



**Comments of **MARQUES**, the European Association of Trade Mark Owners on the Supplemental Report on the new gTLD Subsequent Procedures Policy Development Process (Work Track 5 on Geographic Names at the Top Level)**

**Introduction to **MARQUES****

**MARQUES** is the European association representing brand owners' interests. The **MARQUES** mission is to be the trusted voice for brand owners. **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 representing billions of dollars of trade annually. The trade mark owners and practitioners represented by **MARQUES**, together, own more than three million domain names and advise organisations of all sizes on rights protection in the domain name system. These domain names are relied upon by consumers across Europe as signposts of genuine goods and services.

More information about **MARQUES** and its initiatives is available at [www.marques.org](http://www.marques.org).

***MARQUES' comments on the Supplemental Report on the new gTLD Subsequent Procedures Policy Development Process (Work Track 5 on Geographic Names at the Top Level)***

**MARQUES** welcomes the opportunity to provide its comments on the *Supplemental Report on the new gTLD Subsequent Procedures Policy Development Process (Work Track 5 on Geographic Names at the Top Level)* (the Work Track 5 Supplemental Report).

**MARQUES** has been following the issue of the treatment of so-called geographic names at the top level for many years now.

There are thousands of brands registered in Europe (and elsewhere), 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), and VIKING (cruises).

**MARQUES Ltd** - Unit Q, Troon Way Business Centre, Humberstone Lane,  
Thurmaston, Leicester LE4 9HA United Kingdom  
Phone +44 116 274 7355 Fax +44 116 274 7365 Email: [info@marques.org](mailto:info@marques.org) /[aromeo@marques.org](mailto:aromeo@marques.org)

In September 2013 we wrote to the Chairman of the Board of ICANN on the subject of the protection of geographic terms, a copy of which is attached for convenience. Our position remains unchanged. In that letter we said:

*“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”.*

Notwithstanding the above comments, we recognise that the restrictions developed on the treatment of geographic terms for the Applicant Guidebook for the 2012 round of New gTLDs (the AGB 2012) (namely the terms reserved from use in section 2.2.1.4.1 and the terms identified as requiring governmental consent or non-objection in section 2.2.1.4.2) were a compromise developed by the ICANN multistakeholder community. No single interest group achieved everything that they wanted from these AGB 2012 outcomes, but collectively they were felt to represent a fair and appropriate balance of the competing interests and opinions.

**MARQUES** does not agree with all of these AGB 2012 restrictions as a matter of law and principle. For example, the reservation of the ISO 3166-1 alpha 3 three-letter codes and the obligations to obtain governmental support/non-objection for names which match capital city and other names irrespective of the intended use, have no basis in law. Nevertheless, **MARQUES** is prepared to support their continuing application for future rounds of New gTLDs, and thus we support the Preliminary Recommendations as set out in the Work Track 5 Supplemental Report.

**MARQUES** intends to oppose any proposals which would seek to expand the scope of the protection of geographic terms further than is already provided under the AGB 2012 and, for the avoidance of doubt, also opposes a definition or use of the term *“geographic name”* or *“term with geographic meaning”* that broadens the current group of names that are reserved/unavailable or only available if accompanied by appropriate documentation (of support or non-objection). To the extent that the working group is minded to expand the scope of protection for geographic terms then **MARQUES** in turn would withdraw its support for the preliminary recommendations.



We thank you for your kind consideration of the above comments, and we remain at disposal for further discussion.

Yours sincerely,

Submitted on behalf of **MARQUES**

22 January 2019

Signed on behalf of Michael Zoebisch, Chair of **MARQUES** Cyberspace Team

A handwritten signature in black ink, appearing to read "Alessandra Romeo".

Alessandra Romeo, **MARQUES** External Relations Officer

Enclosure:

- **MARQUES** position letter on GAC advice relating to geographical names 23<sup>rd</sup> September 2013