

Dear: [Member of European Parliament –or- Permanent Rep. for European Union Country X]

I am writing to you concerning the European Union’s current efforts to modernize the trade mark system in the Union as a whole and adapt it to the Internet era.

I am writing in my capacity as the Chair of the Policy Committee of the Not-for-Profit Operational Concerns (NPOC) constituency group within ICANN (the Internet Corporation for Assigned Names and Numbers). ICANN is responsible for the coordination of maintenance and methodology for handling the unique Internet identifiers (domain names), and ensuring the domain name system’s stable and secure operation. ICANN is also responsible for the processes involved in the establishment of new global Top Level Domain names (gTLDs).

NPOC represents Not-for-Profit and Civil Society organization operational concerns within ICANN with regard to the operations of the domain name system. NPOC also serves as a forum for wider Not-for-Profit and Civil Society organization operational concerns with regard to domain name issues.

NPOC has concerns with regard to one particular part of the Council of the European Union “*Proposal for a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks*”. The proposal wording, reproduced below, can be found on page 35 of the document at:

<http://data.consilium.europa.eu/doc/document/ST-11827-2014-INIT/en/pdf>:

Section 3: Rights conferred and limitations; Article 10: Rights conferred by a trade mark; Item 3: reads:

*“The following, in particular, may be prohibited under paragraph 2; [page 35]:
(d) using the sign as a trade or company name, or as a domain name, or as a part thereof;”*

As you are no doubt well aware, there have long been discussions within Internet constituency groups, including governments and intellectual property interests, around what is acceptable and what is not acceptable with regard to both gTLDs and second and lower level domain names.

The purpose of this expression of concern from the NPOC community is not with regard to those broader issues but with regard to the intent and potential problems posed by the last five words in the proposed regulation as referenced above, wording with regard to the issue of:

“using the sign....as a part thereof [of a domain name]’.

NPOC finds this wording problematic, unnecessary, and recommends deleting it from the proposed regulations.

As I will illustrate below with examples, this wording risks opening a Pandora’s Box of problems, including scope for predatory litigation, with regard to otherwise proper domain name use. As well, it is an unnecessary regulation since domain name trademark violations are adequately covered under other normal trademark protections.

This issue is of particular concern to the Not-for-Profit and Civil Society organization constituency since, unlike commercial entities, they tend to have long descriptive names and make wide use of acronyms as organizational identities. Such acronyms frequently contain letter strings either in common use or as innocent elements of trademarks where there is no intent of intellectual property infringement.

NPOC worries that the proposed wording would open the door to predatory litigation by interests seeking financial gain in the guise of trademark protection. I note that the creation of the NPOC constituency group within ICANN was prompted by domain name concerns initially expressed by the International Red Cross (IRC) and the International Olympic Committee (IOC).

Here are two brief examples of the kinds of problems the proposed wording could generate. I will draw from personal experience:

1. I am a member of the Austria based International Federation for Information Technology and Tourism (IFITT) whose domain name is ifitt.org. Part of that domain name, the word iFIT, is trademarked by Icon Health and Fitness, Inc. While in this case the ifitt.org domain name may be protected by legacy rights (predating the regulation), under this wording "*as a domain name, or as a part thereof*" Icon Health and Fitness might legally object to IFITT using its trademark "iFIT" as part of its domain name. The regulation could also open up litigation against small entities as a way of extracting predatory financial settlements.
2. I am the Director of ICT for Science, Technology and Development for the Society for the Advancement of Science in Africa (SASA) whose domain name is sasascience.org. The acronym SASA is widely used just in Africa alone. At the same time, an Asian clothing company, SA SA Overseas Ltd, owns the global trademark rights to SASA. At registration the company wrongly claimed that the word "sasa" had no meaning in foreign languages, whereas in fact as a word has meaning both in Swahili and in Samoan. While Africa may seem far removed from Europe, trademarks involve global rights and multilateral trade agreements increasingly incorporate procedures covering intellectual property rights. It would be unfortunate if unnecessary wording in European regulations negatively impacted honest domain name use elsewhere in the world.

On behalf of NPOC I would like to thank you for considering this request that the phrase at issue be removed from the proposed legislation.

Should you have any questions please feel free to contact me.

Sincerely,

Sam Lanfranco, Chair, NPOC Policy Committee

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