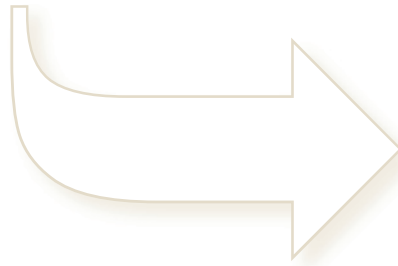


Legal claimants guide in the matter of domain names



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The defence of his rights in the naming areas is rendered complex by the conjunction of:

- ▶ the absolute uniqueness of domain names in a given extension (only one «afnic.fr» may exist);
- ▶ the multiplicity of rights liable to come into play (intellectual property, right to a name, commercial rights, etc.)

The purpose of this document is to present several practices to be developed by the rightful claimants so as to correctly and knowledgeably protect their interests.

1 - Overall presentation

1 **First of all**, prevention and monitoring are the best arms of all !

A company must determine a domain name registration strategy by adapting the reservations to its own activity and very rapidly noting any disputed behaviour, by means of its own monitoring or the use of automated monitoring (certain registrar offer this type of service). This must be done in order to:

1. be informed as quickly as possible and to rapidly cause the disturbance to end,
2. not lose proof of the holder's bad faith,
3. not risk having the absence of reaction raised against a petition for a summary proceeding.

2 **Secondly**, put the disputed holder on notice to immediately take all appropriate measures for either transferring or deleting the domain name in dispute.

The most frequent findings for a formal notice involve domain names that are identical/similar (or not) to a pre-existing trademark.

It is possible at this stage to not wish to bring any judicial or extra judicial recourse, but rather to give priority to direct negotiations with the holder of the domain name: all particulars are available in the Whois (www.afnic.fr/outils/whois), subject to the obligations connected to the protection of personal data.

3 **Lastly**, bring the matter before the competent bodies. Two types of recourse exist in France:

- ▶ **Extra judicial recourse**: the ADR (Alternative Dispute Resolutions)
- ▶ **Judicial recourse**

Extra judicial recourse: the ADR (Alternative Dispute Resolutions)

Two bodies offer dispute resolution services for the *.fr* and *.re*:

► The CMAP:

Centre de Médiation et d'Arbitrage de Paris / Centre for Mediation and Arbitration of Paris

This body proposes obtaining a recommendation concerning the resolution of the dispute on-line, from an independent third party. This recommendation may be used by the parties as the basis for new discussions or be used in its entirety in the form of a memorandum of understanding. Confidentiality is ensured. It must be noted, however, that the holder of the domain name may refuse taking part in this proceeding.

► The WIPO:

World Intellectual Property Organization

It proposes a UDRP (Uniform Domain Name Dispute Resolution Policy)-type proceeding adapted to *.fr* and *.re*. This is a binding proceeding that the holder of the domain name cannot elude. The decision is enforceable and may be published and made public. It is all the same possible to submit the dispute at all times to a court of competent jurisdiction.

The AFNIC does not take part in these proceedings and remains neutral in relation to the dispute. It does not take part either in the expert proceeding or the decision-making process. So it would not be useful to assign the AFNIC who, in accordance with the naming Charter, only applies the decisions. Nevertheless, it has negotiated arbitration rules with each of them in order that the decisions be rendered in conformity with the naming Charters.

 Their particulars are available on the AFNIC site, as well as a wealth of additional information:
www.afnic.fr/doc/ref/juridique/parl


Judicial recourse

The choice of the competent court remains the most difficult to make since it depends on several criteria. In general, due to geographic jurisdiction, the competent court is that of the place where the «disputed» holder is located. This choice may, however, be adjusted depending on:

- the subject matter of the dispute: does it concern trademark infringement, cybersquatting, unfair competition?
- the amount of the damages involved and the person who is at the origin of the matter:
 - for a matter involving less than 1,500 euros and for a private individual: small claims court.
 - for much greater amounts: the court of first instance or the high court has jurisdiction, trade tribunal, criminal court...

In most cases, it is preferable to be assisted by an attorney and, with his help, create a file by beginning, for example, with an examination of the circumstances of the dispute (are you the holder of a trademark? are there factors demonstrating the holder's bad faith such as offers to sell the domain name, or pages including content that is belittling in nature, etc.).

You must also furnish the trademark registration certificates, copies of the «kbis» (excerpt from the Register of Trade and Companies), etc.

 Case law now exists that will enable you to evaluate your chances of success:
www.afnic.fr/doc/ref/juridique/jurisprudence-fr
<http://arbitr.wipo.int/domains/decisions/index-cctld-fr.html>

2 - How do you make the choice corresponding to your expectations and possibilities?

Regardless of the type of proceeding selected it is good to have an idea of the advantages and disadvantages of each of the existing recourse.

Alternative dispute resolutions (ADR)	Judicial proceedings
Advantages	
<p>Financial advantages</p> <ol style="list-style-type: none"> 1. costs are often less 2. impossibility of obtaining money damages, the only possible outcome being the transfer or striking of the disputed domain name. <p>Procedural advantages</p> <ol style="list-style-type: none"> 1. no additional proceedings for having a decision applied abroad 2. rapidity of the decisions or the recommendation 3. the times for extra judicial proceedings are foreseeable. 	<ol style="list-style-type: none"> 1. the possibility of obtaining money damages in judicial matters 2. strong foreseeability of French judicial decisions based on four principles favouring their clearness: fraud, recognition, anteriority, legitimacy 3. rapidity of summary proceedings based on trademark infringement or harm to a well-known trademark.
Disadvantages	
<ol style="list-style-type: none"> 1. possibility for the «disputed» holder to refuse to take part in the on-line recommendation proceeding 2. possibility for the «disputed» holder to appeal the decision in the case of arbitration. 	<ol style="list-style-type: none"> 1. necessity of implementing an additional «enforcement proceeding» when the defendant is located outside of France 2. unforeseeability of times connected to the possible recourse brought against a judicial decision (appeal, appeal to the Court of Cassation -French Supreme Court-, appeals from enforcement decisions) 3. relative slowness of judicial proceedings on merits 4. difficulty of evaluating financial costs.

It is important to take into account your financial capacities and the holder's solvency in choosing the action to be brought (for example, a private individual does not have the same financial capacity as a company).

3 - What should you do with respect to domain names appearing in a list of domain names blocked by the AFNIC?

The AFNIC publishes on its site the list of domain names that have been blocked in connection with the outlines of action to obvious violations of the charter (www.afnic.fr/doc/ref/juridique/violation-charte). This publication is a monitoring tool for claimants. When claimants identify a dispute using this means they may take the steps set out above, namely:

- ▶ contact the «disputed» holder in order to immediately obtain the transfer or elimination of the disputed domain name,
- ▶ bring alternative dispute resolution proceedings, or have recourse to the courts in the absence of any reply from the «disputed» holder.

By means of this mechanism, the AFNIC allows every claimants to plan his or its reaction as best as possible: to have more time for verifying the list of the blocked domain names, for completing the complaint file, and for bringing an adapted action, while avoiding that the domain name be transferred from one holder to another, thereby making the application of the decisions somewhat difficult.

Regardless of the action taken, it is essential to inform the AFNIC of such action by providing it with a copy of all of the correspondence and regularly consulting its web site.

The absence of any reaction by the claimants shall lead in fine to re-establishing the disputed domain name, the AFNIC considering thereby that the claimants effectively injured have been fully informed and have made a conscious choice to not bring a proceeding.

4 - What is the outcome of these proceedings?

Most judicial decisions or decisions rendered by dispute resolution bodies lead to the transfer of the domain name or even its elimination. They may also result, as the case may be, in the rejection of the initial request.


In the case of an elimination operation, the registrar that is technically responsible for the disputed domain name shall contact the AFNIC's technical teams and execute the decision.

The operation for the transfer of the domain name is a little more complex to implement, since it may be voluntary or forced according to whether or not there is the intervention of a judge or an expert.

Articles 38 and 40 of the *.fr* Charter (articles 34 and 36 of *.re* Charter) govern cases of forced transfer following court decisions or decisions of dispute resolutions bodies. The procedures thus described are totally functional and have already been used successfully.

In the case of a court decision, it suffices that either one of the parties notifies the decision to the AFNIC in order that it execute the requested operation concerning the domain name.

On the technical level, the registrar of your choice (it may be different from that of the holder acknowledged as being «dishonest») shall carry out a transfer entry and attach the request for AFNIC intervention (restricted access to our registrars) signed only by you, as well as the copy of the decision.

 *.fr* and *.re* Charter :
www.afnic.fr/obtenir/chartes/nommage-fr
and
www.afnic.fr/obtenir/chartes/nommage-re

Be aware that in the case of decisions issued by dispute resolution bodies you must take into account the time limit for appealing the decision (for example, 20 days for WIPO decisions).

Article 39 of the *.fr* charter (article 35 for *.re*) sets out the provisions relating to a voluntary transfer of domain names and, in particular, the possibility for parties who have reached a settlement to execute it immediately and in total security.

In this case, the registrar of your choice (it may be different from that of the adverse party) shall carry out a transfer entry and attach the form for voluntary transfers (transmission letter) (restricted access to our registrars) of domain names signed jointly by the assigning holder and the holder taking it over. No other additional document shall be requested.

In both cases, the new administrative and technical information shall be published in the Whois the day after the transfer operation.

These few guiding key points aim at developing the understanding for all involved of the stakes concerning domain names and to present the framework of the outlines of action to obvious violations of the charter.

For more information, we suggest you consult the sites of the AFNIC and of its partners and that you consult specialised counsel.

Thanks to Vincent Fauchoux (attorney) for the information provided.