

France

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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 1997 to administer the French TLDs.

AFNIC was appointed as the French registry by an order of 19 February 2010, pursuant to the law governing domain names in France.

The law provides that the French registry must be domiciled in the European Union and is appointed by the Ministry for Digital Economy pursuant to a public tender process, for a five-year period that can be renewed once (article 45 of the Postal 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, *MA v AFNIC*).

The French registry is in charge of the .fr TLD and those of French overseas territories: .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 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) have been permitted in a .fr domain name since July 2011.

The following characters are admitted: a, à, á, â, ã, ä, å, æ, b, c, ç, d, e, é, ê, ë, f, g, h, i, î, í, ï, j, k, l, m, n, ñ, o, ó, ô, õ, ö, ø, p, q, r, s, t, u, ú, 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.

Since 9 December 2014, the AFNIC has allowed the registration of domain names under the .fr TLD that consist of only one or two characters. AFNIC created and maintains a list of domains whose registration is subject to prior review. These are geographical terms, generic terms related to crimes and offences (*bombe, deportation, profanation, assassinat, crime*), beliefs (*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*), regulated businesses (*architecte, artisan, chirurgien*), the state (*academie, impôt, drapeau, sénat*), organisations (*syndicat*), values (*bordel,*

racism), gTLDs (*arpa, biz, cctld*), and the names of French administrative communes.

Eligibility

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

Any third party can request verification from AFNIC if it has difficulties in contacting the holder of a domain name (through its postal address, telephone number or e-mail) or to contest its eligibility. A template is available on the website www.afnic.fr/medias/documents/afnic-formulaire-verification-en.pdf.

This procedure is intended to regulate the eligibility and contactability of registrants. 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, individuals domiciled within the European Union may 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 domain name on the basis of a prior right, the rights holder 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 opposition on the basis of a prior right, which can be:

- a trademark already registered and protected in France;
- an existing trade name or sign 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 result, 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 Postal 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 must allow the registrant to respond to any request to cancel or transfer his or her domain name; and if necessary, to resolve the situation.

3 Registration duration

For how long is registration effective?

A 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.

The registration cost of a .fr domain name consisting of one or two characters is €200.

5 Transfer

Are registered domain names transferable? If so, how?

Yes, domain names are transferable and the transfer process is conducted by e-mail.

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.

The registrant who wants to transfer its domain name to a new registrar needs the transfer code and the new registrant must be eligible to register 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 (the incoming registrar) and the former (outgoing) registrar has to be informed.

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

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

Since 24 February 2015, AFNIC has offered its new .fr Lock service, for locking the domain name at the registry level. The goal is to secure the registration and to prevent hacking risks. Operations on locked domain names follow a specific procedure including a process of authentication.

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 TLDs of French overseas territories.

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 Postal 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 administered by the French registry, to decide on the validity of .fr domain names.

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

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 (see question 7).

10 Time frame for opposing registration

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

Not applicable (see question 7).

Transfer or cancellation

11 Dispute format

What is the typical format for a cancellation or transfer action in court litigation?

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

French courts are competent if it can be justified that the website under the domain name in question, which 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 identity of the parties (merchant or non-merchant). Parties are not required to be represented by an attorney-at-law before the commercial courts.

The Syreli procedure is an online procedure. The complaint and the evidence are sent to the AFNIC on the Syreli platform: www.afnic.fr/en/dispute-resolution/tools-and-procedures/syreli-dispute-resolution-system-24.html.

This procedure was introduced on 21 November 2011. Complaints under the Syreli procedure are founded in article L 45-2 of the Postal 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 evidence and to pay a charge of €250 + VAT. The respondent does the same, if it wishes to respond. It does not have to pay any charges. Each party can either file the complaint or respond in its own name or be represented by a third party. Unless this representant is an attorney-at-law, he or she must be duly authorised and must produce a signed power of attorney.

The decision is rendered within two months by a panel of three members composed of the AFNIC's director and two other members designated by the 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 commencement of proceedings;
- 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
- it is cheaper than a court action.

The disadvantages of choosing ADR are:

- no compensatory damages;
- no prohibition on use of 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 issues other than 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 a 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 some liability in the case.

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 (Paris Court of Appeal, pôle

5, 2e 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 AFNIC 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, must first be 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 domain name in dispute 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 on using that 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.

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 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 damages suffered.

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 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 infringed 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, 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 Intellectual Property Code).

Statistics for 2013

Out of 58 decisions concerning domain names rendered and published in France in 2013, the judges have sentenced to damages in 36 cases.

The granted monetary relief was, for the majority, between €10,000 and €20,000. See below for a table showing the judgments published in 2013.

2013 - amount of the damages (published decisions concerning domain names)	27 decisions -TGI (1st instance)	31 decisions - CA (2nd instance)
€0 - 5,000	1: €2	1: €1 1: €1,500 1: €2,000 1: €2,500 2: €3,000 1: €4,000
€5,000 -10,000	1: €4,000 1: €10,000	1: €5,000
€10,000 - 20,000	1: €15,000 1: €20,000	2: €10,000 2: €15,000 1: €18,000 3: €20,000 1: €23,000
€20,000 - 55,000	1: €22,000 1: €40,000 1: €49,000	1: €30,000
€55,000 -100,000	0	1: €75,000 1: €80,000
€100,000 -200,000	0	0

Of these 58 decisions, publication of the judgment in reviews or on a website has been asked for 23 of them and it has been granted by the judges in only seven cases.

Statistics for 2012

Of 53 decisions concerning domain names rendered and published in France in 2012, the judges 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		

Of these 53 decisions, publication of the judgment in reviews or on a website was asked for in 12 cases and granted by the judges in three 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 Intellectual Property Code under articles L 716-9 to L 716-13).

Article L 716-9 provides that:

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 organised criminal group, the penalties will be increased to a five-year imprisonment and a fine of €500,000.

Article L 716-10 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 organised 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 Intellectual Property Code).

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

Trademark cancellation action

The action will be declared inadmissible by the court if the trademark owner has tolerated the use of the mark for five years, unless the applicant has acted in bad faith (article L 714-3 of the Intellectual Property Code).

Civil liability

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

20 Estoppel and prescription**Can a registrant's rights in a domain name expire because of non-use. Can a registrant be estopped from bringing an infringement action? In what circumstances?**

A registrant's rights in a domain name cannot expire 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 a condition to be able to further request a protection of a 'distinctive sign'.

A decision ruling that an active and previously existing domain name can prevail over a trademark was rendered by the court of first instance in

Update and trends

AFNIC is expected to introduce an ADR procedure that can be administered by a third party, which could be the WIPO. The decision will be rendered by an expert, and not by the French registry, as is the case with the Syreli procedure. The procedure will be called the PARL Expert.

There was a similar ADR procedure available in the past, but it was abandoned in 2011 pursuant to the cancellation of the first French law regulating domain names by the Constitutional Council, which is in charge of the review of constitutional issues. The 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. As of March 2015, only one Syreli decision has been contested before the courts.

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 or a copyright (article L 711-4 of the Intellectual Property Code). 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 a domain name 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).

21 Disputes timescales

What is the typical time frame for an infringement action at first instance and on appeal?

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

22 Standing

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

A civil action for trademark infringement is filed by the trademark owner. An exclusive licensee may bring an action, unless otherwise specified in his or her 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 Intellectual Property Code).

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

It is not required that a trademark licence is registered before the French trademark registry. The licence can be proven by any means.

The exclusive licensee has to produce a written agreement proving 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 domain names, 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 charges to be paid to AFNIC for a Syreli procedure are €250 (before VAT).

In the first and second instance courts, costs are 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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