



INTELLECTUAL PROPERTY LATEST NEWS

SACEM and SCAM use their opt out right

SACEM and SCAM shared their intention to exercise their opt-out rights in order to protect member creators and publishers from the development of AI tools. From now on, entities developing AI tools and using works from the repertoires of these copyright collection societies to train their databases and carry out data mining activities will have to obtain prior authorization and expressly negotiate the conditions of these exploitations.

Mango condemned to 2 million euros damages for free-riding to the prejudice of Celine

Paris Court of appeal, November 10, 2023, No. 21/19126

Celine, famous luxury leather goods company, sued the Spanish ready-to-wear company Mango for unfair competition and free-riding for having copied several of its bag, glasses and jewelry designs.

The Court of Appeal confirmed Paris Judicial Court's ruling and stated that, while these copies taken individually were not at fault, the litigious models were nevertheless strongly inspired by the luxury goods company's models and were for the most part marketed at the same time as those of Celine, which was likely to evoke Celine products in the minds of customers. Thus, Mango took advantage of Celine's reputation to sell its own products, which constitutes parasitic actions, regardless of whether their products are commercially successful or labeled with the MANGO trademark.

Mango is sentenced to 2 million euros damages for the economic and moral harm caused to Celine's reputation and image which is based on luxury and exclusivity.



Entry of the Ile de Ré salt added in the protected geographical indications register

On November 24, 2023, the European Commission approved the entry of the Ile de Ré's Fleur de sel in the protected geographical indications register, joining the list of 1666 food products already protected. Thanks to this distinction, recognized by the Institut national de l'origine et de la qualité (INAO), the traceability of the products of the Ile de Ré's salt merchants is now certain.

INTELLECTUAL PROPERTY LATEST NEWS

Lawful use of a third party's trademark as a keyword in website referencing

Cour of cassation, Octobre 18, 2023, no. 20-20.055

The company owning the trademark "AQUARELLE" sued a rival company for trademark infringement and unfair and parasitic competition for having reserved a keyword identical to its trademark on the referencing website Google AdWords and for using the "Aquarelle" sign in the source code of its website, thereby creating a likelihood of confusion among consumers.

The Court of cassation ruled that the use of the term "Aquarelle" on the referencing website did not infringe one of the essential functions of the trademark. Indeed, there was no use of the sign "AQUARELLE" either on the competitor's online ad, or in the link, or in the URL address. The average Internet user was therefore able to differentiate between the two companies' websites. There was therefore no risk of infringement of the trademark's function as an indication of origin.

Puma against Carrefour : applicant's duty of loyalty in counterfeit seizures

Cour of cassation, December 6, 2023, no. 22-11.071

Puma had requested authorization to carry out a counterfeit seizure against Carrefour for marketing shoes reproducing a figurative element of their trademarks and had sued Carrefour for infringement of its reputed trademarks, counterfeiting and unfair competition.

The Cour de cassation recalled that the applicant presenting a request for seizure of counterfeiting goods must present all the objective facts likely to enable the judge to fully grasp the stakes involved in the lawsuit and to fully exercise his power to assess the circumstances of the case in a proportionate manner. In this case, Puma failed to indicate that Carrefour was indeed the owner of trademarks for the sign in question, and that INPI and EUIPO had already ruled out any imitation of Puma's trademarks, and therefore any likelihood of confusion between the signs. Because of Puma's duty of loyalty failure, the infringement seizure reports were cancelled.



INTELLECTUAL PROPERTY LATEST NEWS

Refusal of protection for advertising photographs in the Leroy Merlin catalog for lack of originality

Douai Court of appeal, November 30, 2023, no. 22/02443

Leroy Merlin commissioned a photography studio to produce advertising shots to promote its garden center products. The photographer sued Leroy Merlin for infringement of copyright for having reproduced the litigious photographs in its catalogs and on its website without authorization after their commercial relationship had ended.

The Douai Court of Appeal stated that, while the photographer had some decision-making power with regard to the layout of the objects, the play of shadows and the colors, the photographs themselves did not create a universe or a particular atmosphere that allowed them to go beyond their advertising purpose, and therefore did not reflect the photographer's personality. The photographs were therefore not protected by copyright.



Jean-Paul Gauthier perfumes: Likelihood of confusion and autonomous distinctive position

Paris Judicial Court, December 1, 2023, No. 23/11158

The owner of the French trademark "DIVINE" sued the company Puig for infringement for identical reproduction of its trademark for identical products under the trademark "GAULTIER DIVINE". In its defense, Puig argued in defense that the GAULTIER DIVINE sign formed a unitary and indivisible whole, rather than a simple identical reproduction of the DIVINE trademark, and highlighted the highly distinctive and renowned GAULTIER element, thereby avoiding any likelihood of confusion with the prior trademark.

The court sentenced Puig for infringement and ordered the company to stop using the DIVINE sign, either alone or in conjunction with other signs. The judges held that the juxtaposition of the "GAULTIER" umbrella trademark was not sufficient to rule out the likelihood of confusion, since the term "DIVINE" kept an autonomous distinctive position in the sign, due in particular to the absence of any combination of meaning between the two words GAULTIER and DIVINE, and the predominant emphasis on DIVINE in the contested representations. The litigious products must therefore be withdrawn from distribution channels in France, and the contested trademark is cancelled. Information on a possible appeal is not yet available.

MEDIAS, ENTERTAINMENT AND ADVERTISING LATEST NEWS

Ad « Buuuuud » violating the Evin law

Paris Court of appeal, October 24, 2023, No. 22/20719

AB Inbev France, the French subsidiary of the Belgian brewery group of the same name, was sued by the Association Nationale de Prévention en Alcoologie et Addictologie (ANPAA) for unlawful use of the "Buuuuud" and "King of Beers" trademarks in advertising.

According to article L3323-4 of the French Public Health Code, authorized advertising for alcoholic beverages is limited to the indication of the alcoholic strength by volume, the origin, name and composition of the product, the name and address of the manufacturer, agents and stockists, as well as the method of production, sale and consumption of the product.

The Paris Court of Appeal stated that the advertisements did not comply with these provisions, because the expression "Buuuuud" was used by soccer commentators and fans, so that the brand created a connivance in the public mind between soccer and beer. Furthermore, the expression "KING OF BEERS" is not a reference to a sales method and represent an encouragement to excessive alcohol consumption. The Court confirms the withdrawal of these advertisements under a fine of 1,000 euros per day of delay and per infringement found and prohibits AB Inbev France from using the disputed slogans

End of strike for Hollywood actors

In our [September-October 2023 issue](#), we reported on the signing of an agreement between the screenwriters' union and US production studios. The actors' union SAG-AFTRA also won its case after 118 days of historic strike action, signing a tentative agreement on December 5, 2023. Actors will benefit from a new remuneration model for secondary actors, guarantees of consent and compensation for the use of AI, and a significant increase in streaming remuneration. Productions paralyzed by the strike should be able to resume in the coming months, after a crisis that has cost the sector at least \$6.5 billion.



Adaptation of the law on influencers to EU law

Bill n°112 containing various provisions for adapting to EU law

In our [June-August 2023 issue](#), we reported on the adoption of the law aimed at fighting against the abuses of commercial influence on social networks. On November 15, 2023, the Ministry of the Economy passed a bill proposing to amend this law in order to take into consideration the remarks expressed by the European Commission as part of the law's notification procedure. The recast of the law is essentially aimed at technical adaptation measures which should have a limited impact on the actual content of the law, enabling above all the removal of articles redundant with the DSA.

MEDIAS, ENTERTAINMENT AND ADVERTISING LATEST NEWS

No parasitic use of the "Fast & Curious" format

Paris Court of appeal, Novembre 10, 2023, n° 21/1316

A candidate in a municipal election was convicted of parasitism for having posted a clip entitled "Fast & Cabourg" on the official Facebook page of his election campaign, using the format, visual and audio presentation of the "Fast & Curious" program produced by the media company Konbini.

On November 10, 2023, the Paris Court of Appeal ruled that parasitism was not characterized, pointing out that the principle of freedom of trade implies that a product that is not the subject of private rights can be freely reproduced and marketed. Konbini did not establish the fame or value of the program in question, and no intellectual property rights were asserted. In consequence, the fact that the characteristics of the format and spirit of the "Fast & Curious" program had been reproduced was irrelevant to the outcome of the dispute. Konbini's claims for parasitic use were dismissed in their entirety.



UEFA and FIFA provisions on the organization of soccer competition are contrary to competition law and the freedom to provide services

ECJ, December 21, 2023, No. C-333/21, European Superleague Company

UEFA and FIFA, the two main associations promoting world and European soccer, opposed the launch of a new soccer competition, the "Superleague", initially led by twelve major European clubs, threatening to expel any clubs and players taking part.

The CJEU ruled that the UEFA and FIFA provisions, which submit the creation of any new inter-club soccer competition to their prior authorization, and which are not governed by any criteria ensuring that they are transparent, objective, non-discriminatory and proportionate, are contrary to Union law. The Court stated that the provisions granting these associations exclusive control over the commercial exploitation of soccer competition rights were likely to restrict competition, given the importance of these events for the European media, consumers and viewers. Although this decision does not expressly authorize the Superleague, it does pave the way for the development of new European competitions.

CONTACT US



Stéphanie BERLAND

Attorney - Partner Team
IP/IT/Data

sberland@steeringlegal.com

+33 6 81 45 05 01



Leslie HERAIL

Attorney
IP/IT/Data

lherail@steeringlegal.com

+33 1 45 05 15 65



Elly VONG

Paralegal
Team IP/IT/Data

evong@steeringlegal.com

+33 1 45 05 15 65



5 offices in France

- Angers
- Fort-de-France
- Marseille
- Paris
- Tours



7 offices in the world

- **United Arab Emirates** : Abu Dhabi and Dubai
- **Africa** : Abidjan en Ivory Coast et Niamey in Niger
- **Brazil** : Porto Alegre , Rio de Janeiro, and Sao Paulo

