



By email: for publication

Dr. Steve Crocker, Chairman of the ICANN Board  
Mr. Cherine Chalaby, Chair of the new gTLD Program Committee  
12025 Waterfront Drive, Suite 300  
Los Angeles,  
CA 90094-2536

23<sup>rd</sup> September 2013

Dear Dr. Crocker and Mr. Chalaby,

We write to express our concerns with recent GAC Advice on geographic names, and both its current, and potential impact on trademark rights-holders.

### **Introduction to MARQUES**

MARQUES is the European Association representing brand owners' interests.

MARQUES unites European and international brand owners across all product sectors to address issues associated with the use, protection and value of IP rights, as these are vital to innovation, growth and job creation, which ultimately enhance internal markets.

MARQUES' membership crosses all industry lines and includes brand owners and trademark professionals in more than 80 countries.

### **MARQUES position on GAC Advice relating to geographic names**

We have consulted widely amongst our members.

There are currently thousands of brands registered in Europe which share geographic or cultural meanings, for example: AMSTERDAM (beverages), ALPS (electronics), AVON (cosmetics), DANISH (meat), IBERIA (airline), LONDON (tobacco), LYON (tobacco), MILAN (pharmaceuticals), MUNSTER (bedding), PARIS (bicycles), RHINE (construction), ST. IVES (soap), TIROL (furniture), WACHOVIA ["die Wachau" in German](finance), WATERFORD (furniture) and ZURICH (insurance). Many of these have been applied for as new gTLDs, for example: DODGE (motor vehicles), HERMÈS (luxury goods), LANCASTER (fashion), NOKIA (communications), OLYMPUS (cameras) and VIKING (cruises).

We also note that there are certain brands registered in Latin American, such as IPIRANGA and VIVO, that have been applied for in the current round of new gTLD applications, and

which could be followed in the future by many others, including BRAHMA and HAVAIANAS. In addition to being recognised brands, all these share separate geographic or cultural meanings.

For current and future new gTLD applicants, which include many trademark owners, it is important that the new gTLD program provides a predictable, fair, and consistent application process that conforms with general principles of law.

We urge ICANN to scrutinize the GAC Advice on claimed geographic names, as it relates to established trademark rights that have been obtained lawfully by trademark owners in numerous nation states.

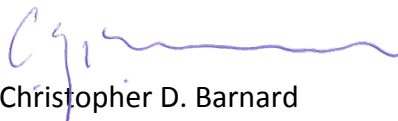
International law and jurisprudence, including the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) and the Paris Convention of 1883, instructs that such nation states do not possess a priori or even exclusive rights to geographic terms. Trademark owners have long-established rights under such binding international treaties to use what may otherwise be a geographic term as a mark (unless the term would be perceived as geographically descriptive, or mis-descriptive). Even in the case of a conflict with an existing trademark right and claimed national interest in such term, international jurisprudence informs that such terms may co-exist, but not to the detriment of trademark owners' rights.

It follows from this internationally accepted legal foundation that nation states should not be able to arbitrarily restrict trademark owners' rights to make lawful use of their trademarks through ICANN, when international agreements to which they are signatories would not allow such restriction. This should apply particularly with respect to rights which, as in the present case before the ICANN Board, have previously been (lawfully) allowed by national trademark offices pursuant to their treaty obligations.

ICANN's acceptance of the GAC Advice would raise the potential for further legal scrutiny of which the outcome is uncertain.

Over the years, the Government Advisory Committee has consistently supported lawful IP rights protection mechanisms in the new gTLD program. MARQUES remains grateful for governments' continuing participation in ICANN and the voice that they give to internet users around the world. However, on this occasion we urge the ICANN Board to carefully consider the GAC Advice and to act in the best interests of the multi-stakeholder model which is enshrined in ICANN's By-Laws by respecting internationally-recognised legal principles.

Yours sincerely



Christopher D. Barnard  
Executive Director  
MARQUES Limited