

World Trademark Review Daily

Domain name must be sufficiently distinctive to be protected under unfair competition rules

Cybersquatting

France - Hogan Lovells International LLP

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In a ruling of July 17 2012, the Court of Appeal of Versailles has decided that, while a domain name without a supporting trademark could be protected under the rules of unfair competition, it had to be sufficiently distinctive. Applying this principle, the Court of Appeal refused to grant protection to the domain name 'chambres-et-literie.fr' and thus declined to sanction the registrant of the domain name 'chambres-et-literie.com'.

Claimant [Mobilier et Agencement](#) was specialised in the sale of mattresses and bedding accessories through a shop and a website under the domain name 'chambres-et-literie.fr', which it registered on September 24 2003. In addition, the claimant had been granted a licence to use the French trademark CHAMBRES ET LITERIE by its registered owner, a Mr Tahrrat. The said trademark had been registered on September 7 1995, but not renewed upon expiration 10 years later. However, Tahrrat subsequently filed a new application for the French trademark CHAMBRES ET LITERIE on May 20 2009, which was granted protection.

In the meantime, defendant [Groupe Matelsom](#), a competitor of the claimant, registered the domain name 'chambres-et-literie.com' on March 16 2005 to redirect it to its main website at 'matelsom.com'. Upon discovering this, the claimant sent a cease and desist letter to the defendant on May 23 2006. Given the defendant's failure to cooperate, the claimant initiated court proceedings with Tahrrat as a joint claimant for trademark infringement and unfair competition. In its defence, Groupe Matelsom applied for the cancellation of the trademark CHAMBRES ET LITERIE. On November 25 2010 the Court of First Instance of Nanterre ruled in favour of the defendant and ordered the cancellation of the CHAMBRES ET LITERIE mark.

The claimant then decided to appeal to the Court of Appeal of Versailles, relying solely on the protection of the domain name 'chambres-et-literie.fr' under the rules of unfair competition, given the cancellation of the CHAMBRES ET LITERIE mark. Tahrrat withdrew from the proceedings.

On appeal, the claimant argued that the registration and use of the domain name 'chambres-et-literie.com' constituted an act of unfair competition and that it was an attempt to benefit from the claimant's goodwill, investments and reputation, which caused detriment to the claimant.

In response, the defendant highlighted the fact that the domain name 'chambres-et-literie.com' redirected to its website at 'matelsom.com' and was thus not capable of creating confusion. The defendant further contended that, in any event, the term '*chambres et literie*' (meaning 'bedroom furniture and bedding') was mundane and generic, and thus not capable of being protected or reserved.

The Court of Appeal noted that the domain name 'chambres-et-literie.fr' was indeed too generic, as it merely described the claimant's activity and website content, so that the words '*chambres*' and '*literie*' were akin to keywords. On this basis, the Court of Appeal ruled that, while a domain name could be protected through the tortious rules of unfair competition, it needed to be distinctive, which was not the case in this instance. The Court of Appeal added that '*chambres et literie*' did not indicate a particular source or affiliation, so that this term could be freely registered under 'com'.

This decision is interesting in that it articulates very clearly the principle applicable to the protection of domain names under French law, namely that they can be protected alone (without a supporting trademark) under the rules of unfair competition provided that they are distinctive.

After the cancellation of the trademark ordered by the Court of First Instance of Nanterre, it would not have been possible to then successfully bring a complaint under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP), as a trademark (registered or otherwise) is always necessary for a successful UDRP complaint. However, the claimant could likely have brought a successful complaint under the UDRP instead of initiating court proceedings in the first instance, as it would have been able to rely on trademark rights reproduced in the domain name. In addition, given that the defendant used the domain name to redirect to its website, which was in direct competition with that of the claimant, it is conceivable that the claimant could also have succeeded in substantiating the defendant's lack of rights or legitimate interests, as well as registration and use in bad faith, as required under the UDRP.

Indeed, the registration by a competitor of a domain name string (used by a trademark owner to point to its identically branded website) under a different top-level domain is generally viewed as classic cybersquatting.

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This is because it is usually aimed at diverting internet users looking for a well-known website to a different competing website, thus causing damage to the brand owner's goodwill and reputation and unjust enrichment to the competitor. It thus seems that the claimant's initial choice of French court litigation to deal with the later identical domain name registration by the defendant under '.com' may not have been the most appropriate course of action in the present instance - filing a UDRP complaint may have been more advisable, not to mention quicker and cheaper.

This goes to show that one needs to tread carefully when choosing a strategy to prevent the use of a domain name, as making the wrong choice could result in losing trademark rights and future chances to obtain the cancellation or transfer of an abusive domain name registration.

This decision is not publicly available.

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