



**Computer & Communications
Industry Association**
Tech Advocacy Since 1972



EDRi



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Dear Sir or Madam,

We are writing to you to express our concerns in relation to internet domain names in the current European “trademark package”.

We understand the Council seeks to broaden the protection afforded by trademarks to target domain names in particular (see Art. 10 (3)(d) TMD and Art. 9 (3)(d) CTMR). We believe that this would be detrimental to internet users, free speech, social commentary and the internet.

First, individual internet users and NGOs often register and use domain names for a wide number of purposes which are socially valuable and cannot be equated with the selling of goods and services.

For instance, domain names have been registered to parody particular companies or products, carry out social commentary or criticise corporate policies. The proposal to single out domain names expressly as a form of trademark infringement will have a chilling effect on legitimate activities, free speech and public debate. We have collected examples that provide ample illustration and are only the tip of the iceberg (see Annex).

Intermediaries like online companies and Internet Service Providers (ISPs) often receive requests to take action on the basis of overbroad assertion of rights which, unfortunately, regularly occur. NGOs and individual users are often ill equipped to defend themselves against overbroad claims to assert trademark rights. Both online intermediaries and individual users need to defend themselves against such claims. Therefore, new provisions which would broaden trademark rights and make unjustified claims more threatening should be avoided.

Second, we also understand the Council proposal would catch further forms of domain name uses such as online discussion platforms where views on a brand owner's products, policies, production methods, marketing strategies etc. are exchanged by the internet community. We see no valid reason to attack this type of activity.

Thirdly, since domain names are global, trademarks are territorial, a nuanced approach is required. The current framework, including dispute resolution procedures, provides such an approach. Fora such as WIPO and ICANN's dispute resolution mechanism are better suited to deal with these issues. The current proposal would upset this balance and encourage a more indiscriminate and overreaching assertion of trademark rights without adding clear benefits to trademark owners.

We therefore call upon EU Member States and the European Parliament not to amend the Commission proposal in respect of domain names, where there is no apparent need to do so. Instead, clarifying what the limits of trademark law and the rights of NGOs and internet users are would be far more productive and adapted to the internet era.

Our broad coalition, which includes organisations representing civil society, internet domain registries, domain name owners, internet service providers and internet companies would like to thank you for your time and attention.

Yours sincerely,



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Director,
CCIA Europe



Peter Van Roste
General Manager,
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Joe McNamee
Executive Director,
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Innocenzo Genna
Chair, Innovation and Growth Committee,
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Jeremiah C Johnston
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ANNEX - overreaching trademark claims against legitimate domain names

'Chilling effects', an organisation that works with several universities to collect and analyze legal complaints about online activity, [collected data on the use of trademarks in content removals](#) and found that 9% of requests relate to domain names.

The examples below illustrate legitimate instances of use of domain names by individual users, activists and NGOs. In all these cases, however, trademark owners used their trademark to threaten with legal action or assert their rights in an overbroad manner.

- In 2013, a feminist group created a [parody site](#) (partywithplayboy.com) of Playboy magazine. Playboy takes action against them and the ISP, see [link](#).
- A journalist and activists protested at a manufacturer of dairy products for closing a factory in France by setting up a website at "jeboycottedanone.com". The company sued but eventually the Paris Court of Appeal cleared the use of the domain name, see [link](#).
- The owner of the trademark in "Ajax" for cleaning products, attempted to take away the domain name of "Ajax.org," from a non-profit organisation with no connection to cleaning products, see [link](#).
- Archie Comics, a US comic book publisher, filed suit against the parents of a 2-year old girl named Veronica Sams, for whom the parents registered the domain name "veronica.org." for a noncommercial website.
- In a land dispute in Southern California, environmentalists opposed the development of a local area called 'Ahmanson Ranch'. A group called Save Open Space registered the domain "ahmanson.org" to oppose development on the plot, which they argued would harm endangered species of plants and animals. The developer tried to take over the domain name arguing trademark infringement, see [link](#).
- Greenpeace Finland created a protest website parodying Finish oil company Neste's annual report, and criticising their practices for aggravating forest destruction. Neste requested from the hosting provider that the website be taken down and a transfer of the domain name "Nestespoil.com" to them before WIPO, see [link](#).
- A French user created a website at 'incidents-rapt.com' allowing users to report traffic incidents on the public network. The RATP sent a [cease-and-desist letter for trademark infringement](#) and threatened to sue, see [link](#).
- The Chicago Auto Show threatened legal action against a parody site, autoshowshutdown.org, which provides information about the "Auto Show SHUTDOWN Festival" - an annual event where hundreds of cyclists parade through Chicago to raise awareness about global warming and to promote sustainable transportation, see [link](#).
- Time Warner Cable took action against TWCCustomerService.com, which looks a lot like a Time Warner site but asks: "What Can We Do Worse?", going after social media accounts associated with the website (YT, Twitter), see [link](#).