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November 26, 2014

Via Email

Mr. Alan Greenberg
Greenberg ICT Services
alan.greenberg@mcgill.ca

Re: European Union Trademark Reform And The Domain Name Industry.
Katten Reference: 384001-00002

Dear Mr. Greenberg:

We write to share recent developments with respect to the ongoing reformation of the European Union Regulation on the Community Trade Mark (*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”), both with potentially severe impacts on the internet and the domain name industry. We also write to encourage you to discuss this matter with your colleagues and constituents in the ICANN At-Large Advisory Committee, as well as consider writing to the European Union regulators participating in the final discussions of this regulation.

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 trade mark regimes. Both the Regulation and Directive prohibit the types of listed conduct below, although currently proposed revisions by the European Council explicitly insert prohibitions concerning domain names. These proposed revisions are reflected 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;

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- 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.

We feel strongly that the proposed this language is wholly unnecessary and superfluous given that the rights conferred by a Community Trade Mark already extend to Internet domain names. In practice, the proposed language will likely:

- Embolden spurious complaints against non-commercial uses, improperly elevating 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;
- Confuse judges who are not savvy in matters relating to the Internet and the domain name industry, resulting in an improper readiness to sustain cases of infringement in sole deference to the Directive;
- Erode safe harbors for contributory causes of action against domain name registration authorities;
- Have a chilling effect on non-commercial expression by registrants in the European Union; and
- Ultimately, result in an aggregate negative impact on domain name registration and renewal rates among registrants in the European Union.

In essence, the proposed language is sloppy and poorly suited for the dynamic nature of the Internet. Fortunately, time remains to weigh in and oppose this proposed amendment. Final negotiations recently began between the European Parliament (hereinafter “the EP”) and the European Council (hereinafter “the Council”), with the European Commission serving as a quasi-mediator. These negotiations are called “Trilogue” and they will most likely continue until early 2015.


Only the Council has proposed this problematic new language, and so your colleagues and constituents in the ICANN At-Large Advisory Committee, may wish to express opposition to the Council’s language, as well as a preference the EP version. Accordingly, we encourage you and your colleagues and constituents to consider filing public comments with the relevant European Union regulators identified below.

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For the European Parliament:	
MEP Max Andersson	max.andersson@europarl.europa.eu
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William Reid, Permanent Representation of Ireland.	william.reid@dfa.ie

We appreciate your time and attention, and we remain at your disposal should you have any questions, or wish to discuss this matter in greater detail.

Best regards,



Brian J. Winterfeldt

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