

LACOSTE:

Imitation of the “crocodile” design.

The company

Lacoste is a French company, founded in 1933 by tennis player René Lacoste and André Gillier. It sells clothing, footwear, sportswear, eyewear, leather goods, perfume, towels and watches. The company distinguishes by its green crocodile logo.

Boston, 1923, a young tennis prodigy René Lacoste is 19 and likes a challenge. His team captain promises him the crocodile leather suitcase the player admired in a store window if he wins his upcoming match. René doesn't win but he had the determination of the crocodile on court, which is why an American journalist gave him this nickname.

The crocodile takes shape in 1927 under the pen of designer Robert George. An early fan of customization, René Lacoste immediately has it embroidered on his blazers.

Backgrounds

Mr. A.S applied for registration of the trademark GREEN ZONE (mixed) in international class 25. This trademark had been contested by SPORLOISIRS S.A. on the grounds of confusion with its LACOSTE trademarks and crocodile design and the notoriety of the latter.

Client

SPORLOISIRS S.A.



LACOSTE 



First decision of the National Industrial Property Office

By resolution dated 19th. October 2016, the National Directorate of Industrial Property of Uruguay granted the registry of the trademark GREEN ZONE No. 438314, not allowing the opposition filed by Sporloisirs S.A.

In this case, the TMO understood that the signs analysed globally had particular characteristics in the denomination and design that made them different and therefore able to coexist. As well it considered that the image of the crocodile in the sign applied for was different from the design of the crocodile included in the opposing trademarks.

Recursive instance: resolution in favour of SPORLOISIRS S.A.

On January 23, 2017, SPORLOISIRS S.A. filed an administrative appeal against the resolution granting the GREEN ZONE trademark No. 438314 based on the confusion and notoriety of its family of trademarks. At that instance, it was argued that, notwithstanding the fact that the trademark applied for included the words 'GREEN ZONE', the inclusion of the characteristic and well-known design of SPORLOISIRS would undoubtedly lead to confusion in the mind of the consumer, which would constitute an unfair advantage and detriment to their industrial property rights. Several documents were also added in the corresponding instance to support the allegations.

By decision dated November 11, 2019, the TMO granted the appeal and rejected the registration of the trademark GREEN ZONE in class 25. In the appeal instance, the TMO accepted the grounds expounded by the opponent, recognising that SPORLOISIRS' trademarks constitute a family of trademarks characterised by the crocodile design and that the LACOSTE registrations, and its crocodile figure, are recognised and well-known trademarks in the clothing and footwear industries in Class 25. Therefore, all these aspects may lead to the consumer's confusion.

The mentioned resolution became final on February 2020 considering the applicant did not file further action before the High Administrative Court.

Conflicting trademarks:

SPORLOISIRS S.A.
is the owner of the
following "CROCODILE"
trademark applications:



A.S. applied for
trademark GREEN ZONE
(mixed) in class 25:



Conclusions

The relevance of the present resolution relies on the fact that it was possible to revoke the previous TMO decision which had understood that the trademarks were not confusingly similar. The study carried out in the second instance exceeded the mere analysis of confusion between trademarks and took into account a fundamental aspect such as the notoriety of the trademarks.

The notoriety of the trademarks on which the opposition is based and the ownership of a family of trademarks were key in this case. The inclusion of the characteristic element of the LACOSTE family of trademarks will lead to consumer confusion and consequently to association with well-known trademarks.

by:



**Dr.
Virginia Cervieri**

Senior Partner
vcervieri@cmlawyers.com.uy



**Dr.
Natalia Paladino**

Partner
npaladino@cmlawyers.com.uy



**Dr.
Andrea Casales**

Lawyer
acasales@cmlawyers.com.uy