

First decision under new ADR procedure for '.fr' domain names France - Hogan Lovells

Cybersquatting Internet issues

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In a [recent decision](#) under the [PARL EXPERT](#) before the [World Intellectual Property Organisation](#) (WIPO), a Swiss company specialised in medical imaging software development has obtained the transfer of a domain name identically reproducing its trademark under '.fr', the country-code top-level domain for France.

The complainant was Pixmeo SARL, a company based in Switzerland founded in 2010. The complainant was the owner of several trademark registrations for OSIRIX in several jurisdictions, including in Switzerland, the European Union and an international trademark registration designating a number of countries, including France, the earliest of which was registered in 2013. The complainant's main website was available at '[osirix-viewer.com](#)' (the domain name 'osirix-viewer.com' was registered by the complainant's CEO on July 30 2007).

The respondent was IMAGE ET, a company based in France also specialised in the medical imaging and technology field.

The disputed domain name was 'osirix.fr'. It was registered on August 7 2010 (renewed after July 1 2011) and was resolving to a website offering services in connection with the medical imaging software OSIRIX.

WIPO, together with [AFNIC](#), the French Registry, [announced in 2016 the launch of a new alternative dispute resolution](#) (ADR) procedure to resolve domain name disputes under '.fr'. This new ADR procedure, which became available on July 4 2016, is known as the [PARL EXPERT](#) (standing for '*Procédure Alternative de Résolution des Litiges*', or ADR procedure). The [PARL EXPERT](#) is an alternative to the existing [Syreli](#) procedure (standing for '*Système de REsolution de Litiges*', or dispute resolution system), which is another ADR procedure already available for '.fr' domain names, but administered by [AFNIC](#) instead of [WIPO](#). Like the [Syreli](#) procedure, the [PARL EXPERT](#) conforms to the current French domain name legislation, as regulated by [Articles L 45-2 et L 45-6 of the Code des postes et des communications électroniques](#) (the French Posts and Electronic Communications Code or CPCE).

To be successful under the [PARL EXPERT](#), a complainant must demonstrate, first, that it has standing (*intérêt à agir*) to file the complaint and, second, that, pursuant to [Article L 45-2 of the CPCE](#), the disputed domain name:

- i. is likely to disrupt public order or violate principles of morality, or infringe any rights protected by the French Constitution or by French law;
- ii. is likely to infringe IP rights or personality rights, unless the domain name holder has a legitimate interest in the domain name and is acting in good faith; or
- iii. is identical or similar to the name of the French Republic, of a local authority or group of local authorities, of a local or national institution or public service, unless the domain name holder has a legitimate interest and is acting in good faith.

Regarding whether the complainant had standing to bring the complaint, the expert found that, at the time of filing of the complaint, the domain name 'osirix.fr' was identical to the complainant's trademark registrations for OSIRIX and similar to the complainant's domain name 'osirix-viewer.com'. The expert therefore found that the complainant had standing to bring the complaint in accordance with [Article L 45-6 of the CPCE](#).

Moving on to the substantive requirements, the complainant based its claim on the ground that the domain name 'osirix.fr' was "likely to infringe intellectual property rights or personality rights, unless the domain name holder has a legitimate interest in the domain name and is acting in good faith", in accordance with [Article L 45-2\(2\) of the CPCE](#), which is the relevant provision for brand owners.

Turning to the first requirement, and whether the domain name at issue was likely to infringe the complainant's IP rights, the expert found that the domain name was identical to the complainant's trademark as it reproduced the OSIRIX mark in its entirety and, furthermore, the domain name 'osirix.fr' was also similar to the complainant's domain name 'osirix-viewer.com'. The expert also noted that the term 'Osirix' was identical to the name of the medical imaging software developed and used in commerce by the complainant since 2004. The expert therefore found that the domain name 'osirix.fr' was likely to infringe the complainant's rights, in accordance with the first requirement under [L 45-2\(2\) of the CPCE](#).

Moving on to the second requirement under [Article L 45-2\(2\) of the CPCE](#), the expert is required to examine whether the respondent can claim a legitimate interest in the domain name 'osirix.fr'. The expert noted that

the complainant had stated that the respondent was not affiliated to the complainant in any way and was not authorised by the complainant to use the complainant's OSIRIX mark. However, the expert found that, based on the complainant's statements alone, the complainant had not submitted evidence to demonstrate that the respondent lacked a legitimate interest in the domain name.

Turning to the third requirement under Article L 45-2(2) of the CPCE, the expert found that the respondent had registered the domain name 'osirix.fr' in bad faith. In reaching this conclusion, the expert took into consideration a number of factors. Firstly, the fact that the complainant's founders had used the term 'Osirix' since 2004 in connection with the medical imaging software that they had developed and had registered the domain name 'osirix-viewer.com', which resolved to their main website, in 2007. Secondly, the fact that the complainant had registered the trademark OSIRIX and, in particular, an international trademark designating France (where the respondent was based), was also a factor that tipped the balance in favour of the complainant. The expert also took into consideration the content of the website to which the domain name 'osirix.fr' was resolving, as it not only reproduced the complainant's OSIRIX mark, it also referred to the provision of services in connection with the complainant's medical imaging software. The expert also underlined that, given that the respondent was at some point part of the OSIRIX Foundation, the respondent could not assert that it registered the domain name 'osirix.fr' without knowledge of the complainant's product. Finally, the expert also took into consideration the fact that the respondent had failed to take part in the proceedings.

Given these circumstances, the expert found that the evidence put forward by the complainant was sufficient to demonstrate that the respondent had registered the domain name 'osirix.fr' with the aim of taking advantage of the complainant's goodwill and renown by creating a likelihood of confusion with the complainant, and that the use of the domain name to offer services in competition with those offered by the complainant was also in bad faith.

The expert therefore found that the complainant had succeeded in establishing the respondent's bad faith, even though it had failed to demonstrate that the respondent lacked legitimate interests in the domain name 'osirix.fr'. The expert therefore ordered the transfer of the domain name to the complainant.

This decision is the first decision delivered under the new PARL EXPERT for '.fr' domain names administered by WIPO. It is an important precedent as it highlights that, for the purpose of Article L 45-2(2) of the CPCE, a complainant is not necessarily required to demonstrate prior registered rights (although in cases where the domain name at issue pre-dates the trademark by a significant period of time, it is often more difficult to prove bad faith). The decision also underlines that what is important for the purpose of bad faith is that the respondent had prior knowledge of the complainant at the time of registration of the domain name in question and intent to take advantage of its goodwill and reputation, rather like the situation under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP).

It is also of note that the expert found that the complainant had not succeeded in demonstrating that the respondent lacked a legitimate interest in the domain name 'osirix.fr'. Technically speaking, a complaint under the UDRP would have failed on these grounds, but it is important to underline that under the UDRP a complainant is normally required to make out a *prima facie* case that a respondent lacks rights and legitimate interests and it is for the respondent to demonstrate otherwise. In this case, the respondent did not reply at all and so it is quite likely that a UDRP panel would have found a lack of rights and legitimate interests and also ordered a transfer. It therefore seems likely that the UDRP and the PARL EXPERT will produce substantially similar results, despite the fact that the drafting of the two procedures is subtly different, but only time will tell.

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