

Last episode in the 'vente-privee.com' saga?
France - Hogan Lovells LLP

Cancellation
National procedures

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In a [decision of March 31 2015](#), the Paris Court of Appeal is likely to have ended the current judicial debate on whether the trademark consisting of the domain name 'vente-privee.com' is distinctive for e-commerce services for the purpose of French law. This long-awaited decision resolves the disagreement between two different sections of the First Instance Tribunal of Paris, which issued contradictory decisions in this respect at the end of 2013.

The claimant was Showroomprive.com, a French company set up in 2007, offering its members access to sales of goods from different companies at reduced prices and for a limited period of time, via its website '[www.showroomprive.com](#)'.

The defendant was Vente-privee.com, a French company set up in 2001 operating a major e-commerce platform also allowing its registered members to have access to offers for goods and services from different companies at reduced prices and for a limited period of time. The defendant's main website is at '[www.vente-privee.com](#)' and the defendant owned French trademark rights in the term 'vente-privee.com', including the French word mark VENTE-PRIVEE.COM (No 3623085).

The claimant, a competitor of the defendant, had initially brought a claim before the First Instance Tribunal of Paris in order to obtain the cancellation of the trademark VENTE-PRIVEE.COM for lack of distinctiveness, in relation to services in Class 35 (including "the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods"). It argued that the trademark was not distinctive at the time of registration and that it had not acquired distinctiveness through use in respect of such services. The claimant submitted that any use of the trademark after its registration date could not be taken into account to assess whether the mark had acquired distinctiveness through use.

On November 28 2013 the tribunal decided in favour of the claimant. It considered that the defendant's arguments related to the fame of its business, website and domain name in France was not evidence of the distinctiveness and fame of the trademark itself. In the absence of sufficient evidence that the mark itself was well-known, such as consumer surveys, the tribunal considered that the mark should be cancelled for services in Class 35. However, in a different decision on December 6 2013, the tribunal (albeit a different section) then went on to declare that the mark was well-known.

The defendant lodged an appeal against the first decision of the tribunal.

In its decision of March 31 2015, the Paris Court of Appeal partially upheld the tribunal's decision, but overruled the decision on most points and arguably on the most important point - namely, the validity of the trademark. The court considered that, at the time of registration, the trademark was not distinctive but that it had acquired distinctiveness through use, and rejected the claimant's assertion that use post registration could not be taken into account. The court's decision was based, for instance, on a number of consumer surveys produced by the defendant, including a survey from 2011 ranking the most popular brands in France, and including the defendant's (which presumably, and crucially, was not produced at first instance).

This decision harmonises the inconsistency between two sections of the tribunal and is in line with another recent [decision dated July 23 2014 issued by the first instance tribunal of Lyons](#).

Beside the fact that the Court of Appeal has settled the score on the issue of the distinctiveness of the mark, for the time being it is useful to note that the defendant had initially failed due to lack of pertinent evidence and the alleged confusion between the notoriety and goodwill of its business, its website, its domain name and its trademark.

This decision is a further illustration of the fact that a trademark consisting of an association of descriptive words with a TLD can be considered as distinctive provided that there is sufficient documented evidence of its renown.

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