

NEWSLETTER

IP / MEDIAS



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The ECJ affirms that the liability of the operator of a hybrid online sales site can be engaged under certain conditions in case of advertisements for counterfeiting products from third party sellers.



INTELLECTUAL PROPERTY LATEST NEWS

Louboutin / Amazon Case: Liability of the online sales platform displaying ads of counterfeiting products from third-party sellers

ECJ, Dec. 22, 2022, joined cases C-148/21 and C-184/21

This decision follows the filing before the Luxembourg and Belgian courts by Christian Louboutin of two actions for infringement of its trademark against Amazon, which presented on its website advertisements from third party sellers for infringing red-soled shoes.

Both courts decided to stay the proceedings in order to ask ECJ for a preliminary ruling. The question was whether Amazon can be held liable as the operator of a hybrid website, which, in addition to its own advertisements, includes an online marketplace for third-party sellers. If so, the court was asked to determine the relevant criteria to be taken into account.

ECJ states that the liability of an operator of a hybrid sales website can be held in case of advertisements for infringing products of third party sellers if a reasonably informed and reasonably attentive user is likely to establish a link between the services of that operator and the offers of infringing products of third party sellers. This assessment is made in concreto through relevant criteria such as (i) the uniformity of the presentation of the offers, (ii) the presence of the marketplace's logo on the third-party ads and (iii) the existence of additional services consisting in providing support to the third-party seller in the presentation of their advertisements, and in stocking and shipping the goods offered on the same marketplace.

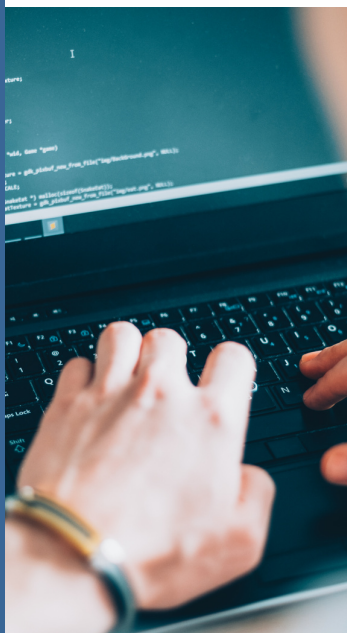
In conclusion, if the way in which the advertisements are presented on a marketplace does not make it possible to clearly distinguish the offers of the operator of the site from those of third-party sellers, the commercialisation of infringing products by the latter can be imputed to the operator itself.

**Invalidity of a writ of summon for software copyright infringement too imprecise**

Nanterre Judicial Court, 1st Ch., Dec. 14, 2022

The publisher Dassault Systemes Solidworks sued its client Emitech for copyright infringement, alleging that it held insufficient licenses for its CAD software "Solidworks".

Emitech claimed the nullity of the summons due to a formal defect, as it did not contain any development allowing to demonstrate the originality of the software's source code. The Court declared the summons invalid, considering that the alleged formal defect caused the defendants a disadvantage in that they were unable to defend themselves effectively, as they were unable to prove the opposite : the lack of originality.



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Reminder of the conditions of infringement of a renowned trademark

In two decisions, the EU General Court recalls the distinct and cumulative conditions for rejecting the registration of a trademark on the basis of infringement of a prior renowned trademark pursuant to Article 8(5) EUTMR. Under this article, it must be shown cumulatively that **(1)** the signs at stake are identical or similar; **(2)** the prior mark has a reputation in the Member State in question or in the EU; **(3)** undue advantage has been taken of the distinctive character or of the reputation of the prior mark or of the prejudice caused to it; and **(4)** there is a link in the mind of the relevant public between the conflicting marks.

No violation of the renowned PUMA trademark

EU General Court, Dec. 7, 2022, n° T-623/21

PUMA, on the basis of its semi-figurative EU trademark "**PUMA**", registered in class 25, filed an opposition against the application for registration of the EU trademark "PUMA" filed by the VAILLANT company in class 11 for lighting equipment and heating appliances, considering that this application infringed its renowned trademark.




The Opposition Division and then the Board of Appeal of the EUIPO dismissed PUMA's action, which then appealed the decision to the General Court of the ECJ.

The General Court considered that although PUMA prior trademark was particularly well known to the public, the goods at stake did not concern related market sectors, thus there was no risk of association between the signs by the consumers. Due to the lack of this requirement, the General Court confirmed there was no violation of the renowned PUMA trademark.



No violation of the renowned ROLEX trademark

EU General Court, Jan. 18, 2023, n° T-726/21

ROLEX, on the basis of two of its EU figurative marks " " and " " registered in class 14, filed an opposition against the application for international registration designating the EU of the figurative sign " ", filed by the intervener PWT in class 25 "*clothing, footwear, headgear*".

The Opposition Division and then the Board of Appeal of the EUIPO dismissed ROLEX's action, which then appealed the decision to the General Court of ECJ.

According to the General Court, the existence of the infringement of the renowned trademark has not been demonstrated. The applicant has to prove there is a serious risk that one of the types of injury referred to in Article 8(5) of Regulation No 207/2009 will occur in the future. In the present case, the General Court considered that this proof was not provided.

INTELLECTUAL PROPERTY LATEST NEWS

3D trademarks and motion trademarks: clarification of distinctiveness and genuine use

On the distinctiveness of a 3D trademark

EUIPO, Dec. 5, 2022, R 1305/2022-5

The Board of Appeal of the EUIPO ruled on the distinctiveness of a 3D trademark representing a corkscrew in the shape of a bone, filed in STL format allowing the dynamic representation of the 3D trademark.

The EUIPO first refused to register the trademark for lack of distinctiveness, considering that the shape appearing on the graphic representation chosen in the application for registration did not diverge significantly from existing shapes on the concerned market.

The Board of Appeals, on the other hand, stated that all the views of the file in STL format must be taken into account in the assessment, and not only the chosen representation of it appearing in the application. The Board of Appeals found that the trademark in question deviates significantly from what can be found on the market. The distinctive character is thus retained.

On the genuine use of a 3D trademark

EU General Court, Dec. 14, 2022, n° T-553/21

The applicant, Agrarfrost, filed an application seeking revocation for non-genuine use of a 3D EU trademark reproducing a smiley face for McCain French fries.

The General Court ascertained the actual use of the 3D trademark for the goods in question. Indeed, in order to determine whether there is genuine use of the trademark, the General Court recalled it is necessary to assess whether the relevant public perceives the shape as a commercial indication of origin. The General Court found that McCain successfully demonstrated that the consumer is able to associate the 3D shape with McCain company. It relies in particular on major advertising campaigns conducted by McCain in the EU. Consequently, the General Court states that the contested trademark fulfils its essential function.

The distinctiveness of a motion trademark

EUIPO, Dec. 14, 2022, rejection of applications n° 018710078 and n° 018710082

The EUIPO rejects two applications for registration of motion trademarks relating to two sequences representing an oval cheese cut into two pieces and repositioned to create a heart.

The EUIPO recalls that in order to assess distinctiveness, all perceptible elements must be considered and not only those in motion. Consequently, movement or change of position as well as fixed or moving verbal and figurative elements are relevant and constitute an element of the trademark.

The EUIPO considers that the movement of the cheese cut to create a heart does not give the sign an inherent distinctive character. Indeed, a consumer would not be able to distinguish the commercial origin of the cheeses designated in the application for a motion trademark from those commercialized by competitors, that are molded or arranged in a heart.

INTELLECTUAL PROPERTY LATEST NEWS



The EUIPO's approach regarding virtual goods and NFTs in the Nice Classification

EUIPO Communication

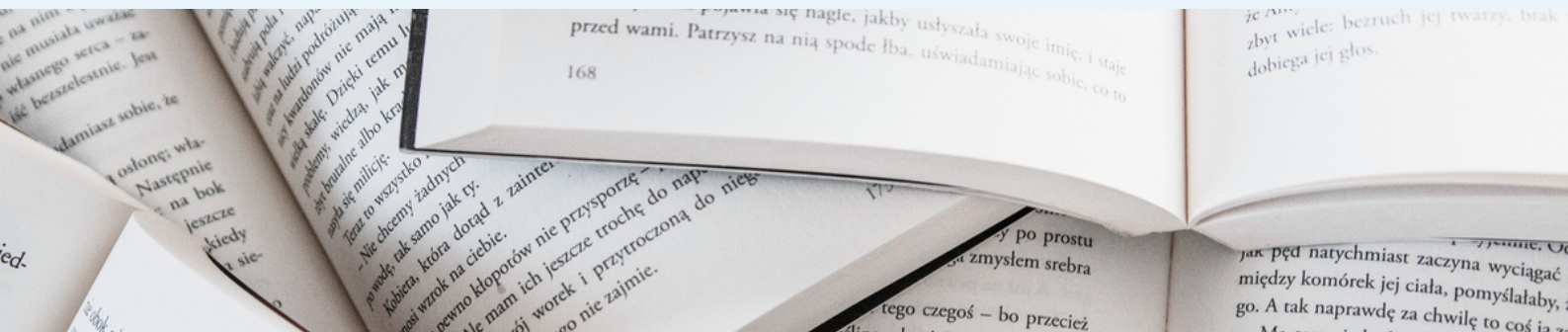
The EUIPO indicates that virtual goods are of the essence of Class 9, but that the term on its own lacks precision and clarity. Therefore, trademark applications for virtual goods will have to specify the content to which the virtual goods relate.

In addition, the 12th edition of the Nice Classification, which came into effect on January 1, 2023, incorporates the term *"downloadable digital files authenticated by non-fungible tokens"* in Class 9. According to the Office, the type of digital item authenticated by the NFT must be specified in the trademark application, as the use of the term "non-fungible token" on its own is not acceptable.

The Office adds that virtual goods and NFTs will also be considered as services under the pre-existing principles in this area.

Signature of an agreement regulating contractual relations between authors and book publishers

Interprofessional agreement of December 20, 2022



This agreement was signed on December 20, 2022 by representative organizations of authors and publishers with the support of the Ministry of Culture.

The parties reached a consensus on six points: the introduction of a half-yearly rendering of accounts; a new rendering of accounts regime for insignificant contributions; the creation of an obligation to inform the publisher in the event of sub-transfer of the work, part of the work or rights to the work; an option to terminate the translation contract in the event of the disappearance of the contract for the transfer of the translated work; the improvement of technical points at the time of the period following the end of the publishing contract; and the modification of the terms and conditions of the provision for returns.

However, no agreement has been reached on the issue of authors' remuneration, which will have to be rediscussed during further exchanges in 2023.

Finally, the agreement specifies that some of its provisions may require legislative or regulatory intervention to allow their generalization.

MEDIA, ENTERTAINMENT AND ADVERTISING LATEST NEWS

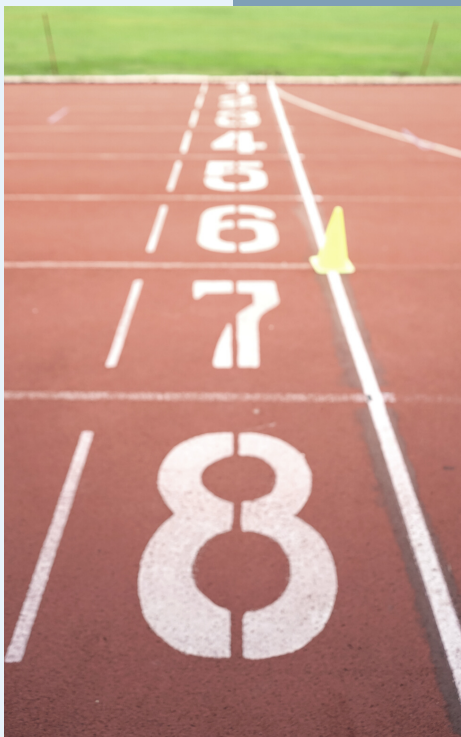
Yuka: information about the risks associated with nitrites is a matter of freedom of speech

Paris Court of Appeal, Dec. 8, 2022, n°21/14555

This litigation opposed ABC Industrie company, specialized in the manufacture of charcuterie, and Yuca company, which developed the "YUKA" application, whose purpose is to inform consumers about the quality of products available on the market. Yuka was accused of having classified ABC Industrie's hams as "bad", particularly given the presence of nitrites in its products. In addition, when the product was scanned, a banner invited users to sign a petition to ban nitrites, presented as an "additive that promotes the development of colorectal and stomach cancer". ABC Industries considered this to be a misleading and unfair commercial practice, disparagement and a call to boycott. It sought damages from Yuca as well as prohibition and publication measures.

On September 13, 2021, the Commercial Court of Aix-en-Provence ordered Yuca to pay damages of €25,000 and to remove any misleading or disparaging content relating to ABS Industries's products as well as any references to the high risk of cancer associated with the use of nitrites in meat products. Yuca appealed the decision.

The Aix-en-Provence Court of Appeal overturned the Commercial Court's judgment, considering that the score attributed to the products was justified by criteria that are perfectly clear to the consumer and that the prohibition of nitrites is a matter of public debate. As a result, Aix-en-Provence Court of Appeal concluded that in publishing this information on its application, Yuca did not exceed its freedom of speech recognized by constitutional and conventional texts.



The use of surveillance based on artificial intelligence systems during the 2024 Olympic Games is authorized.

Legislative file on the 2024 Olympic and Paralympic Games bill

On January 31, 2023, the Senate adopted by a large majority the bill relating to the Olympic and Paralympic Games of 2024, examined under accelerated procedure.

This text authorizes the use of surveillance based on artificial intelligence systems to ensure the security of sports events through the use of "smart cameras" that can detect crowd movements thanks to algorithms. The government has stated that these cameras will not be used for facial recognition. The bill also provides for the possibility of using body scanners at the entrances of stadiums and other sports facilities with a capacity of more than 300 people.

MEDIA, ENTERTAINMENT AND ADVERTISING LATEST NEWS

Regulation of influencers' practices

Bill of Nov. 15, 2022, n° 457

Bill of Dec. 15, 2022, n° 653

Bill of Dec. 27, 2022, n° 672

Three bills have been introduced to regulate the activities of influencers on the Internet. The first one, dated November 15, 2022, aims at regulating commercial and advertising practices related to the online influencer market. The second, dated December 15, 2022, seeks to reinforce prevention of and fight against illicit commercial practices related to the Internet influence market. Finally, the third bill of December 27, 2022 aims to fight against the abuses of influencers on social networks.

Two of these bills propose a similar legal definition of the influencer, the bill of November 15, 2022 also giving a definition of the agent of influencers. This bill proposes to establish a written contract between the agent and each influencer he represents, containing mandatory mentions. The conclusion of a contract between the influencer and the brand he/she collaborates with will also be imposed.

The influencer will also have to mention in a clear and non-equivocal way the existence of a partnership. The bill of December 27, 2022 also prohibits influencers from promoting certain products or services (pharmaceutical products, medical devices, surgical procedures, risky financial investment services). The promotion of subscriptions to sports betting, registration for professional training, gambling and chance games will be subject to prior information.

This bill also aims at establishing more transparency. Indeed, when the influencer is only the intermediary of the actual supplier, he will have to give the potential purchasers the identity of the latter.

These bills emerge in a context of reflexion around the influence sector. In order to discuss the scope of the influencer's profession and to set a framework for this activity, under the impulse of Bruno Le Maire, a public consultation "Influencers / Content creators" has also been launched.

DGCCRF orders BeIN Sport to stop broadcasting Atalanta Bergamo matches

BeIN SPORTS communication

This injunction is justified by the presence on the players' shirts of the logo of a sponsor, the company "Plus500", operating a financial transaction platform.

Article L222-16-1 of the French consumer Code prohibits advertising relating to investment services involving risky financial contracts.

