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Famous trademark: complementarity between products and services relevant to likelihood of confusion (France – Cour de cassation)

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Cour de cassation, Chambre commerciale, March 27, 2019, Appeal No. T 17-28.213

The French Supreme Court (*Cour de cassation*) overturned the judgment of the Paris Court of appeals ([here](#)) which had denied similarity between goods and services on the ground that they were only indirectly related, because the Court of appeals should have examined whether these goods and services were of a complementary nature.

The US company Clinique Laboratories LLC (Clinique) which specializes in the manufacture and marketing of cosmetic products owns the European Union Trademark “CLINIQUE”, registered in 1996. It designates in particular perfumes, toiletries, cosmetics, hair and body care products. Clinique discovered in 2016 that a French Company WB Technologies (WBT) was using “CLINIQUE DIGITALE” and “LA CLINIQUE DIGITALE” on a website and for an upcoming web-app to allow the consumer to build a digital beauty profile. Therefore, Clinique filed a motion requesting a preliminary injunction based on likelihood of confusion and misappropriation of the reputation of the CLINIQUE mark. .

In first instance and on appeal, the Parisian judges rejected Clinique’s claims, even though they acknowledged the fame of the trademark CLINIQUE. According to them, Clinique’s products (cosmetic products) and WBT’s services (innovative IT products in the field of beauty) were quite dissimilar. For them “CLINIQUE DIGITALE” does not designate cosmetics, but innovative technological products and particularly a digital application as WBT merely offers to its client a vehicle for exchanging advice and practices on cosmetics products. The appeal judges considered that even if the purpose of the app was to offer “tailor-made and simplified beauty solutions”, these beauty solutions were proposed by the users of the app themselves and not by the company. In addition, WBT does not manufacture or market cosmetics. Therefore, only an indirect link could be drawn between Clinique’s products and WBT’s services. Thus, regarding the likelihood of confusion or association, the consumer would not have thought that the sign LA CLINIQUE DIGITALE would have been a declination or adaptation of the trademark and would not have made a link between the signs either.

The French *Cour de cassation* censured this assessment: in addition to this “indirect link”, the judges should have checked whether the products referred to in the trademark registration of CLINIQUE and the services as offered by WBT were not complementary in nature, which could

lead the public to attribute a common origin to both.

Thus the *Cour de cassation* points out that in assessing the degree of proximity or dissimilarity between products, as part of the overall examination to assess whether or not there is a link or risk of association, it cannot be merely noted that products are dissimilar because of their nature, but it must be verified that they are not complementary.

This decision is welcome as it does greater justice to well-known trademarks, which deserve an extensive scope of protection.

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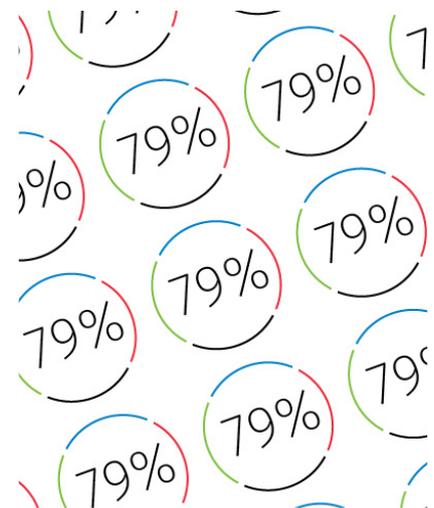
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