

Via Email

Mr. Fadi Chehadé
Chief Executive Officer

Dr. Steven Crocker
Board of Directors Chair

ICANN

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Re: The Domain Name Industry and European Trademark Reform.

Dear Mr. Chehadé and Dr. Crocker:

We write to share recent developments with respect to the ongoing reformation of the European Union Regulation on the Community Trade Mark and encourage ICANN to participate in the currently available consultation process. In ICANN's case, we encourage your executive and government affairs colleagues within ICANN to confer with European Union regulators participating in final discussion of this regulation. Both measures have potentially serious impacts on the Internet and the domain name industry. (See 207/2009/EC Article 9, hereinafter "the Regulation," and the European Union Directive Relating To Trade Marks (See 2008/95/EC Article 5), hereinafter "the Directive").

In their present codification, the Regulation and the Directive describe the rights conferred by ownership of a Community Trade Mark (referred to as "signs" within the Regulation and the Directive) and attempt to harmonize national and local trademark regimes. Both the Regulation and Directive prohibit the types of conduct listed below, with the proposed revision affecting domain names highlighted in redline format .

The following *inter alia* may be prohibited:

- Affixing the sign to the goods or to the packaging thereof;
- Offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;
- Importing or exporting the goods under that sign;
- Using the sign on business papers and in advertising; and
- Using the sign as a trade or company name [...], or as a domain name, or as a part thereof.

DNA Letter: The Domain Name Industry and European Trademark Reform

We believe the proposed language is unnecessary and superfluous given that the rights conferred by a Community Trade Mark already extend to Internet domain names. In essence, the proposed language is sloppy and poorly suited for the dynamic nature of the Internet. In practice, the proposed language will likely, *inter alia*: improperly elevate all domain names as being analogous to “a trade or company name”; invite new legal arguments that the European Union has explicitly expanded the rights conferred by a Community Trade Mark; and erode safe harbors for contributory causes of action against domain name registration authorities.

Time is of the essence but, fortunately, time remains to confer with European Union regulators on the matter. Final negotiations continue between the European Parliament and the European Council, with the European Commission serving as a quasi-mediator. These negotiations are called “Trialogue” and they will most likely continue for a short period.

As you might already be aware, this European process often lacks transparency: essentially a final step that takes place behind closed doors—thus emphasizing why input from ICANN and other interested parties is vital at this juncture. This process is unlike the transparent and open ICANN multi-stakeholder model, with public comment announcements accompanying background details, specific questions to the community, and submission portals. Accordingly, we encourage you and your government affairs colleagues and constituents to confer with the relevant European Union regulators identified below regarding the impact of these proposed changes.

Below the signature block is a list of participants with whom we encourage contact by ICANN. ICANN is likely to have a more inclusive list of contacts. Many other members of the ICANN community are providing meaningful interventions in this process. As the global leader of the multi-stakeholder model, we urge ICANN to participate and appropriately intervene in order to guarantee ongoing stable DNS operation.

We appreciate your time and attention. If you wish to discuss a collaboration involving other ICANN community members with EP Members and EU Representatives, we are willing to discuss that. We remain at your disposal should you have any questions, or wish to discuss this matter in greater detail.

Best regards,



Kurt Pritz
Executive Director, Domain Name Association

cc: Adrian Kinderis, DNA Board Chair
Jakob Kucharczyk, Director, CCIA Europe
Peter Van Roste, General Manager, CENTR
Joe McNamee, Executive Director, European Digital Rights
Siada El Ramly, Director General, European Digital Media Association
Innocenzo Genna, Chair, Innovation and Growth Committee, EuroISPA
Jeremiah C Johnston, President, Internet Commerce Association

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