Preliminary comments of AIPPI on the Position Paper on the Creation of the .EU Internet Top Level Domain

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on behalf of the comments prepared by

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1. Introduction

The creation of a new .eu top level domain has been proposed by the European Commission to meet the needs of European businesses and consumers. Although referred to as a ccTLD, such a proposal falls somewhere between gTLDs and ccTLDs as such a designation would relate to all 15 countries of the EU, and to any further countries which join the EU.

2. Intellectual Property Protection

The purpose of this position paper is to address what steps should be taken to protect intellectual property rights in the establishment of the .eu TLD. A legitimate concern is that the introduction of the new TLD will attract cybersquatters in addition to legitimate business registrations. In addition to the problems posed by cybersquatters, the introduction of .eu will give rise to conflicts between legitimate business concerns who use the same or similar names or trade marks in different countries or in different sectors. This problem will be most acutely felt where different organisations own registered trade marks in relation to similar goods in different countries.

2.1 Uniform Dispute Resolution Policy

It is recommended that the ICANN UDRP be applied to the .euTLD. This procedure appears to be working well in practice and enables trade mark owners to deal with
cybersquatters more quickly and cheaply than resorting to Court action. As .eu is more akin to a global domain than a single country domain, the ICANN UDRP, which was established to address bad faith registrations in .com, .org and .net, is well placed to address .eu cybersquatters. It may be appropriate to establish a .eu based dispute provider to provide the mediation services relating to this new TLD.

In order for the UDRP to operate correctly, WHOIS data, which details the domain name holder, date of registration and the registry responsible for the registration needs, to be publicly accessible in relation to all domain names.

### 2.2 Proposal for generic second level domains

The Commission has raised the possibility of having generic second level domains to characterise and identify particular sectors of the economy and/or categories of organisation. For example .ngo.eu. Such a proposal has the advantage of reducing possible disputes between competing trade mark holders who use their marks in different sectors, in much the same way as the proposed introduction of additional gTLDs will permit organisations that trade under the same mark in different sectors to have their own domain names. However, it does raise the following issues:

1. Would the creation of generic second level domain names prevent a company from obtaining [its name].eu? I.e. would the generic second level domain be compulsory? This would involve considerable thought as to the categories which would need to be offered and may well lead to multiple applications for the same company which would be counterproductive to the aim or user-friendliness.

2. Presumably the Registry would not have to police the different categories. It would be unreasonable to expect a Registry to determine whether a company could legitimately claim to be entitled to registration in a second level domain.

3. Assuming that the Registry would not police who was entitled to register in which second level domain, disputes could be addressed via the UDRP. The UDRP would need to be adapted in order to be able to deal with a complaint by one company that another company which, although entitled to use the mark the subject of the registration, should not be entitled to register it in relation to that second level domain.

4. To be effective, the second level domain has to be intuitive to users. This may prove difficult to achieve in practice given the different languages used across the European Union.

### 2.3 Famous Marks

Although owners of famous marks will be able to make use of the UDRP to assist in clearing cybersquatters from domain names featuring the famous mark, if this system is extended to cover .eu TLD, it would be preferable, from the perspective of the famous mark holders, to have in place an exclusion system similar to that proposed in relation to the introduction of new gTLDs. It would make sense from the perspective of avoiding duplication of cost and effort (and avoiding conflicting decisions) to have the same system apply to .eu as to the new gTLDs. Therefore, if a “blacklist” type regime is introduced prior to the launch of the new gTLDs, permitting owners of marks to prove
that their marks are internationally famous and thus prevent third parties from obtaining registrations for these marks, this regime should be extended to the .euTLD.

2.4 Marks owned by different parties in different EU Member States

There is no easy solution to the question of who should have the rights in .eu where a mark is used in relation to the same (or similar) product in different member states, but owned by separate companies. The establishment of generic second level domains will not assist these problems.

It seems that the only practical solution to these problems, which will in any event be relatively rare, is to continue to operate on the first come first served basis.

3. Conclusion

The introduction of .eu TLD will be welcomed by intellectual property rights holders, provided sufficient steps are taken to ensure that the scope for potential abuse of intellectual property is restricted. This requires similar safeguards to be in place in relation to .eu as are proposed for the introduction of the new gTLDs. In particular, a dispute resolution procedure (and preferably the ICANN UDRP), registrant requirements to ensure that intellectual property rights holders can obtain the appropriate details required to take action to protect their rights and a commitment to the protection of famous trade marks.

Respectfully submitted on March 15, 2000 on behalf of AIPPI by

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