

2023 AIPPI Trilateral Meeting in Venice (IT – FR – ES)

Venice, Friday, March 31, 2023

Tania Kern & Giulia Cortesi – Kern & Weyl

tania.kern@kern-weyl.com

giulia.cortesi@kern-weyl.com

How to ensure the Protection of a Sport, Fashion or Design Event in France

There are many different ways to protect Sport, Fashion or Design Events under French Law. Such protection is archived thanks to the protection of the names and logos of these live events (I.) and to the protection their content (II.).

I. Protection of Sport, Fashion or Design Event names and logos

Sport, Fashion or Design Event names and logos are protected in France by trademark and copyright laws, unfair competition and also ad hoc legislations.

1. Protection by trademark law

Any name or logo which is distinctive can be registered as a trademark and thus be protected by trademark law.

The distinctivity of live events names is however often questionable because such names are often descriptive of the event they cover.

However, the criteria of French Courts and the French IP Office to assess the distinctivity of live events names and more specifically of sport events names remain surprisingly low.

Indeed, as an example, the French trademark "**COUPE DU MONDE 2006**" (*Worldcup 2006*) has been assessed distinctive for "*figurines, statues [...], figurines, trophies, badges [...] games and toys*" the Court having considered that "*it does not only refer to the world sporting event which takes place every four years, and is not generic or usual, but wholly arbitrary, and thus valid.*" (Court of First Instance of Bobigny May 22, 2007, No 06/05978).

The trademarks "**EURO 2016**" "**EUFA**" and "**UEFA EURO 2016**" registered in class 16 for "*tickets and other access rights*" and in class 39 and 41 for "*various services related to the reservation and supply of tickets, the organization and promotion of events, especially sports events*" and the trademark "**EURO 2020**" have also been considered distinctive for among others services in class 41: "*Organization of competitions; betting and gaming services relating to sports; provision of sports facilities; coverage of radio and television sports events; ticket reservation services and information services for sports events or entertainment*" (INPI July 17, 2018 and December 11, 2017 - International trademark registration No 1 360 890 - and Court of First Instance of Paris May 31, 2019, No 16/11073).

However, "CHAMPIONNAT D'EUROPE DE FOOTBALL 2016" has not been considered distinctive for products in class 25. The judges have indeed retained that "*for the average consumer who is a fan of sports competitions, the sign refers to a unique event, of great notoriety, and to it alone; for goods in class 25, this reference is not arbitrary, as clothing is traditionally sold as souvenirs or as a sign of support for a team during sports events of this type*" (Court of Appeal of Aix-en-Provence May 12, 2021, No 18/12224).

When a logo is added to a name, the distinctivity of the trademark is less problematic.

aIR GuitaR

As an example, the trademark *Championnats de France* has been considered sufficiently distinctive as a whole taking into account the particular stylization fonts and shape even if the terms "CHAMPIONNATS DE FRANCE" and "AIR GUITAR" are descriptive (**Court of Paris May 24, 2011, No 09/16662**).



The trademark FESTIVAL INTERNATIONAL DU FILM has also been considered sufficiently distinctive to constitute a valid trademark as the terms "FESTIVAL INTERNATIONAL DU FILM" well-known for more than fifty years are associated to the logo of a stylized palm (Court of Grasse Feb. 13, 2001, No 97/04843).

2. Protection of names and logos by ad hoc legislations

The names and/or logos of live events and in particular the Olympic symbols, are protected in addition to trademark law by ad hoc legislations.

2.1 Protection of the Olympic symbols by ad hoc legislations

The Olympic symbols are protected by ad hoc legislations such as the Nairobi Treaty internationally and in France by the French Sport Code.

A. The Nairobi Treaty

The 55 States party to the Nairobi Treaty are under the obligation to protect the Olympic symbol (i.e. any sign consisting of or containing the Olympic symbol) against any use for commercial purposes (in advertising, on goods ...) without the authorization of the International Olympic Committee and to refuse or invalidate the registration as a mark of any sign consisting of or containing the Olympic symbol.

France is however not a signatory of this international Treaty.

B. The French Sport Code

Art. L.141-5 of the French Sport Code as lastly modified by the law of March 2, 2022 provides that:

1.-The French National Olympic and Sports Committee is the owner of the national Olympic emblems. It is also the depositary of:

1° The Olympic emblems, flag, motto and symbol;

2° The Olympic anthem;

3° The logo, mascot, slogan and posters of the Olympic Games;

4° The year of the Olympic Games "city + year", in conjunction with the French Paralympic and Sports Committee;

5° The terms "Olympic Games", "Olympism" and "Olympiad" and the acronym "JO";

6° The terms "Olympic", "Olympian" and "Olympienne", except in common language for normal use excluding any use of one of them for promotional or commercial purposes or any risk of confusion in the mind of the public with the Olympic movement.

The fact of registering as a trademark, reproducing, imitating, affixing, deleting or modifying the elements and terms above listed or their translations, without the authorization of the French National Olympic and Sports Committee are punishable by the same penalties than those provided for in Articles L. 716-9 to L. 716-13 of the French Intellectual Property Code i.e. criminal penalties provided for trademark infringement i.e. among others from 3 to 7 years imprisonment and from 300,000 to 750,000 euros fines (the highest figures correspond to dangerous goods or to acts committed by an organized group. Penalties are doubled in case of recidivism and are five times higher for legal entities).

As an example, the Paris first instance Court ruled that a Polo shirt Collection sold under the name "POLO RIO 2016 COLLECTOR" and polo shirts bearing figurative elements imitating the Olympic rings (5 interlaced hearts in blue, yellow, black, green and red) have infringed among others article L141-5 of the French Sport (Court of Paris June 7, 2018 No 2016/10605).

2.2 Prohibition to sell tickets for a live event without the producer's authorization

Even if the name or logo of the live event is not protected by trademark law, the organizer or producer of the event can benefit from the protection of Article 313-6-2 of the French Criminal Code providing that:

"The fact of selling, offering for sale or exhibiting for sale or transfer or providing the means for the sale or transfer of admission tickets to a sporting, cultural or commercial event or a live performance, in a habitual manner and without the authorization of the producer, organizer or owner of the exploitation rights of this event or performance, is punishable by a fine of €15,000. This penalty is increased to a fine of €30,000 in the event of a repeat offence."

Interestingly, on the basis of this article, in a case where Prodis Union (the National Syndicate of Producers) noticed on the Google search engine the presence of advertisements for the sale of tickets for Rammstein, Grand corps malade, Drake and

Metallica shows, which referred to sites not authorized to sell by the producers, the Paris Court of Appeal upheld the judgment of the Paris Court of First Instance, which had prohibited Google from allowing the purchase of the keywords "purchase/sale, tickets/tickets and show/concert" via Google Ads for any advertisement aimed at a public located in France, with a view to selling show tickets without the written authorization of the show producer concerned. The Court also awarded to Prodis Union €300,000 as a compensation for the direct and indirect damage to the collective interests of the profession represented by the union and €60,000 as a compensation to the costs incurred in filing the procedure (Paris Court of Appeal March 29, 2023, No 21/00704).

Google defense that Google Ads constitutes a simple commercial communication that does not allow the sale or offer for sale of show tickets and that Article 313-6-2 of the Criminal Code would not allow the repression of the activity of intermediation platforms ensuring the occasional or authorized resale of show tickets has been rejected. The defense based on Article 6 I 2° of the LCEN limiting the liability of the host has also been rejected on the grounds that Google had been informed of the unauthorized sale of the tickets and had therefore been aware of their illegal nature.

3. Protection of event names by copyright law

French law also allows names and logos to be protected by copyright if these names and logos are original, i.e. that these names and / or logos express the personality of their creator.

There are few examples in case law regarding the protection of the names of live events by copyright but one can refer to a Paris Court of Appeal decision where the figurative elements of the two UEFA trademarks reproduced below have been considered as original creations



entitled to copyright protection.

The publisher who reproduced on the cover page of a magazine these two logos have been sentenced to pay in addition to damages based on trademark infringement, 60,000 euros damages based on copyright infringement (Paris Court of Appeal May 21, 2021 Pole 5 chr 2, No 19/15976).

4. Protection of live events against Ambush marketing by the concept of unfair competition / parasitism and by the Sport Code.

Ambush marketing has been defined by French Courts as *"an advertising strategy aiming to associate the commercial image of a company with that of an event and thus to take advantage of the media impact of the said event without having paid the rights which are relative to it and without having obtained the prior authorization of the organizer of the event"* (Paris Court of Appeal - June 8, 2018, No 17/12912).

The fact to take advantage of a live event without being a sponsor can be considered as unfair competition / parasitism under French law. Indeed, French case law has developed the

concepts of unfair competition and parasitism in application of Article 1240 of the French Civil Code that provides that *"Any act of man, which causes damage to another, obliges the person by whose fault it occurred to repair it."* There is no list of specific conduct prohibited as in other EU countries.

Ambush marketing falls into the concept of parasitism which is the set of behaviors by which an economic agent interferes in the wake of others in order to profit from their reputation, know-how or investments, regardless of any risk of confusion.

In addition to unfair competition/parasitism, the French Sport Code provides to sport live events an ad hoc protection. Indeed, article L333-1 of the French Sport Code that provides among others that: *"Sports federations, as well as the organizers of sports events mentioned in Article L. 331-5, own the right to exploit the sports events or competitions they organize"* has been widely interpreted. The rights granted include exclusive rights to enter into sponsorship contracts and therefore to prohibit third parties to take advantage of a sport event or competition they do not sponsor.

The concept of parasitism and article L333-1 of the French Sport Code are of specific interest when economic actors that are not sponsors manage to take advantage of a live event without reproducing the name or logos or content such live events. However, the limit between a statement which falls within the scope of freedom of speech and a statement which is prohibited can be difficult to draw.

As an example, the Paris Court of first instance has sentenced DIOR for posting Instagram stories during the Cannes Festival reproducing the Festival poster. The Court considered that the posts were suggesting that DIOR was an official partner of the Festival and sentenced DIOR for copyright infringement (reproduction of the poster), trademark infringement (reproduction of the trademark on the poster) and parasitism (Court of Paris December 11, 2020, No 19/08543).

However, the French Supreme Court rejected the action of the French Rugby Federation based on illicit exploitation of a sports event (art. L.333-1 Sport Code) and parasitism (art. 1240 Civil Code) against Fiat in a case where Fiat issued the following statement: *"France 13 ENGLAND 24 - The Fiat 500 congratulates England for its victory and gives appointment to the French team [...] for France- Italy"*. The Court considered that the advertisement *"merely reproduces a current sports result, acquired and made public on the front page of the sports news paper, and refers to a future match that is also known as already announced by the newspaper in a news article"* and that *"there is no risk of confusion ant FIAT has not promoted its own commercial activity"* which is arguable (French Supreme Court May 20, 2014, No 13-12.102).

Finally, in a similar case, Pizza Hut was sentenced for illicit exploitation of sports events (art. L.333-1 Sport Code) and parasitism (art. 1240, Civil Code) for the broadcasting of an advertisement including the following sentence *"Football evening, tonight at 9pm, PARIS-ST ETIENNE, enjoy your game with: the 2 pizzas... 21€90"* (First Instance Court Paris, June 2, 2016, No 16/00754).

II. Protection of Sport, Fashion or Design Event content

The content of Fashion, Sport, or Design Events can be protected in France through Copyright laws, unfair competition and ad hoc legislations.

1- Protection by Copyright

According to Article L.111-1 of the French Intellectual Property Code (IPC) , the author enjoys an exclusive intangible property right over his work, by the sole fact of its creation, which is enforceable against all, provided that the creation is original.

Originality is to be considered as the main criterion for protection and that it is up to the person claiming copyright protection to demonstrate the originality of the work.

We must therefore ask ourselves whether fashion shows can be considered original and therefore protectable by copyright.

To answer this question, with regard to fashion shows, we have to take a step back in time to what the fashion shows of the 1950s were and compare them to what fashion shows are today.

Vintage fashion shows were simply aimed at presenting clothes and accessories to a limited and selected audience of customers invited to attend a catwalk.

Instead, today's fashion shows are real performances in collaboration in which different arts intertwine and communicate.

As an example, Maria Grazia Chiuri, Dior Artistic Director, for the Dior spring-summer 2023, decided to make different art forms dialogue within the fashion show asking various artists to collaborate within the show to create collective energy thanks to the contributions of various committed artists in such a way that the public can feel involved and become protagonists themselves.

The scenography of the Dior shows was created by artist Eva Jospin, a baroque cave inspired by the Buttes Chaumont grotto in Paris and two Dutch choreographers and dancers Imre and Marne van Opstal performed during the show.

Another example is the Issey Miyake's "Theatrical floating dresses" fashion show, where Satoshi Kondo, artistic director of Issey Miyake, presented the Spring/Summer 2020 collection in a very original way: the dresses coming down from the ceiling to be placed directly on the models.

One more example, during its Spring Summer 2023 show in Paris, Parisian fashion brand Coperni used a sprayable, liquid fibre to spray a dress onto model Bella Hadid in what can be described as a live performance art.

One last example, the French maison On Aura Tout Vu, presented in 2023 its sunlight power collection couture in Paris in a show integrating messages, dance and theatre performances.

The idea of this collection is that each of us becomes an energetic element that holds part of the solution to the current energy problem by inserting extremely thin and flexible photovoltaic elements into couture pieces.

While it is clear that the individual creative elements of a show namely: a set design, a theatrical performance, a ballet, may be protected by copyright if originals, it needs to be understood whether: **(i)** the fashion show, taken as a whole, can be considered protected by copyright and **(ii)** who is the rights holder as well as the enforcer of the rights.

A first answer came from French administrative Paris Court of Appeal in a case where the question was whether the services rendered by a choreographer and a director of a "fashion show" could be exempt from VAT as authors of intellectual works. The Court ruled that the creations were "spectacles de mode" and not "défilés" and therefore intellectual works among those protected by copyright (Court of Appeal of Paris October 2, 1997 n°89PA01692 & 89PA01691 "Recueil Lebon").

Once it is assumed that a show can be protected as a whole, a necessary step is the qualification of the work within the categories defined by the French intellectual property code.

In fact, the qualification of the type of work has a direct consequence on the ownership of exploitation rights.

Article L.113-2 of the French IPC defines a work of collaboration as a work where several authors are contributing and a composite work as a work where a pre-existing works can be integrated without the collaboration of the author of the latter.

In the case of works of collaboration and composite work the rights holders are indeed the individual authors which implies that the show organizers, the fashion houses, must ensure that the rights have been assigned to them to exploit the show.

We come to an entirely different conclusion if we qualify the show as a collective work within the meaning of Article L.112-2 of the French IPC where a collective work is:

- a work developed on the initiative of an entity, who will assume the direction and who present and exploit the work under his name;
- a work which is the result of the contribution of different authors, each contribution having to merge into the whole.

In this case the ownership of the rights lies with the person who carries out the direction and coordination activity and who bears the costs and risks making it easier for the show organizers to exploit and defend the rights to the show.

A confirmation, albeit indirect, of the qualification of a fashion show as a collective work has come from case law.

In a judgment of 5 February 2008, the Court of Cassation upheld the ruling of the Court of Appeal that had held that: *“Fashion houses are the copyright owners on their creations as well as on their fashion shows, which are intellectual works benefiting from copyright protection as long as they are original”* (Court of Appeal of Paris January 17, 2007 n°05/08545; Cour de Cass. 07-81.387 February 5, 2008).

In this case it was decided that by photographing several fashion shows and contributing from French territory to the online distribution of the images thus obtained, without the authorization of the copyright owners (the Fashion houses), the photographs committed the criminal offence of counterfeiting.

In this regard we recall that, according to Article L122-4 of the French IPC, any representation or reproduction in whole or in part without the consent of the author or his successors or assigns is unlawful.

Nevertheless, Article L122-5 9° of the French IPC allows the reproduction or representation of a work for the exclusive purpose of immediate information in direct relation to the work. It is, however, an exception of very strict interpretation and difficult to implement.

To conclude on the protection of the content of a fashion show by copyright, it should be noted that a practice has existed in France since the 1960s known as “press accreditation”, which created at least “an appearance of copyright ownership” by fashion houses, even before the principle was confirmed by case law.

Indeed, journalists who wish to be accredited for fashion shows must sign a press commitment from the French Couture Federation stating that:

“the accreditation is equivalent to authorization to record, within the fashion shows, the images necessary to inform the public within the strict framework of the exercise of the right to information, to the exclusion of any commercial exploitation”.

The press accreditation mentions the existence of an exception to copyright in the name of information, indirectly referring to an alleged right of fashion houses.

2- Protection by Unfair Competition

In certain cases, the content of a show may be protected subsidiarily, even in the absence of copyright by unfair competition law.

As an example, the French Supreme Court ruled on a light and music show presented in the quarries of the village of Baux en Provence (Cour de Cass. 15-28.352 January 31, 2018).

In this case the Court has considered that the concept of immersing the spectator in images and music is only the expression of an idea, thus not protectable by copyright due to the idea/expression dichotomy principle.

On the other hand, the Court held that *“the Company Culturespaces had deliberately ride on the coat-tails of the company Cathédrale d’Images by maintaining a confusion about*

its status as the buyer and new operator of the shows with the aim of profiting from the success and reputation of these former shows”.

3- Ad hoc legislation

Sport events benefit from specific and additional protection in the French Sport Code.

The French Sport Code clearly provide that Sports federations & organizers own the right to exploit the sports events or competitions they organize including the right to broadcast (Art. L.333-1).

Moreover, Article L.333-10 of the French Sport Code, in its version in force since 04 March 2022, provide for the possibility to obtain all proportionate measures to prevent and block illicit broadcasting of sport events trough an accelerated procedure on the merits or in a summary proceedings.

In a recent first case on this matter (BeIN Sports v/ Orange), BeIN Sports, holder of the audiovisual rights of the African Cup of Nations, obtained an order against Orange, one of the major ISP to block several sites broadcasting the competition (Paris judicial Court, January 20, 2022 n°22/50416).

Following to this case, the results obtained applying this new measure are very encouraging in France considering that, in the first semester of 2022, the global illicit sports audience decreased by half and that the new law allowed the blocking of 1,299 sites that illegally broadcasted sports content online.

Moreover, it is important to highlight the fact that the ARCOM (the French Regulatory Authority for Audiovisual and Digital Communication), the four major French ISP (Orange, SFR, Bouygues Telecom, Free) and sports rights holders have just signed an agreement to protect sports broadcasts which includes agreed Best practices but also a repartition system of the costs re the blocking measures.

Finally, we are waiting for a further step, namely the conclusion of new agreements with hosting companies and the search engines.

Conclusion

As a conclusion, live event protection is undoubtedly an important issue in the E.U., particularly against the illegal live streaming very detrimental to rights holders.

In March 2023, the EUIPO Observatory Expert Group on Cooperation with Intermediaries issued a Discussion Paper on the *“Challenges and good practices from online intermediaries to prevent the use of their services for live event piracy”* in a view of the upcoming recommendation by the European Commission on combating online piracy of live content.

The subject should therefore see some exciting developments in the coming months and hopefully a forthcoming legislative intervention at EU level.

