

## **French geographic names in shifting sands!**

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Protection of geographic name by trademarks have often been questionable in the European case law and this was particularly true in France these last monthes.

Indeed, French law has the particularity to give rights to the French «collectivités territoriales» (i.e.: municipality, grouping of municipalities, department, region...) on their geographic names which is not without incurring monopolistic problems in the field of trademarks. This has in fact recently hit the headlines in France.

For instance, on the one side, the municipality of “Laguiole” was simply dispossessed of its name after several years of legal proceedings (Laguiole was finally considered by the French courts as descriptive in the field of cutlery!) and on the other side, the tourism Office of “Val’Thorens” has been considered as the "author" of the ski resort’s name (considered as a collective work on the ground of copyrights).

In this context, the rights of the French legal authorities on their own geographic names and the possibilities for them or for others to obtain a trademark including the name of a French «collectivité territoriale» are quite unclear.

Thanks to municipalities lobbying, the French Legislator has finally adopted a new law on March 17<sup>th</sup> 2014 (called the "Hamon law") in order to clarify these questions.

So what are the rights of communities on their own name? What does the "Hamon law" actually change?

### **1. BEFORE THE HAMON LAW**

For many years, the French law has governed and protected the geographical names by granting them a special protection related to:

1. The needs of the «collectivités territoriales» to identify their institutions and their own services to people
2. Consumer’s protection requirements (via Protected Designation of Origin which must meet a set of specifications.)

However, the protection granted has some significant limitations:

- In reality, the name of a «collectivité territoriale» is subject to an automatic protection insofar as it is limited to public services only (town hall services, roads maintenance, waste management, etc.).

In practice, this protection does not meet the needs of «collectivités territoriales» (eg in the Laguiole case, the cutlery products are obviously not included in the public service mission and therefore the municipality has no protection for this kind of product).

In this context, for a community that has a particular expertise and / or historical activity and wishes to provide comprehensive protection for the economic activities of its citizens, the automatic protection provided by French law is not suitable nor sufficient.

- The specific protection of geographical names via the Protected Designation of Origin is restricted to local products whose characteristics are truly related to the geographical location of production (eg: Champagne and Roquefort whose distinctive features are directly linked/related to their place of production, in addition to specifications with a particular know-how).

These limitations were notably issued from the French Case law which considers that it is in the public interest to preserve the availability of geographical names for the actors of the «collectivités territoriales».

Therefore, it is difficult also for a non-public actor to get a right / a monopoly on a geographical name and/or on a complex sign including a geographical name.

These crisscrossed and limited legal protections create a situation which is unclear for the «collectivités territoriales» themselves and for the person who wants to file a trademark application including a geographic name.

## 2. AND AFTER?

With the Hamon Law, the French legislator has introduced new legal attributes in order to strengthen the rights of «collectivités territoriales» faced with the abusive use of their name and to clarify the situation for private actors. Thus, the new law:

- Grants the French «collectivités territoriales» access to a warning system on request before the INPI, which will inform them of any new trade mark application involving /including their name.
- Opens access to opposition proceedings to the French «collectivités territoriales» on the basis of an infringement of their name, their image or their reputation (until now the procedure was only opened to trademark owners).
- Also creates a new category of geographical indications the "Geographical Indications protecting Industrial and Hand-crafted products" ("IGPIA" in French). These IGPIA concern any type of manufactured products provided they are from a particular geographical area and they have specific characteristics due to their origin (quality, reputation, etc. ...). That could be for instance products such as Calais lace.

Moreover, the law also opens the opposition proceedings on the basis of an IGPIA to the Organizations of defense and management of the said IGPIA, against a mark which designates similar products.

***This new category of IGPIA represents in our opinion the major contribution of the Hamon law insofar as it is truly a new kind of intellectual rights.***

However, here the protection is not automatic and the concerned operators should create a consortium, jointly define the criteria for the products issued from the geographical indication, write detailed requirements (with particularly strategic specification determining the scope of protection) and file a request before the INPI to recognize the existence of their IGPIA.

### **3. SO NOW...**

In this context, we believe that the solution is obviously to determine a specific legal and IP strategy:

✓ For every «collectivité territoriale»:

Finally the Hamon law does not really increase the extent of the rights of the French «collectivités territoriales» on their own name but simply provides tools that will enable them to react more quickly and more easily.

The protection of the geographic names of the «collectivités territoriales» still has limits, so that if the community has no effective legal policy, it cannot access the various aforementioned tools which require a proactive approach.

In addition, the tools developed by the Hamon law may be poorly exploited if the «collectivités territoriales» do not have **pre-established internal IP management processes, including trademark strategy**, assisted by their IP Attorney, and if they have not thought up and fixed their legal strategy by asking the right questions, including: what do I want to protect? For what purpose? What use of my name am I willing to tolerate or conversely what cannot I accept? What level of response and what approach based on cases encountered do I expect?

It is so necessary to secure an upstream policy of legal protection, enhancement and communication having in mind the particular sensitivity of geographical names.

**This strategy will necessarily include trademark questions** to complete the other kinds of legal tools which cannot give the same monopoly.

✓ For the anyone willing to use and file a trademark application including a geographic name, the situation remains uncertain and they need to place their project in the particular context of geographic names and to secure it with a preliminary analysis of the risk of a reaction third parties with a particular view on the «collectivité territoriale» rights and also the risk of refusal of the French trademark Office.

Indeed, the **choice of such a sign, as a trademark, has particular consequences notably as regards availability searches.**

The first point is to be informed that the name chosen includes a geographical name (which is not obvious considering that they are numerous and not necessarily well known).

The next point is to check whether there is any protection for public services that could be opposed considering the activities concerned by the project (for instance, cleaning services which are relevant services for a municipality).

It is then important to be sure that there is no Protected Designation of Origin including or close to the projected name (here whatever the activities concerned).

Finally, it is important to investigate to find out whether the French «collectivité territoriale», or any third legitimate organization, has a legal protection strategy via trademarks or IGPIA and, if any, what is its content.

Of course complete availability searches (among trademarks, trade names, domain names, copyrights, etc.) are necessary as for any new trade name / trademark that needs to be secured.

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