

Application of the Decree dated February 6, 2007 : allocation of “.fr” domain names restricted to the benefit of protection of trademark owners.

In parallel to the registration of the millionth “.fr” domain name (AFNIC source), the Court of Appeal of Paris limited the conditions for allocating “.fr” domain names in a Decree dated January 16, 2008.

In the case at hand, the Sunshine company had registered the trademark “SUNSHINE” in July 2001 in class 25, to designate in particular clothing.

On April 7, 2005, an individual (Mr D.) registered the domain name “www.sunshine.fr” to develop his photography business.

Claiming ownership of the domain name “sunshine.fr”, the Sunshine company decided to file an interim injunction against Mr D. in order to have the litigious domain name transferred to its benefit.

After rejection of the injunction, the Sunshine company appealed the decision on July 31, 2007 based on the new Article R. 20-44-45 of the French Post and Electronic Communication Code (from the decree dated February 6, 2007, regarding the allocation and management of Internet domain names) which prohibits registration of a domain name which is *“identical of likely to be confused with a name which has been granted and intellectual property right”*, unless the requested party is acting in good faith or justifies a legitimate right or interest.

Before the Court, Mr D. claimed that the dispute involved a domain name which was registered prior to promulgation of the decree it from being applied.

However, to assess the Sunshine company’s request regarding transfer of the domain name, the Court decided to rule according to Law in effect on the day it was to pronounce its judgment.

Thus, judging that Mr D. did not benefit from a right to the domain name “sunshine.fr” or a legitimate interest for such registration, the Court of Appeal of Paris ordered transfer of the domain name to the benefit of the company in possession of the trademark beforehand.

Note that for the case at hand, transfer of the domain to the benefit of the owner of the trademark was ruled even though there was no risk of confusion between the products targeted in the registration of the trademark (clothing) and those offered on the litigious internet site (photographs).

Beyond protecting owners of intellectual property rights, it should be noted that the decree dated February 6, 2007 also protects the State, local governments as well as elected representatives in exercising their mandate, by giving them the ability to register their name as a domain name. Nevertheless, companies or certain associations which have a corporate name identical to that of an elected representative, for example, may continue to use their domain name if it had been registered as a trademark prior to January 1, 2004.

These new restrictive rules resulting from the decree dated February 6, 2007, signal a break from leniencies afforded to conditions for allocating “.fr” domain names.

Indeed, since May 2004, there is no longer an obligation to prove any right whatsoever to a name to be able to register it as a domain name, and since June 2006, private individuals can be attributed a domain name.

Let us remember for all intents and purposes that anyone who wishes to register an “.fr” domain name must first check that the name requested does not infringe previous rights of third parties (copyrights, trademark rights, personality rights, etc.).

The AFNIC naming charter, which includes registration rules for “.fr” is very clear on this point.

The requesting party must then contact a registration office which is responsible for submitting the request and completing administrative procedures with the AFNIC (French Internet Naming Association – Association française pour le nommage internet en coopération), which handles administrative and technical management of “.fr” domain names.

■ Illegal diffusion of the documentary “The World According to Bush”: Google fined Euros 150,000

It is the second time that Google has been sentenced for having made an audiovisual work available on its Google Video service (free download) without authorisation.

Google was already sentenced for a first time in October 2007 for having made “The children of Tranquillity Bay” available on its service and was ordered to pay Zadig Productions Euros 20,000 in damages.

It is a strong message sent to Google as it has been convicted today for the same acts with a much higher fine.

After discovering that the Google Video service was broadcasting the documentary “The World According to Bush” in its full version, free of charge and without authorisation, the Flash Film company (producer) and Editions Montparnasse (distributor) gave notice to Google France as well as its American parent company to remove access to the film work.

When Google failed to act, the Flash Film company and Editions Montparnasse sued Google as well as its French subsidiary for counterfeiting and parasitism.

In a judgement handed down on January 20, 2008, the Court of Commerce of Paris acknowledged that Google has the status of host, however it was held liable for maintaining access to the litigious video after having received notice from the requesting parties.

Google is now condemned to pay Euros 150,000 for damages to the requesting parties. It is also prohibited from broadcasting all or part of the documentary (which means it must overhaul its indexes), under penalty of Euros 1,500 per day late. It must also publish the court decision on its website “in optimal legibility conditions”.

The solution adopted by the Court of Commerce of Paris is warning to host providers who, informed of the illegal character of litigious content, are not diligent enough in removing the content, as stipulated in the LCEN (Digital Economy Confidence Act – Loi pour la Confiance dans l’Economie Numérique).

■ Verification of telephone records of employees not subject to an employer’s information obligation.

Does verifying the telephone records of employees with a private automatic branch exchange (PABX), without informing them beforehand constitute illegal monitoring?

In a decision handed down on January 29, 2008, the corporate chamber of the Court of Appeal of Paris answered in the negative and thus provided enlightenment into the employer’s information obligation.

In the case at hand, after becoming aware that Mr X, an employee working as a regional sales inspector, had called adult chat lines from his work station for more than 60 hours between July 2002 and January 2003, the Canon France company fired him for excessive use of his work telephone for personal use.

Considering that he was fired without serious or just cause, Mr X. brought the case before the labour court.

He esteemed that the telephone records did not constitute receivable evidence as he was not informed that his telephone line was being monitored.

His request was based on Article L. 121-8 of the French Labour Code which prohibits the collection of any information personally involving an employee with a system of which he/she has not been made aware beforehand.

Nevertheless, the Court of Appeal of Paris upheld the dismissal of Mr X based on the fact that the telephone records obtained through a PABX included telephone numbers, call lengths and their cost, and not personal data concerning the employee.

Furthermore, the Court of Appeal highlighted the serious misconduct of the employee, characterised in the use of private chat lines which he knew were prohibited within the company.

In conclusion, employers may thus monitor telephone calls made by employees from their work stations without informing them beforehand, provided the monitoring process does not divulge any personal information.

■ Lacking a distinctive character, the trademark “Texto” submitted by SFR is revoked.

Though it had won its case against the owner of the trademark “Haricot Texto” for counterfeiting in a judgement on November 30, 2007, SFR has just lost ownership exclusivity of the trademark “Texto”, used for SMS services.

Considering that the company One Texto was illegally using its trademark “Texto”, registered on January 23, 2001, SFR sued One Texto for counterfeiting.

In its defence, the company One Texto cited the absence of a distinctive character of the term “Texto”, as several previous press articles on the registration of the trademark already evoke that “texto” (text message) is part of everyday language sodesignate a SMS.

This argument was upheld by the Court of First Instance of Paris, in its judgment handed down on January 29, 2008, dismissing SFR’s request and revoking its trademark “Texto” for lack of distinctive character.

This decision was handed down based on Article L.711-2 a) of the Intellectual Property Code which stipulates that terms which are “exclusively the required, generic, or usual designation of the product or service” may not be registered as trademarks.

The judges considered that when the trademark was registered, the term “Texto” was already used as a usual term to describe “short messages sent by means of a mobile telephone”.

SFR expressed its intention to file an appeal to this decision. To be continued...

Note that preventive actions against degeneration of trademarks are extremely useful, such as the brands BIC or PEDALO have proven!

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