

LONGCHAMP®:

Copyright protection of handbag designs.

LONGCHAMP® is a trademark owned by S.A.S. Jean Cassegrain. It was founded by Jean Cassegrain in 1948 in Paris, France. However, its stellar presentation was not until May 1, 1948, at the Paris Fair.

In the words of Phillippe Cassegrain, Jean’s son, he says: *“My father welcomed customers from all over the world to his stand, eager to discover the latest novelties, the latest fashions!”*

The brand stands for style, quality, creativity, innovation, and art. This is the reason for the success of its products and its solid reputation in all regions and cultures.

Backgrounds

In May 2023, LONGCHAMP became aware that in a store in the metropolitan area of Asunción, the capital of Paraguay, they were commercializing handbags that infringed its copyrights and registered trademarks such as the famous handbag design.



1. 1948, The Paris Fair. (Recovered from <https://www.longchamp.com/es/es/la-historia-de-longchamp/> en fecha 18 de julio de 2023)

This situation, in addition to being an infringement of LONGCHAMP's intellectual property rights, causes a risk of confusion and association regarding the origin of the counterfeit products, and the resulting reputational damage to the LONGCHAMP brand.

Actions

By means of a preliminary investigation that allowed securing the evidence, it was possible to confirm that the store was indeed selling counterfeit handbags with LONGCHAMP's protected designs.

Subsequently, in the presence of a notary public, a purchase was made, and a cease-and-desist letter was sent to those responsible for the store, all of which was recorded in a notarial deed.

In the letter, it is requested that

- ▶ the infringer acknowledges LONGCHAMP's intellectual property rights and the infringement committed;
- ▶ immediately cease the use, sale, or promotion of any product that infringes LONGCHAMP's intellectual property rights;
- ▶ remove any image or content, both physical and online, that is identical or similar to LONGCHAMP's intellectual property rights;
- ▶ handing over the remaining stock of infringing products for their subsequent destruction;
- ▶ indicating the origin of the counterfeit products;
- ▶ and, undertaking through a settlement agreement not to engage in the conduct again subject to the execution of a penalty clause.

S.A.S. Jean Cassegrain
is the holder in Paraguay, among others
of the following trademarks:

Trademark registration
N° 476105, to protect
products of class 18.

LONGCHAMP

Trademark registration
N° 539490, to protect
products of class 18.



Trademark registration
N° 476108, to protect
products of class 18.



Trademark registration
N° 503162, to protect
products of class 18.



Likewise, it has international copyrights, lodged in countries such as Argentina, Brazil, Chile, Colombia, Panama, China, and Russia.



Law No. 1294/98 “ON TRADEMARKS”

Art. 84: *The owner of a right of exclusive use of a registered trademark or trade name may bring an action before the judicial authority against any person who infringes that right. Any of the following acts shall constitute an infringement of the right of the owner of a registered trademark: e) using in trade a sign identical or similar to the trademark or trade name for any goods or services where such use could cause confusion or a risk of association with the owner of the registration; f) to use in trade a sign identical or similar to the trademark or trade name for any goods, services, or activity when this may cause the owner unfair economic or commercial damage due to a dilution of the distinctive force or commercial or advertising value of the sign, or unfair exploitation of the prestige of the sign or its owner ;and , g) publicly using a sign identical or similar to the trademark or trade name, even for non-commercial purposes, when this could cause dilution of the distinctive force or the commercial or advertising value of the sign, or unfair exploitation of its prestige.*

Law No. 1328/98 “ON COPYRIGHT AND RELATED RIGHTS ”

Art. 158: *The owners of any of the rights recognized by this Law, or their representatives or the collective management bodies concerned, may, without prejudice to such other actions to which they may be entitled , request the ceasing of the infringer´s unlawful activity and demand compensation for the material and moral damage caused by the infringement , or the surrender of the profits made by the infringer through the unlawful act, and the payment of procedural costs. The compensation for material damage and prejudice shall include not only the amount that should have been charged for the grant of the authorization, but also a minimum surcharge corresponding to 100% (one hundred per cent) of said amount, except where the aggrieved party proves the existence of a greater prejudice, due account being taken of the income generated by the infringer through the commission of the unlawful act.*

Settlement Agreement

As a result of the actions taken, the infringer was contacted to negotiate a settlement agreement, which as defined in the Paraguayan civil code, the parties **through reciprocal concessions put an end to or prevent litigation².**

Under the terms of the agreement and as required in the cease-and-desist letter, the infringer acknowledges LONGCHAMP’s intellectual property rights, including copyrights.

2. Paraguayan Civil Code, Art. 1495.- The transaction contract allows the parties, through reciprocal concessions, to put an end to litigation or to prevent it. By means of this contract, it is also possible to create, modify, or extinguish legal relations different from those which were the subject of the litigation or the reason for the controversy.

Conclusions

Extrajudicial actions based on copyrights are effective in the fight against piracy in the fashion world.

Cease and desist letters are effective both as a means of safeguarding evidence in the event of litigation and of obtaining a satisfactory result out of court.

Settlement agreements are an effective means of resolving out-of-court actions and preventing litigation and provide clients with a substantial advantage in the terms to be agreed upon.

by:



**Dr.
Lucía Cantera**

Senior Associate
lcartera@cmlawyers.com.uy



**Mgtr.
Carlos Pavón**

Lawyer
cpavon@cmlawyers.com.py