



## 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.

For more information about **MARQUES**, its mission and initiatives, please consult [www.marques.org](http://www.marques.org).

## **MARQUES** position on the paper of the Sub-working Group of the Government Advisory Committee entitled “The Protection of Geographic Names in the New gTLD Process”

We have consulted widely amongst our members. Over a year ago in September 2013, we wrote to the Chairman of the Board of ICANN on the subject of the protection of geographic terms. In this 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”.*

Our position remains the same today. We are very concerned that this Sub Working-Group of ICANN's Government Advisory Committee has produced a set of proposals which misinterpret international law and nearly 150 years of jurisprudence because:

- Private property rights are recognised under international law

- Governments do not have exclusive use of geographic name in any context
- International law which protects sovereign names does not extend beyond national borders
- The Paris Convention and TRIPS recognise private party rights in geographic names: there are jurisdictional limits on national interest in a geographic names.

**MARQUES** is also concerned that this paper proposes vague processes which are unworkable. For example, the recommendation that potential applicants in future new gTLD rounds should use “internet searches” to identify conflicts with so-called sovereign terms is unworkable. Beyond the ISO 3166 lists, there are no authoritative global lists of “any and all names that are in the public interest”.

Similarly, the paper does not address how a conflict should be resolved should a brand owner find itself facing differing views from competing government interests in a name or, worse, where there are territorial ownership disputes between governments.

### **Conclusion**

Over the years the Government Advisory Committee has consistently supported lawful IP rights protection mechanisms in the new gTLD program. **MARQUES** remains grateful for this. However, on this occasion we urge the Government Advisory Committee to act in accordance with the international agreements to which they are signatories and to respect globally recognised legal principles.

Yours sincerely,

On behalf of **MARQUES** Cyberspace Team