

Facebook acts against a licentious social network

By Charlotte Urman, Inlex IP Expertise, France

We all know that the Facebook social Network's history is closely linked to intellectual property questions, with, from the very beginning, an action against its creator Mark Zuckerberg for copyrights infringement.

This is so not a surprise to see that now the American company Facebook Inc. is deeply attached to the defense of its trademarks rights.

The French Court of Paris (3rd chamber, case n°10/11174) has rendered a judgement on June 13, 2013, opposing Facebook Inc. to a French company RM Corporation with a commercial name FUCKBOOK BIDBOYS (quikly changed) and one of its corporate executive, because they had bought and used 11 domain names "fuckbook" with or without dash and with or without the "s" of the plural form, with several extensions such as .net, .fr, .es, .ch, .be, .eu, .com between 2006 and 2011 and filed a French trademark "FUCKBOOK" (quickly and voluntarily withdrawn) in classes 35, 38 and 41.

These signs were used as the name of a dating website that could be held as a licentious social network.

Judges have decided in favour of facebook Inc. on the basis of :

- Regulation (EC) No 40/94 on the Community trade mark (article 9 - 1.c), prohibiting the use without its consent and in the course of trade, of a sign similar to the CTM, for activities which are not similar to those covered by the CTM, when the prior CTM is well-known in the EU and when this illegitimate use takes unfair advantage of, or is detrimental to the distinctive character or the repute of the CTM
- Paris Convention for the protection of Industrial Property (Article 8) for the protection of trade names in all the countries of the Union.

Regarding the defendents argument that they had domain name rights on FUCKBOOK prior to the CTMs FACEBOOK, judges remind the principle that a domain name can only constitute a right when it corresponds to a website with effective use (use which was here posterior to the CTMs FACEBOOK).

When they decided that CTMs FACEBOOK were well-known at the time of the first evidenced use of FUCKBOOK (March 2009) judges took into consideration many press articles from national leading newspapers about economics showing the incremental value of the tm, its economic interest and its increasing repute to the general public, as well as a serious and representative online survey (from the IPOF institute, with 68% knowing Facebook amongst 3.046 respondents of over 15 years, i-e a 30% increase of repute in one year) and many quotations in magazines with diverse topics.

The signs FACEBOOK and FUCKBOOK were judged similar considering that:

- The presence or absence of a dash and or a final letter “s” have no impact for the public,
- The names are very close with minimal differences, a similar sound, the same number of letters with the same “f” at the beginning and “book” at the end.

So even if the meanings are different, there will be a link in the public’s mind considering the repute of FACEBOOK and the fact that the activities covered are also similar.

Harms have been retained on the ground of a devaluation of the image of FACEBOOK (probably for the licentious side..., even if judges failed to explain why and how) and of the fact that the defendants have obviously taken advantage of the link created with FACEBOOK with the pun and direct reference.

Finally, it is to be noted that Facebook Inc. had requested 200.000€ for the attempt to the repute of its trademarks but only got 15.000€ because the amount requested was not demonstrated, when the judges do not more explain how they calculated these damages.

In any case, it is important to remind that CTM owners are entitled to react and win against signs that just allow the public to make a link with their famous trademarks, with no likelihood of confusion to be shown and also no similarity in the activities concerned.

Puns are not always funny.

For more information, please contact:

Charlotte URMAN
European trademark attorney
Inlex IP Expertise
curman@inlex.com
www.inlex.com

