

Paris Court of Appeal clarifies confusion
France - Hogan Lovells

Confusion
Unfair use
Infringement

May 15 2017

In a [January 27 2017 decision](#), the Paris Court of Appeal found that, among other things, use of the domain name 'lecomptoirducoton.fr' had resulted in both trademark infringement and unfair competition in relation to the trademark COMPTOIR DES COTONNIERS.

Facts

The claimant was French company Comptoir des Cotonniers. It owned several COMPTOIR trademarks and had registered the domain name 'comptoirdescotonniers.com' in February 2002. The claimant produced, bought and sold clothes, including home textiles.

The defendant was French company Solitex. It operated in the field of wholesale distribution of bedding and textile products for houses, hotels and leisure. The defendant owned the semi-figurative trademark LE COMPTOIR DU COTON, although its registration had been the object of a partial refusal (the opposition was lodged by the claimant) for bathrobes and slippers. The defendant had registered the domain name 'lecomptoirducoton.fr' in February 2012. This domain name pointed to a website that sold bathrobes, slippers and bath and household linen under the name COMPTOIR DU COTON.

On September 30 2013 the defendant initiated proceedings against the claimant before the Paris First-Instance Tribunal requesting the partial cancellation of some of the claimant's trademarks for non-use in Class 24. The claimant made a counterclaim based on trademark infringement and unfair competition.

The first-instance tribunal found in favour of the defendant, cancelling the claimant's Trademarks 1647434 and 3441895 in Class 24, but found that Trademark 3096023 was valid. The claimant appealed the first-instance decision on November 25 2015.

Decision

First, the court of appeal confirmed the first-instance tribunal's decision regarding the partial revocation of Trademarks 1647434 and 3441895 and agreed that Trademark 3096023 was valid.

In addition, the court of appeal considered whether the domain name 'lecomptoirducoton.fr' had infringed Trademark 3096023 (ie, COMPTOIR DES COTONNIERS). According to the court of appeal, when a domain name is not identical to a trademark, the likelihood of confusion between the two signs should be assessed. This assessment includes a likelihood of association, which should be evaluated internationally. This inclusive evaluation of the visual, phonetic and conceptual similarity of the relevant signs should be based on the overall impression produced by them – in particular, their distinctive and dominant components.

Further, the court of appeal underlined that there might be a likelihood of confusion even if the products and services sold on the website to which the domain name pointed were not identical to the products and services covered by the trademark at issue. Accordingly, a lesser degree of similarity between these goods or services might be offset by a greater degree of similarity between the signs, and vice versa.

In view of the foregoing, the court of appeal held that the domain name 'lecomptoirducoton.fr' had infringed the trademark COMPTOIR DES COTONNIERS and that its use was an act of unfair competition. The disputed signs had the same visual, phonetic and conceptual structure, linking the term '*comptoir*' (ie, counter) with verbal components referring to cotton. The addition of the term '*le*' (ie, the) before the term '*comptoir*' served only to introduce the latter, and thus had a secondary nature. Further, neither the figurative elements nor the colour of the trademark at issue altered the distinctive character of the verbal components of the two signs (ie, *comptoir des cotonniers* and *le comptoir du coton*). Thus, the court of appeal held that the overall impression that emerged from the domain name was that there was a likelihood of confusion, as consumers would confuse the marks or at least think that they were associated and thus had a common origin.

Jane Seager and David Taylor, Hogan Lovells, Paris

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