

Paris Court of Appeal orders cancellation of FRANCE.COM marks and transfer of 'france.com' domain name
France - Casalonga

Cancellation
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- Court has ordered the cancellation of registrations for FRANCE.COM, and ordered the transfer of the domain name 'france.com' to the French State
- 'France' was found to be an element of identity of the French State
- The public was thus likely to believe that the protected goods and services emanated from the French State

In *France.com Inc v Traveland Resorts* (Paris Court of Appeal, September 22 2017), the French State intervened voluntarily, claiming that trademarks containing the term 'France' are contrary to public policy. Finding that the term 'France' is an element of identity of the French State comparable to the surname of natural person, and that the public was likely to believe that the protected goods and services emanated from the French State - or, at the very least, from an official service guaranteed by the French State, the Paris Court of Appeal cancelled the contested French trademark registrations and ordered the transfer of the domain name 'france.com' to the French State.

US tour operator France.com Inc registered the domain name 'france.com' in 1994. It then became aware of Dutch company Travel Resorts' French and EU trademark registrations for FRANCE.COM, including word and semi-figurative marks depicting France in a stylised fashion, as follows:



France.com Inc filed an action against Travel Resorts, claiming fraudulent trademark registration, and requested the transfer of the contested marks.

The parties reached an amicable settlement pursuant to which Travel Resorts assigned its trademarks to France.com Inc.

In the meantime, however, the French State intervened voluntarily, requesting the cancellation of Travel Resorts' trademarks and the transfer of France.com Inc's domain name.

The French State argued that these marks:

- were misleading;
- were contrary to public policy; and
- constituted fraud in light of the French State's interest in the protection of a denomination over which it has sovereignty and upon which it bases its identity.

Further, it claimed that the marks and domain names provided the US tour operator with an illegitimate monopoly, contrary to the general public interest.

The Paris Court of Appeal confirmed that the term 'France' was part of the French State's identity, comparable to a natural person's surname. The term designated the national territory with regard to its economic, geographic, historical, political and cultural aspects, which included the goods and services protected by the contested registrations.

Further, the Paris Court of Appeal considered that the public was likely to believe that the protected goods and services emanated from the French State or, at the very least, from an official service guaranteed by the French State.

The Paris Court of Appeal therefore cancelled the French trademark registrations and ordered the transfer of the domain name 'france.com'.

With respect to the contested EU trademarks, however, the Paris Court of Appeal stated that only the European Union Intellectual Property Office was competent to proceed with their cancellation, should a cancellation action be filed.

Shortly after the 'France.com' matter was decided, the Paris Court of Appeal applied the same reasoning to a design case involving the 'Marianne' design, a French emblem representing a woman wearing the Phrygian cap of liberty (Paris Court of Appeal, October 13 2017).

The French Trademark Office had rejected the design on the basis of public policy, claiming that it would mislead consumers into believing that the goods and services were linked or guaranteed by the French State. The Paris Court of Appeal affirmed.

These decisions are in line with Article 6ter of the [Paris Convention for the Protection of Industrial Property](#), pursuant to which the countries of the Union undertake to refuse or invalidate the registration and to prohibit the use, without authorisation by the competent authorities, as a trademark or as element of trademark, of State emblems, official signs and hallmarks indicating control or warranty adopted by them.

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