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Parody Defense and IP Enforcement in France

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Infringing Trademarks and Copyrights in France: No Parody Defense, No Kidding!

Trademark and copyright owners, notably in the media and entertainment sectors, may be pleased to read that where unauthorized third parties, commonly referred to as alleged infringers, use the owner's trademarks or copyrights on physical goods, a parody defense against a trademark or copyright infringement claims continues to face substantial hurdles in France.

A February 25 judgement of the Paris Judicial Court nicely confirms the long-standing approach French courts take with respect to a parody defense in trademark and copyright infringement lawsuits in cases where the alleged infringer used a trademark or copyrighted work on physical goods in the course of trade.¹

While it may still be appealed, the judgement is a timely reminder that with respect to physical goods, a parody defense is significantly less likely to carry the day in France than for example in the US, where trademark parodies on physical goods appear to have bloomed into a cottage industry.

The case is of practical relevance for customs enforcement and when deciding where and whether to sue when an alleged parody is used for physical goods marketed in Europe.

The Paris Judicial Court Judgement of February 25, 2021

The facts of the case are refreshingly straightforward.

A French company imported from China 1000 embroidered patches reproducing the famous Rolling Stones lips and tongue logo, with the lips featuring the black and white flag of Brittany in a trompe l'oeil style. The French customs withheld the merchandise, the trademark and copyright owner had an infringement seizure carried out and sued the importer. Unsurprisingly the defendant argued that it diverted the meaning of the lips and tongue logo in a humorous manner by associating the logo with the flag of Brittany and with the culture of Brittany.

According to the defendant, applying the flag of Brittany to the lips and using the image not only for the disputed patches but also on other media with a humorous message (“Keep your soft rock, Here we want salted butter”) precluded any risk of confusion with the trademarks, and constituted a parody of the lips and tongue logo under copyright law.

The Paris court made short shrift of these arguments.

As regards the parody defense against the trademark infringement claim, it found that “*the disputed patches do not reproduce any text, [that] from a conceptual point of view, for an average consumer the signs evidently refer to a rock ‘n roll universe conveyed by the logo of the mouth characteristic of the Rolling Stones universe, the flag of Brittany being incapable of preventing this implicit association, [and that] consequently, without it being shown that the plaintiff’s trademarks have been diverted for humoristic ends, **which is in any hypothesis indifferent in trademark infringement matters once the risk of confusion has been characterized in light of the relevant elements**, ... there exists a risk of confusion in the public’s mind which will lead [the public] to consider the disputed sign as an authorized product line of the plaintiff’s trademarks destined to promote musical events in connection with rock concerts in Brittany.*”

As regards the parody defense against the copyright infringement claim, the court found that the patches in and of themselves were devoid of any parody, caricature or humorous effect that the original work itself did not already have, and that such an effect could not result from the impression of the flag of Brittany on the lips of the lips and tongue logo. Hence, “*comparing them with the motif that appears on the “Rolling Stones Classic Tongue Patch”,... these patches reproduce it in a quasi-identical manner with the noted exception of the reproduction of the flag of Brittany*” and infringe the iconic copyrighted lips and tongue logo.

The parody argument thus failed both under the parody exception to copyright and as a trademark non-infringement argument based on the absence of a risk of confusion and/or on parody or fair use.

Before reaching and rejecting the parody defense, the court rejected the defendant’s arguments (i) that the trademark infringement claim was inadmissible because the plaintiff did not justify that it had the right to manage the Rolling Stones’ intellectual property rights or that it had been authorized by Mick Jagger to file the trademarks, the court finding that the plaintiff was the registered owner of the trademarks, and (ii) that the copyright infringement claim should be dismissed because the plaintiff only produced the second, but not the first, rights assignment from graphic design artist John Pasche to the plaintiff, and because the plaintiff did not publicly market patches with the lips and tongue logo. In line with established French case law, the court held that absent a claim by the author him- or herself, a legal entity is presumed vis-à-vis third parties to own the exploitation rights in a copyrighted work that it markets unequivocally in its own name. Here, the court found that the plaintiff marketed embroidered patches through middlemen in many EU countries.

By Way of Background

With respect to the use of trademarks or copyrights on physical goods in the course of trade, French courts consistently draw a line that gives rights holders some predictability in their enforcement and customs enforcement efforts in France.

At first glance, the position of the French courts may appear out of line with EU case law on a parody defense.

The Court of Justice of the European Union (CJEU) has held that “*the concept of parody... must be regarded as an autonomous concept of EU law and interpreted uniformly throughout the European Union*”, and that “*the essential characteristics of parody are first to evoke an existing work, while being noticeably different from it, and secondly to constitute an expression of humor or mockery.*” ² The CJEU specifically rejected adding any additional conditions

that may be found in national copyright laws such as that the parody should display an original character of its own, that it could reasonably be attributed to a person other than the author of the original work and/or that it should relate to the original work itself or mention the source of the parodied work.³

However, the Court of Justice of the European Union also held (i) that the application in a particular case of the parody exception must strike a fair balance between the interests and rights of rights holders and the freedom of expression of the user of a protected work who is relying on the exception for parody, and (ii) that it is for the national courts of the EU member states to determine in light of all the circumstances on the merits whether the application of the parody exception preserves that fair balance.⁴

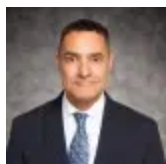
As the Paris Judicial Court decision illustrates, when taking into account all of the circumstances on the merits, French courts continue to reject a parody defense where the alleged parody is used in trade on physical goods and identifies their commercial origin, while allowing such a defense against trademark infringement claims where parody was used to promote public health messages (tobacco brands) or environmental criticism (oil companies or nuclear power plant operators), or where it was used in trade to mock the parodied trademark itself.

References

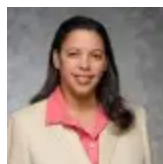
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- 1 Tribunal Judiciaire de Paris, 3rd Chamber, 1st section, RG 19/08859 ^
- 2 Judgment of September 3, 2014, *Deckmyn*, C-201/13, EU:C:2014:2132, paragraphs 15 and 33 ^
- 3 *Deckmyn*, supra, paragraph 33 ^
- 4 *Deckmyn*, supra, paragraphs 34 and 35 ^

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