

### Domain names may infringe *droit d'auteur* France - Hogan Lovells LLP

### Domain names Infringement

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The Lyon Court of Appeal has [confirmed](#) a first instance decision which had found that the registration and use of a domain name constituted not only trademark infringement, but also infringement of French copyright law, known as *droit d'auteur*. *Droit d'auteur* is roughly equivalent to copyright in English, although there are some important differences.

In this instance, the claimant was the Tourist Office of Val Thorens, a well-known French ski resort. The defendant was a French individual specialised in the provision of IT services such as web hosting and advertising.

The domain names 'val-thorens.net' and 'val-thorens.org' were registered by the defendant in 1998 and 2000, respectively. The two domain names directed to real estate websites for properties in the vicinity of the Val Thorens ski resort.

On April 1 2004 the claimant filed a French trademark application for VAL THORENS for goods and services in Classes 1 to 45 of the [Nice Classification](#), including temporary housing services (namely, holiday rentals). In addition, the claimant apparently produced evidence that it had registered the 'val-thorens.com' domain name and started using it as early as April 1997.

The claimant filed court proceedings in Lyons against the defendant, claiming that the domain names owned by the defendant had been registered in violation of the VAL THORENS French trademark, as well as *droit d'auteur* in the term 'Val Thorens', and that the unauthorised use of the term 'Val Thorens' on the defendant's websites was in itself unfair competition.

The Lyons Tribunal of First Instance did not find that there was unfair competition, but granted the claimant's other requests and ordered all uses of the term 'Val Thorens', both in itself and as domain names, to cease on the grounds of both trademark infringement and infringement of *droit d'auteur*.

The defendant appealed and claimed that no *droit d'auteur* could be held in the term 'Val Thorens' and that the trademark of the same name was null and void due to the registration of the two domain names nearly six and four years prior to the trademark registration.

The defendant based its claim on Articles L711-4 and L714-3 of the [French Intellectual Property Code](#). Articles L711-4 provides as follows:

*"It is not possible to register as a trademark a sign which infringes a prior right, including:*

- a) A registered trademark (...);*
- b) A company name if there is a likelihood of confusion in the mind of the public;*
- c) A trade name that is known nationwide and if there is a likelihood of confusion in the mind of the public."*

Article L714-3 states that "a trademark registered in violation of Articles L711-1 to L711-4 will be declared null and void by courts".

The Court of Appeal considered that, whilst the domain names were indeed registered prior to the VAL THORENS mark, such registration was obtained in violation of the existing *droit d'auteur* held by the claimant in the term 'Val Thorens'. In this regard, the court found that, in addition to its use as the name of a ski resort, the term 'Val Thorens' was used as a title in several leaflets, websites and other original works and was therefore protected as such under *droit d'auteur*.

Since the defendant could not provide evidence of use of the two domain names predating the claimant's website, the court found that he was not in a position to rely on the domain name registrations as prior rights to request the cancellation of the VAL THORENS mark.

Furthermore, and despite the defendant's claim that the two activities should be distinguished, the sale of real estate displayed on the defendant's websites was deemed likely to cause confusion in the mind of the public with the holiday rentals covered by the VAL THORENS mark and showcased on the claimant's website.

Whilst no doubt in conformity with French law, this decision will seem strange to those more familiar with notion of copyright law in common law jurisdictions. Titles are not usually protected under copyright because they are not considered unique enough, and are too short to contain the necessary degree of creative authorship. Thus it seems quite unlikely that a US or UK court would have made a similar finding, even more so in respect of what could be argued to be a geographical location. In this regard, the French court also seemed to avoid this issue by finding that Val Thorens was a new expression which had been specially created to describe a particular skiing area and was used as a title on brochures and other works in a new and original way.

In addition, it is not certain that a panel under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) would have found for the claimant under similar circumstances, which may have been the reason why the claimant decided to address the issue of the defendant's domain names using the French courts instead. The UDRP is an alternative dispute resolution procedure that is designed primarily for obvious cases of cybersquatting, and complainants have to prove the all of the following three circumstances:

1. The domain name registered by the respondent is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
2. The respondent has no rights or legitimate interests in respect of the domain name; and
3. The domain name has been registered and is being used in bad faith.

Whilst the claimant would have succeeded on (1), having a registered trademark for numerous services (simply asserting a geographical name would not be enough), it may have had trouble with limbs (2) and (3), given the length of time that the defendant had been using the domain names for a seemingly legitimate business selling real estate in Val Thorens, and the fact that he was doing this a number of years before the claimant registered its own word (non figurative) trademark covering such services (although this in itself also seems rather strange as in theory it may seemingly prevent anyone else from using the term 'Val Thorens' in relation to the sale or rental of real estate property *in* Val Torens) (see, eg, [Kur- und Verkehrsverein St Moritz v StMoritz.com](#) (WIPO Case No D2000-0617), where the panel denied the transfer of 'stmoritz.com', and [Commune of Zermatt and Zermatt Tourismus v Activelifestyle Travel Network](#) (WIPO Case No D2007-1318), where the panel denied the transfer of 'zermatt.com'. In both cases, the complainants were able to assert trademark rights for goods or services other than those described by, or related to, the geographical meaning of the term in question, but the panel found that the registrants nevertheless had a legitimate interest in respect of the domain names as they were using them to provide informational websites about the resorts in question.

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