

The use of a trademark in press articles in a metaphorical sense is not a trademark infringement, according to the French Court of cassation

[MARQUES / CONTRATS / DESSINS ET MODELES]
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The French toy manufacturer Meccano is the owner of a French verbal trademark “Meccano”, which notably designates toys and games in class 28 of the Nice Classification.

Between 2006 and 2012, the French periodical newspaper “Le Point” has reproduced the verbal trademark “Meccano” in several press articles. The trademark “Meccano” was used in a purely metaphorical sense: the actions of French politicians and business leaders were compared to the famous construction toy, which requires intellectual and mechanical agility. A reference was thus made to the construction toy, but the trademark “Meccano” was not used to designate toys for kids.

A legal action was initiated by Meccano against Le Point on the basis of article 1382 of the French civil code on extra-contractual liability, in order to obtain damages for this use of the trademark “Meccano”, but more importantly for preventing the degeneration of this existing trademark into a generic term. According to article L714-7 of the French Intellectual property Code, the owner of a French trademark shall be liable to revocation of his rights if, in consequence of his own acts, the mark has become the common name in trade for a product or a service.

In the past, a distinction has been made by French Courts between trademarks reproduced in a promotional context, and those reproduced in press articles and/or books without any commercial purpose:

- the reproduction of the trademark “Pierrade” in a commercial brochure to generically designate cooking appliances has been considered as an infringement of the trademark “Pierrade”, registered for cooking appliances (Cour de cassation, Commercial chamber, 18 may 2010, n°09-14615);
- but the reproduction of the trademark “Pedalos” has been considered as a non-infringing use of the registered trademark “Pedalos”, since this reproduction was made in a press article without any commercial purpose (Court of appeal of Paris, 13 march 1989).

But this distinction has not always been applied by French Courts: a publisher has been condemned by the Court of first instance of Paris for the reproduction of the trademark “Bic” in a book, despite the fact that no commercial purpose was established (Court of first instance of Paris, 17 September 1980).



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In this case, the Court of first instance of Paris had dismissed the law suit initiated by Meccano, finding that the trademark “Meccano” had not been reproduced in the course of trade, and, hence, that no trademark infringement had been committed by Le Point (Court of first instance of Paris, 25 January 2013).

This first instance decision had been overturned by the Court of Appeal of Paris, which considered that the repeated use of the trademark “Meccano” by the French magazine Le Point was constitutive of a fault and had condemned Le Point to pay 30.000 euros by way of damages (Court of Appeal of Paris, 21 October 2014).

The Court of cassation, in a recent judgement dated 1 March 2017, ultimately annulled the decision rendered by the Court of appeal of Paris. The French Supreme Court judges have ruled that the Court of Appeal of Paris failed to demonstrate that the use of the sign “Meccano” by the magazine Le Point, which was not made to designate goods or services, could lead to the degeneration of the trademark “Meccano”.

The Court of cassation thus seems to apply a distinction between reproductions of trademarks made to designate the goods or services referred to in their application for registration, which infringe the rights of trademarks owners, and those made in press articles and/or books in a metaphorical sense, which are allowed.

This matter will thus now be referred to a second Court of Appeal, which will likely dismiss the law suit initiated by Meccano, in accordance with the judgement rendered by the Court of Cassation.

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