

Copies of judgement  
to be executed issued  
to the parties:

**FRENCH REPUBLIC**  
IN THE NAME OF THE FRENCH PEOPLE

**COURT OF APPEAL OF PARIS**

**Pôle 5 - Chamber 2**

**JUDGEMENT OF 22 SEPTEMBER 2017**

(no.131, 12 pages)

Registration number in general register: **15/24810**

Decision referred to the Court: judgement of 27 November 2015 - Tribunal de Grande Instance of PARIS [district High Court]- 3rd chamber 3rd section - RG no.14/08237

**APPELLANT IN MAIN PROCEEDINGS & RESPONDENT IN SUBSEQUENT APPEAL**

**Société FRANCE.COM INC**, a company incorporated under United States law, acting in the person of its legal representative, Mr Jean-Noël Frydman, domiciled in the role at said headquarters

3109 Grand Avenue MIAMI FL  
33133 UNITED STATES OF  
AMERICA

Represented by Mr François Teytaud, a lawyer at the PARIS Bar, toque (pigeon-hole no.) J 125  
Assisted by Mr Ignacio Diez, a lawyer at the PARIS Bar, toque (pigeon-hole no.) L 207

**RESPONDENT IN MAIN PROCEEDINGS & APPELLANT IN SUBSEQUENT APPEAL**

**G.I.E. ATOUT FRANCE**, in the person of its managing director, Mr Mantel, domiciled in the role at said headquarters located at

79-81, rue de Clichy  
75009 PARIS

Registered at the RCS (Trade Register) of Paris under the number 340 709 211

Represented by Ms Jeanne Baechlin of SCP JEANNE BAECHLIN, lawyer at the PARIS Bar, toque (pigeon-hole no.) L 0034

Assisted by Mr Cédric Meiller pleading for SELAS DE GAULLE - FLEURANCE & ASSOCIES and replacing Mr Jean-François Vilotte, lawyer at the PARIS Bar, toque (pigeon-hole no.) K 35



## RESPONDENT

### THE FRENCH STATE, represented by the MINISTER OF FOREIGN AFFAIRS AND OF INTERNATIONAL DEVELOPMENT (MAEDI)

37, quai d'Orsay  
75351 PARIS

Represented by Ms Jeanne BAECHLIN of SCP JEANNE BAECHLIN, lawyer at the PARIS Bar, toque (pigeon-hole no.) L 0034  
Assisted by Mr Cédric Meiller pleading for SELAS DE GAULLE - FLEURANCE & ASSOCIES and replacing Mr Jean-François Vilotte, lawyer at the PARIS Bar, toque (pigeon-hole no.) K 35

## COMPOSITION OF THE COURT:

After oral report, the case was deliberated on 3 May 2017, in a public hearing, before the Court comprising:

Ms Colette Perrin, Chairperson  
Ms Véronique Renard, Assessor  
Ms Elisabeth Mehl-Jungbluth, Counsel, appointed to  
complete the Court  
who took part in the deliberations

Court Clerk during the deliberations : Ms Carole Trejaut

## JUDGEMENT:

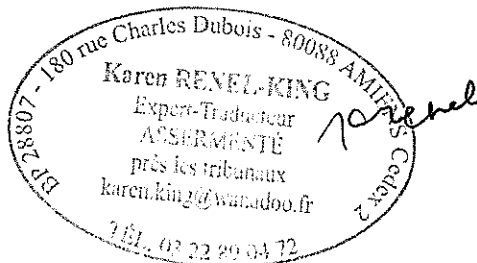
After hearing the Parties  
By making the judgement available to the Court Register, the parties having been previously notified in accordance with the conditions laid down in the second subparagraph of Article 450 of the French Civil Procedure Code.  
Signed by Ms Colette Perrin, Chair, and by Ms Carole Trejaut, Court Clerk, to whom the original of this judgement has been delivered by the signatory magistrate.

## FACTS, PROCEDURE AND CLAIMS FROM THE PARTIES

The American company France.com Inc. is owner of the domain name of france.com registered 10 February 1994.

It discovered that the company under Dutch law of Traveland Resorts has used the following trademark names:

a) the French trademark **france.com** no. 3661596 of 2 July 2009 designating various products and services of classes 16 and 25, 35, 36, 38, 39, 41, 42, and 43,



b) The French trademark [France.com with outline of France] no.3661598 of 2 July designating various products and services of classes 16, 25, 35, 36, 38, 39, 41, 42, and 43,

c) The French trademark 3661602 of 2 July 2009 [France.com with outline of France]

d) The French trademark no.3661602 of 2 July 2009 [France.com with outline of France]

designating various products and services of classes 16, 25, 25.35, 36.38, 38, 39, 41, 42, and 43,

e) The French trademark no. 3661602 of 2 July 2009 [colours ] **FRANCE.com**

designating various products and services of classes 16, 25, 35, 36, 38, 39, 41, 42, and 43,

The company Traveland Resorts was also owner of four registrations of community trademarks claiming priority of the corresponding French registrations, being:

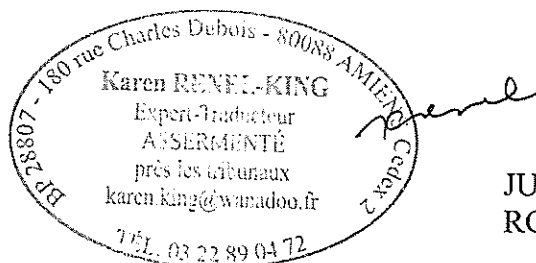
- the registration 08791873 of 22 June 2010 in accordance with filing of 4 January 2010 designating various products and services of classes 16, 25, 35, 36, 38, 39, 41, 42, and 43,
- the registration 08791857 of 22 June 2010 in accordance with filing of 4 January 2010 designating various products and services of classes 16, 25, 35, 36, 38, 39, 41, 42, and 43,
- the registration 08791899 of 22 June 2010 in accordance with filing of 4 January 2010 designating various products and services of classes 16, 25, 35, 36, 38, 39, 41, 42, and 43,
- the registration 08791923 of 22 June 2010 in accordance with filing of 4 January 2010 designating various products and services of classes 16, 25, 35, 36, 38, 39, 41, 42, and 43,

Through a deed served by a huissier (court bailiff) dated 19 May 2014, the company France.com Inc summoned the company Traveland Resorts to appear before the Tribunal de Grande Instance of Paris for fraudulent filings of trademarks in order to obtain the handover of these as well as compensation for any loss or damage suffered.

All of the aforementioned trademarks were assigned to France.com Inc by means of a transaction reached with the company Traveland Resorts in autumn 2014 and a declaration of transfer had been registered at the OHIM (Office of Harmonisation for the Internal Market) 18 May 2015 regarding the community trademark registrations, and 3 July 2015 at the National Registry of Trademarks in regards to the French trademarks.

On the 14 April 2015, the French State and the GIE Atout France applied to be joined as parties in the procedure to establish in particular the infringement of rights of the French State on the name of its territory by the company Traveland Resorts and to obtain the transfer for its benefit of the contested trademarks, as well as the infringement of its rights by the company France.com Inc and to obtain the transfer of the domain name, or alternatively a prohibition on licensing, in addition to the acknowledgement of acts of unfair competition committed to the detriment of GIE Atout France.

On 19 June 2015, the company France.com dropped its legal proceeding and action against the company Traveland Resorts, which was accepted by the latter on the same day.



On 3 September 2015, the French State made additional claims, seeking the cancellation of five registrations of contested French trademarks ceded to the company France.com Inc. and that the latter be ordered to voluntarily renounce the four community registrations before the OHIM.

By an order of 2 October 2015, the procedural judge, on one hand, had recorded the discontinuance of the proceedings of the company France.com Inc in regards to the company Traveland Resorts and on the other, had rejected the plea of material incompetence and territorial competence in favour of the Commercial Court and referred the case to the Court to rule on the merits, examination of all means, analysed such as bar to proceedings or substantive questions, such as those excluded by the competence of the pre-trial assessor.

**By judgement given after due hearing of the parties dated 27 November 2015, the Tribunal de Grande Instance of Paris :**

- declared the application by the French State and by GIE Atout France to be joined to proceedings to be admissible,
- recorded the interest of GIE Atout France in pursuing an action,
- rejected the plea of lack of competence in favour of American jurisdictions,
- rejected the plea on the limitation period of the proceedings to claim ownership, both for the domain name france.com along with the French and community trademarks,
- ordered the company France.com to transfer to the French State, subject to a penalty of 150 Euro for each day of delay and per trademark, after a period of two months following notification of the judgement, the following France.com trademarks:
  - no. 3661596 of 02 July 2009
  - no. 3661598 of 02 July 2009,
  - no. 3661602 of 02 July 2009,
  - no. 3661600 of 02 July 2009,
  - no. 3661603 of 02 July 2009,
  - no. 08791873 of 22 June 2010 in accordance with filing of 4 January 2010,
  - no. 08791857 of 22 June 2010 in accordance with filing of 4 January 2010,
  - no. 08791899 of 22 June 2010 in accordance with filing of 4 January 2010,
  - no. 08791923 of 22 June 2010 in accordance with filing of 4 January 2010,for the products and services referred to at each of these filings, the tribunal reserves the right to assess and set the penalty payments,
- declares that the decision once definitive must be sent to the INPI (French National Institute of Industrial Property) on the initiative of the first party to seek registration in the national trademarks register,
- ordered the company France.com to transfer to the French State, subject to a penalty of 150 Euro for each day of delay, after a period of two months following notification of the judgement, the France.com domain name:
  - judgement is reserved on the assessment of the penalty payments,
  - rejected the claim for unfair competition from GIE Atout France,
  - ordered the company France.com to pay costs,
  - ruled that there are no grounds for compensation for irrecoverable costs,
  - ruled that there are no grounds for provisional enforcement.

The company France.com Inc appealed the decision by declaration at the court registry on 10 December 2015.

**By order of 24 November 2016, the civil procedure Assessor :**

- declared inadmissible or ill-founded the claims of the company France.com Inc. (raising the incompetence of the jurisdictions of the judicial order, unblocking the domain name france.com, so that the injunction is for GIE Atout France to justify the performance of its public-service tasks and financial year, to the allocation of provisional compensation, so that five urgent questions of constitutionality are delivered to the Court of Cassation, so that four questions for a preliminary ruling are submitted to the European Court of Justice for a preliminary ruling),
  - Consequently, regarding the company France.com Inc. the entire claim was dismissed,
- 5.0 rejected the counterclaim of the French State which was taken in the person of the Minister of Foreign Affairs and of International Development and of GIE Atout France seeking an order for provisional enforcement of the judgement of 27 November 2015 of the measure to



- transfer to the French State the domain name france.com,
- ordered the company France.com Inc to pay GIE Atout France the sum of 5,000 Euro in application of Article 700 of the Code of Civil Procedure;
- judgement is reserved on costs.

**Through the last documents submitted via electronic means on 6 September 2016, to which express reference is made, the company France.com Inc. asks the court,** by virtue of Articles 2 and 72 of the constitution of 1958, L.3111-1 of the Code général de la propriété des personnes publiques [French General Code on Public Property], 325 and 700 of the Civil Procedure Code, 9, 1382 and 2276 of the Civil Code, L. 711-3, L. 711-4, L. 712-6 and L. 714-3 code de la propriété intellectuelle [French Intellectual Property Code], 6 ter and 10 of the Convention of Paris 1883, le règlement sur la marque communautaire, [Community Trade Mark Regulation] Order no. 2015-1682 of 17 December 2015, under the recapitulated terms of eight pages comprising a certain number of petitions for findings which do not constitute legal claims within the meaning of the Code of Civil Procedure and in these terms, of:

- admitting the entirety of its claims in law and declare that these are well-founded , primarily,
- to overturn the judgement in its entirety,
- adjudge and declare that, as confirmed by the Constitution which provides that the official name of the geographic entity "France" is the "République française", and that the official name of its administration is "État français" (French State) and that the French Republic has no tangible or intangible property right to the word "France"
- adjudge and declare that the judgement must be overturned inasmuch as it was an erroneous judgement that "the French State had legal rights to the name 'France'", which designates a sovereign state, identifying a country with its identity,
- adjudge and declare that the French State chose to be joined to the proceedings before a civil court, and as a consequence it is ill-founded to plead the benefit of administrative prerogatives, as all its claims must be founded exclusively on book VII of the French Intellectual Property Code,
- dismiss the argument according to which the French State is now invoking the benefit of Article L.3111-1 of the code général de la propriété des personnes publiques (CGPPP: French general code on public property), which specifies that "the assets of public entities under French law Article L.1 in the public domain, are inalienable, and imprescriptible", thus a provision of administrative law, presented for the first time in appeal, except to refer the case back to the administrative tribunal solely competent to adjudge on the matter when the State invokes the prerogatives of public law,
- partially set aside the judgement open to appeal in which the voluntary intervention of GIE Atout France was declared admissible,
- adjudge and declare that the trademarks are the distinctive signs regulated by the provisions of Livre (Book) VII French Intellectual Property Code, while the domain names are property rights which are not regulated by the French Intellectual Property Code, and therefore, partially set aside the judgement open to appeal in which an action was allowed and a claim was granted for transfer of the domain name "france.com", which was not included in the main litigation which the French State applied to be made part of,
- adjudge and declare that the French State claim is unfounded in seeking the benefit of Article 9 of the French Civil Code, which only concerns the private life of natural persons, both in the attributes of their personality and in their physical person,
- adjudge and declare that the domain name "france.com" has been operated in good faith by Mr Jean Noel Frydman and/or the American company France.com Inc. for almost 21 years,
- adjudge and declare that the French State has known for 21 years now that Mr Jean Noel Frydman registered the domain name "france.com",
- adjudge and declare that Mr Jean Noël Frydman, manager of France.com. Inc. was, in the period from 2010 to 2015, in his role as a member of the Advisory Board of French Affairs a real partner of GIE Atout France and thereby of the French State, and that for this reason, neither GIE Atout France nor the French State can assert that in operating the website [www.france.com](http://www.france.com) that he would have acted in disregard of their rights,

As regards the French trademarks France.com

- adjudge and declare that thereby in Article 72 of the Constitution that "France" is not, under the law, a territorial collectivity, in reality the word France designates a geographical area,

- adjudge and declare that the French State holds no prior right, in the meaning of Article L.711-4 of the French Intellectual Property Code on the name "France",
- reverse the judgement in which the American company France.com Inc. is ordered to transfer to the French State, under a penalty of 150 Euro for each day of delay, and per trademark, following the two-month period after notification of this judgement, the French trademarks "France.com" no. 3661596 of 2 July 2009, no. 3661598 of 2 July 2009, no. 3661602 of 2 July 2009, no. 3661600 of 2 July 2009 and no. 3661603 of 2 July 2009, for products and services referred to in each of the filings,

Further, in the alternative,

- adjudge and declare that even if it can be assumed that the French State can invoke a prior right to the word "France", this right would be subject to the same rules as other prior rights, and that the French State could not invoke its benefits after having tolerated use for more than 5 years,
- adjudge and declare that Article L. 711-4 of the French Intellectual Property Code provides only for invalidity of trademarks adversely affecting a prior right, that it does not allow a claim either for their recovery or their transfer,
- adjudge and declare that Article 6 *ter* of the Convention of Paris of 1883, just like paragraph (a) of Article L.711-3 of the French Intellectual Property Code is inapplicable to the France.com trademarks,
- strongly reverse the judgement open to appeal as a consequence.
- adjudge and declare that the action of the French State in claiming the French trademarks "France.com" is inadmissible through application of the provisions set out in Article L712-6 of the French Intellectual Property Code,

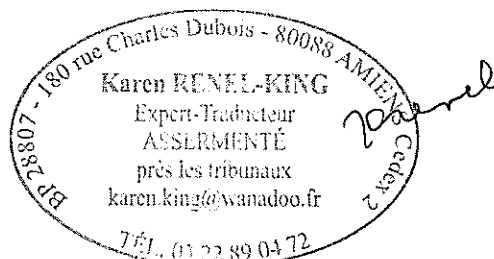
As regards the France.com European trademarks

- adjudge and declare that the France.com European trademarks are independent from the France.com French trademarks even if they have served as priority filings,
- reverse the judgement open to appeal in which the American company France.com Inc. is ordered to transfer to the French State, under a penalty of 150 Euro for each day of delay, and per trademark, following a two-month period after the notification of this judgement, the European trademarks "France.com" no. 08791873 of 22 June 2010 filed on 4 January 2010, no. 08791857 of 22 June 2010, filed on 4 January 2010, no. 08791899 of 22 June 2010 filed on 4 January 2010, no. 08791923 of 22 June 2010 and filed on 4 January 2010, for products and services referred to in each of the filings,
- adjudge and declare that, whatsoever the rights claimed by the French State, whether these are rooted or intangible, this does not mean it concerns imprescriptible rights, as was ruled in the judgement open to appeal, which could be exercised as the company France.com Inc. the owner of the france.com domain name for over 21 years, in a public manner and with full knowledge of the French State,

Further, in the alternative,

- order the French State, to reimburse 3,072,000 USD of investments, and 1,092,000 USD of salaries, a sum assessed on the date of 1 May 2016, which should be rounded or adjusted on the date of the judgement to be delivered,
  - order the French State to pay it 3,000,000 Euro by way of compensation for the loss of opportunity due to the loss of its main shares, its domain name and of its trademarks,
- Assuming that the judgement would be overturned on appeal,

- adjudge and declare that the blocking of the domain name since 20 April 2015 constitutes an unlawful act which opens the right to compensation,
- order the French State to pay 675,000 Euro damages for this reason, on 15 December 2015, to be adjusted on the date of the judgement to be delivered,
- to allocate to it, on the basis of Article 1382 of the French Civil Code, of 1,000,000 Euro of damages and additional interest, which must be paid in full (in solidum) by the French State and GIE Atout France,
- adjudge and declare that independently of the fact that the "absence of professionalism of France.com Inc." had not been established by Atout France with the burden of proof in the matter, and, even if this allegation was substantiated, it would not fall within the scope of Article 10 of the Convention of Berne, therefore GIE Atout France "charged with the official promotion of tourism in France" cannot invoke the advantage as it is not a commercial company in competition with France.com Inc.,



- dismiss the GIE Atout France appeal proceeding,  
In a counterclaim,
- in consequence, order GIE Atout France to pay it 1,000,000 Euro of damages and interest for the abusive proceeding,
- order the publication of the judicial decision to be notified in 5 newspapers of its choice and amounts advanced to pay from Atout France, with a limit of 5,000 Euro ex-tax maximum per insertion, and on the home page of the france.com website for a month in font size 12,
- order the French State and GIE Atout France to pay it 120,000 Euro in solidum by application of the provisions of Article 700 of the French Code of Civil Procedure, the French State and GIE Atout France before also being ordered to pay in solidum the entire costs of these proceedings, which will be recoverable by its legal Counsel according to the provisions of Article 699 of the French Code of Civil Procedure.

**By means of the last documents submitted via electronic means on 13 March 2017, to which reference is also expressly made, the French State and GIE Atout France ask the Court to :**

- declare inadmissible the claim of inadmissibility of application to be joined to the proceedings of the respondents formulated by the company France.com by means of findings disclosed on 10 September 2016 by application of Articles 74 and 954 of the French Code of Civil Procedure,
- confirm the judgement in which the transfer to the French State is ordered, under a penalty of 150 Euro for each day of delay, and per trademark, the 9 trademarks constituting the denomination France.com and registered fraudulently under the name of Traveland Resorts MDV.BV and most recently assigned to the company France.com Inc., as follows:

a) the registration no. 3661596 of 02 July 2009 having as a purpose the denomination France.com for designating the products of classes 16 and 25, and services of classes 35, 36, 38, 39, 41, 42, and 43, [France.com with outline of France]

b) the registration no. 3661598 of 2 July 2009 having as a purpose the France.com associated with the representation of France including a heart in designating the products of classes 16 and 25 and the services of classes 35, 36, 38, 39, 41, 42, and 43

[France.com with outline of France]

c) the registration no. 3661602 of 2 July 2009 having as a purpose the denomination france.com associated with the representation of France including a heart in designating products of classes 16 and 25 and services for classes 35, 36, 38, 39, 41, 42, [France.com with outline of France]

d) the registration no. 3661600 of 2 July 2009 having as a purpose France.com associated with the representation of France including a heart in designating the products of classes 16 and 25 and the services of classes 35, 36, 38, 39, 41, 42, and 43

e) the registration 3661603 of 22 June 2010 having as a purpose France.com associated with the representation of France including a heart in designating the products of classes 16 and 25, and services of classes 35, 36, 38, 39, 41, 42, and 43,

f) the registration 08791873 of 22 June 2010 in accordance with filing of 4 January 2010 designating products of classes 16 and 25, and services of classes 35, 36, 38, 39, 41, 42, and 43,

g) the registration 08791899 of 22 June 2010 in accordance with filing of 4 January 2010 designating products of classes 16 and 25, and services of classes 35, 36, 38, 39, 41, 42, and 43,





h) the registration 08791899 of 22 June 2010 in accordance with filing of 4 January 2010 designating the products of classes 16 and 25, and services of classes 35, 36, 38, 39, 41, 42, and 43,

i) the registration 08791923 of 22 June 2010 in accordance with filing of 4 January 2010 designating the products of classes 16 and 25, and services of classes 35, 36, 38, 39, 41, 42, and 43,

furthermore

- rule on the cancellation of five French registrations of aforesaid trademarks dated 2 July 2009,
- order the company France.com Inc., to voluntarily renounce to the OHIM the four registrations of community trademarks taken up under the priority right of the cancelled French trademarks, under penalty of 500 Euro per day and per registration, following the two-month period after notification of the judgement to be delivered (sic),

- confirm the judgement in which the company France.com is ordered to transfer the domain name france.com to the French State,

Further, in the alternative,

- forbid the company France.com Inc. to cede or give as a licence to all third parties under any form or for any purpose whatsoever the domain name france.com under penalty of 10 million Euro for each recorded transfer,

- forbid the company France.com to use the domain name to serve to operate a website likely to cause confusion among the general public on the origin of the product or service proposed or damage the image and/or the identity of France under penalty of 500,000 Euro per infraction recorded,

in any event,

- declare inadmissible the monetary penalty claimed against the French State in the absence of legal proceedings by the State judicial officer,

- dismiss all claims and pleas in bar by the company France.com, and, ruling on the cross appeal of GIE Atout France,

- adjudge and rule that, in making use of the domain name france.com to serve to operate a website exclusively dedicated to tourism in France in conditions devoid of the professionalism required, the company France.com Inc. had committed acts of unfair competition liable to harm GIE Atout France, charged with the official promotion of tourism in France,

- order the company France.com Inc. to pay to GIE Atout France the sum of 20.0 Euro in damages and interest,

- judgement is reserved on the assessment of penalties imposed,

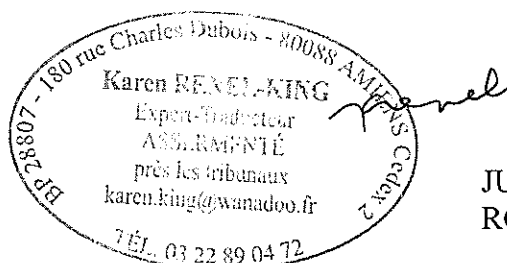
- order the company France.com Inc to pay to GIE Atout France the sum of 20.0 Euro in application of Article 700 of the Code of Civil Procedure;

- order the company France.com Inc to pay the costs which shall include court costs of 19 January 2015.

The order for closing the arbitral proceedings was issued 30 March 2017.

#### GROUNDS FOR THE JUDGEMENT:

Whereas the Appellant's arguments formulated on a "preliminary basis" according to which (page 18 of the last submissions) "this current litigation is civil and not administrative, and the judgement rendered on the basis of sovereign grounds, must be reversed as a consequence, other than to refer it before the administrative tribunal of Paris", translated in these same foregoing documents by a petition to reject the argument of the French State according to which it would invoke henceforth the advantage of administrative prerogatives, does not constitute an exception of incompetence in the meaning of the French Code of Civil Procedure, which, in any event, was rejected by order of the Civil Procedure Assessor of 24 November 2016, on this day definitive, for the reason that it had been invoked for the first time in appeal





### **On the joinder application of the parties GIE Atout France and the French State**

Considering that the Appellant reproached the first judges for having declared admissible the application by GIE Atout France to be joined to the proceedings, asserting that the application of the latter, based on Article 10 of the Convention of Paris, and which uniquely targets unfair competition, does not sufficiently relate to the main proceeding;

That the respondents conclude that this application is inadmissible because it would be an exception to the procedure subject to the provision of Article 74 of the French Code of Civil Procedure and that the Appellant would not have resumed this procedural exception in its documents of 10 May 2016 ;

Considering moreover, that the claim to have the application for joinder declared inadmissible constitutes a bar on proceedings which can perhaps be invoked in any event, being raised in the case, on one hand because the question had been referred to the tribunal, and on the other, as the Appellant's foregoing final conclusions contain such a flat refusal of admissibility;

Considering that in support of its initial submissions, the company France.com opposed the registration of the contested trademarks of prior rights on the domain name france.com, whose operating conditions are precisely the subject of the claims by GIE Atout France ;

The court was therefore justified in concluding that the application to be joined to the proceedings by GIE Atout France had a sufficient connection with the initial claims within the meaning of Article 325 of the French Code of Civil Procedure and had declared it as admissible;

Considering moreover, that the foregoing written submissions of the Appellant contain no claim in regards to declaring inadmissible the application to be joined to the proceedings by the French State;

### **On the French and community trademarks "France.com"**

Whereas it is established that following the assignments of trademarks at issue used to the benefit of the American company France.com, the French State took up its action of claiming recovery of the aforesaid trademarks in conflict with this company;

Whereas the company France.com criticises this judgement for having accommodated this claim and of having ordered it, under penalty, of transferring to the French State, trademarks at issue for the products and services referred to in each of the filings;

Whereas the restitution claim by the French State is founded mainly on the provisions of Article L 712-6 of the French Code of Intellectual Property; that the respondent party exercises rights in respect to the denomination "France" and indicates having the authority to be the rights holder to the contested trademarks; that it asserts, in essence, that it is apparent the trademarks are misleading or cause obstacles to public order, that they constitute fraud to the interests of the French State in the protection of a denomination on which its sovereignty is exercised and on which its identity is founded and that by their very nature appear to confer an advantage to the American tour operator of an illegitimate monopoly in regards to the general public interest;

That on this point and also in substance, the Appellant contests all the fraudulent nature of the filings of French trademarks at issue carried out on 2 July 2009 and in terms of the community trademarks, indicates that regulation on these trademarks does not allow for recovery if it is not before the EUIPO;



Accordingly, according to Article L.712-6 of the French Code of Intellectual Property, "if a registration claimed was fraudulently infringing the rights of a third party, or in violation of a statutory or contractual obligation, the person who believes it has a right to the trademark may claim ownership by legal proceedings";

Whereas, on one hand, the claim of a trademark for fraud does not assume existence of prior conflicting rights over the contested trademark but proof of interests knowingly unrecognised by the depositor, and on the other, a trademark contrary to public policy cannot give rise to any claim; Taking the view in this case that the Dutch company Traveland is no longer joined as a party because of an agreement reached with the company France.com confirming the transfer of the contested trademarks the company France.com; that the Court has no evidence provided to allow it assess the full circumstances of the filings of the trademarks at issue by the company Traveland, cannot find if this company pursued, at the time of filings, a legitimate purpose in compliance with the role of trademark guarantee of origin or if, on the contrary, it was seeking to deprive the French State of a trademark which naturally preserves its identity and/or its sovereignty;

That the claim for recovery of trademarks cannot therefore succeed and accordingly, the judgement is overturned which granted this claim;

Whereas, as a further alternative the French State seeks, in accordance with Articles L711-2, L711-3 et L711-4 of the French Code of Intellectual Property, the cancellation of five of the aforementioned trademarks, dated 2 July 2009, and that it ordered under penalty the company France.com inc, to voluntarily surrender before the OHIM (become EUIPO) the four community trademark registrations taken under priority of the cancelled French trademarks;

That the Appellant argues essentially that the aforesaid provisions are applicable in the case and that the French State has no right to hold the denomination "France" which only designates a geographical area;

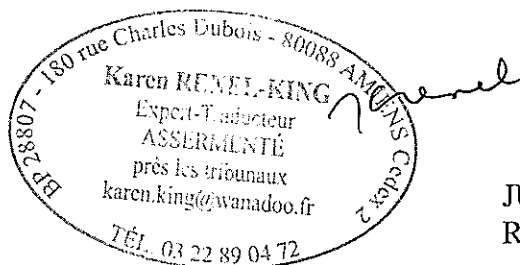
As the enumeration of the prior rights under Article L 711-4 of the French Code of Intellectual property was not exhaustive, the denomination "France" claimed by the French State is subject to constituting a precedence in filing the French trademarks at issue and from which thereby exists a risk of confusion in the public mind;

Whereas it is not demonstrated or even alleged by the company France.com that the French State was aware of the use of the contested trademarks by the filing company before the publication of their transfer occurring in July 2015 so that an extinction of rights due to acquiescence cannot be relied on against the respondent;

Whereas, contrary to what is asserted by the Appellant, the designation "France" constitutes for the French State an element of identity akin to the family name of a natural person; that this term designates the national territory of its economic, geographical, historical, political and cultural identity, which, in particular, has the role of promoting all the products and services referred to in the filings of the trademarks at issue; that the suffix .com corresponding to an internet domain name extension does not in substance modify the perception of the trademark;

Thus, the general public will identify these products and services as issuing from the French State or at the very least an official service benefitting from the reputation of the French State; that the risk of confusion is also strengthened by the stylised representation of the geographical borders of France in the complex trademarks in question;

Whereas it appears appropriate to cancel the France.com French trademarks no.3661596, no.3661598, no. 3661602, no.3661600 and no. 3661603 filed on 2 July 2009 for all the products and services referred to in each of the filings.



However, as regards the community trademarks numbers 08791873, 08791857, 08791899 and 08791923, it is up to the French State to refer to EUIPO its application for invalidity without the need to order the company France.com to proceed voluntarily and under constraint for a complete surrender of these signs "taking into account the reasons for invalidity already selected notably by EUIPO against the sign France.com";

#### **On the domain name**

Whereas, the Appellant's argument according to which the French State, which has other website addresses available to it, "has no need" for the domain name france.com is ineffective;

Whereas, for reasons identical to those already stated, this domain name allowing access to a website dedicated to tourism in France, is detrimental to the designation "France" which constitutes for the French State an element of its identity;

That the judgement shall be confirmed in that it has granted the request for the transfer in favour of the respondent, the good faith invoked by the company France.com, in supposing it established, being here ineffective;

That finally and assuming that the foregoing final documents submitted by the Appellant contain a bar to the proceedings drawn from statutory limitation of a claim in regards to the domain name, it suffices to recall that a domain name is intangible personal property, not subject to textbook tradition, and to which in consequence the provisions of Article 2276 of the French Civil Code are not applicable as was pointed out by the tribunal ;

#### **On the unfair competition**

Considering that GIE Atout France, who indicated being charged by the French State with an official mission to promote tourism in France reproaches the company France.com for "a form of unfair competition" which would consist of operating in bad faith (sic) a website which "unnecessarily handicaps its mission";

Furthermore, beyond its assumptions and false assertions, GIE Atout France, does not demonstrate the existence of any act of unfair competition committed against it by the latter; that laying claim to a special task in the public interest, it does not demonstrate in particular being prey to customer poaching as it does not even claim any harm to its reputation other than by the accusation of the reservation of the domain name or the trademarks being contested, no more in any event than the reality of harm alleged; That the judgement shall thus be confirmed in that the claim in regards to unfair competition has been rejected;

#### **On the claims of the company France.com**

Considering that the outcome of litigation leads to rejecting the various claims for compensation from the company France.com, being observed in any event that there is no justification for this, contrary to what the latter is claiming, of invoking the other party's liability of the Judicial Agent of the French State as part of this litigation;

That, as an unsuccessful party, the Appellant has no grounds for claiming damages for unjustified proceedings;



**On the other claims**

Whereas, the company France.com, the losing party, will bear the costs which will include the costs for the report of 19 January 2015;

Whereas, finally, there is no reason for application of the provisions of Article 700 of the French Code of Civil Procedure in favour of GIE Atout France .

**FOR THESE REASONS**

Confirm the judgement of 27 November 2015 with the exception where the company France.com Inc. was ordered to transfer to the French State, under a penalty of 150 Euro for each day of delay, and per trademark, following the two month period after the notification of this judgement, the French and community trademarks "France.com" no. 3661596, no.3661598, no.3661602, no. 3661600 no. 3661603 no. 08791873, no. 08791857, no.08791899 and no. 08791923, for the products and services referred to in each of the filings,

Ruling within this limit and adding to it,

Cancel the France.com French trademarks no. 3661596, no. 3661598, no. 3661602, no. 3661600 and no.3661603 filed on 2 July 2009 for all the products and services referred to in each of the filings.

Refer the respondents to provide better concerning the community trademarks numbers 08791873, 08791857, 08791899 and 08791923.

Declare inadmissible the claims for financial penalties made against the French State.

Reject all other claims.

Order the company France.com Inc to pay the costs which shall include the court costs of 19 January 2015.

The Court  
Clerk

The Chairperson

Je, soussignée, Karen RENEL,  
Traductrice Expert près la Cour d'Appel  
d'Amiens certifie que la traduction qui  
précède est conforme à l'original  
libellé en langue *français*  
visé ne varietur sous le n° *777*  
Fait à *Amiens* le *16/10/17*  
(Décret n° 53914 Art. 8 du 26.9.1953).

*Renel*



TRANSLATED BY SWORN TRANSLATOR WITH  
THE COURT OF APPEAL OF AMIENS, FRANCE  
AND CERTIFIED TRUE TO THE ORIGINAL  
UNDER NUMBER *777*  
DATE: *16/10/17*