

Addition of TLD can make trademark distinctive France - Hogan Lovells LLP

Cancellation National procedures Infringement

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In *B v Pressimmo On Line* (October 14 2014), the Paris Court of Appeal has ruled that, while the term 'se loger' (meaning 'to find somewhere to live') on its own was descriptive in relation to real estate, it was distinctive when combined with the top-level domain (TLD) '.com'.

The claimant was a group of companies ([Pressimmo On Line](#) and [Se Loger.com](#)) operating the website 'www.seloger.com', the first French property website. The defendant was Janny B, an estate agent based in the Paris suburbs.

The claimant registered several trademarks in France for 'se loger', 'SeLoger', 'Se Loger' and 'SeLoger.com'. The trademarks were registered in a number of international classes, some designating property-related services specifically, and some other services as well as goods (in Class 16).

Subsequently, the defendant registered the domain names 'seloger-pas-cher.com', 'selogermoinscher.com' and 'se-logerimmo.com', and used these domain names in relation to her property business.

The claimant sent a letter to the defendant asking her to cease using terms reproducing its trademarks, to no avail. The claimant then initiated proceedings before the Paris *Tribunal de Grande Instance* on the grounds of trademark infringement and unfair competition. The rights relied upon by the claimant were not limited to its trademarks, but also included its domain name 'seloger.com' and its company name.

In her response brief, the defendant requested the cancellation of the trademarks arguing that they were merely descriptive of the services and goods covered.

On March 15 2013 the tribunal decided to wholly reject the defendant's request for cancellation of the trademarks and accepted the claimant's claim that the defendant had infringed its trademarks, as well as its rights in the domain name 'seloger.com'.

On May 27 2013 the defendant appealed the tribunal's decision.

In its decision of October 14 2014, the Paris Court of Appeal only upheld the tribunal's decision partially and overruled the decision on most points. The Paris Court of Appeal did not consider that there was any act of infringement or unfair competition on the defendant's part and overturned the tribunal's decision on this point. In addition, the Paris Court of Appeal found that some of the trademarks consisting of the terms 'SeLoger' and 'Se Loger' should be partially cancelled in respect of several services under Classes 36, 37, 39 and 42, for being descriptive.

However, the Paris Court of Appeal decided that, for these very same services, the trademarks consisting of 'SeLoger.com' were not descriptive and could thus not be cancelled. The Paris Court of Appeal's reasoning was based on the fact that the domain name 'seloger.com' and associated website had been extensively used prior to the claimant applying for the SELOGER.COM marks. The goodwill and fame of the 'seloger.com' website at the time of application for the SELOGER.COM marks meant that these trademarks had already acquired distinctiveness.

Interestingly, the same tribunal (albeit two different sections) had issued two contradictory decisions at the end of 2013 in relation to another trademark consisting of a generic term and a TLD, namely 'vente-privee.com', ordering the cancellation of the trademark on the one hand (decision of November 28 2013) and declaring that the trademark was well-known on the other hand (decision of December 6 2013). This inconsistency will probably be harmonised by the Paris Court of Appeal and possibly in light of its decision of October 14 2014.

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