



Cabinet Beau de Loménie

INTERNATIONAL TRADEMARK & DESIGN LITIGATION: GUCCI V. GUESS APPLE V. SAMSUNG

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INTRODUCTION

reputation in trademarks :

EU and French Regulations :

- art. 8.5 of the EU regulation and L.713-5 of the French IP Code (taking unfair advantage of, or detrimental to, the distinctive character or reputation)
- Reputation = one of the factors for assessing the risk of confusion/ link between the signs at stake

New Regulation (EU) 2017/1001 of 14 June 2017 on the EU trademark (c Changes ?



WWW.SOLDES.GUESS.COM



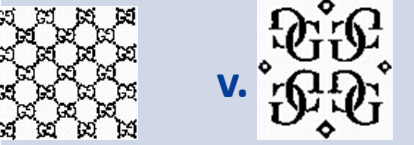


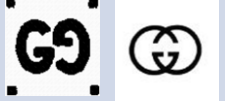
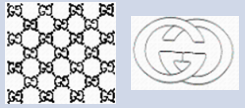
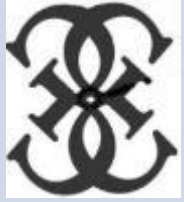
GUCCI V. GUESS IN EUROPE

❑ EUIPO, Italy and France

- **Court of Justice of the European Union 11 October 2016** (decision on opposition) : the signs are not similar
- **Court of Appeal of Milan 10 July 2014**: infringement denied but unfair competition and parasitism admitted : constant imitation of the creative universe of GUCCI
- **First instance Court of Paris 30 January 2015** (appeal pending) : all Gucci's claims rejected



GUCCI V. GUESS IN EUROPE

SIMILARITY BETWEEN THE SIGNS	PROTECTION ATTACHED TO LETTERS
<p>French Court</p>  <p>v. = different</p>  <p>v. = different</p> 	<p>Conclusion : WEAK !!</p> <p>Not the letter but the way it is represented</p>
<p>EUIPO</p>  <p>v.</p>   <p>Different – Ornamental sign Different visual impression/no possible oral or conceptual comparison</p>	<p>Limits to the protection :</p> <ul style="list-style-type: none"> - Abstract ornamental element and not letter - Oral comparison not determinant (G not perceived) - Conceptual comparison : same

GUCCI V. GUESS IN EUROPE

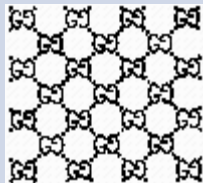
INFLUENCE OF REPUTATION	HOW REPUTATION IS PROVEN AND ASSESSED
<p>EUIPO</p> <p>The signs must have a minimum level of similarity, even if low - If no similarity at all between the signs, reputation is not to be considered</p> <p>Reputation = One factor of the global assessment to be made</p> <p>Not sufficient per se</p> <p>Criterion not autonomous = part of the global assessment</p>	<p>France : Reputation is not proven</p> <p>Reputation must be proven for each trademark and not globally for several resembling trademarks</p> <p>GUCCI did not prove that the letter G under different forms was known by consumers to be related to GUCCI</p> <p>Also: trademarks affixed very discretely on the products – GUCCI is dominant</p> <p>No turnover given trademark by trademark</p> <p>No poll</p>

WHAT ABOUT VALID USE ?

Cancellation for non use was requested by Guess before the French Court



similar to



is made up with the same trademarks → use of
the **complex trademark validates the two others**
Distinctive character not altered

The quantity of use **does not need to be significant** for the use to be valid

HOW UNFAIR COMPETITION/PARASITISM IS ASSESSED

ITALY : Yes

Products launched **immediately** after the **presentation of GUCCI collections**

Same inspiration (shape, color, material, graphic and decorative choices, or also for the combination of these elements)

Systematic and massive exploitation of the creativity of GUCCI

FRANCE : No



= no infringement

no risk of confusion with Gucci's TM

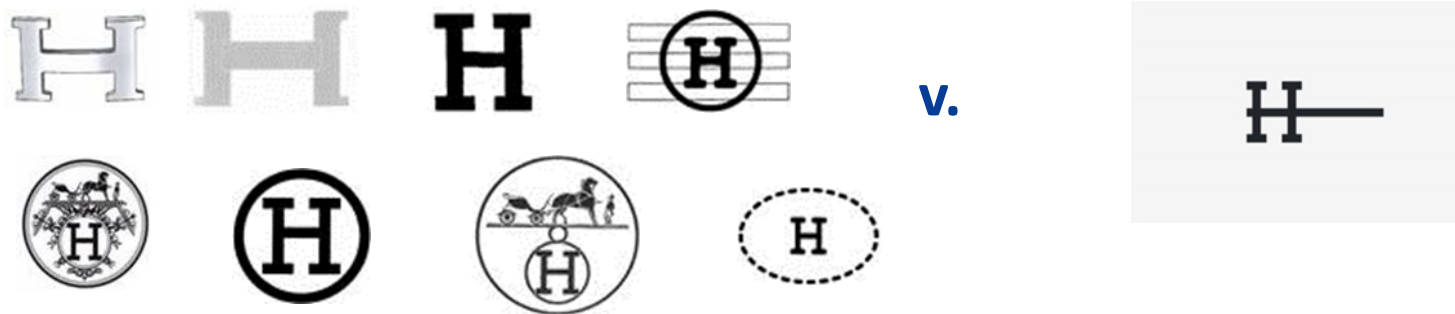
Gucci cannot monopolize the use of beige and brown colors

Range effect : imitation of a range of goods not proven (small selection of goods only)

GUCCI V. GUESS IN EUROPE

□ Similar cases

- **Hermès v. Colmena (EUIPO 6 June 2017)**



- **Deutsche Telecom v. Tekkers Ltd (EUIPO 13 January 2017)**



APPLE V. SAMSUNG

❑ No litigation in France

**EUIPO : Decision of the Invalidity Division 12 June 2013
against Apple registered design :**



APPLE V. SAMSUNG

NOVELTY

Prior design



Common features :

- main parts with rows of icons and a bottom part with a single line of icons
- icons are coloured and represent some objects
- icons have captions under the images

Differences :

- Colour of the background
- Shape of the icons
- Icons in the bottom line back and white
- Icons clearly differ

INDIVIDUAL CHARACTER

- Informed user = familiar with designs of graphical user interfaces
- **No substantial constraints** on the designer's freedom
- Features common to both designs = **features free** to be used by everyone
- **Colour combination** of backgrounds and icons, **shape** of the icons **different**

Overall impression different

APPLE V. SAMSUNG IN FRANCE

EXTENT OF PROTECTION	INFLUENCE OF REPUTATION
<p>Conclusion : Weak !!</p> <p>Design validated but scope limited (different colours, different shape of icons suffice)</p>	<p>No incidence</p>



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FIRM OF THE YEAR
2017

Thank you for your attention

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