

### Adding features to liberate a trademark, good idea?

By Charlotte URMAN, INLEX IP EXPERTISE, France

In today's e-cigarette world, disputes about traditional cigarettes still flourish, also regarding trademark registration and availability.

In France, it is quite rare that Appeal Courts contradict INPI's oppositions decisions, but here the applicant, a Bulgarian company, whose trademark application was rejected by the opposition division, decided to go for broke in appeal.

The granted opposition was based on the CTM:  
(in the name of Philip Morris)



against a french tm application:



...both of them for tobacco products.

The applicant may have played on the fact that the signs should be considered as different “as a whole”, because of insertion of colours, different flowers, another typo and a heart design to replace the letter V, ...or maybe just did not proceed with any availability search.

It was obviously without counting on the trademark watch ordered by Philip Morris and its immediate reaction with opposition proceeding.

The French court of appeal (Paris, February 12, 2014) here decided that there is a likelihood of confusion between the trademarks, in particular because of the strong similarities between the dominant names “EVE” and “e♥a” (that should be read EVA), both of them being feminine first names.

Judges noted that the wording “super slims” and “slims” are descriptive in the tobacco field of activity.

They also considered the graphic elements (cream background, smooth writing and light coloured floral patterns) as likelihood factors.

3K€ have been charged to the applicant together with the final rejection of its trademark application.

What should be memorized from this dispute?

- Companies which consider their trademarks as real assets have a watch service to be able to anticipate and use the administrative proceedings to defend their rights.
- It is recommended to conduct availability searches before filing a trademark application and that can help to save costs.
- It is not always sufficient to insert differentiating features to try to avoid likelihood of confusion and it is preferable to request a legal opinion within the availability search and then to analyse the possibilities to amend the project and make it different from any anteriority found.

***For more information, please contact:***

Charlotte URMAN  
European trademark attorney  
Inlex IP Expertise  
[curman@inlex.com](mailto:curman@inlex.com)  
[www.inlex.com](http://www.inlex.com)

