confusion

Cass. Crim., 12/06/2019, PETRUS v PETRUS LAMBERTINI

“the Coureau brothers and their company have made clever use of the trademark they have filed and which has been validated despite the opposition of the civil party, with the obvious aim of attracting the customer's attention but that attracting the customer's attention does not mean deceiving him or risking to deceive him”

- Different appellation of origin
- Addition of LAMBERTINI
- Known that PETRUS has no second wine
- Difference of price





## II. THE FAMOUS MARKS AND THE PROTECTION OF THEIR OWNER

### I. The traditional requirements

❖ Absence of similarity of the goods

→ The protection provided by this provision is 'irrespective of whether the goods or services for which [the later mark] is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered



## II. THE FAMOUS MARKS AND THE PROTECTION OF THEIR OWNER

### I. The traditional requirements

- ❖ Absence of similarity of the goods

Paris, September 17, 2008 MOET & CHANDON v MEXX « Dom Perignon »  
“The use of this famous trademark among various decorative elements representing, in addition to graffiti, ordinary items such as lipstick, iron, shoes, on a common cotton t-shirt offered for sale for a unit price of 29.90 euros is likely to demean, popularize and depreciate it in the eyes of the public, thus causing damage to the prestige that is attached and thereby to its economic value”





## II. THE FAMOUS MARKS AND THE PROTECTION OF THEIR OWNER

### I. The traditional requirements

- ❖ Absence of similarity of the goods

EUIPO Opposition No B1593014, November 30, 2010, COINTREAU v Edouard COINTREAU

“On account of the exceptionally high reputation of the opponent’s marks, the fact that the contested mark reproduces the earlier trade marks will necessarily create an immediate mental link between the signs in the consumers’ mind, even if seen on different goods and services in classes 20, 25, 41 and 42. This is further reinforced by the fact that both the opponent’s and the applicant’s goods basically concern public at large and that due to the opponent’s sponsorship activities the relevant public is used to also see the earlier marks in connection with different fashion, cultural and design events. It is therefore conceivable that the relevant public of the opponent’s goods may overlap with the public of the contested goods.”



## II. THE FAMOUS MARKS AND THE PROTECTION OF THEIR OWNER

### I. The traditional requirements

#### ❖ The similarity of the signs

→ A certain degree of similarity between the signs must be found

→ Similarity should be assessed according to the same criteria: visual, aural or conceptual similarity



## II. THE FAMOUS MARKS AND THE PROTECTION OF THEIR OWNER

### I. The traditional requirements

#### ❖ The similarity of the signs

Cassazione civile, 04/02/2016, n. 2191, CASTELLA v RENZO CASTELLA :  
In the specific wine sector, there is a frequent presence of companies marketing the same product, using their corporate name or almost homonymous brands. Thus, in the specific productive sector in question - the family name has a minor distinctive value, the addition of the first name to the family name, especially if it is accompanied by other descriptive elements, is sufficient to exclude confusion of the distinctive signs of different companies



## II. THE FAMOUS MARKS AND THE PROTECTION OF THEIR OWNER

### II. Special requirements

- ❖ Link between the signs
  - The mere fact that the marks in question are similar is not sufficient for it to be concluded that there is a link between them
  - The goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public



## II. THE FAMOUS MARKS AND THE PROTECTION OF THEIR OWNER

### II. Special requirements

- ❖ Link between the signs

Court of Florence, 26 April 2016, SOLAIA v. SOLAIO:

Counterfeiting but not on the basis of the well-known/renowned trademark because the SOLAIA trademark, although widely recognized, did not possess a "certain evocative power, a specific symbolic value" that transcended the sector of goods to which it belonged and that the use of the SOLAIO trademark for dissimilar goods and services therefore did not present a risk of dilution of the trademark.



## II. THE FAMOUS MARKS AND THE PROTECTION OF THEIR OWNER

### II. Special requirements

#### ❖ Risk of injury

→ Unfair advantage: free-riding, riding on the coat-tails

→ Detriment to distinctiveness: dilution by blurring

→ Detriment to repute: dilution by tarnishing

➔ Difficulties to prove the injury when it is only potential



## II. THE FAMOUS MARKS AND THE PROTECTION OF THEIR OWNER

### II. Special requirements

#### ❖ Risk of injury

Cass. Civ. Sec. I, n. 26000, 8/06/2018 (Italy) :

- Dilution = when its ability to identify the goods or services for which it is registered is impaired
- Unfair advantage = the notion is closer to the advantage to the third party of using the sign identical or similar to the mark, rather than the damage suffered by the mark



## II. THE FAMOUS MARKS AND THE PROTECTION OF THEIR OWNER

### II. Special requirements

- ❖ Use without due cause
- up to the applicant to show that it has due cause to use the mark applied for
- lack of due cause must be generally presumed

30/07/2007, MARTINI FRATELLI (fig.) / MARTINI R 1244/2006-1

The Board of Appeal confirmed that the applicant had two good reasons for using the name MARTINI in the trade mark applied for: (i) MARTINI is the family name of the founder of the applicant's company, and (ii) the existence of a coexistence agreement dating from 1990.





**THANK YOU FOR YOUR  
ATTENTION**

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