



Legal analysis - Decision of the Paris Court of Appeal, October 19, 2012

Summons. On December 1, 2008, thirteen French companies decided to commence legal proceedings against AFNIC and one of its registrars regarding the registration of 129 domain names allegedly infringing said companies' rights.

The claimants' strategy was to seeking redress only against the registrar and AFNIC as the Registry for the *.fr* TLD, without holding the owners of the aforementioned domain names liable for the infringement.

As regards to the registrar, the claimants basically accused it of allowing the registration of the aforementioned domain names.

As regards to AFNIC, the claimants alleged on the one hand, that AFNIC was liable for not having suspended or blocked the 129 domain names as soon as the summons had been served, and on the other hand for allowing natural persons to anonymously register domain names under the *.fr* TLD.

Whois data anonymity. First of, all it should be stressed that the registration of a domain name by a natural person is not "anonymous": all the personal information regarding the registrant is collected and held by the registrars. As a matter of fact, only the information accessible via the Whois database of domain names under the *.fr* TLD is not made available to the public.

Ruling. Both the Court of First Instance and the Court of Appeals excluded AFNIC's liability for the anonymous registration procedure ("restricted information" option) available for individual registrants. In its decision of August 26, 2009, the Paris Court of First Instance , emphasized that this procedure had been set up to satisfy the legal obligations imposed on AFNIC by the French Data Protection Authority (CNIL).

In addition, as noted by the lower court, AFNIC has implemented several solutions to obtain the domain name registrant's identity when a domain name has been registered anonymously , including a tool for contacting the domain name administrative contact , an online form requesting the disclosure of personal data , and the request to enforce a legal decision ordering to disclose of the holder's identity.

The decision of the lower court having been confirmed, its reasoning concerning the anonymous registration procedure has therefore been confirmed by the Court of Appeal of Paris.

Domain names suspension and blocking. Regarding AFNIC's liability for not having suspended or blocked the 129 domain names on receipt of a simple summons from the claimants, the Court of First Instance of Paris held that AFNIC was not liable, while specifying that "when [the registrar] has been notified by a right holder that a domain name [it manages infringes an intellectual property right, both the registrar and [AFNIC] are subject to an obligation of results pursuant to Article R.20-44-45 of the French Electronic Communications and Telecommunications Act".

The Paris Court of Appeal confirmed that AFNIC was not liable for not blocking and not suspending the domain names, but unlike the Court of First Instance of Paris, in a judgment of October 19, 2012, that will serve as a landmark decision among registries worldwide, the Paris Court of Appeal also stated that:

- Article L.45 of the French Electronic Communications and Telecommunications Act "does not oblige [the Registry] to suspend or block domain names or, in





general, to take precautionary measures in cases of pre-litigation or litigation action, no more than said article grants [the Registry] the right to do so";

- the Ministerial Order appointing AFNIC [as the Registry for the .fr TLD] of February 19, 2010, "also defines in Annex 1, § 4 the scope of its remit and states that: "unless pursuant to a court decision , the registry is not allowed to block, delete or transfer domain names using procedures other than those referred to in the last two paragraphs hereinabove";
- in addition, the well known nature of certain trademarks not having been retained by the Court of First Instance, if, AFNIC had implemented suspensive or blocking measures on right holders mere request, AFNIC could have been held liable with even greater justification for having restricted freedom of trade.

The Court of Appeal thus stated:

- "in consequence, , it shall be added to the judgment that the request to hold AFNIC liable for not having blocked or suspended the disputed domain names on mere request from a third party must be rejected".

AFNIC, while respecting the rights of trademark owners, as evidenced by the Syreli procedure implemented on November 3, 2011, welcomes this decision, which perfectly defines its function and powers.

For the future. Even though the legal framework for domain names under the .fr TLD has changed, it seems vain to ask AFNIC to block, suspend or take any other measure on simple request, especially as Article L.45-6 of the French Electronic Communications and Telecommunications Act unambiguously now provides that:

- "Any individual that has a valid reason for doing so may ask the competent registrar to delete or transfer a domain name for the individual's benefit when the domain name in question falls within the scope provided for in Article L. 45-2.

The registry shall rule on this request within two months of its receipt, in accordance with an adversarial procedure as determined by the registry's rules of procedure which may provide for the intervention of a third Party chosen in accordance with transparent, non-discriminatory conditions that made available to the public. In particular, the rules of procedure define the rules of conduct applicable to third Parties and ensure the impartial and contradictory nature of their intervention".

