



Domains & Domain Names

in 16 jurisdictions worldwide

2014

Contributing editor: Flip Petillion



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Getting the Deal Through is delighted to publish the first edition of *Domains & Domain Names*, a new volume in our series of annual reports, which provide international analysis in key areas of law and policy.

Following the format adopted throughout the series, the same key questions are answered by leading practitioners in each of the 16 jurisdictions featured.

Every effort has been made to ensure that matters of concern to readers are covered. However, specific legal advice should always be sought from experienced local advisers. *Getting the Deal Through* publications are updated annually in print. Please ensure you are always referring to the latest print edition or to the online version at www.GettingTheDealThrough.com.

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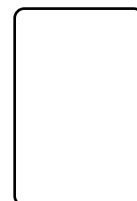


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France

Marie-Emmanuelle Haas

ME Haas

Registration of domain names at ccTLD registry

1 Registry

Which entity is responsible for registration of domain names in the country code top-level domain (ccTLD)?

The entity responsible for registration of domain names in the .fr national extension is the French association for a cooperative domain name system (AFNIC). It is a non-profit association that was created in 1998 to administrate the French TLDs.

The AFNIC was appointed by an Order of 19 February 2010, according to the law governing domain names in France.

The law provides that the AFNIC must be domiciled in the European Union and is appointed by the Ministry for Digital Economy pursuant to a tender public process, for a five-year period that can be renewed once (article 45 of the French Post and Electronic Communication Code, introduced by Law No. 2011-302 of 22 March 2011).

The Council of State, which is the highest administrative court in France, ruled that the French registry has a 'mission of public policy' (CE, sub-sections 10 and 9, 10 June 2013, M. A. v/ AFNIC).

The French Registry is in charge of .fr and of overseas TLDs: .re (Reunion Island), .pm (St Pierre and Miquelon), .tf (French Southern and Antarctic Territories), .wf (Wallis and Futuna) and .yt (Mayotte). French law applies to all these extensions.

We will focus on .fr, which is the national TLD for France.

2 Registration procedure

How are domain names registered?

Registrars

The registration process is exclusively performed through registrars, which are service providers including but not limited to Internet Service Providers (ISPs). They are accredited by the AFNIC to register domain names under .fr. A web agency can be accredited as a registrar for one of the French ccTLDs. An accredited registrar is a mandatory intermediary between the AFNIC and the registrant. There are about 400 accredited registrars.

The list of all accredited registrars is available at: www.afnic.fr/en/your-domain-name/how-to-choose-your-domain-name/registrars-directory/.

The characters

Internationalised domain names (IDNs) can be included in a .fr domain name since July 2011.

The following alphanumeric characters are admitted: a, à, á, â, ã, ä, å, æ, b, c, ç, d, e, è, é, ê, ë, f, g, h, i, î, í, ï, j, k, l, m, n, ñ, o, ò, ó, ô, õ, ö, ø, p, q, r, s, t, u, û, ü, v, w, x, y, ý, ÿ, z, ß, 0, 1, 2, 3, 4, 5, 6, 7, 8, 9, - (hyphen; minus sign).

The maximum number of characters is 63.

AFNIC created and maintains a list of domains whose registration is subject to prior review. These are geographical terms,

generic terms related to crimes (bombe, deportation, profanation), freedoms (boudha, juif, tantrique, pasteur, secte, culte), health (acid, coke, marijuana), international organisations (asean, bird, bit, casque-bleu, casque-bleus, wipo, unesco), internet organisations (apnic, arin, centr, iana, icann), offences (assassinat, cime), regulated business (architecte, artisan, chirurgien), the state (academie, impôt, drapeau, sénat), structures (syndicat), values (bordel, racism), gTLDs (arpa, biz, ccTLD), and to the name of the French cities and villages that are local districts (communes).

Eligibility

There are eligibility rules for .fr (article L. 45-3 of the French Post and Electronic Communication Code).

Any third party can inform the AFNIC of a difficulty to contact the holder of a domain name (postal address, telephone number or e-mail) or contest its eligibility. A template is available on the website www.afnic.fr/medias/documents/afnic-formulaire-verification-en-pdf.

This procedure is meant to control the eligibility and reachability of the registrant. It can also be started by the AFNIC or by a registrar (article 3.2 of the registration rules for French extensions).

After an unsuccessful verification procedure, the domain name can be deleted.

Individuals: since 2006

Since 2006, individuals domiciled within the European Union can register a .fr domain name.

Domain names registered in the name of individuals are anonymously registered, for the purposes of personal data protection. In case of a conflict with a third party that can oppose a prior right, the right owner can request the disclosure of the registrant's name, by using a template that is available on the registry's website. It has to justify its rights on a prior right that can be:

- a trademark already registered and protected in France;
- an existing trade name or signboard protected in France;
- an existing title protected by French intellectual property rights (copyrights); or
- a surname or a pseudonym.

The French registry will examine the request on the basis of the likelihood of confusion between the domain name at issue and the opposed prior right, without analysing the content of the websites.

In case of an anonymous WHOIS, the French registry provides the possibility to use its contact interface to communicate with the domain name's administrative contact.

Legal entity: location in Europe

Any legal entity with its headquarters or principal place of business within the territory of one of the member states of the European Union or in Iceland, Liechtenstein, Norway and Switzerland can register a .fr domain name.

Validity rules

There are validity rules (article L.45-2 of the French Post and Electronic Communication Code).

According to these rules, a domain name must comply with public policy and morality and must not infringe rights recognised by the law. It must not infringe intellectual property rights or personality rights, unless the registrant justifies that he or she has a legitimate interest and is acting in good faith. The domain name must not be identical or similar to the name of the French Republic, or to the name of a territorial collectivity, which are the country subdivisions in France, or a group thereof, or of an institution or national or local public service, unless the registrant justifies that he or she has a legitimate interest and is acting in good faith.

The French Registry has to allow the registrant to: respond to any request to cancel or transfer his or her domain name; and to eventually regularise the situation.

3 Registration duration

For how long is registration effective?

The domain name is registered for an automatically renewable period of 12 months.

The WHOIS database is the property of the French Republic.

4 Registration costs

What is the cost of registration?

A .fr domain name is sold for a few euros by the French Registry to the registrars, which are free to establish the resale price to the public.

5 Transfer

Are registered domain names transferable? If so, how?

Yes, domain names are transferable.

Only a registrar can be in charge of the process of moving a domain name from one registrar to another and of the process of modifying the name of the registrant.

These processes are conducted via e-mail.

The registrant who wants to transfer its domain name to a new registrar needs the transfer code.

The new registrant has to be eligible for registering a .fr domain name.

The registrant can change registrar.

When the new registrant wants to change registrar, the process has to be started by the new registrar called the 'incoming' registrar and the former or 'outgoing' registrar has to be informed.

The AFNIC will send two notification e-mails, one to the current registrant and one to the future or new registrant. Each has a 15-day deadline to confirm that he or she accepts the transfer by clicking on the link provided in the e-mail. If it cannot proceed by e-mail, a paper procedure is available, but it is not the usual way to proceed.

In the absence of any reply within 15 days, the transfer operation is cancelled and the name of the registrant is not modified.

6 ccTLD/gTLD registration

What are the differences, if any, with registration in the ccTLD as compared with a generic top-level domain (gTLD)?

There is a French Law that regulates .fr domain names and the French overseas TLDs.

There are eligibility and validity rules. (Articles L.45 to L.45.8 and R.20-44-38 to R.20-44-47 of the French Post and Electronic Communication Code. Law No. 2011-302 of 22 March 2011 and Decree No. 2011-926, 1 August 2011, modified by Order No. 2014-329 of 12 March 2014 and by Decree No. 2012-951 of 1 August 2012.)

The .fr domain names cannot be registered directly with the registry.

There is a specific procedure, called Syreli, that is administrated by the French registry, to decide on the validity of .fr domain names.

The state is represented by members of the ministry in charge of telecommunications, the ministry in charge of industry and the ministry in charge of research, within AFNIC's board of directors, which has 10 members.

Opposing registration in the ccTLD**7 Notification of third parties**

Are third parties notified of a domain name registration or attempt to register a domain name? If so, how? If not, how can third parties receive notice?

Third parties are not notified of a domain name registration or attempt to register a domain name. There is no opposition procedure.

8 Opposition procedure

How may a third party oppose registration? What are the remedies if the opposition is not successful? What are the remedies to enforce a decision?

There is no opposition procedure.

9 Costs of opposition

What are the costs related to a pre-litigation action?

Not applicable.

10 Time frame for opposing registration

What is the timing related to a pre-litigation action?

Not applicable.

Transfer or cancellation**11 Dispute format**

What is the typical format for a cancellation or transfer action in court litigation (domains registered in either a ccTLD or a gTLD) and through ADR (ccTLD only)?

The typical format for a cancellation or transfer action in court litigation is to file an action on the merits based on prior rights. It can be intellectual property rights, mainly trademarks or other rights that are protected under French law, like rights on a company name, on a trade name or a signboard that are known throughout the national territory. It can also be based on the violation of the French law governing .fr and overseas domain names.

French courts are competent as soon as it can be justified that the website under the litigious domain name, that can be any ccTLD or gTLD, targets internet users who are domiciled in France.

There is no discovery. Pursuant to the notification of the writ of summons, there are procedural hearings that are meant to organise and follow up the communication of exhibits and documents between the parties. Once the judge considers that all parties have had enough time to explain their position, the case can be pleaded.

Intellectual property cases are judged before the civil courts. Parties must be represented by an attorney at law and this is a written procedure.

When no trademark or copyright is opposed, the case can be judged either by a civil court or by a commercial court, depending on the quality of the parties (merchant or non-merchant). It is not requested to be represented by an attorney at law before the commercial courts.

Syreli procedure is an online procedure. The complaint and the exhibits are sent to the AFNIC on the Syreli platform: www.afnic.

fr/en/dispute-resolution/tools-and-procedures/syrel-dispute-resolution-system-24.html.

This procedure was introduced on 21 November 2011. The complaint is based on article L.45-2 of the French Post and Electronic Communication Code, which provides validity rules (see question 2). The complainant has to first open an account on the Syreli platform to send the complaint and the attached exhibits and to pay the tax of €250 + VAT. The respondent does the same, if it wishes to respond. It does not have to pay any tax.

The decision is rendered within two months by a panel of three members composed of the AFNIC's director and of two members designated by the AFNIC's director.

12 Strategy

What are the pros and cons of litigation and ADR in domain name disputes? What are the pros and cons of choosing a local forum to litigate a gTLD dispute compared with the ICANN ADR format for the gTLD?

The advantages of choosing ADR are:

- speed of the procedure;
- automatic suspension of the domain name at issue;
- adapted to international cases;
- easy to start;
- when a trademark is opposed, there is no need to have a valid trademark in a specific country;
- ease of the implementation when the transfer or cancellation is ordered; and
- cheaper than a court action.

The disadvantages of choosing ADR are:

- no compensatory damages;
- no prohibition to use the name at issue; and
- the debate is limited to the question of the defendant's legitimate rights and interest and bad faith.

After the ADR procedure is concluded, the winning party can start a procedure before a court of competent jurisdiction to claim compensatory damages and prohibition to use the litigious name at issue, under penalty.

The advantages of choosing a local forum to litigate a gTLD dispute compared with the ICANN ADR format for the gTLD are as follows:

- the claim can include a request for compensation and prohibition to use the litigious domain name, under penalty;
- when the defendant is identified and domiciled in France, the implementation and enforcement of the decision will be easier;
- it enables the discussion of other issues apart from the absence of the registrant's legitimate rights or interests and the registrant's bad faith; and
- it enables the suing of other parties in addition to the sole registrant.

The disadvantages of choosing a local forum to litigate a gTLD dispute are as follows:

- there is no automatic suspension of the domain name at issue;
- it is difficult to reach the registrant who is domiciled abroad and to serve a writ of summons;
- the WHOIS is anonymous and there is no disclosure procedure, which prevents them from serving a writ of summons;
- when the registrant is not domiciled in France, it might be difficult to implement and enforce the decision abroad;
- it is preferable to limit the debate to the absence of the registrant's legitimate rights or interests and to the registrant's bad faith; and
- the court procedure might be longer and more expensive until a final decision is rendered.

13 Appeal

What avenues of appeal are available?

There is no appeal procedure to contest a Syreli decision.

Each party can prevent the implementation of a decision by starting a court action before a French court within a 15-day deadline as of the notification of the Syreli decision to the parties.

The action has to be brought before a first instance court.

14 Defendants

Who may act as defendant in an action to cancel or transfer a gTLD in local courts?

The defendant is the registrant.

The registrar can be party to a court procedure, but it is not necessary unless it can be proved that it has engaged its responsibility.

The registrar is not considered by the French courts as a service provider. Therefore, it does not benefit from the exemption of liability provided by the French law implementing Directive 2000/31/EC on electronic commerce (Law No. 2004-575 of 21 June 2004). It has been ruled that a registrar has a mere technical role and is not liable on the basis of trademark infringement, because it does not make any use of the opposed trademark in the course of trade (CA Paris, pôle 5, 2^e ch., 19 October 2012, No. 09/20514, SA Air France, SCA Compagnie Générale des Établissements Michelin, SA Compagnie Gervais Danone, SA France Télévisions, SNC Lancôme Parfums et Beauté & Cie, SA L'Oréal, SAS Renault, SA Voyageurs du Monde v/ AFNIC, SA EuroDNS).

It is not necessary to sue the registry.

Chapter 7 of the 'naming charter' provides that 'pursuant to paragraph 4 of the Annex to the Order of 19 February 2010, the AFNIC may only intervene in accordance with a court order handed down after legal proceedings or as part of the Syreli procedure'. It further provides that (article 7.1):

AFNIC does not interfere in judicial proceedings relating to domain names for which it is responsible.

AFNIC does not have the authority to take precautionary measures, since they can only be implemented further to a Court order taken to meet the requirements of this article.

It is therefore the sole responsibility of the third parties concerned to take all the appropriate measures to stop any violation they claim to infringe their rights.

The naming charter requests that any decision rendered by a court requesting the AFNIC to implement it, has to be first notified to the AFNIC by a bailiff.

15 Remedies for infringement

What remedies are available to a successful party in an infringement action?

The successful party can obtain:

- either the cancellation or the transfer of the domain name at issue, in certain cases, for example when the litigious domain name is not a .fr domain name and when it is used in France and in other countries where the complainant has no right, the remedy may be a prohibition to use the litigious domain name in France;
- the payment of damages, including a publication of the decision in reviews or on a website during a certain period of time, the involved costs being borne by the losing party;
- a prohibition of use of the name at issue, for whatever purpose and in any way and for any means, if the prior right is a Community trademark, the prohibition of use can cover the territory of all EU members; and
- a compensation for the incurred fees, with the payment of a lump sum of €1,000 to €5,000.

Update and trends

A new ADR procedure administrated by WIPO will soon be available again.

There used to be such an ADR procedure before. It has been abandoned in 2011, pursuant to the cancellation of the first French Law regulating domain names by the Conseil Constitutionnel, which is in charge of the review of constitutional issues.

This procedure started with the request of an individual, Mr Mathieu P to the Conseil d'Etat, which is the highest administrative court in France, to cancel the order that had designated the French registry. This request led to a referral to the Constitutional Council to judge the constitutionality of the law with regards to the French Constitution. The decision states that the parliament delegated to the government the power to define the regulation governing domain names while this is part of the power reserved to it. The Constitutional Council decided that this law violated individual rights to free enterprise, property (Constitutional Council, decision No. 2010-45, QPC, 6 October 2010). It underlined the importance of domain names in the digital economy. This is the context in which French domain name regulation is evaluating.

The French law governing French ccTLDs and .fr is still quite new and one of the issues is how to combine it before a judicial court with other provisions, such as trademark law.

16 Injunctive relief

Is injunctive relief available, preliminarily or permanently, and in what circumstances and under what conditions?

A preliminary injunction can be requested in urgent cases, in order to obtain the suspension of the domain name at issue, the prohibition of any use thereof or the award of an interim payment as a compensation for the suffered damages.

The interim decision has to be executed, even in case of an appeal.

In case of a trademark infringement, the court provides the possibility to start summary proceedings to request measures under penalty in order to stop the alleged imminent infringement. In certain circumstances, such measures may even be ordered on the sole request of the complainant who can start a non-adversarial proceeding (article L.716-6 of the French Intellectual Property Code).

17 Damages

How is monetary relief calculated?

To calculate monetary relief, the judges take into consideration the economic damage, the non-economic damage and also, when a trademark is infringed, the loss in the infringing trademark's value.

The publication of the judgment is considered as a complementary compensation for the suffered damages. The costs are supported by the losing party.

In trademark cases, it is provided that the court may award a compensation that is calculated on the basis of the suffered loss and of the benefit realised by the infringer. A lump sum can be awarded as a global compensation (article L.716-14 of the French Intellectual Property Code).

Statistics for 2012

Out of 53 decisions concerning domain names rendered and published in France in 2012, the judges have ordered damages in 23 cases.

The granted monetary relief was, for the most part, between €5,000 and €55,000:

2012 – amount of the damages (published decisions concerning domain names)		
	11 decisions – TGI (1st instance)	12 decisions – CA (2nd instance)
€0–5,000	1: €1 1: €1,500 1: €2,000	1: €1,000 1: €2,000 1: €4,000 1: €4,500
€5,000–10,000	1: €5,000 1: €6,000 1: €10,000	1: €5,000 1: €8,000
€10,000–20,000	1: €15,000 1: €20,000	1: €10,000 1: €16,000
€20,000–55,000	1: €30,000 1: €35,000	2: €40,000 1: €50,000 1: €52,500
€55,000–100,000	-	-
€100,000–200,000	1: €200,000	-

Publication of the judgment in 2012

Out of these 53 decisions, publication of the judgment in reviews or on a website has been asked for 12 of them and it has been granted by the judges in only three cases.

Statistics for 2011

In 2011, out of 88 decisions concerning domain names rendered and published in France, the judges have ordered damages in 45 cases.

The granted monetary relief was, for the most part, between €1,000 and €55,000:

2011 – amount of the damages (published decisions concerning domain names)		
	22 decisions – TGI (1st instance)	23 decisions – CA (2nd instance)
€0–5,000	1: €2,000 1: €3,000 1: €4,000	3: €1,000 1: €2,000 1: €2,860
€5,000–10,000	5: €5,000 1: €7,000	1: €5,000 1: €6,000 1: €8,000
€10,000–20,000	4: €10,000 1: €11,000 1: €15,000 1: €16,000 1: €17,000	5: €10,000 3: €15,000 1: €16,000
€20,000–55,000	1: €20,000 1: €35,000	2: €20,000 1: €30,000 1: €35,000
€55,000–100,000	1: €60,000 1: €70,000 1: €97,200	1: €62,000
€100,000–200,000	-	1: €100,000

Publication of the judgment in 2011

Out of these 88 decisions, publication of the judgment in reviews has been requested 20 of them and has been granted by the judges in only seven cases.

18 Criminal sanctions

What criminal remedies exist, if any?

In case of a trademark infringement, the suit can be filed before the criminal court.

Criminal remedies are identified in the French Intellectual Property Code under articles L.716-9 to L.716-13).

Article L716-9:

Any person, who, for the purpose of selling, supplying, offering for sale or lending goods under an infringing mark, a) imports, under any customs regime, exports, re-exports or transships goods presented under an infringing mark, b) reproduces industrially goods presented under an infringing mark, c) gives instructions or orders to commit the acts provided for at (a) and (b) shall be liable to a four-year imprisonment and a fine of € 400,000.

Where the offences provided for under this article have been committed by an organized criminal group, the penalties will be increased to a five-year imprisonment and a fine of €500,000.

Article L716-10 states that a person who does any of the following shall be liable to a four-year imprisonment and a fine of €400,000:

a) holds without legitimate reason, imports under all customs procedures or exports goods presented under an infringing mark; b) offers for sale or sells goods presented under an infringing mark; c) reproduces, imitates, uses, affixes, removes, modifies a mark, a collective mark or a collective mark of certification in violation of the rights conferred by its registration and of prohibitions which rise from this; d) delivers knowingly a product or provides a service other than that which is required of him under a registered mark shall be liable to a three-year imprisonment and a fine of €300,000. The infringement, under the conditions provided for at (d), shall not be considered constituted if a pharmacist exercises the faculty of substitution provided for under Article L. 5125-23 of the Public Health Code. Where the offences provided for at (a) to (b) have been committed by an organized criminal group, the penalties will be a five-year imprisonment and a fine of €500,000.

The criminal or the civil judge can order the total or partial closing of the enterprise (article L.716-11-1 of the French Intellectual Property Code).

Legal entities may be declared criminally liable (article L.716-11-2 of the French Intellectual Property Code).

19 Limitation periods

Is there a time frame within which an action must be initiated?

Trademark infringement

The action for trademark infringement shall be barred after five years as of the infringement ceased (article L. 716-5 of the French Intellectual Property Code).

Trademark cancellation action: the action will be declared inadmissible by the Court if the trademark owner has tolerated the use thereof for five years, unless the applicant's has acted in bad faith (article L. 714-3 of the French Intellectual Property Code).

Civil liability

The time frame is five years as of the day when the right owner knew or should have been aware of the litigious facts (article 2,224 of the French Civil Code).

20 Estoppel and prescription

Can a registrant's rights in a domain name prescribe because of non-use? Can a registrant be estopped from bringing an infringement action? In what circumstances?

No, a registrant's rights in a domain name cannot prescribe because of non-use.

Nevertheless the registrant who does not use its domain name is not able to oppose any right to a third party.

Using a domain name is the condition to be able to further request a protection on this 'distinctive sign'.

The first decision that ruled that an active prior domain name can prevail on a trademark, has been rendered by the court of first instance in *Le Mans* in 1998 (*TGI Le Mans*, 1re ch., 29 June 1999, RG No. 9802878, *Microcaz v Océanet and SFDI*, JurisData No. 1999-133025)

The provisions of the court provide that a trademark is not valid, if it infringes, 'notably' a list of rights such as a prior registered trademark, a trade name that is known on the entire national territory, a copyright, etc (article L.711-4 of the Court). It has been ruled that, since this list of prior rights is not limited, a new right, such as a right on a domain name, which, like the right on a trade name, is acquired by use, can be regarded as a distinctive sign and protected as such.

In the *Sunshine* case, the Court of Cassation ruled that an action requesting the transfer of the domain name at issue has to be an action on the merits (Cass. com., No. 08-12.904, 9 June 2009, *Mr André D v Sunshine*, AFNIC, OVH, JurisData No. 2009-048529).



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21 Disputes timescales

What is the typical time frame for an infringement action at first instance (at trial or in an ADR procedure) and on appeal?

The typical time frame for an infringement action at first instance is one year and at second instance (appeal) is also one year.

22 Standing

Who is entitled to seek a remedy and under what conditions?

The civil action for trademark infringement is filed by the trademark owner. The exclusive licensee may bring an action, unless otherwise specified in the contract if, after formal notice, the right holder does not defend his or her right.

Also, any party to a licence agreement is entitled to intervene in infringement proceedings brought by another party to obtain compensation for his or her own loss allegedly suffered (article L.714-7 of the French Intellectual Property Code).

When the right owner files a suit, the non-exclusive or exclusive licensee can join the action.

It is not requested to register a trademark licence before the French trademark registry. The licence can be proven by any means.

The exclusive licensee has to produce a written agreement providing the exclusivity.

23 Burden of proof

What is the burden of proof to establish infringement and obtain a remedy?

The burden of proof falls on the right holder. It has to demonstrate that there are phonetic, visual or conceptual similarities between its sign and the respondent's domain name, to prove that it is likely to create a risk of confusion in the public mind.

Infringement can be proven by any means. Good faith is not taken into account.

24 Case law and precedent

Is a case law overview available on procedural or substantive issues? Does the case law have a precedential value?

An annual case law overview has been available since 2009. The first case law review commented on the published decisions that had been rendered in 2008. Since 2008, between 53 and 88 have been published each year: 57 in 2008, 62 in 2009, 62 in 2010, 88 in 2011 and 53 in 2012.

Case law has no precedential value. It is meant to be used to know how to apply and interpret the law.

25 Appointment of panellists

Can parties choose a panellist in an ADR procedure involving a ccTLD? Can they oppose an appointment?

The Syreli procedure, which is currently the only available ADR procedure for .fr, does not provide for the designation of a panellist.

26 Costs

What is the typical range of costs associated with an infringement action, including pre-litigation procedures, trial or ADR, and appeal?

The Syreli tax to be paid to the AFNIC is €250 without VAT.

In the court of first or second instance court costs are approximately a few hundred euros.

The fees depend on the difficulty of the case and of the duration of the procedure. There is no official mandatory fee schedule.



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