

A clear demarcation of protection between copyright versus unregistered community designs (ucd), and infringement actions versus unfair competition and parasitism actions



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The 15th November 2016 SARL JILLI SHOES v. SAS SANDRO ANDY Decision of the Paris Court of Appeal is interesting in clarity and method of analysis. It could be taken as an example of the arguments and grounds which need to be brought by owners to defend their rights, especially in cases that lack filings.

In order to sue the manufacturers of a clear copy of its ALBATOROCK shoes, the SANDRO ANDY Company (hereafter SANDRO) claimed a copyright and Unregistered Community Design (UCD), clearly presenting each ground for complaint.

SANDRO first characterized **their work** as a combination of several clearly defined elements. This allowed the judges to determine the originality of this combination of already known elements, considering them as innovative and reflecting the mark of the creator in comparison with the previous LOUBOUTIN sneakers and other examples provided by the adversary.

SANDRO also invoked a UCD. The decision analyzed the novelty and individual character criteria of ALBATOROCK shoes according to Art. 4 §1 and 5-a and 6-a of EC Regulation N° 6/2002 on Community designs. Both criteria were fulfilled as the characteristics of the ALBATOROCK shoes were not present in the aforementioned shoes and because all the significant identifiable differences which produce in the informed user (i.e. the consumer of said sneaker), sensitive to the details of style, an overall distinct impression.

Infringement and unfair competition actions are also clearly distinguished.

Judges can easily recognize the **copyright infringement** in the JILLI SHOES reproduction of the combination of characteristics of the ALBATOROCK sneaker.

Determining **infringement of the SANDRO ANDY UCD** requires a more detailed analysis according to Art. 19.2 and 10 of Regulation N° 6/2002 on Community designs. For an intentional copy, a 3-year period from divulgation and the overall visual impression, taking into account the degree of independence of the author, are criteria that have to be examined. It is stated that during the 3 years from the first divulgation within the European Community of the ALBATOROCK design, JILLI SHOES sold sneakers identically reproducing the combination of elements of said sneaker, creating a visual impression identical to that of ALBATOROCK on the informed user.

The Court of Appeal, applying its rigorous analysis methodology, also recognized **unfair competition and parasitism**, this despite the arguments of JILLI SHOES, which included pretending that the contested shoes were intended for children and not for adults.

In view of these elements, the Court of Appeal increased the damages fixed by the Court of First instance, from 20 000 € to 60 000€ for

infringement, and from 30 000 € to 90 000€ for unfair competition and parasitism.

In light of this decision, we would advise:

- **To claim a copyright, take the time to define all the characteristics of the work**, the judges will not do this in your place,
- **Claim an unregistered design if possible**, it will strengthen your position, even if infringement is more complex to analyze,
- **Unfair competition and parasitism can be invoked in addition to infringement**, to repair damages resulting from the risk of confusion or from taking advantage of the knowledge, work or investment of third parties.



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