

September 2020 Edition

ADR Trends

Afnic out-of-court dispute resolution procedures

afnic

Foreword

New edition of “ADR Trends”!

On [page 5](#), Afnic invites you to discover its position on the eligibility of a holder of a .fr domain name located in the UK post Brexit.

And discover the new SYRELI (Afnic dispute resolution platform) decisions that have been handed down on each of the items addressed in this review.

Lastly, to round out your knowledge, visit the Afnic website to view its [practical guides for holders of domain names](#) and [rights holders](#).

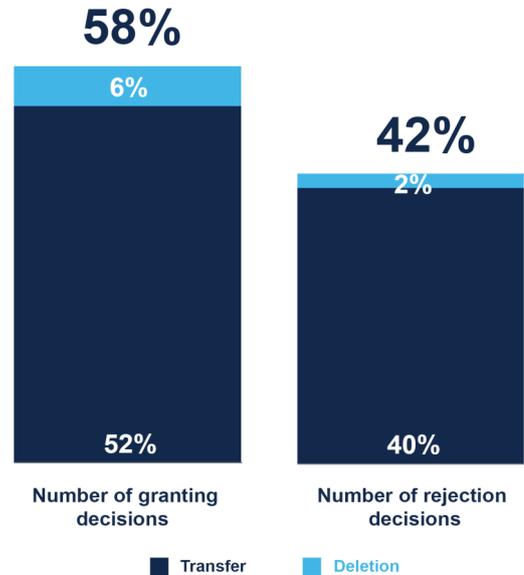
Enjoy reading!

Contents

Facts and figures	4
News	5
Completeness of the claim file	7
Admissibility of the claim	8
Admissibility of documents	9
Claimant's right to bring action	11
Grounds for the claim	12
Eligibility of Claimant	14
Holder's consent	16
Refusal or failure to reply by Holder	17
Legitimate interest of the Holder	18
Holder's bad faith	19
Must-read sections	26

Facts and figures*

1462 SYRELI decisions rendered



Domain name transfer or deletion rate following a PARL decision

Since November 2011, SYRELI College has rendered 1,462 decisions. For 58% of the requests, the College granted the requests, of which 52% are requests to transfer the domain name and 6% are requests to delete the domain name.

*Trends are based on data from November 2011 to May 2020



Eligibility of a holder of a .fr domain name located in the UK post Brexit



Since the United Kingdom announced that it wished to leave the European Union, many people have asked us about Afnic's position on the eligibility of registering a .fr domain name for persons located in the United Kingdom.

Until midnight on 31 January 2020, the effective date of the United Kingdom's withdrawal from the European Union, Afnic's position was as follows: wait for the precise provisions of Brexit and apply the principle of non-retroactivity of laws.

The SYRELI College had occasion to position itself quickly on this question since on 27 December 2019 an applicant domiciled in the United Kingdom requested the transfer of the domain names and via the SYRELI procedure.

As a reminder, according to the provisions of Article L.45-6 of the French Post and Electronic Communications Code (hereinafter referred to by its French abbreviation 'CPCE'), "Any person with an interest in acting may request the competent registry to cancel a domain name or transfer it to him providing the domain name falls within the cases provided in Article L. 45-2".

In this case, in decisions **FR-2019-01940 vinted-important.fr** and **FR-2020-01943 wwwvinted.fr**, the applicant argued that the registration of the domain names was likely to breach its intellectual property rights and more specifically its 'VINTED' brands and that the holder had not shown any legitimate interest and was acting in bad faith (see grounds provided in Article L.45-2 2 of the CPCE).

(Cont'd page 6)



Eligibility of a holder of a .fr domain name located in the UK post Brexit

In this context, the College, meeting on 6 February 2020, first of all considered that the applicant did indeed have an interest in acting with regard to its 'VINTED' brands which pre-dated and were similar to the disputed domain names, and then turned to consider the applicant's eligibility since the latter wished to obtain the transfer of the domain names in its favour.

As a reminder, Article L. 45-3 of the CPCE provides: "The following may request the registration of a domain name, in each of the top-level domains:

Natural persons residing in the territory of the European Union;

Legal persons having their registered office or main establishment in the territory of one of the European Union Member States".

The question arising was therefore whether the applicant, a legal person domiciled in the territory of the United Kingdom and therefore outside the European Union since 31 January 2020, could request the transfer of the disputed domain names.

In both decisions, the question was settled by the SYRELI College in the following manner: "On 29 January 2020, the European Parliament ratified the withdrawal agreement of the United Kingdom from the European Union for a withdrawal effective at midnight on 31 January 2020. However European Union law will cease to apply to the United Kingdom only at the end of a transitional period provided until 31 December 2020. Given the current state of affairs as regards communications made on Brexit, the SYRELI College considers that the Applicant is fully eligible for Article L.45-3 of the CPCE [...] Therefore the College has ruled that the request for transfer was admissible [...]"

The question of what happens after the 'transition' remains unresolved. What will happen as of 1 January 2021?

Completeness of the claim file



The Rapporteur ensures that

1. The application form is complete;
2. The costs of the proceedings have been paid;
3. The domain name has been registered and active (neither frozen, nor blocked);
4. The domain name is not subject to any judicial or out-of-court proceedings.

[if a complaint has been filed, it ensures that the latter explicitly addresses the domain name in question]



If the claim does not comply with any one of these items, it is rejected by the Rapporteur.



The Rapporteur does not verify the consistency of the documents filed by the Parties or their relevance to the arguments presented.



Benchmark decisions

Judicial or out-of-court proceedings in progress concerning the domain name in dispute:

FR-2015-01056 parkingmazarine.fr

FR-2015-00967 ambassadebenin.fr

FR-2014-00768 atosho.fr

FR-2014-00747 steico.fr

FR-2014-00679 le-boncoup.fr

Judicial or out-of-court proceedings in progress not concerning the domain name in dispute:

FR-2014-00820 syndicat-portage-salarial.fr

Admissibility of the claim



Standing to represent the Claimant

The College considers claims made on behalf of a Claimant by a third party not having standing to represent the Claimant, or not proving such standing, to be inadmissible.

Only lawyers have standing to represent Claimants; they merely have to prove their status as lawyers.

Industrial property lawyers have standing to represent their clients within their area of specialisation.

All other representatives must produce a power of attorney authorising them to act in the name and on behalf of the Claimant, issued by the Claimant's legal representative.

Discover or rediscover our blog entitled "How to avoid inadmissibility in the SYRELI procedure": [read the blog](#)

36 claims have been ruled inadmissible by the SYRELI College due to lack of authority to act in the name and on behalf of the Claimant.



Benchmark decisions

FR-2017-01303 biocoop-souffel.fr

FR-2017-01320 chaise-tolix.fr

FR-2019-01814 etslemaitre.fr

FR-2020-01946 norlog.fr

Admissibility of documents



The College

1. Reserves the right not to accept documents provided in a foreign language;
2. Not to take into account documents submitted by hyperlink;
3. Not to take into account documents that are not usable;
4. Not to take into consideration any arguments without supporting documents.



There may be little evidence but it must be the **RIGHT** evidence!

Discover or rediscover our blog entitled "How to avoid inadmissibility in the SYRELI procedure": [read the blog](#)



Benchmark decisions

On the lack of documents in proof:

FR-2016-01093 canordest.fr

FR-2016-01239 mavenhosting.fr

On documents submitted by hyperlink:

FR-2016-01190 davidyurman.fr

FR-2017-01321 institut-montparnasse.fr

FR-2018-01535 sushiman.fr

FR-2019-01770 dentiste-la-rochelle.fr

On documents provided in a foreign language:

FR-2019-01759 eurosportshop.fr

FR-2019-01872 pro-realttime.fr

FR-2019-01920 gwpharm.fr

FR-2019-01922 cluse.fr

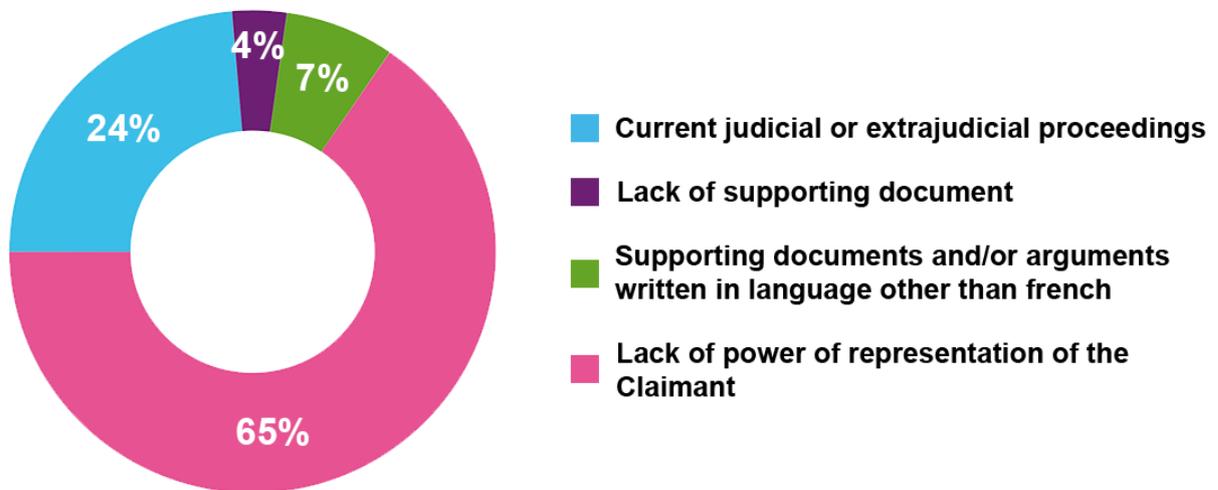
On documents non usable:

FR-2016-01180 akin.fr

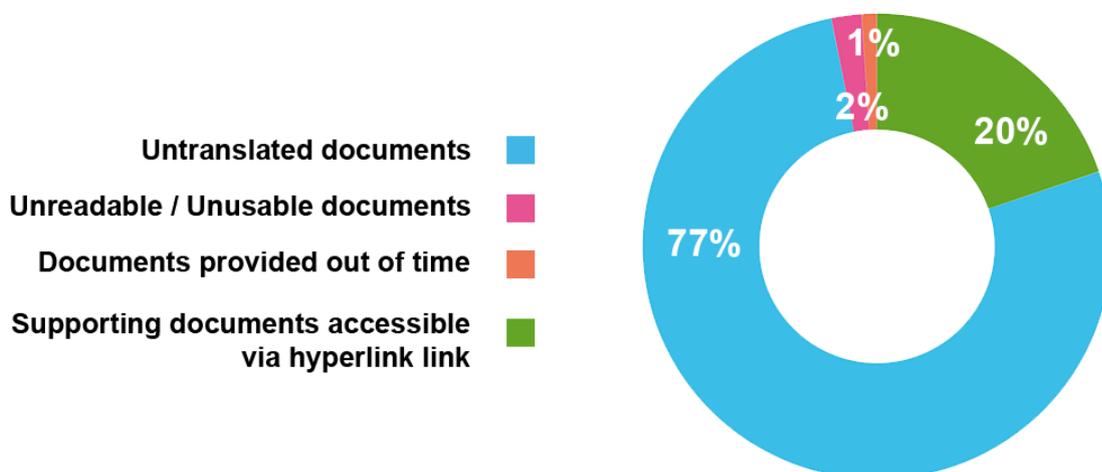
Admissibility of the claim and of documents

4% of petitions are inadmissible

Facts and figures



6,5% of the admissible petitions contain inadmissible documents



Claimant's right to bring action

Article L.45 of the French Electronic Communications and Telecommunications Act (CPCE):

"Any individual that has a valid reason for doing so may petition 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. L.45-2 [...]."



The Claimant has a right to bring action if

1. It has an identical, virtually identical or similar domain name¹ under another TLD for the disputed domain name;
2. If it has a virtually identical or similar domain name¹ under the same TLD for the disputed domain name;
3. It holds a trademark¹, business name¹, surname or pseudonym, title of ownership (work, patent, design and model etc.), A.O.C. / A.O.P.¹ that is similar, identical or virtually identical to the disputed domain;
4. it can show proof of having been the holder of the domain name under dispute (registration invoice in its name, old extract from the Whois database, etc.)

¹ No matter what the date of creation or registration.



In accordance with Article II.vi.b. of its Regulations, the College does not carry out any additional search.

Any claim submitted by a Claimant who does not substantiate his/her/its right to bring action, will be declared inadmissible by the College.

Discover or rediscover our blog entitled "Domain name litigation: the recognition of an AOC rights in the SYRELI procedure": [read the blog](#)



Benchmark decisions

Absence of right to bring action:

FR-2016-01252 maisons.fr
FR-2017-01310 schottfrance.fr
FR-2017-01341 baume-du-tigre.fr

Qualification of right to bring action:

FR-2017-01381 muscadet.fr
FR-2019-01769 lacompagniedulin.fr

Grounds for a claim

Article L.45-2 of the French Electronic Communications and Telecommunications Act (CPCE)



Article L.45-2 paragraph 1 The domain name is liable to disrupt public order or morality, or the rights guaranteed by the French Constitution or French law;

Article L.45-2 paragraph 2 The domain name is liable to infringe intellectual property rights or personal rights, unless the Claimant provides proof of a legitimate interest and is acting in good faith;

Article L.45-2 paragraph 3 The domain name is identical or related to that of the French Republic, of a local authority or group of local authorities, of an institution or a local or national public service, unless the Claimant provides proof of a legitimate interest and is acting in good faith.



Any claim filed on grounds other than those set out in Article L.45-2 will be declared inadmissible by the College.

Discover or rediscover our blogs entitled:

“L.45-2 paragraph 1 of the CPCE: when a domain name disrupts the French law”: [read the blog](#)

“The defence of personality rights in the SYRELI procedure”: [read the blog](#)



Benchmark decisions

1st Paragraph:

FR-2017-01381 muscadet.fr

FR-2018-01661 parc-asterix-tarif.fr

FR-2018-01719 locationdeloreau.fr

FR-2019-01925 sodipor.fr

2nd Paragraph:

FR-2019-01929 chaussuredefootdecathlon.fr

FR-2019-01935 tradeamundifinance.fr

FR-2019-01939 cocacola.re

3rd Paragraph:

FR-2016-01080 chambord.fr

FR-2016-01227 rambolitrain.fr

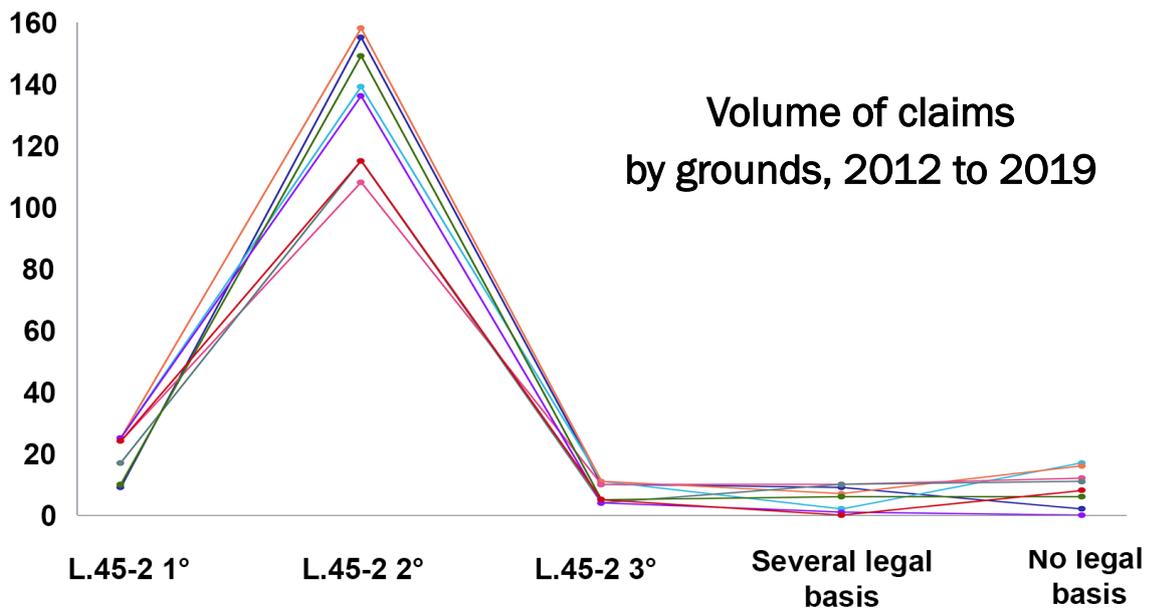
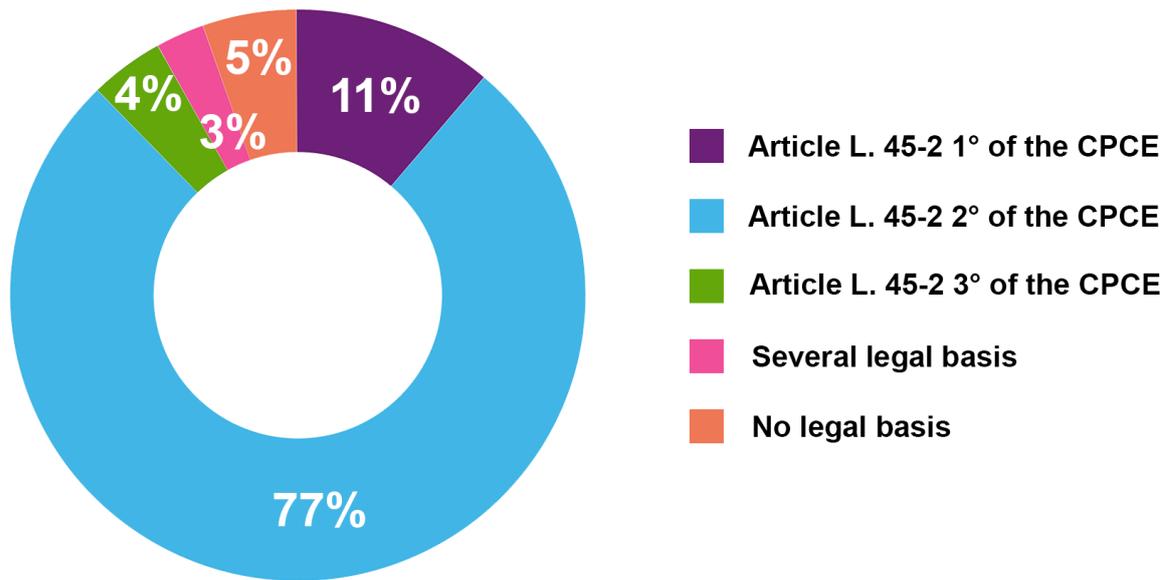
FR-2019-01823 pontdain.fr

FR-2019-01873 allocpam.fr

...

Grounds for a claim

Facts and figures



Eligibility of Claimant



The Claimant is deemed to be non-eligible when

The latter is located outside the territory of a Member State of the European Union.

Brexit: during the 2020 transitional period, holders resident in the UK remain eligible for the .fr (to find out more, see page 5, News).



A domain name cannot be transferred to a Claimant that is ineligible under the naming policy of the .fr TLD, even though it may have a right to bring action.



The claim by a Claimant who is ineligible under the naming policy of the .fr TLD is admissible if

1. It requests the transfer of the domain name to one of its direct wholly-owned subsidiaries located in an EU Member State and providing such subsidiary can show a legal tie to the Claimant;

2. It requests deletion of the domain name.



The College considers a request for the transfer of a domain name to an indirect subsidiary as inadmissible, even if the subsidiary is wholly-owned.

Discover or rediscover our blog entitled “What means of action for a Right-holder ineligible under the Naming Policy?”: [read the blog](#)



Benchmark decisions

Ineligible Claimants:

FR-2016-01244 electrabike.fr

FR-2017-01406 baume-du-tigre.fr

FR-2018-01692 virgilabloh.fr

FR-2019-01936 instax.fr

FR-2018-01670 thombrowne.fr

FR-2019-01786 lattescrossfit.fr

BREXIT :

FR-2019-01940 vinted-important.fr

FR-2020-01943 wwwvinted.fr

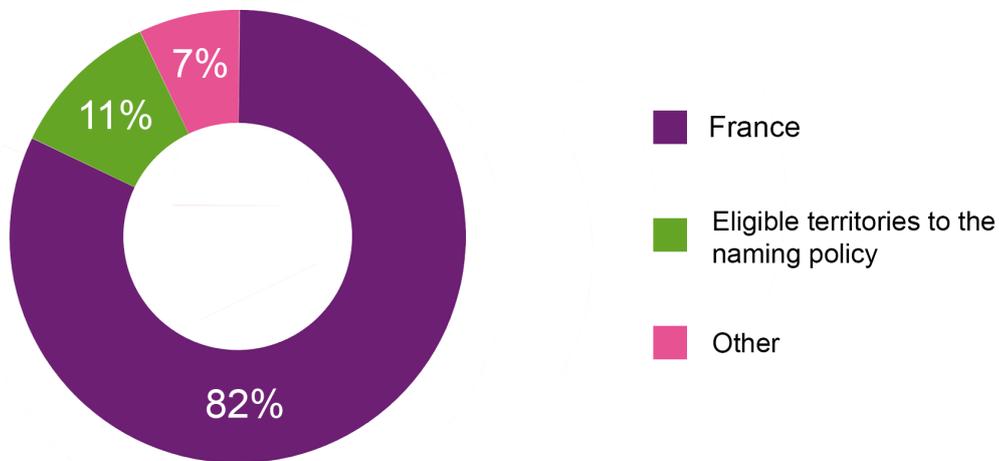
Ineligible Claimants but admissible claims:

FR-2018-01631 espritsoldes.fr

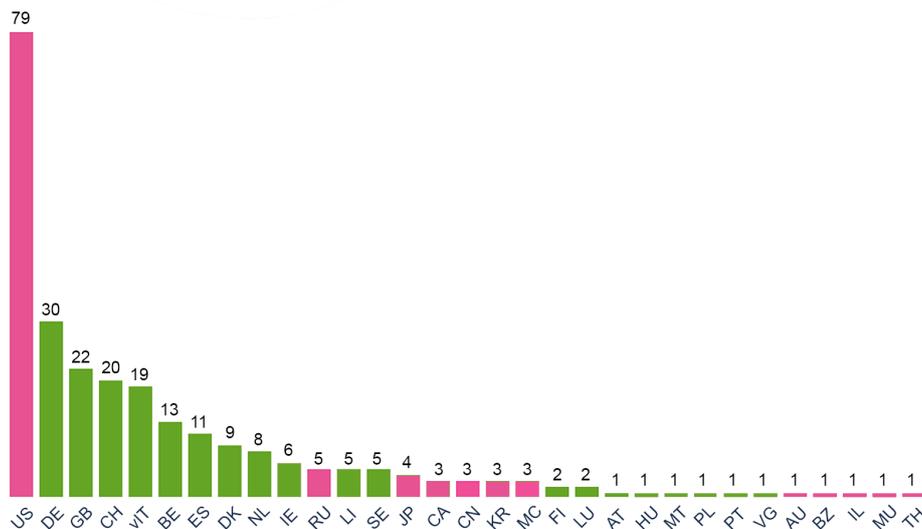
Eligibility of Claimant

Facts and figures

Claimant's nationalities



Claimant's nationalities outside of France



Holder's consent



The College takes note of the Holder's consent if and only if:

1. The Claimant has a right to bring action and is eligible under the .fr naming policy;
2. The Holder's consent is explicit;
3. The consent is for transfer the domain name to the Claimant and not to a third party.

In the absence of any of these criteria, the College will continue to examine the dossier considering that the Holder does not agree to the transfer or deletion of the domain name.

8,5% of Claimants have obtained the Holder's consent



Benchmark decisions

Holder's consent:

FR-2019-01932 lacentraledeauto.fr

FR-2019-01933 u-paris2-assas.fr

FR-2020-01945 bricoramadirect.fr

Holder's consent to transfer the domain name to a third party:

FR-2012-00038 sportintown.fr

Holder's consent with no right of Claimant to bring action:

FR-2014-00606 tandm.fr

Non-explicit Holder's consent:

FR-2016-01274 concours-sesame.fr

Refusal or lack of reply from Holder



The College examines

1. The grounds provided by the Claimant:

- Domain name likely to undermine public order or morality or the rights guaranteed by the Constitution or by the law (L.45-2 paragraph 1);
- Domain name likely to infringe intellectual property rights or personal rights, unless the Claimant provides proof of a legitimate interest and is acting in good faith (L.45-2 paragraph 2);
- Domain name identical or similar to that of the French Republic, a local authority or grouping of local authorities or a national or local institution or public service, unless the Claimant provides proof of a legitimate interest and is acting in good faith (L.45-2 paragraph 3).

2. The absence of legitimate interest of the Holder, except in the cases provided in Article L.45-2 paragraph 1 of the CPCE;

3. Bad faith on the part of the Holder, except in the cases provided in Article L.45-2 paragraph 1 of the CPCE.

Discover or rediscover our blogs entitled:

“L.45-2 paragraph 1 of the CPCE: when a domain name disrupts the French law”: [read the blog](#)

“The defence of personality rights in the SYRELI procedure”: [read the blog](#)

Legitimate interest of the Holder

Article R.20-44-46 of the CPCE



The Holder has a legitimate interest if

1. It uses the domain name (or demonstrates that it is prepared to do so) in connection with the offering of goods or services;
2. It is known by an identical name or one related to the domain name EVEN if it has NO right to do so;
3. It has used the domain name for non-commercial purposes:
 - without any intention to deceive the consumer,or
 - without damaging the reputation of the other name.



Non-exhaustive list!

The College then assesses the Holder's lack of good faith.

Whatever the circumstances, in the absence of legitimate interest, the College will grant the redress sought by the Claimant.



Benchmark decisions

Legitimate interest: Use of the domain name in connection with the offering of goods or services

FR-2016-01227 rambolitrain.fr

FR-2016-01178 palaiseau.fr

FR-2016-01182 creationvideotelling.fr

FR-2019-01821 autodiscountsport.fr

Legitimate interest: Is known by an identical name or one related to the domain name

FR-2017-01298 m3.fr

FR-2017-01428 palomas.fr

Absence of any legitimate interest on behalf of the Holder:

FR-2016-01199 foehnxrh.fr

FR-2017-01342 ltb-france.fr

FR-2018-01633 waterbike.fr

FR-2018-01640 exim.fr

Holder's bad faith

Article R.20-44-46 of the CPCE



The College has considered that the Holder is in bad faith when

Paragraph 1. it has obtained or requested registration of the domain name primarily with a view to selling, renting or transferring it [...] and not for the purpose of actually operating it (see following pages);

Paragraph 2. It has obtained or requested registration of the domain name with the aim of damaging the reputation (see following pages) of the Claimant or of a product or service similar to or associated with this name;

Paragraph 3. It has obtained or requested registration of the domain name with the primary aim of profiting from the Claimant's reputation by creating confusion in consumers' minds (see following pages).



Non-exhaustive list!

Whatever the circumstances, if the Holder's lack of good faith is established, the College will grant the redress.

Other indications of evidence of a lack of good faith are taken into consideration by the College (see below).



Benchmark decisions about other evidences of bad-faith

Domain name registered in order to disrupt business activities:

FR-2012-00223 reminiscence-paris.fr

Domain name registered to prevent its registration by a rights holder:

FR-2013-00476 leclerc-pharmacie-discount.fr

FR-2016-01196 prenompatronyme.fr

Bad faith established on the basis of a body of evidence:

FR-2017-01292 lab-merieux.fr

FR-2016-01228 patronyme-metier.fr

Bad faith

Interpretation of article R.20-44-46 paragraph 1 of the CPCE

Paragraph 1. The fact of having obtained or requested registration of the domain name primarily with a view to selling, renting or transferring it [...] and not for the purpose of actually operating it, can be characterised as bad faith;



The College must

1. Determine if the Holder can furnish proof of operation of the domain name prior to its proposed sale
 - If so, the criterion of a lack of good faith cannot be retained.
2. Consider whether the proposal to sell, lease or transfer the domain name is the main goal of the Holder
 - If so, the criterion of bad faith may be retained.



Benchmark decisions

Domain name registered primarily for the purpose of selling it:

FR-2016-01217 louis-dreyfus.fr

FR-2016-01219 lacentraleduparticulier.fr

FR-2016-01237 vonage.fr

FR-2017-01309 stada.fr

FR-2017-01395 pharmaprix.fr

FR-2018-01565 docmorris.fr

Bad faith

Interpretation of article R.20-44-46 paragraph 2 of the CPCE

Paragraph 2. The fact of having obtained or requested registration of the domain name with the aim of damaging the reputation of the Claimant or of a product or service similar to or associated with this name can be characterised as bad faith.



The College must

1. Consider whether the domain name affects the goodwill of the Claimant OR that of an equivalent product or a service
2. Determine whether a prejudice may be caused in the minds of consumers (affecting product awareness, brand awareness, reputation of the Claimant, etc.).
 - If so, the criterion of bad faith may be retained.



Benchmark decisions

Domain name registered in order to damage the reputation of the Claimant or that of a product or service assimilated with that name:

FR-2013-00443 etreenceinte.fr

FR-2014-00815 prenompatronyme.fr

FR-2015-00938 adopteunmecgratuit.fr

FR-2015-01033 lalaitiere.fr

FR-2015-01018 base-loisirs-creteil.fr

Bad faith

Interpretation of article R.20-44-46 paragraph 3 of the CPCE

Paragraph 3. The fact of having obtained or requested registration of the domain name with the primary aim of profiting from the Claimant's reputation by creating confusion in consumers' minds can be characterised as bad faith.



The College must

1. Determine whether the domain name benefits from the reputation of the Claimant or that of a product or service assimilated with its name
2. Consider, on the basis of the documents in proof, whether the domain name creates a likelihood of confusion in the minds of consumers (product awareness, brand awareness, reputation of the Applicant, etc.)
 - If so, the criterion of bad faith may be retained.



A French Holder cannot claim ignorance of or ignore the reputation of major companies established in France.



Benchmark decisions

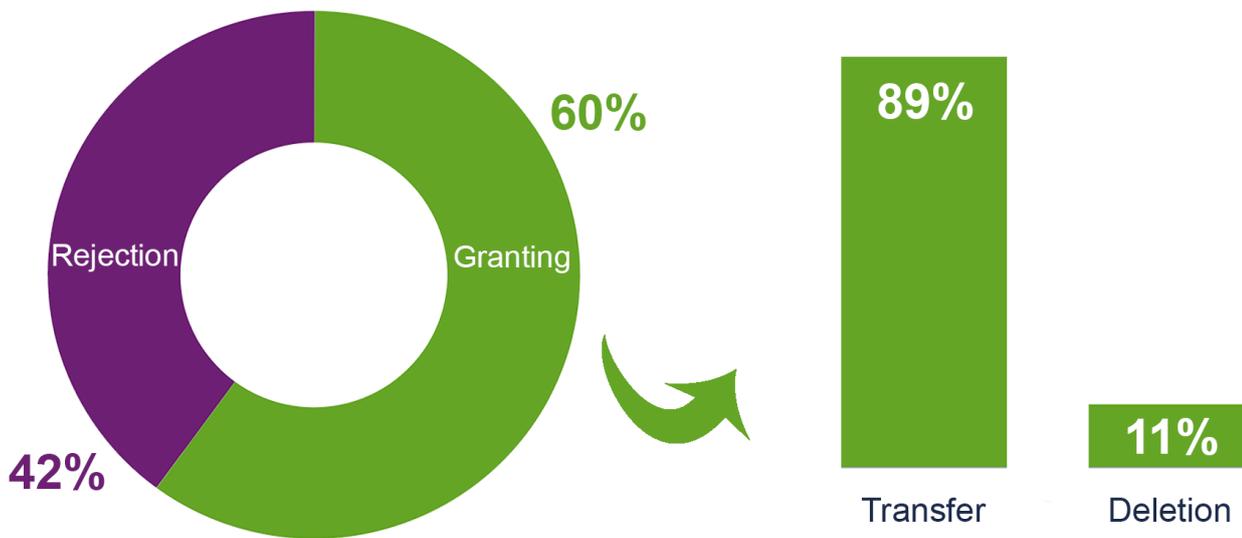
Domain name registered primarily for the purpose of benefitting from the reputation of the Complainant by creating confusion in the minds of consumers:

FR-2019-01873 allocpam.fr	FR-2019-01929 chaussuredefootdecathlon.fr
FR-2019-01877 picardgroupe.fr	FR-2019-01935 tradeamundifinance.fr
FR-2019-01878 chaudierevigas.fr	FR-2019-01940 vinted-important.fr
FR-2019-01912 boursoramacreditimmobilier.fr	FR-2020-01942 centrecommercial-auchan.fr
	...

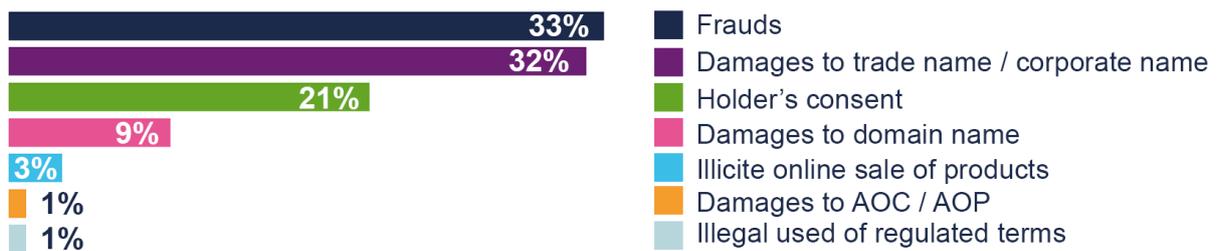
Legal basis of the article L.45-2 paragraph 1

Facts and figures

165 decisions rendered



Reasoning for granting the requests



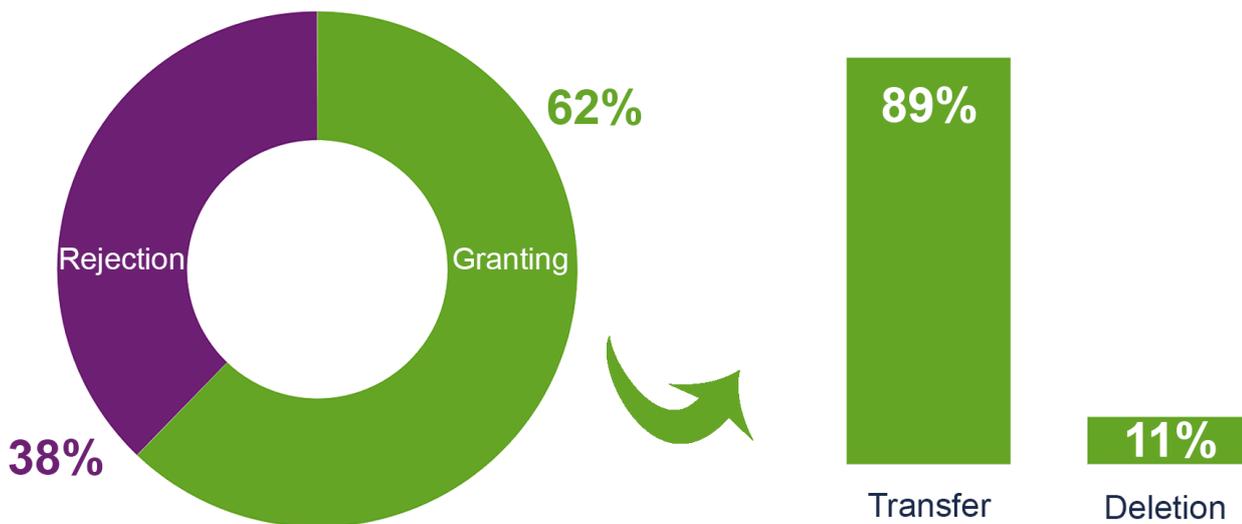
Reasoning for rejecting the requests



Legal basis of the article L.45-2 paragraph 2

Facts and figures

1156 decisions rendered



Reasoning for granting the requests



Reasoning for rejecting the requests



Legal basis of the article L.45-2 paragraph 3

Facts and figures

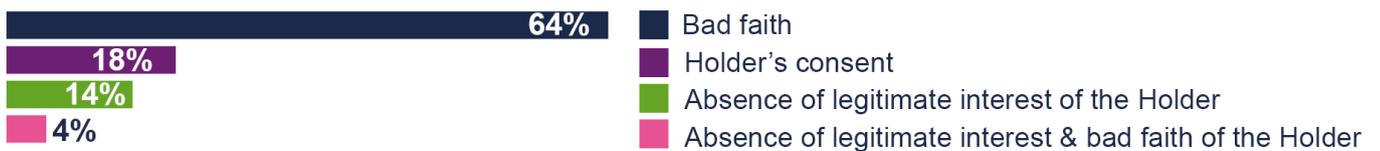
61 decisions rendered



- Identical or related of a local authority
- Identical or related of a public establishment
- Identical or related of a national public institution
- Identical or related of a public service



Reasoning for granting the requests



Reasoning for rejecting the requests



Must-read sections



SYRELI platform: www.syreli.fr

SYRELI decisions: www.syreli.fr/decisions



Parl Expert platform: <https://www.parl-expert.fr>

Parl Expert decisions: <https://www.parl-expert.fr/fr/decisions>



Legal booklets : www.afnic.fr/en/dispute-resolution/

- Guide for rights holders
- Guide for domain name holders
- Booklet « Dispute resolutions made easy »



Latest news

The SYRELI platform will soon get a new look!

- A more intuitive Platform for Users;
- Option to file a claim in several stages and finalise it later;
- The arguments you present in support of your claim or response will no longer be limited;
- Incorporation of a search engine for Afnic decisions: SYRELI, ADR EXPERT (or PARL, in French) and PREDEC
- Direct provision of a practical help tool to prepare submission or response files via the “ADR Trends” review