

FRENCH REPUBLIC
In the name of the People of France

[Stamp: Received 01 DEC. 2015]

EXTRACT
from the official records held at the Registry

TRIBUNAL
DE GRANDE INSTANCE
[DISTRICT COURT]
OF
PARIS

ENFORCEABLE EXECUTION COPY

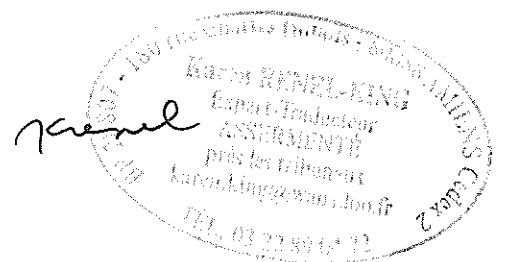
General Register No: **14/08237**

SELAS DE GAULLE FLEURANCE & ASSOCIES

mailbox: #K0035

[Stamp: *Tribunal de Grande Instance of Paris -S 033-*]

[Signature]



**TRIBUNAL
DE GRANDE
INSTANCE
[DISTRICT COURT]
OF
PARIS**



Division 3, Court 3

DECISION
handed down on 27 November 2015

General Register No:
14/08237

ORIGINAL NO:
[handwritten: 7]

Summons of:
19 May 2014

CLAIMANT

FRANCE.COM.INC, represented by its legal representative, Mr Jean-Noël FRYDMAN.
3109 Grand Avenue
MIAMI FL 33133 US

represented by Mr André BERTRAND of SELARL ANDRE BERTRAND & ASSOCIES – SOCIETE D’AVOCATS, members of the PARIS bar, mailbox #L0207

DEFENDANTS

TRAVELAND RESORTS MDV B.V
Seeligsingel 6 and 7
NL-4811 CN BREDA (NETHERLANDS)

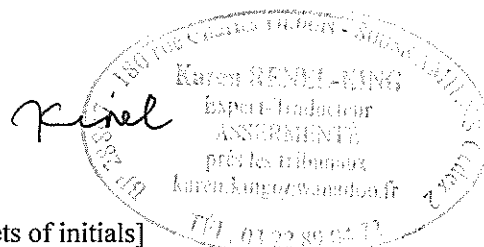
represented by Mr Christian BEER, member of the PARIS bar, mailbox #E0107

THE FRENCH STATE, represented by the Ministry of Foreign Affairs and International Development (MAEDI)
Voluntary Intervenor
37, quai d’Orsay
75351 PARIS

ATOUT FRANCE GIE, Voluntary Intervenor
79/81 rue de Clichy
75009 PARIS

represented by Mr Louis DE GAULLE of SELAS DE GAULLE FLEURANCE & ASSOCIES, members of the PARIS bar, mailbox #K0035

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30/11/2015]**



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COMPOSITION OF THE COURT

Arnaud DESGRANGES, Vice-President
Carine GILLET, Vice-President
Florence BUTIN, Vice-President

assisted by Marie-Aline PIGNOLET, Registrar

DELIBERATIONS

At the hearing of 6 October 2015
held in open court

DECISION

Handed down by being made available at the Registry
Inter partes
in the first instance

The US company France.com owns the <France.com> domain name,
registered on 10 February 1994.

It came to the said company's attention that the Dutch company Traveland
Resorts had applied to register the following trade marks:

- French Trade Mark No 3661596 for **france.com**

filed on 2 July 2009, designating goods and services in classes 35, 36, 38,
39, 41, 42 and 43;

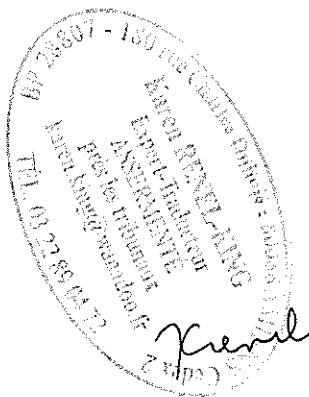
- the semi-figurative trade mark [please see French original for trade mark
depiction]

filed in France on 2 July 2009 under numbers 3661600 and 3661602, and
Community Trade Marks 8791899 and 8791923, filed on 4 January 2010
under priority of the aforementioned trade marks, designating goods and
services in 35, 36, 38, 39, 41, 42 and 43,

- the semi-figurative trade mark [please see French original for trade mark
depiction] in colour

filed in France under numbers 3661598 and 3661603, and Community
Trade Marks 8791857 and 8791873, filed on 4 July 2010 under priority of
the aforementioned trade marks. As a result of the foregoing, in a legal
document of 19 May 2014, France.com summoned Traveland Resorts to
appear before the above court for having fraudulently applied to register
verbal and semi-figurative French trade marks and to obtain the transfer of
these trade marks as well as an award of damages.

The French State and the EIG Atout France voluntarily joined the
proceedings pursuant to submissions filed electronically on 14 April 2015,
particularly to have the court find that the rights of the French State to the
name of its territory had been infringed by the Dutch company and to obtain
the transfer to it of the disputed trade marks, and to find that its rights had
been infringed by the US company and to obtain the transfer of the domain
name or, in the alternative, a licensing ban, and to find that acts of unfair



competition had been committed to the detriment of the EIG Atout France.

In submissions of 19 June 2015, France.com withdrew its proceedings and action against Traveland Resorts, which the latter accepted the same day.

In its submissions filed electronically on 3 September 2015, the French State made additional requests, seeking the cancellation of the five registered French trade marks at issue that had been assigned to France.com and asking the court to order France.com to contact the OHIM in order to voluntarily surrender the four registered Community Trade Marks.

Further to an additional application submitted by the US company France.com, in an order of 2 October 2015, the *juge de la mise en état* [procedural judge] recorded the withdrawal of the proceedings initiated by France.com against Traveland Resorts, on the one hand, and rejected the objection to jurisdiction as to subject-matter and territory in favour of the Commercial Court, and referred the examination of all the arguments deemed to be preliminary objections or substantive matters back to the court ruling on the merits to the extent that they did not come within the jurisdiction of the procedural judge.

According to its most recent claims, as set out in submissions filed electronically on 28 September 2015, France.com Inc. petitions the court to:

- accept all the arguments, claims and pleas made by the US company France.com Inc. and rule that they are well-founded,

Having regard to the settlement agreement signed in Miami on 25 September 2014 by France.com Inc and on 6 October 2014 by Traveland Resorts,

Having regard to Article 1 of the *code de procedure civile* [French Civil Procedures Code];

Having regard to Articles 2044 and 2052 of the *code civil* [French Civil Code],

Having regard to the *exceptio litis finitae per transectionem* [ground of inadmissibility],

- find that the main dispute between the US company France.com Inc. and Traveland Resorts ended as a result of a settlement agreement, which became final on 6 October 2014,

- find that the French State and the EIG Atout France voluntarily joined the proceedings on 14 April 2015, more than five months after this final settlement agreement, whereas the France.com trade marks had already been assigned,

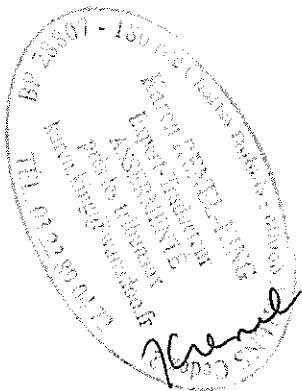
- reject the voluntary joinder of the French State and the EIG Atout France,

Having regard to Article 325 of the Civil Procedures Code, had the argument as to inadmissibility raised before the procedural judge been held to be a ground of inadmissibility,

- reject the voluntary joinder of the French State and the EIG Atout France due to the insufficient link between it and the main dispute,

Still having regard to Article 325 of the Civil Procedures Code, had the argument as to inadmissibility raised before the procedural judge been held to be a ground of inadmissibility,

- rule in any event that the voluntary joinder of the French State and the EIG Atout France to the proceedings is inadmissible as it relates to ownership of the Community trade marks for 'France.com' and the 'France.com' domain name, which are insufficiently linked to the main dispute as the said Community trade marks and domain name were not at issue in the original



dispute between the US company France.com Inc and the Dutch company Traveland Resorts.

Having regard to Article 31 of the Civil Procedures Code, had the argument as to inadmissibility raised before the procedural judge been held to be a ground of inadmissibility,

- find that Atout France is an EIG whose purpose is to promote French tourism,
- hold and rule that Atout France has no interest, capacity or interest [*sic*] to take part in legal proceedings, especially to voluntarily join a dispute concerning ownership of the <France.com> domain name and the French and Community trade marks for 'France.com',
- dismiss the action brought by the EIG Atout France as well as its voluntary joinder to the proceedings against the US Company France.com Inc,

Having regard to Article L721-3 of the *code de commerce* [French Commercial Code], had the argument as to inadmissibility raised before the procedural judge been held to be a ground of inadmissibility,

Having regard to the withdrawal of proceedings between France.com Inc. and the Dutch company Traveland Resorts, the jurisdiction of the *tribunal de grande instance* of Paris cannot replace that of the *tribunal de commerce*, as the issue concerns the transfer of a domain name, which is not related to trade mark rights,

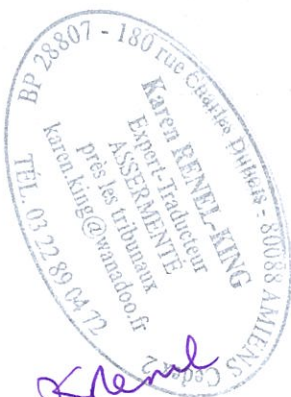
- consequently instruct the French State to take proceedings in the proper court,

Having regard to the exhibits filed in court,

Having regard to Articles 3 and 14 of the Civil Code concerning the above court's lack of jurisdiction *ratione loci* and lack of jurisdiction *ratione materiae* to decide on the transfer of the <France.com> domain name, had the argument as to inadmissibility raised before the procedural judge been held to be a ground of inadmissibility and should it be found that this argument should have been raised from the outset,

Having regard to international public policy,

- find that the <France.com> domain name was registered in the United States on 10 February 1994 by Mr Jean Noël Frydman, a citizen of the United States of America who lives there,
- find that for around 21 years, the <France.com> domain name has been exploited since 1994, first by the US Company France Online Inc. and subsequently since 1999 by the US company France.com Inc. via the www.france.com website, a website drafted in English intended exclusively for American tourists who wish to visit France,
- find, as a result, that there is no connection that permits the French State or the EIG Atout France to summons France.com Inc. to appear before the above court in relation to ownership of the <France.com> domain name, which is the US property of a US company,
- hold and rule that, as the French State voluntarily joined proceedings that did not relate to the <France.com> domain name, France.com Inc should not have raised this argument as to jurisdiction at the start of the proceedings, as first of all, it should have addressed the inadmissibility of the voluntary joinder and the fact that it only related to the French trade marks for France.com,
- hold and rule that pursuant to international public policy, a French court cannot decide on the ownership of an asset located in the United States that belongs to a US company,



K. King

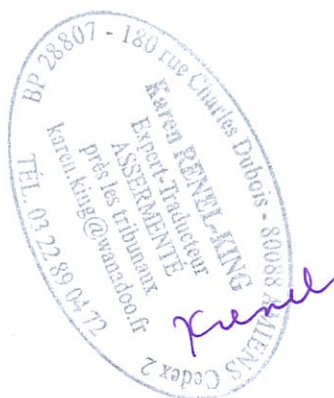
- consequently dismiss the French State's entire action to establish ownership and obtain the transfer of the <France.com> domain name, Having regard to the exhibits filed in court,
- Having regard to the positive prescription provided for in Article 2276 of the Civil Code had the argument as to inadmissibility raised before the procedural judge been held to be a ground of inadmissibility,
- find that the <France.com> domain name registered on 10 February 1994 has been used peacefully by the US company France.com for around 21 years, to operate the www.france.com website,
- find that ownership of the <France.com> domain name by the US company France.com Inc. has never been questionable, that the company has always acted in an unambiguous manner and that the <France.com> domain name has always been peacefully exploited via the www.france.com website,
- hold and rule accordingly that France.com Inc. has valid grounds on which to claim the benefit of the 10-year positive prescription laid down in Article 2276 of the Civil Code and consequently the action to establish ownership of the <France.com> domain name is completely out of time,
- dismiss the French State's action to establish ownership of the <France.com> domain name,

Having regard to Article 1354 *et seq.* of the Civil Code,

- find that the Foreign Affairs Minister currently in office publicly acknowledged that 'the www.france.com URL has been owned since 1994 by a company whose registered office is in Florida, in the USA',
- find that, in four ministerial replies in 2014, the French State acknowledged before the Nation's representatives that '*Owing to the lack of a comprehensive international legal framework for Internet domain names, the French government is unable to rely on any specific rights to the <France.com> domain name. Indeed, the US company that registered 'France.com' in 1994 cannot be required to assign it to the French government, as the only rules applicable to the generic '.com' domain name defined in the early 1990s concern the 'first applicant/purchaser'*',
- find that the French State officially and publicly acknowledged that:
 - * '*The www.france.com URL has been owned since 1994 by a company whose registered office is in Florida, in the USA*'
 - * '*the US company that registered <France.com> in 1994 cannot be required to assign it to the French government, as the only rules applicable to the generic '.com' domain name defined in the early 1990s concern the 'first applicant/purchaser'*',
 - * '*owing to the lack of a comprehensive international legal framework for Internet domain names, the French government is unable to rely on any specific rights to the <France.com> domain name,*
- hold and rule that these are out-of-court admissions for which the French State is responsible,
- consequently dismiss all of the claims made by the French State as well as its action relating to the <France.com> domain name,

Having regard to the ECHR's decision in *Paeffgen*,

Having regard to Article 17 of the Declaration of Human Rights, had the procedural judge not accepted the objections to jurisdiction raised by the US company France.com Inc,



- hold and rule that the <France.com> domain name is owned by France.com Inc., which cannot be dispossessed of it unless it first receives ‘appropriate damages’,
- find that the French State has not officially proposed to purchase the <France.com> domain name for a price approved by the US company France.com Inc,
- consequently dismiss the French State’s claim to transfer the <France.com> domain name,

Having regard to the Regulation of 26 February 2009 on the Community trade mark, particularly Articles 96 and 100 thereof, had the procedural judge not accepted the objections to jurisdiction raised by the US company France.com Inc,

- hold and rule that only the OHIM has the authority to recognise the validity of, or claims of ownership relating to, these Community trade marks in the main,
- dismiss the French State’s action and claims to establish ownership of and revoke semi-figurative Community trade mark numbers 8791899, 8791923, 8791857 and 8791873 for ‘France.com’,

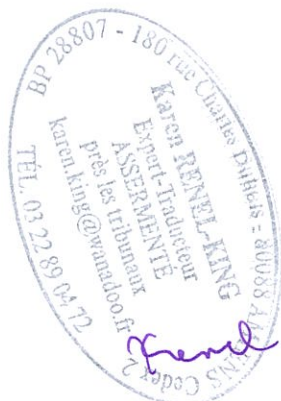
Having regard to Book VII of the *code de la propriété intellectuelle* [French intellectual property code],

Having regard to international treaties,

- hold and rule that the French State does not hold any specific rights ‘to the name of its territory’ that might be enforced against the US company France.com Inc. and that might allow it to request the transfer of the <France.com> domain name owned by France.com Inc., which cannot be dispossessed of it unless it first receives ‘appropriate damages’,
- consequently dismiss the French State’s claim to transfer the <France.com> domain name,

Having regard to Article L.712-6 of the intellectual property code, had the procedural judge not accepted the objections to jurisdiction raised by the US company France.com Inc,

- find that the French State has no legitimate right to claim ownership of, and no prior right to enforce against France.com Inc. in relation to, the trade mark word ‘France’ to justify its application to establish ownership of the trade marks for ‘France.com’, which were not therefore filed in breach of its rights,
- hold and rule that the action brought by the French State to establish ownership of the semi-figurative French trade marks for ‘France.com’, *i.e.*, trade marks FR 3661600, FR 3661602, FR 3661598 and FR 3661603, and the French verbal trade mark for ‘France.com’ number FR 3661596 filed on 2 July 2009 by Traveland Resorts, but which have since been transferred to France.com Inc., is entirely ill-founded,
- find, in any event, that the action to establish ownership of these five French trade marks for ‘France.com’, numbers 3661596, 3661600, 3661602, 3661598 and 3661603 has been completely time-barred since 7 August 2012,
- consequently dismiss the action brought by the French State and its claim to establish ownership of the semi-figurative French trade marks for ‘France.com’, *i.e.*, trade marks FR 3661600, FR 3661602, FR 3661598 and FR 3661603, and the French verbal trade mark for ‘France.com’ number FR 3661596,



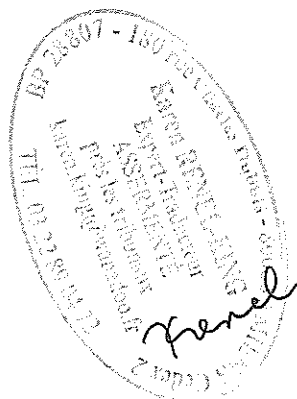
- order the compulsory publication of the forthcoming decision in three newspapers to be chosen by France.com Inc, for up to €5,000 per publication to be borne jointly and exclusively by the French State and the EIG Atout France,
- order the French State and the EIG Atout France jointly and severally to pay €80,000 pursuant to Article 700 of the Civil Procedures Code to France.com Inc., less the amount awarded in this respect by the procedural judge,
- award all costs and expenses of these proceedings against the French State and the EIG Atout France, to be collected by Mr André Bertrand in accordance with the provisions of Article 699 of the Civil Procedures Code,
- order the immediate enforcement of the forthcoming decision, notwithstanding an appeal or a guarantee, including as regards the publication measures to be imposed.

In support of its claims, France.com puts forward the following arguments:

- the <France.com> domain name has been exploited in the United States since 1994. The entire website has been drafted in English since 1997 and specialises in French tourism; it has received numerous awards for its contribution to French tourism,
- the French State cannot rely on any specific right to the domain name,
- France.com, the owner of the domain name, plans to assign it and has notified the French authorities accordingly,
- the domain name has been peacefully exploited for 15 years,
- the French State has never challenged the validity of the French or Community trade marks for France.com,
- the main dispute between France.com and Traveland Resorts was definitively settled by the settlement agreement entered into on 6 October 2014, before the French State and the EIG Atout France even joined the proceedings on 14 April 2015,
- these parties joined the proceedings even though notice of a trade mark assignment had already been given, and therefore had no grounds on which to do so,
- in any event, the claims made in the context of the joinder must be sufficiently linked to the main dispute, which is limited to five French trade marks, not to Community trade marks or the domain name, which are the subject of the joinder of the French State,
- the EIG Atout France has no interest or capacity to take part in legal proceedings,
- the commercial court has jurisdiction, as the dispute relates to the transfer of a domain name, which is unrelated to trade mark law,
- the action to revoke the trade marks is inadmissible,
- the voluntary intervenors do not have any 'prior rights' that may be enforced against France.com, and cannot request the transfer of the trade mark.

In their submissions in response filed electronically on 28 September 2015, the French State and the EIG Atout France petition the court as follows:
Having regard to Article L 712-6 of the intellectual property code and Article 101 (2) of EC Regulation 207/2009

- find that the voluntary joinder of the French State and the EIG Atout France to the proceedings is admissible,



- dismiss the company's arguments, objections to jurisdiction and procedural objections.
- find the counter-claim for patently illegal action made against the French State to be inadmissible,
- hold and rule that by applying for French and Community trade marks made up of the name France.com, Traveland Resorts infringed the rights of the French State to the name of its territory,
- hold and rule that the assignment of the disputed trade marks to France.com Inc cannot be enforced against the French State, as it was not registered in the National Trade Marks Register on the date of the voluntary joinder, *i.e.*, 14 April 2015,
- find that the settlement agreement entered into between France.com inc and Traveland Resorts under Article 2045 of the Civil Code is null and void and, in any event, that it cannot be enforced against the French State with regard to public policy and supranational rules,

In any event,

- order the transfer to the French State of the nine trade marks made up of the name France.com and fraudulently registered in the name of Traveland Resorts and lastly assigned to France.com Inc, namely:

a) registration number 3661596 of 2 July 2009 concerning the name france.com, designating goods in classes 16 and 25 and services in classes 35, 36, 38, 39, 41, 42 and 43,

b) registration number 3661598 of 2 July 2009 concerning the name France.com associated with a depiction of France including a heart at its centre, designating goods in classes 16 and 25 and services in classes 35, 36, 38, 39, 41, 42 and 43,

c) registration number 3661602 of 2 July 2009 concerning the name France.com associated with a depiction of France including a heart at its centre, designating goods in classes 16 and 25 and services in classes 35, 36, 38, 39, 41, 42 and 43,

d) registration number 3661600 of 2 July 2009 concerning the name France.com associated with a depiction of France including a heart at its centre, designating goods in classes 16 and 25 and services in classes 35, 36, 38, 39, 41, 42 and 43,

e) [sic] registration number 3661603 of 2 July 2009 concerning the name France.com associated with a depiction of France including a heart at its centre, designating goods in classes 16 and 25 and services in classes 35, 36, 38, 39, 41, 42 and 43,

f) registration number 08791873 of 22 June 2010 filed on 4 January 2010, designating goods in classes 16 and 25 and services in classes 35, 36, 38, 39, 41, 42 and 43,

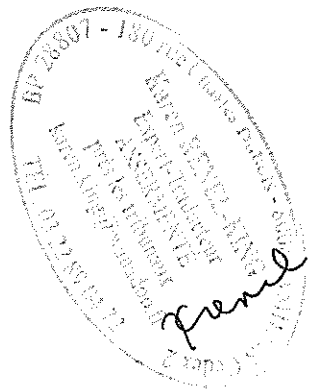
g) registration number 08791857 of 22 June 2010 filed on 4 January 2010 for designating goods in classes 16 and 25 and services in classes 35, 36, 38, 39, 41, 42 and 43,

h) registration number 08791899 of 22 June 2010 filed on 4 January 2010 for designating goods in classes 16 and 25 and services in classes 35, 36, 38, 39, 41, 42 and 43,

i) registration number 08791923 of 22 June 2010 filed on 4 January 2010 for designating goods in classes 16 and 25 and services in classes 35, 36, 38, 39, 41, 42 and 43,

In the alternative, pursuant to Articles L711-2, L711-3 and L711-4 of the intellectual property code,

- cancel the five aforementioned registered French trade marks of 2 July 2009,



- order France.com inc to voluntarily abandon the four Community trade marks registered with the OHIM under priority of the cancelled French trade marks, subject to a penalty of €500 per day of delay and per registered trade mark following a period of one month after service of the forthcoming decision,

The <France.com> domain name

Having regard to Articles 9 and 1382 of the Civil Code,

Having regard to Article 2 of the Constitution of 1958,

- hold and rule that by applying to register the <France.com> domain name and exploiting the name most recently to operate a website dedicated exclusively to tourism in France inconsistently and purely speculatively with a view to selling the associated domain name, France.com Inc. breached the State's rights to the name and image of its territory and adversely affected the State's sovereignty,

- order France.com Inc to transfer the 'France.com' domain name to the French State within one month of service of the forthcoming decision, subject to a penalty of €500 per day of delay thereafter,

In the alternative:

- prohibit France.com Inc from assigning or licensing the domain name France.com to a third party in any form and in any respect whatsoever, subject to a penalty of €10 million per transfer observed,

- prohibit France.com from using this domain name to operate a website likely to create confusion in the public's mind as to the origin of the product or service proposed or to harm the image and/or identity of France, subject to a penalty of €500,000 per breach observed,

Having regard to Article 10 of the Paris Convention,

- hold and rule that, by using the domain name France.com to operate a website dedicated exclusively to tourism in France without the required professionalism, France.com Inc committed acts of unfair competition to the detriment of the EIG Atout France, which is responsible for officially promoting tourism in France,

- order France.com Inc to pay the EIG Atout France €20,000 in damages,

- reserve its right to liquidate the penalties imposed,

- order immediate enforcement,

- order France.com Inc and Traveland Resorts to pay the EIG Atout France €20,000 pursuant to Article 700 of the Civil Procedures Code,

- award all costs against France.com Inc, including the costs of the affidavit prepared by the Benichou Legrain firm of judicial officers on 19 January 2015.

In substance, the French State and the EIG Atout France argue as follows:

- they have an interest in taking part in legal proceedings and their claims are adequately linked to the original claims, as they concern the same rights as those claimed in the original summons,

- they voluntarily joined the proceedings before the proceedings between France.com and Traveland Resorts had been withdrawn, and a settlement agreement is only final and binding between the parties involved, whereas in any event, the voluntary intervenors claim a right specific to them (the right to the name and image of the territory),



- the EIG Atout France provides a public service role involving the national and international promotion of tourism in France and therefore has an interest and capacity to take part in legal proceedings,
- it is not within the remit of the OHIM to decide on an action to establish ownership,
- the US company has not provided any proof as to the genuine exploitation of the domain name, except recently in order to sell it to the highest bidder,
- the French State relies on non-proprietary rights (right to a name and an image) that are protected by the Constitution, which constitute attributes of its personality and may not therefore be transferred, subject to limitation or seized,
- the OHIM believes that the trade mark France.com is not distinctive and the *Cour de Cassation* [French supreme court] believes that an operator cannot appropriate a sign that identifies a county, even less so the name of a country itself, and the Paris Convention prohibits the use of coats of arms, flags and other State emblems,
- EC Regulations 874/2004 and 1654/2005 govern the filing of domain names,
- the trade marks for France.com that now belong to the US company are misleading or breach public policy, grant the said company an illegitimate monopoly with regard to the public interest, and must be cancelled,
- the foregoing also applies to the domain name, which infringes the identity and digital sovereignty of the French State, the use of which for tourism in France is likely to instil confusion in the public's mind,
- the US company has not provided proof that the domain name has been exploited peacefully for 21 years,
- the action brought by the voluntary intervenors is not time-barred due to the fact that rights to a name cannot be transferred or time-barred,
- this action and the protective measures taken are not wrongful.

In submissions filed electronically on 1 October 2015, Traveland Resorts makes the following claims:

First, [the court is asked to]

- decline jurisdiction in favour of the Commercial Court of Miami, Florida, Having regard to Articles 384 and 394 *et seq.* of the Civil Procedures Code,
- record the withdrawal of proceedings and action by Traveland Resorts registered in the General Register under number 14/08237 and rule that each party must bear the fees and expenses incurred,
- Having regard to Article 1 of the Civil Procedures Code and Articles 2044 and 2052 of the Civil Code, rule that the voluntary joinders of the French State and the EIG Atout France are inadmissible,
- dismiss all the claims made by the French State and the EIG Atout France against Traveland Resorts, as the latter no longer holds any rights to the trade marks and domain name at issue,
- order the French State and the EIG Atout France to pay Traveland Resorts €3,000 pursuant to the provisions of Article 700 of the Civil Procedures Code,
- award all costs against the French State and the EIG Atout France, such costs to be collected by Mr Christian Beer pursuant to the provisions of Article 699 of the Civil Procedures Code.



The proceedings were closed at the hearing of 6 October 2015 and the parties put forward their arguments the same day.

GROUNDS OF THE DECISION

1 – The voluntary joinder

The French State and the Eig Atout France voluntarily joined the proceedings pursuant to submissions dated 14 April 2015.

France.com believes that this joinder was tardy as it occurred after the settlement agreement had been signed, that it is inadmissible as it is not adequately connected to the original proceedings, that the EIG has no interest or capacity to take part in legal proceedings and that the application is within the jurisdiction of the Commercial Court.

In his order of 2 October 2015, the procedural judge rejected the objection to jurisdiction raised in favour of the commercial court. The claim made in this respect is therefore irrelevant.

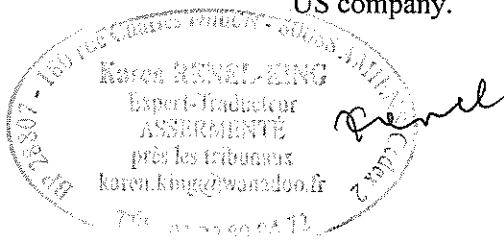
The settlement agreement entered into on 6 October 2014 between the two parties originally involved in the dispute (France.com and Traveland resorts) relating to verbal and semi-figurative French and Community trade marks cannot be enforced against third parties due to the fact that agreements are effective solely between the parties involved, particularly as the entry in the trade marks register following the conclusion of the agreement was not published until 13 May 2015 (voluntary intervenors' exhibit 11).

Furthermore, although the settlement agreement put an end to the court proceedings in accordance with the provisions of Article 384 of the Civil Procedures Code, the case remains with the court until a decision has been issued recording the withdrawal of proceedings, which occurred pursuant to an order of 2 October 2015, after the parties to the settlement agreement had filed submissions withdrawing proceedings on 19 June 2015.

In submissions of 19 June 2015, France.com withdrew its proceedings and action against Traveland Resorts, which the latter accepted the same day.

Furthermore, when the voluntary intervenors filed their submissions on 14 April 2015, the proceedings between France.com and the Eig Atout France were pending before the *tribunal de grande instance* of Paris. Therefore, the voluntarily joinder was not tardy.

Pursuant to Article 325 of the Civil Procedures Code, in order for a voluntary joinder to be admissible, there must be an adequate link with the original claims. In the case in point, the original summons of 19 May 2014 relates to the fraudulent filing of an application for two French trade marks, whereas the claims made by the voluntary intervenors concern the same French trade marks, as well as Community trade marks and a domain name. Although these claims are not entirely identical, there is an adequate link between the first and second sets of claims, if only due to the fact that the Community trade marks referred to by the French State and the EIG Atout France were filed under priority of the French trade marks claimed by the US company.



Furthermore, in support of its original claims, France.com relied on its prior rights to the domain name france.com to oppose the registration of the trade marks at issue, which is the subject of claims made by the voluntary intervenors.

As a result of the foregoing, the claims made by the French State and the Eig Atout France in the context of their voluntary joinder are linked to the original claims and are therefore admissible.

Lastly, the interest of the Eig Atout France in taking part in legal proceedings is challenged.

Pursuant to Article 31 of the Civil Procedures Code, action may be taken by anyone with an interest in the success or rejection of a claim.

The EIG Atout France, an agency that develops tourism in France, has a public service role involving the promotion of tourism in France, the performance of tourism engineering operations and the implementation of a competitiveness and quality policy for companies in the industry. (Article L141-2 of the *code du tourisme* [French tourism code])

In dealings with third parties, its director has the option to make commitments on behalf of the grouping in relation to any matter within the scope of its objects. (end of same Article).

The provisions of chapter 1 of section V of book II of the commercial code, which govern the EIG, do not apply to this matter as they are contrary to the aforementioned legal provisions and are therefore expressly excluded. (Article L141-2, paragraph 1 of the tourism code).

These proceedings fall within the scope of the Eig's objects and do not require the consent or approval of shareholders at a general meeting. The EIG has an interest in taking part in legal proceedings.

2 – The lack of jurisdiction of the French courts in favour of the US courts

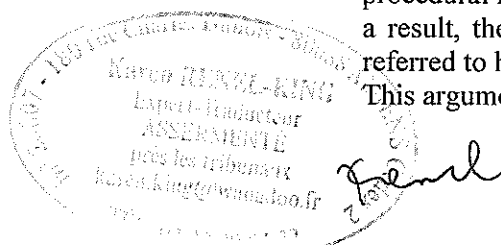
In his order of 2 October 2015, the procedural judge ruled that the *tribunal de grande instance* of Paris did have jurisdiction.

France.com and Traveland Resorts argue that the French courts should decline jurisdiction in favour of the US courts with regard to international public policy, as the dispute relates to a domain name, a movable asset situated in the United States that belongs to a US company, and that the voluntary intervenors cannot claim the benefit of the provisions of Article 14 of the Civil Code that provides for an exemption from jurisdiction.

This objection was raised tardily by Traveland Resorts, notably after the additional hearing of 22 September 2015, and falls within the exclusive jurisdiction of the procedural judge, in accordance with the provisions of Article 771 of the Civil Procedures Code, as a result of which the court ruling on the merits does not have jurisdiction to decide this point.

France.com raised this objection in its submissions for the aforementioned procedural hearing, but did not reiterate it in the body of its submissions. As a result, the procedural judge did not believe that the objection had been referred to him and did not therefore reply.

This argument is therefore inadmissible.



3 – The action by the French State and the EIG Atout France is time-barred

With regard to Article 2276 of the Civil Code, France.com relies on the positive prescription in relation to personal property, arguing that the domain name at issue was registered in 1994 and has indisputably been exploited peacefully since that time.

Although domain names are liable to appropriation, they are intangible assets that are not material objects. Accordingly, the provisions of Article 2276 of the Civil Code do not apply.

Action to establish ownership of a trade mark is time-barred five years after the date of publication of the application, save in the event of the applicant's bad faith, pursuant to Article L712-6 of the version of the intellectual property code resulting from the act of 11 March 2014, .

France.com argues that although the original application filed by Traveland was indeed fraudulent (which it stipulated in its original summons), this is no longer the case, as it is now the legitimate proprietor of these trade marks.

However, as the original application clearly infringed the rights of the French State, the action taken by the voluntary intervenors to establish ownership of both the domain name and the trade marks at issue is not time-barred.

4 – Out-of-court admissions

France.com argues that, in the context of ministerial replies, the French State, through its Foreign Affairs Minister, acknowledged that the disputed domain name was owned by a US company whose registered address was in Florida and that the company could not be required to assign it to the French State. France.com believes that these statements constitute out-of-court admissions, as a result of which the claimants' claims must be rejected.

However, an admission may be made in order to prove a legal fact, but this is not the case when it relates to a point of law. As a result, the statement according to which the French State cannot claim ownership of this domain name due to applicable regulations and the absence of any international legal framework is an opinion formed by its representatives on a point of law, and cannot therefore be classified as an out-of-court admission.

5 – The claim as to ownership of the French and Community trade marks

The French State challenges the validity of the verbal and semi-figurative French and Community trade marks, which became the property of France.com during the proceedings, on the basis that they infringe its rights to its name and territory, *i.e.*, its attributes.

First, it imports to point out that, contrary to what France.com suggests, the OHIM cannot deal with this issue in the case in point as, pursuant to the provisions of Article 41 of the Community Trade Mark Regulation (EC) 207/2009, an opposition may only be raised by proprietors and licensees of national and Community trade marks registered for identical goods and services (which is not the case here, as the French State is relying simply on its personal attributes as prior rights).



The provisions of Article 45-2 of the *code des Postes et communications* [French Postal and Communications Services Code], which prohibit anyone from adopting a domain name identical to the name of a territorial community (unless they have a legitimate interest in doing so and act in good faith), do not apply in the case in point, as they only govern domain names with the extension <.fr>.

The French State relies on the provisions of Article L711-4 of the intellectual property code, pursuant to which *a sign that infringes prior rights cannot be adopted as a trade mark, particularly ... h/ the name, image or reputation of a territorial community*, as well as Article L711-3 of the same code, which prohibits the adoption as a trade mark of a sign *a/ excluded by Article 6 ter of the revised Paris Convention of 20 March 1883 for the protection of industrial property* (particularly the coats of arms, flags and emblems of a state).

France.com argues that the French State may only bring an action for revocation on the basis of Article L711-3 as a counter-claim, provided that the trade mark was relied on against it in the main proceedings.

However, where the ground of revocation is based on Articles L711-1 to 3 (a sign likely to constitute a trade mark, distinctiveness and lawfulness), an action for outright revocation may be brought by any interested person (including the Prosecution Service), whereas where the ground of revocation is based on Article L711-4 (unavailability of a sign due to the existence of prior rights), an action for revocation may only be relative and may only be brought by the rights holder.

Accordingly, in the case in point, in any event, the French State is entitled to take part in legal proceedings.

Furthermore, in any event, the claims of the French State and the EIG Atout France are based on Article L711-4 of the Intellectual Property Code, not on the aforementioned provisions.

A ‘territorial community’ within the meaning of Article L711-4 referred to above means a group of individuals with shared interests in a specified geographic territory and does not refer solely to the administrative meaning of the term. Therefore, these provisions apply to the French State, which includes a group of individuals with shared interests on national territory. Protection of the attributes of the territorial community is assessed with regard to the public service tasks assigned to it, by seeking to determine whether there is a risk of confusion.

In the case in point, the US company’s trade mark, which is made up solely of the word ‘France’ and the addition of the suffix ‘.com’, which corresponds to the extension of the main domain name, which does not suffice to change the perception of the sign at issue, for designating the goods and services referred to in the registration to promote tourism in French territory, on the one hand, unduly privatizes the name of the community in favour of its proprietor, whereas by nature, the name should be available for public and collective use and, on the other hand, infringes the rights of the French State to its name, which refers to a sovereign state and identifies a country with its own economic, geographic, historical and cultural identity, which is notably intended to promote the country and notably to promote tourism in France in the interests of the national community.



Furthermore, the use of the trade mark 'France' alone, with no extra component (other than '.com'), for all the designated goods and services suggests that an official body has approved them, and is likely to make the public believe that it designates the goods and services of an official or accredited body, in association with the public authorities.

Verbal trade mark number 3661596 therefore infringes the French State's rights to its name.

The foregoing also applies to the other eight semi-figurative French and Community trade marks filed in black and white or in colour, which include the name 'France.com' together with a stylised depiction of the geographic borders of France, surrounding a heart, which is not likely to render the disputed signs distinctive. These trade marks also infringe the French State's rights to its name.

Accordingly, pursuant to the provisions of Article L712-6 of the Intellectual Property Code, the French State can legitimately claim ownership of these trade marks, for which an order will be made in the body of the decision.

6 – Ownership of the domain name

The French State believes that the appropriation by the US company of the <France.com> domain name for purely speculative purposes infringes its name, its identity and its sovereignty.

The content of the website operated at this address by the US company undoubtedly does not harm the image of the country, but like the trade marks referred to above, the domain name used by France.com infringes the State's rights to its name, its identity and its sovereignty.

Furthermore, owing to the possibility to create associated e-mail addresses, the owner of the domain name has privileged and monopolistic access to the detriment of other operators, which is in fact used as a commercial argument by the agent responsible for selling the disputed website, who speaks highly of the apparent reliability and credibility of the address, which can be attributed to a service of the French State or an authorised third party.

Accordingly, the <France.com> domain name owned by the US company infringes the rights of the French State to its name. The French State therefore has valid grounds on which to request the transfer thereof, where France.com cannot legitimately claim any advance payment of appropriate damages.

7 – Unfair competition

On the basis of Article 1382 of the Civil Code, inappropriate behaviour such as behaviour designed to create a risk of confusion in the minds of customers as to the origin of a product is punished on the grounds of unfair competition.



The EIG Atout France, which is responsible for officially promoting tourism in France, argues that France.com has committed acts of unfair competition to its detriment and claims the payment of €20,000. However, the EIG has not provided proof of the loss it has suffered as a result.

This claim will be rejected.

8 – The other claims

France.com, the losing party, shall bear all costs. France.com and Traveland resorts shall bear their own costs, according to the terms and conditions set by them when proceedings were withdrawn.

Pursuant to the provisions of Article 700 of the Civil Procedures Code, the court will order the party required to pay the costs to pay the other party an amount to be determined by the court, for the costs incurred that are not included in the costs of proceedings, on the basis of fairness or the economic situation of the party against which the order is made. The French State makes no claim in this respect in its submissions. It seems unfair to award the EIG Atout France, whose claims will all be rejected, compensation for the irrecoverable costs incurred.

No specific circumstance of the case justifies an order for immediate enforcement.

ON THESE GROUNDS

The court, ruling in open court, by virtue of an *inter partes* decision in the first instance made available at the Court Registry,

Rules that the voluntary joinder of the French State and the EIG Atout France to the proceedings is admissible,

Finds that the EIG Atout France has an interest in taking action,

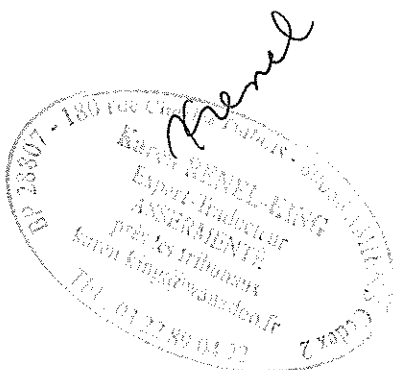
Rejects the objection to jurisdiction in favour of the US courts,

Rejects the argument that the action to establish ownership of the <France.com> domain name and the French and Community trade marks is time-barred,

Orders France.com to transfer the following France.com trade marks to the French State, subject to a penalty of €150 per day of delay and per trade mark following the expiry of a period of two months after service of this decision:

- number 3661596 of 2 July 2009
- number 3661598 of 2 July 2009
- number 3661602 of 2 July 2009
- number 3661600 of 2 July 2009
- number 3661603 of 2 July 2009
- number 08791873 of 22 June 2010 filed on 4 January 2010,
- number 08791857 of 22 June 2010 filed on 4 January 2010
- number 08791899 of 22 June 2010 filed on 4 January 2010
- number 08791923 of 22 June 2010 filed on 4 January 2010

for the goods and services referred to in each application, on the understanding that the court reserves the right to liquidate the penalties,



Decision of 27 November 2015

Division 3, Court 3

Number in the General Register: 14/08237

Rules that the decision, once final, must be sent to the INPI [French Industrial Property Office] by the first party to act, to be registered in the National Trade Marks Register,

Orders France.com to transfer the <France.com> domain name to the French State, subject to a penalty of €150 per day of delay following the expiry of a period of two months after service of this decision,

Rules that the court reserves the right to liquidate the penalties,

Rejects the claim made by the EIG Atout France on the basis of unfair competition,

Awards all costs against France.com,

Finds that no compensation for irrecoverable costs will be awarded,

Finds that there is no need to order immediate enforcement.

Done in Paris on 27 November 2015

The Registrar
[signature]

The President
[signature]



General Register No: 14/08237

Enforceable OFFICE COPY in:

Claimant 1: FRANCE.COM.INC and others

versus Defendant 1: TRAVELAND RESORTS MDV B.V and others

ACCORDINGLY, THE FRENCH REPUBLIC authorises and orders:

All judicial officers, pursuant to this request, to enforce the said decision,

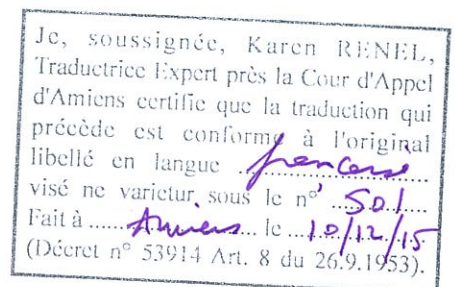
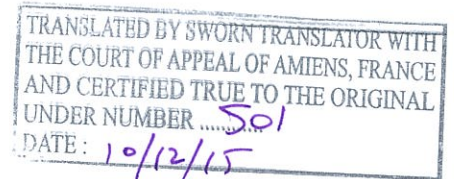
All Attorney Generals and Public Prosecutors of the District Courts to provide assistance in that respect,

All police captains and officers to provide assistance when required to do so,

In witness whereof, this judgment was signed and issued by me, the undersigned Chief Registrar of the District Court of Paris

pp The Chief Registrar
[stamp: Tribunal de Grande Instance of Paris]
[signature]

19th and last page



Renel