

Reputation of a mark and assessment of the likelihood of confusion (France - Cour de cassation)

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Cour de Cassation, Chambre Commerciale, January 31, 2018, Appeal No. C 16-10.761

The French Supreme Court emphasizes that the reputation of the earlier mark is a relevant factor in the assessment of likelihood of confusion and gives it wider protection.

In 2009, adidas initiated an infringement action in France relying on its famous three stripes figurative mark (consisting of three equidistant parallel vertical stripes of the same colour and width contrasting with the background - [here](#)) against the company Promotex, which had imported sweatpants with two contrasting parallel vertical stripes ending in a wider horizontal band. The First Instance Court of Paris, in a judgment of 25 March 2010, allowed the claim, but the Court of Appeal of Paris reversed it by judgment of 23 October 2015, refusing to take into account the fame of the mark to assess the likelihood of confusion and to consider that the defendant had caused detriment to adidas' famous mark.

The French Supreme Court totally censured this assessment ([here](#)), reciting that the reputation of a mark is a relevant factor in the assessment of the likelihood of

confusion, in that it confers on a mark a high distinctive character and gives it extensive protection.

The Supreme Court noted that the Court of Appeal had found that the signs at issue had a certain (albeit low) similarity and it was therefore incumbent on it to make an overall assessment of the likelihood of confusion taking into account the reputation of the earlier mark. The Court of Appeal was wrong to say that, reputation notwithstanding, it was possible to exclude a likelihood of confusion because of the low similarity of the signs.

The Supreme Court also disagreed with the Court of Appeal as regards the detriment which could be suffered by the adidas mark. Given that the fame of the mark invoked by adidas was not contested by Promotex, it was incumbent on the Court of Appeal to make the relevant assessment. The guidance given by the Supreme Court makes it necessary to perform an overall assessment of the existence of the link that could be made in the mind of the public between the offending sign and the earlier famous mark taking into account the intensity of the reputation of the mark, the degree of its distinctive character (whether intrinsic or acquired by use) and the similarity or identity of the products in question.

The Supreme Court's decision brings French case law into line with CJEU cases, e.g. *Sabel v Puma* and *Canon*, and gives famous brand owners, such as adidas, additional certainty. The case might be remitted to the Court of Appeal for reconsideration by Promotex. If not, the first judgement will become final. In any case, this is yet another dispute where patience and resilience pay off for adidas in its global fight against infringing use of two stripes.

The author represented adidas in the proceedings through the first and appeal instances, Me Carole Thomas-Raquin before the Supreme court.