

## **French Courts confirm TEXTO lacks distinctiveness in class 38**

On September 23, 2009, the Paris Court of Appeal confirmed cancellation of the French trademark for “TEXTO” hold by French phone operator SFR. That mark was filed in 2001 in respect of “*services of written messages for radio-phones*”.

SFR was indeed suing for trademark infringement French company ONE TEXTO incorporated in respect of “*communication, marketing, advertising, mobile telephony, SMS for business and management and for robotic and hi-tech fields*”. ONE TEXTO also filed the eponym trademark in 2003 in classes 35, 38 and 42 and owned the domaine ***onetexto.com***.

ONE TEXTO requested the cancellation of the earlier trademark for descriptiveness. Several publications articles were indeed provided so as to demonstrate that “TEXTO” was known by the public for naming a small written and convivial message sent by mobile phone.

The Court of Appeal ruled that at the time of filling of the mark “TEXTO”, this word was INDEED usual for designating a message sent by phone and was not particularly associated to the plaintiff. Being a usual designation of a service in the current language, cancellation of the mark “TEXTO” was thus upheld by the Court.

We remain a bit surprised that SFR refrained from arguing that the mark TEXTO had acquired a distinctive character through long and intensive use. But the matter is strategically interesting for any company operating in relation to telephone communication services / activities but also while considering suing a competitor on the basis of a mark which distinctiveness is likely to be discussed.

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