Protecting Brands Online

Jurisdictional comparisons **First edition 2012**

General Editor:
Shireen Peermohamed
Harbottle & Lewis

EUROPEAN LAWYER REFERENCE

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Casalonga Avocats Caroline Casalonga

1. DOMAIN NAMES

Law no 2011-302 of 22 March 2011 governs domain names in France. It applies to .fr and to the other extensions of the national territory (for example, re for Réunion, .gp for Guadeloupe). It came into force on 1 July 2011. The articles of the law related to domain names have been included in the French Post and Electronic Communication Code (P&EC Code), together with the articles of decree no 2011-926 of 1 August 2011 (Articles L45 to L45-8, R 20-44-34 to R 20-44-44 and R 20-44-50). Article L 45-1 of the P&EC Code provides that the registration and renewal of domain names may be refused, or the domain name may be suppressed, if it infringes a prior intellectual property (IP) or personality right, unless the domain name applicant or owner justifies that it has a legitimate claim to the name and that it acted in good faith.

Concerning generic top-level domain names (generic tlds) and country code top-level domain names (cc tlds), a few different laws apply to brand protection against infringing domain names: the trade mark provisions of the French Intellectual Property Code, the French Civil Code provisions on rights to the name and Article 1382 of the French Civil Code (general torts provision that is the basis for claims for prior company name and unfair competition).

1.1 Can a brand owner prevent use of its brand in a country code top level domain name (cc tld)?

The conditions are the same for cc tlds and generic tlds, if the use of the generic tld is directed to the French public (for example, if the website is in French or purchases are available in France). Accordingly, we have cited below case law involving both .fr and .com domain names.

A brand owner may base its action on the following different legal grounds:

(a) Trade mark infringement

In order to bring a claim based on trade mark infringement, the brand owner must prove that the contested domain name is used in commerce for goods and services that are identical or similar to those protected by the prior trade mark registration.

Consequently, the mere registration of a domain name without use does not constitute trade mark infringement (Cass Com, 13 December 2005, no 04-10143; CA Paris, 2nd chamber, 1 October 2010, no 09/06253).

Likewise, the use of a domain name for redirection to a website with

another address is not considered as use in commerce and therefore does not constitute trade mark infringement. For example, the Paris court held that the use of the domain name freewifi.fr to redirect to the website *www.osmozis.fr* did not constitute trade mark infringement of the prior French registration FREE as the domain name was not used in commerce, but *'as a technical road access to the website of the company'*. The court did order the transfer of the domain name, however, on the grounds of the well-known character of the mark FREE in France for internet access and telecommunication services (TGI Paris, 3rd chamber, 3rd section, 29 October 2010). In another matter, the Paris court held that the use of the domain names toywatch.fr and toy-watch.fr for a blog on the brand TOYWATCH did not constitute trade mark infringement as the use was not a use in commerce but for information purposes. However, the domain names were cancelled on the grounds of the P&EC Code provisions cited above (TGI Paris, 3rd chamber, 1st section, 26 October 2010, no 10/07870).

Specific conditions for well-known marks

The owner of a well-known trade mark does not have to prove use in commerce of the litigious domain name to obtain its transfer, but that the registrant has tried to take advantage of the repute of the mark and has blocked the registration of that domain name to the right owner.

The Paris court ordered the transfer of the domain names louisvuittonfoundation.com, louisvuitton-foundation.com and louis-vuitton-foundation.com, which had been registered to but not used, as the sole purpose of the registrations was to take unfair advantage of the brand's repute and to block the registration of those domain names by the brand owner (Cass Com, 21 October 2008, no 07-14.979).

(b) Company name, commercial name or prior domain name

The brand owner may also oppose its company name or a prior domain name against the registration of an identical or similar domain name. As for trade mark rights, the litigious domain name has to be used in commerce and create a likelihood of confusion with the prior right claimed. Company names, commercial names and domain names are protected for the services for which they are used. Concerning .fr, the new law, as codified in the P&EC Code, surprisingly does not include company names or trade names among the rights that can be opposed to a domain name.

(c) Unfair competition, parasitism, fraudulent or misleading commercial practice

On the basis of unfair competition, however, a brand owner may be able to obtain the transfer of domain names that are not used in commerce if it is able to prove that the registrant acted to take unfair advantage of and to damage the brand owner. Unfair competition is a valid ground where the registrant filed several domain names reproducing and imitating the brand and does not have any legitimate rights to the mark. It is also a valid basis for acting against registrants using domain names on parking websites. A

complaint can also be based on bad faith and fraudulent behaviour.

For example, the French High Court confirmed the decision of the Paris Court of Appeal (Paris CA) holding that the German company SEDO, which proposed domain names for sale with links to parking websites and advertising, was jointly liable for unfair competition with the registrant of the litigious domain name(s). In this case, the domain name hotel-meridien.fr was directed to a parking website. The High Court rejected the argument asserted by SEDO that it was simply hosting a website and was therefore only a technical intermediary without liability (Cass Com, 21 October 2008, no 07-14.979).

What procedures are available?

(a) Alternative procedures

Since the law of 22 March 2011, there have been two types of alternative dispute resolution (ADR) procedures:

- an ADR handled by AFNIC (*Association Française pour le Nommage Internet en Co-opération*) from 21 November, 2011, entitled SYRELI, (i)
- a mediation-based solution ADR procedure entitled Online Recommendation, (ii).

(i) SYRELI

AFNIC, the registry of the .fr cc tld, published details on its new dispute resolution system and announced its coming into force on 21 November 2011. It replaces the former 'PARL' and short-lived 'PREDEC' dispute resolution systems.

Unlike the former PARL system, where the case could be decided by experts appointed by WIPO's Arbitration and Mediation Center, under the SYRELI system, decisions are taken by AFNIC.

The terms and conditions of the SYRELI dispute resolution system developed by AFNIC were published on 3 November 2011 in the French Official Journal.

Domain names concerned

The SYRELI dispute resolution procedure applies to .fr and .re domain names created or renewed after 1 July 2011.

For .fr and .re domain names created or renewed before 1 July 2011, in case a procedure has to be started before the next renewal, prior right holders will have to introduce a court action.

The procedure applies to all the other extensions managed by AFNIC (for example, .gp for Guadeloupe), starting on 6 December 2011.

Procedure

The examination fee is set at EUR250 excluding VAT. It is paid by the plaintiff with the filing of the complaint.

The plaintiff has to prove:

- that it has a valid interest to act; and
- that the disputed domain: (i) breaches public order or morality, or

the rights guaranteed by the French Constitution or French law; (ii) infringes intellectual property rights or personal rights, and that the owner has no legitimate interest in the domain name and is acting in bad faith; or (iii) is identical or confusingly similar to the name of the French Republic, of a local authority or of a group of local authorities, of an institution or a local or national public service, and that the owner has no legitimate interest in that name and is acting in bad faith.

The language of the procedure is French and the translations into French shall be made by a sworn translator. Upon receipt of the complaint and payment, the domain name is put on hold and the domain name holder is informed about the procedure. From the date of that notification, AFNIC has a two-month period to grant its decision.

The domain name holder has 21 days from the notification date to answer the plaintiff's arguments and file any evidence.

AFNIC issues its decision on the sole basis of the arguments and evidence provided by the parties.

There is a 15-day period from the notification of the decision before it becomes enforceable. Within that period, the parties may contest the decision before the courts.

If contested in this way, the AFNIC decision will not be executed and the domain name will continue to be frozen until a final court decision or the withdrawal of the court action.

With the holder's consent, the decision is immediately enforceable without waiting for the end of this 15-day period.

The parties have the right to request the execution of the decision. If it is not executed within 60 days, the AFNIC may cancel the domain name.

(ii) Online mediation

A mediation-based solution can be chosen by the parties. It can be administered by the *Centre de Médiation et d'Arbitrage de Paris* (CMAP) – see *www.mediationetarbitrage.com*.

This ADR procedure enables the parties to a dispute relating to one or several domain names to entrust the issue, by common agreement, to a mediator who gives a recommendation.

The mediator may suggest solutions other than the mere deletion or transfer of the domain name. He may also propose monetary compensation.

If the parties agree to the proposed recommendation, they sign a settlement agreement. This agreement and the mediator's recommendation are kept confidential. It is sent to AFNIC for execution.

(b) Court proceedings

The brand owner may also file an action before the French courts. The court may order the transfer of the litigious domain name or prohibit its use, not only on the basis of the infringement of prior IP rights but also on the basis of fraud, unfair competition, parasitism, false advertising and any other grounds relevant to the case. The court may order the payment of damages, the publication of the decision and the reimbursement of lawyers' fees.

A court action is recommended when the defendant not only used the litigious domain names, but also committed other litigious acts, such as the use of the brand on the website, on keywords or on metadata. A court action enables the brand owner to obtain not only the transfer of the domain name or a prohibition on the use of it, but also the publication of the decision, the payment of damages and the reimbursement of lawyers' fees.

Before the action on the merits, the brand owner may ask the court for a preliminary injunction order prohibiting the domain name registrant from using the litigious domain name.

(i) Preliminary injunction procedure

If the infringement of the prior IP right(s) is obvious, the brand owner may request that the court grant a preliminary injunction prohibiting the use and the transfer of the litigious domain name. When the use is so detrimental that it will cause irreparable harm to the prior right owner, such measures may be ordered in an *ex-parte* procedure. The decision is immediately granted by the judge. If there is no evidence of irreparable harm, the preliminary injunction procedure is *ex-parte* and takes up to one week if the matter is very urgent; otherwise it takes two to three months.

After the grant of the preliminary injunction order, the brand owner has to file an action on the merits within 30 days.

(ii) Action on the merits

A regular civil action on the merits takes between 12 and 18 months. The brand owner may also, if there is some urgency, request the court to grant a fixed date for the hearing within two to six months. Such urgent procedure should be limited to relatively straightforward cases as all of the evidence and arguments have to be included in the initial complaint.

If the court decides that the use or registration of the domain name constitutes an infringement of the brand owner's prior rights or an act of unfair competition, it will order the transfer of or a prohibition on the use of the litigious domain name. The court generally the payment of damages, the publication of the decision and the partial reimbursement of lawyers' fees.

The brand owner may also file a criminal action against the domain name registrant. However, this type of action should be reserved to very specific cases where the defendant not only registered one or more litigious domain names, but also committed other fraudulent acts, such as the retail of counterfeit products on the website. Criminal actions are generally very long, except when one of the defendants is placed in custody.

1.3 Can trafficking or trading in cc tlds comprising or including a brand owner's name be prohibited by a brand owner?

The registration and trading of domain names, if they do not involve other acts such as acts of unfair competition, are not, by themselves, illegal based upon the principle of free trade. However, such trading has been prohibited under certain circumstances, for example, in the following cases: when the brand is well known (Cass Com, 21 October 2008, no 07-14.979) or when

the trading of the domain names was accompanied with links to advertising and parking pages (Cass Com, 21 October 2008, no 07-14.979).

2. METADATA

2.1 Can a brand owner prevent use of its brand in metadata (such as metatags or the metatitle) for a website?

The answer to this question depends on whether the brand is used for information purposes or if it is used to take unfair advantage of the brand.

(a) Use of a competitor's mark in a metatag

Until 2009 and a decision of 7 January 2009, followed by another decision of 29 October 2010 (TGI Paris, 3rd chamber, 3rd section, 7 January 2009, *Like Mirror v EURL OMC Olivier Mondin* and 29 October 2010, *Free v Osmozis*), a website using the brand of a third party as a metatag was systematically condemned for trade mark infringement and unfair competition (see, for example, the decision of CA Paris, 12 January 2005, *Dreamnex v Kaligona*).

On 7 January 2009, the Paris Court of First Instance decided that using a trade mark in a metatag is not a use in the course of trade and is not public – therefore, it can not constitute trade mark infringement. On 29 October 2010, the Paris Court of First Instance granted another decision, stating that the use of a brand in a metatag did not constitute trade mark infringement as the metatags are not visible and are therefore not used as trade marks. The court stated that a trade mark has to be visible for the public to guarantee the origin of the goods and that therefore such use did not constitute trade mark infringement (3rd chamber, 3rd section, 29 October 2010, *Free v Osmozis*).

This decision should not have too broad an impact, however, as the use of a brand as a metatag may always be considered an act of unfair competition, misleading advertising or unfair practice.

(b) Use of the mark as a reference, for information purposes

The court always considers all the facts of the case and may decide that the use of a third party's brand is legal. If the metatags are used simply for information purposes and the user is not taking advantage of a competitor's brand, then the use should be authorised – for example, if the mark is used as a necessary reference to indicate that the products are compatible. In its decision of 3 September 2010, the Paris court applied this reasoning, holding that the company Live Syncro was not liable for infringement of the marks Windows used as metatags as the use was a necessary reference to indicate that the Live Syncro products were compatible with the Microsoft products and that there was no risk of confusion as to the origin of the goods (TGI Paris, 3rd chamber, 2nd section, 3 September 2010, no 09/02965)

Procedure

It is recommended, before filing an infringement or unfair competition action against the unauthorised use of a brand in metatags, to secure

evidence of such use. We recommend asking a bailiff to draw up an official report evidencing such use.

The court proceedings against the non-authorised use of a mark in metatags are identical to the court proceedings described in section 1 for domain names.

3. KEYWORD ADVERTISING

The French courts are generally in favour of the prohibition of the unauthorised acquisition and/or use of a mark as a keyword by a third party, either on the grounds of trade mark infringement or on the grounds of unfair competition. The case law based on trade mark infringement has evolved since the Court of Justice of the European Union (CJEU) responded to the French High Court's prejudicial question in the Google decision (CJEU C-236/08 to 238/08 *Google France and Google Inc v LV Louis Vuitton and others*, 23 March 2010).

The French courts distinguish between the liability of the competitor using a third party's brand as a keyword and the liability of the internet referencing provider operating the keyword advertising scheme.

3.1 Can a brand owner prevent the acquisition and/or use of its brand as a keyword by an advertiser?

In the matter of *Google France v CNRRH,* the French High Court issued its decision on 13 July 2010, following the CJEU's response to the prejudicial questions. The French High Court found that Google was not liable for trade mark infringement but that the advertiser may be liable for trade mark infringement for the unauthorised use of a trade mark as a keyword if: (i) there is a likelihood of confusion; and (ii) the consumer may be misled as to the origin of the goods or services. The advertiser is condemned on the basis of trade mark infringement.

This decision is in line with the later decision of *Interflora v Marks & Spencer*, 22 September 2011 (case C-323/09).

Since the CJEU decision of 23 March 2010, advertisers have been held liable and have been condemned on the basis of unfair competition and misleading advertisement (CA Paris, 5th division, 4th chamber, 19 May 2010, *Multipass v Smart & Co*), violation of a well-known trade mark and misleading advertisement (TGI Paris, 3rd chamber, 2nd section, 11 June 2010, *SNCF v Eorezo, J-L H*), trade mark infringement and violation of the rights on a commercial name (CA Paris, 5th division, 1st chamber, 15 September 2010, *Suza International v Professionnal Computer Associés France, Google France*, CA Montpellier, 2nd chamber, 2 February 2011, *Earsonics v Insono*), trade mark infringement and unfair competition (CA Aix en Provence, 2nd chamber, 8 June 2010, *Ecowash Mobile Paca v Cosmeticar*), and violation of rights on a company name and on a domain name (CA Paris 5th division, 2nd chamber, 27 May 2011, *Business Pharm v ID Image Dynamique*).

3.2 Can a brand owner prevent the acquisition and/or use of its brand as a keyword by the internet referencing provider (such as a search engine) operating the keyword advertising scheme?

The French High Court issued three decisions on 13 July 2010 regarding the Google matter, following the CJEU's response to its prejudicial questions. The French High Court followed the CJEU decision, stating that the exemption of responsibility provided by the Law and invoked by Google '*applies to an internet referencing service provider in the case where that service provider has not played an active role of such a kind as to give it knowledge of, or control over, the data stored*'. It considered that the Court of Appeal did not research whether Google had played an active role and that Google was not liable for trade mark infringement for proposing keywords for sale (Cass Com, 13 July 2010, *Google France and Google Inc v LV Louis Vuitton, Google France v CNRRH, Google France v Luteciel*).

In another decision issued on the same day, the French High Court ruled that Google was not liable for trade mark infringement for proposing keywords for sale. In this case, the plaintiff had also sued Google for misleading advertising on the basis of Article L 121-1 of the French Consumer Code. The French High Court found that the plaintiff had not proved that proposing keywords for sale for the purpose of referencing websites on Google is an advertisement service (Cass Com, 13 July 2010, *Google France, Google Inc and Google Ireland Ltd v Gifam*).

However, in a later decision of 11 May 2011, the Paris CA held that Google and the advertiser Home Cine Solutions, who purchased and used keywords reproducing the mark of a competitor, were both liable for unfair competition, misleading advertising and illegal comparative advertising. Cobrason is a distributor of hi-fi and video equipment. Its competitor, Home Cine Solutions, purchased the keyword Cobrason through the Google Adwords program. The court decided that the purchase and use of such keywords by a competitor constitute acts of unfair competition and parasitism. The court further stated that such use created confusion in the minds of the public. The court also decided that such use also constituted misleading advertising on the basis of Article L 121-1 of the French Consumer Code as it was indicated on the advertising link 'whypaymore', since the indication was likely to divert internet users looking for Cobrason to the competitor's website.

Procedure

As with metadata, prior to bringing an action, it is crucial to keep official evidence of the unauthorised use of the mark by asking a bailiff to prepare a report documenting the unauthorised use.

The court proceedings against the non-authorised use of a mark for keyword advertising are identical to the court proceedings described in section 1 for domain names.

4. LINKING

4.1 Can a brand owner prevent a third party linking to its website?

The answer to this question depends on the way that the link is used.

A simple link to another website for information purposes is not by itself

considered to constitute trade mark infringement or unfair competition on condition that the website keeps all of the information as to the origin of the linked website, in particular the address. For example, the website of a news agency linking to magazine websites with full articles was not considered to constitute infringement as the web users could clearly see that they were being transferred to a new web address.

French courts consider that the practice of linking is inherent to the internet and that any website owner is presumed to have implicitly authorised third parties to make links to its website.

The courts consider that if the link simply drives the user to a different website, such use is considered as fair use in accordance with the rules of the world wide web (see T Com Paris, 26 December 2000, *SNC Havas Numérique and SA Cadresonline/SA Keljob*).

However, the linking to a third party website by keeping the address of the first website, a practice called 'framing', is considered to constitute trade mark and copyright infringement as well as unfair competition.

4.2 Can any practical, commercial or technical steps be taken by the brand owner to assist and/or reduce the risks of its website being linked to?

A website can prohibit linking in its terms and conditions, but this may not be efficient. Moreover, as discussed above, linking is considered by French judges as constituting fair use and in accordance with the functionality offered by the world wide web.

The website owner may always prohibit the linking by including in the source code in the body tag the following indication: BODYonLoad='if(self!=top) top.location=self.location'. With this indication, the website should always appear as the website of the brand owner.

5. FRAMING

5.1 Can a brand owner prevent the framing of its website in a window on another website?

As mentioned above, the linking to a third party website is authorised. However, the linking should direct the web user to the website linked with the URL of that second website.

For example, the Paris court decided that the use by Keljob, a French employment company, of a link to the website of its competitor cadresonline.com with the frame of the Keljob website and the Keljob URL address constituted acts of unfair competition and Keljob was ordered to stop the use (T Com Paris, 26 December 2000, *Havas Numérique and SA Cadresonline/SA Keljob*).

The framing of the website of a third party without authorisation may also constitute copyright infringement and trade mark infringement if the trade mark is reproduced.

5.2 Can any practical, commercial or technical steps be taken by the brand owner to assist and/or to reduce the risks of its website being framed?

As with linking, the website owner may always prohibit the linking by including in the source code in the body tag the following indication: BODYonLoad='if(self!=top) top.location=self.location'. With this indication, the website should always appear as the website of the brand owner.

Procedure

Before taking any action, it is important to keep official evidence of the framing by asking an officer of the court to prepare a report documenting the unauthorised use.

The brand owner may then file an action based on copyright or trade mark infringement as well as unfair competition. The main steps for filing such an action and a preliminary injunction are described in section 1.

6. USE OF BRAND ELEMENTS, BUT NOT IN A DOMAIN NAME

6.1 Can a brand owner prevent the use of its brand name as a third party website 'trading' name, 'label' or torrent name?

Whether a brand owner can prevent the use of its brand as a third party website 'trading' name, 'label' or torrent name will depend on the specific facts of the case. If the third party does not distribute the original brand owner products then the use is prohibited. However, if the third party's website is distributing authentic goods then the use should be authorised if the third party does not mislead the public by giving the impression that the website is the original brand owner's website.

For example, the French company IM Production, registered owner of the trade mark Isabelle M, filed a trade mark infringement against the use of its trademark in the web address *www.monshowroom.com/isabellem* as this website was not offering for sale clothing from the Isabelle M brand. The court decided that there was a likelihood of confusion and condemned the defendant for trade mark infringement (TGI Paris, preliminary injunction order, 10 December 2009).

6.2 Can any practical, commercial or technical steps be taken by the brand owner to assist and/or to reduce the risks of its brand being used in this way?

The brand owner can indicate in its website terms and conditions that the use of its brand without authorisation in any manner is prohibited. It can also indicate that its trade marks are registered and that all elements of its website are subject to copyright protection. However, as the terms and conditions are simply for information purposes, this may not be dissuasive. Further, such indications are not prerequisites for filing an infringement or unfair competition action.

Procedure

Before taking any action, it is important to keep official evidence by asking a

bailiff to prepare a report documenting the unauthorised use.

The brand owner may then file an action based on copyright or trade mark infringement as well as unfair competition. The main steps for filing such an action and a preliminary injunction are described in section 1.

7. USE OF WEBSITE CONTENT

Under French law, a website and its content are protected by copyright. The content may also be protected by database protection. In addition, when the website content includes the brand owner trade marks, the use may constitute trade mark infringement (Article L 112-3 of the French IP Code).

The 'get-up' of a website and the whole website architecture may be considered a work of authorship under French law.

A website may also benefit from the database protection provided under Article L 112-3 of the French IP Code.

The source code of a website is also protected by copyright.

To benefit from the protection of copyright, the website owner has to be able to prove that the work claimed is original. If there is no evidence of such originality, the copyright action will be rejected. However, the website owner may always file an action on the basis of unfair competition and condemn the person who reproduced or imitated the content of its website on the basis of unfair competition or parasitism.

For example, the Paris CA rejected an action filed on the basis of copyright protection by a brand owner who claimed reproduction of its website's general conditions as such may not be protected by copyright protection (CA Paris, 4th chamber, 24 September 2008, *venteprivée.com/ Kalypso*).

The owner of a website filed an action against a third party who had copied the architecture of its website. The court decided that the website was not protected by copyright as it was not original, but that the copy constituted unfair competition acts and parasitism (TGI Paris, 3rd chamber, 4th section, 28 May 2009, *Jérôme S/Association Lexeek*).

8. SOCIAL NETWORKING SITES

8.1 Can a brand owner prevent use of/reference to its brand name on social networking sites?

The mere use of a brand name as a reference on a social networking site to discuss a product does not constitute trade mark infringement as there is no use in commerce.

When the brand is used as a trade mark to advertise third party products or counterfeit goods, then the use becomes a trade mark infringement.

8.2 Can a brand owner prevent the posting on social networking sites of content which is defamatory of it or its brand?

The posting on social networking sites of brand-defamatory content may constitute defamatary acts, trade mark infringement or acts of unfair competition or parasitism depending on the circumstances. A distinction should be made between whether the content damaging the reputation of

the company or the reputation of the brand owner on its trade mark.

(a) (i) Should the content damage the reputation of the company, the brand owner would be entitled to prevent the posting of the content on grounds relating to the defamation and the provisions of the press law.

(ii) Should the content damage the reputation of the trade mark, the brand owner would be entitled either to prevent the posting of the content or to claim its removal on grounds relating to the provisions of the Intellectual Property Code, provided that the mark is used as a trade mark in the content designates products and services similar to those provided by the owner.

(b) However, it should be noted that, in certain circumstances, the use of a brand, whether registered as a trade mark or not, may be considered as valid on the basis of freedom of speech, in particular when the trade mark is used as a parody. For example, the Court of Appeal of Paris considered that the parody of the sign ESSO by Greenpeace (the letters 'S' of the trade mark were replaced by the US dollar symbol) was not an infringement of the trade mark because the use of the brand was not dedicated to the promotion of the products and services in favour of Greenpeace. The use of the mark was considered as a parody and not in relation to business (CA Paris, 14th division, section A, 26 February 2003, ruling on summary proceedings; CA Paris, 4th division section A, 16 November 2005, *Esso v Greenpeace France*, ruling on action on the merits). The Paris court also rejected an action filed by Danone against the blog website *www.jeboycottedanone.com* on which there was a parody of the DANONE trade mark and where the web user could sign a declaration to boycott Danone products after Danone had announced a restructuring plan that had employment consequences. The court decided that, under the principle of freedom of speech, third parties could criticise a brand owner by using its logo and trade mark as a parody (CA Paris, 4th Division, section A, 30 April 2003, *Cie Gervais Danone, Groupe Danone v Réseau Voltaire, Mr OM, SA 7 Ways, ELB Multimedia, Gandi*, Mr VL). This position was confirmed by the Supreme Court, which considered that Greenpeace did not exceed the limits of the freedom of speech in reproducing and parodying the logo Areva in relation to a dead fish and a death's head on its website (Cass Com, 1st division, 8 April 2008, *Greenpeace France et New-Zealand v SPCEA*).

8.3 Can any practical, commercial or technical steps be taken by the brand owner to assist and/or to reduce the risk of this happening?

It is generally advisable on a social networking site not to react through legal procedure, but to react with a specialised team for social networking that will use the same tools as the web users and control the use of the brand name and trade mark on social networking websites. For example, when the brand owner has committed an error and its brand is subject to defamatory discussions, the brand owner may apologise for the mistake and the brand

owner image may be much better than it would be with a court action against such defamatory acts.

The best way for a brand owner to prevent all kinds of infringements of its own content on social networking sites is to participate actively on the site itself.

9. APPS

An application or application advertisement for a mobile internet device has to comply with the general conditions of the providers, such as iTunes for Apple, which includes an undertaking not to infringe third party IP rights.

Using a logo of a brand owner may constitute trade mark infringement or copyright infringement as well as an act of unfair competition if the user is not authorised by the right holder.

In order to initiate an action based on trade mark infringement and unfair competition, the brand owner must demonstrate that there is a likelihood of confusion and that the mark is used for goods and services that are identical or similar to those included in its prior registration. If the mark is a well-known mark, the extent of the protection will be broader and the brand owner will have to prove that the use damages its reputation or takes unfair advantage of the repute of the mark.

10. REGISTERING A CC TLD

AFNIC is the French registrar for French cc tlds. Domain names can be registered through agencies accredited by AFNIC. The conditions for registration of a .fr can be found on AFNIC's website: *www.afnic.fr*.

Domain names are granted on a 'first come, first served' basis. When filing a domain name, the registrant undertakes to respect the .fr charter, which includes an undertaking not to infringe prior IP rights or personality rights unless the domain name applicant or domain name owner justifies that they have a legitimate interest in the name and acted in good faith (Article 45-1 of the PEC Code). However, there is no verification that the domain name is not infringing prior rights by the registrar or agency in charge of the reservation of domain names.

Composition of a domain name

A domain name can be composed of letters, numbers and hyphens. The following domain names cannot be registered:

- composed with one single letter or number;
- composed with only two letters;
- starting or ending with a hyphen;
- more than 255 prints; and
- 1,000 characters or – 'xx—'.

French cc tlds

The following French cc tlds are available:

- .fr;
- .asso.fr (this extension is reserved for all organisations);

- .com.fr;
- .gouv.fr (this extension is reserved for the French government); and
- .tm.fr (this domain name is reserved for trade mark owners).

Who may file a French domain name

The following persons or organisations may file a French cc tld domain name:

- companies that have their headquarters or an office in Europe (European Union, Switzerland, Norway, Iceland and Liechtenstein); and
- any individual domiciled in Europe (European Union, Switzerland, Norway, Iceland and Liechtenstein).

Registration duration

The domain name is registered for 12 months.