

'France.com' saga: the French State is entitled to claim the trademarks and domain name on the ground of its prior rights on the name 'France'

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On 6 April 2022, the French Supreme Court (Court of Cassation) ruled in favour of the French State in a case that has opposed it for many years to the company France.com, Inc. directed by Mr Frydman. The latter was the owner of the domain name "france.com", registered in 1994, and of several "France.com" trademarks registered in 2009 and 2010 (some of which were semi-figurative and included a motif representing the stylised borders of France). In 2015, the French State took legal action to have the signs in question attributed to it, invoking prior rights which it claimed to own over the term "France" as part of its identity.

The disputed signs were apparently initially used in the context of a travel agency offering holidays in France. However, this operation appears to have subsequently ceased and the domain name has been put up for sale.

The case notably raised the question of whether the name of a State confers on the latter a prior right enforceable against the registration of a trademark or a domain name.

Against the contested trademarks, the State invoked Article L711-4 of the French Intellectual Property Code (now Article L711-3 in an amended form), which, without expressly referring to the case of the name of a State, provided:

"A sign which infringes earlier rights, and in particular:

(...)

(g) the personality rights of a third party, in particular to his or her surname, pseudonym or image;

(h) the name, image or reputation of a territorial authority" ('collectivité territoriale' designates a public territorial entity such as a city or a district)

In a judgment of 27 November 2015, the Paris Court of First Instance held that paragraph (h) extended to the name of a State, whose public service missions were considered equivalent to those of a territorial authority for the purposes of that article.

In a judgment of 22 September 2017, the Paris Court of Appeal also recognised the rights of the French State, but on the basis of paragraph (g), on the grounds that *"the appellation "France" constitutes for the French State an element of identity assimilable to the patronymic name of a natural person"*.

The Court de Cassation did not decide between the two paragraphs. According to the Court:

"(...) the list of prior rights referred to in Article L. 711-4 of the Intellectual Property Code (...) is not exhaustive and (...) the appellation "France" constitutes for the French State an element of identity, in that this term designates the national territory in its economic,

geographical, historical, political and cultural identity, for which it is entitled to claim a prior right within the meaning of this article.

Having thus recognised that the French State was the owner of a prior right within the meaning of Article L711-4, the High Court also approved the trial judges' ruling that the disputed trademarks infringed this right:

"(...) the [appeal] judgment held that the suffix '.com', corresponding to an internet domain name extension, is not such as to alter the perception of the sign, so that the public will identify the goods and services designated in the registration of the trade marks as emanating from the French State or at least from an official service benefiting from its guarantee. It concluded that there was a likelihood of confusion, which, in complex marks, was reinforced by the stylised representation of the geographical borders of France. In this respect, the Court of Appeal (...) rightly held that the prior right of the French State had been infringed.

The French Supreme Court refused to refer a question to the Court of Justice for a preliminary ruling on this point since, in its view, the Trade Marks Directive is a clear instrument as regards the non-exhaustive nature of the list of prior rights opposable to a trade mark which it contains.

With regard to the disputed domain name, the company France.com, Inc. essentially criticised the Court of Appeal for having ordered its transfer to the French State, even though no text provides for such a measure, which allegedly constituted an unjustified expropriation, infringing on its right of ownership, protected both by national rules and by the European Convention on Human Rights (ECHR).

The Court de Cassation rejected this argument, on the grounds that *"if the use of a domain name can be assigned or protected under domestic law, it is on condition that it does not infringe the rights of third parties"*.

The Court de Cassation noted that the Court of Appeal had ruled that France.com, Inc. had ceased operating its website dedicated to tourism in France, which was accessible at the address 'www.france.com', before putting to sale the domain name 'france.com'; and that the possibility of creating email addresses associated with this domain name gave its holder privileged and monopolistic access to the detriment of other operators, and was used as a commercial argument by the agent in charge of selling the disputed site, who praised the apparent confidence and credibility of this address as being able to be attributed to a service of the French State or to an authorised third party. The Court de Cassation concluded that *"in view of these circumstances, which highlight the unlawful nature of the sale of the domain name 'france.com', which had ceased to be used, the company France.com cannot claim to own a protected asset"* within the meaning of the ECHR or French law.

Finally, the Court stated that in holding that the domain name "france.com" infringed the State's rights over its name, its identity and its sovereignty, and undermined the appellation "France", which constitutes an element of its identity, the Court of Appeal ruled on the basis of Article 9 of the Civil Code, as invoked by the French State. Article 9 in question is the article relating to the protection of privacy, on which the protection of the personality rights of individuals is generally based.

The case also had twists and turns in the United States, as after the Court of Appeal's ruling, the French State notified the decision to Web.com, the domain name registrar, which transferred the domain name to it. According to the hashdn.com website, Mr Frydman sued in U.S. Court in 2018. However, the Court of Appeals for the Fourth Circuit ruled that the French government has sovereign immunity. Mr Frydman's petition for an *en banc* rehearing was

rejected. His writ of certiorari was also rejected by the Supreme Court in its order list on 13 December 2021 (<https://news.hashdn.com/2021/12/13/supreme-court-refuses-to-hear-france-com-case-domain-name-wire/>).

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