



The Internet Corporation for Assigned Names and Numbers

7 April 2014

Governmental Advisory Committee
Via, Ms. Heather Dryden
Chair, Governmental Advisory Committee

Re: Governmental Advisory Committee (GAC) Advice – .AMAZON (and related IDNs)

Dear Ms. Dryden:

I am pleased to inform you that the ICANN Board New gTLD Program Committee (NGPC) continues to make progress to address the open item of advice from the GAC concerning the New gTLD Program applications for .AMAZON, and related IDNs. As you are aware, in its Durban Communiqué, the GAC advised the ICANN Board that “the GAC has reached consensus on GAC Objection Advice according to Module 3.1 part I of the Applicant Guidebook on the following application: .amazon (application number 1-1315-58086) and related IDNs in Japanese (application number 1-1318-83995) and Chinese (application number 1-1318-5591).”

As previously reported, ICANN commissioned an independent, third-party expert to provide additional advice on the specific issues of application of law at issue. The analysis attached has been received and is being considered by the NGPC as it continues to deliberate on the appropriate next steps to address the GAC’s advice on .AMAZON (and related IDNs).

ICANN provides this analysis to keep the parties informed and welcomes any additional information that they believe is relevant to the NGPC in making its final decision on the GAC’s advice on .AMAZON (and related IDNs). ICANN has requested that Amazon EU S.à r.l. (the applicant of the .AMAZON applications identified in the GAC’s advice) submit any additional information by 14 April 2014.

The NGPC is committed to giving due consideration to the complex issues at the crux of the matter, and reiterates its commitment to the most timely response possible to all interested parties including the distinguished members of the GAC. We appreciate the collaboration of the GAC in the New gTLD Program and all of its deliberations and inputs to the process.

Thank you in advance for your kind attention.

Sincerely,

Stephen D. Crocker
Chair, ICANN Board of Directors

Jérôme Passa

Contact Information Redacted

I, the undersigned Jérôme Passa, *agrégé* in law, professor at the Université Panthéon-Assas (Paris II, France), have been requested by ICANN to provide an opinion on the well-foundedness of various objections raised against the reservation of the new gTLD ‘.amazon’. This legal opinion is set out below.

1. In 2011, the Internet Corporation for Assigned Names and Numbers (ICANN), which is responsible for the worldwide administration of the Domain Name System (DNS), launched a new domain name system offering operators the possibility of reserving new gTLDs (generic Top Level Domains) designed to provide suffixes for new domain names.

Under this system, a company can reserve its own name or that of its trade mark or one of its trade marks, such as ‘.vuitton’ or ‘.ipad’, for example, as a new gTLD. Geographical names and purely generic product or service names can also be reserved in this way.

The system and, in particular, the conditions for assigning these new gTLDs are set out in a lengthy document entitled the Applicant Guidebook.

When, after an in-depth evaluation process, ICANN decides to assign a new gTLD to an applicant, the parties enter into an agreement known as a ‘registry agreement’ under which ICANN delegates the management of the new suffix to the beneficiary; the beneficiary thus becoming the registry operator for the new gTLD.

The beneficiary to whom the new gTLD is reserved is the only one permitted to exploit, or to authorise others to exploit, worldwide the domain names associated with the suffix consisting of this gTLD.

As the registry operator of the new suffix, the beneficiary of a new gTLD reservation may decide to open its gTLD and allow interested third parties to reserve domain names associated with this suffix (second-level registrations in this gTLD). It then becomes the registrar of these third-party domain names and, as such, draws up its own naming conventions, laying down the conditions under which third parties can reserve these domain names.

Some new gTLDs, namely those consisting of a generic product or service name, are by their nature open, while those consisting of the name of a business or a brand are not necessarily open.

2. Reservation of a new gTLD may infringe prior third-party rights or, more generally, interests.

ICANN is clearly well aware of this issue since a certain number of provisions in the Applicant Guidebook are aimed at preventing this type of infringement.

The beneficiary of a prior right or interest, for example, can object to the assignment of a gTLD (Applicant Guidebook, 3.2.1).

In addition, on issues affecting its member states, ICANN's Governmental Advisory Committee (GAC), an inter-governmental committee made up of representatives of national governments and intergovernmental organisations, can issue advice to ICANN's board on applications for new gTLDs (Applicant Guidebook, section 3.1).

The advice of the GAC, which may suggest that ICANN refuse to reserve a given gTLD (as in the case of '.amazon' as we shall see below) is sent to the applicant which has a right of reply.

3. In view of the objections raised by the GAC and various member states, this concern to protect prior third-party rights and interests has led ICANN to consider the legitimacy and opportuneness of assigning the new gTLD '.amazon' to its applicant, namely the Amazon company .

The undersigned has been consulted on the specific issue of whether, on strictly legal grounds in the field of intellectual property law relating, in particular, to the rules of international law or fundamental principles, ICANN would be **bound**:

- to assign the new gTLD in question to its applicant, or, to the contrary,
- to refuse to assign it in order to protect prior rights as mentioned above.

In essence, the answer lies in whether or not a prior right actually exists and, where this is the case, in the nature and function of the right and the scope of protection conferred upon it by the rules of law.

Consequently, the undersigned will limit his opinion to the provisions of applicable international **intellectual property** agreements, to the fundamental principles governing this area of law and, where applicable, to the rules of supranational law constituted by the provisions of the applicable European Union legislation in the field of intellectual property.

With a few individual exceptions, there will be no reference to the provisions of the various regulations adopted by ICANN, the legal nature of which is likely to give rise to some debate.

Given the wording of ICANN's questions to the undersigned, this opinion will concentrate exclusively on the reasons why ICANN might be led to assign or refuse to assign the new gTLD in question, in other words on the disputes which have arisen during the evaluation stage of the application. It will not examine, as its main focus, questions and disputes likely to arise in the subsequent stage, following assignment of this new gTLD, during which the second-level domains open in the gTLD will be exploited.

The examination will deal with the application for assignment of the new gTLD '.amazon'.

4. Amazon, a US corporation and owner of the *Amazon* trade mark for various products and services in a wide range of countries, has made an application for the new gTLD ‘.amazon’.

Objections have been raised against this application by various Latin American countries, including Brazil and Peru, through which the River Amazon flows and whose territories form part of the river’s 5.5 million km² plain, known as Amazonia.

These objections were passed on by the GAC which recommended that ICANN reject Amazon’s application.

The issues currently facing ICANN are:

- whether the rules and principles cited in support of these objections and reiterated in the unfavourable advice issued by the GAC are of such nature as to oblige ICANN to reject the application filed by Amazon (A) or, to the contrary,
- whether the rules and principles cited by Amazon in its response of 23 August 2013 to the GAC’s advice oblige it to reserve the new gTLD ‘.amazon’ (B).

A.- Concerning the objections to the assignment of the new gTLD ‘.amazon’

5. Though the term ‘amazon’ does not appear to correspond to the name of the Amazonia region in any language, and in particular in Spanish, Portuguese or English, an objection against the reservation of the new gTLD ‘.amazon’ for Amazon might, in principle, nevertheless be raised on the basis of the notion of ‘geographical indication’ as defined in intellectual property law.

Indeed, where a geographical indication is protected on this basis it is protected not simply against the use of identical names but also, in most legal systems, against the use of names which imitate or invoke it. This is only logical since the use of a name which is merely similar may also be designed to take advantage of the reputation of the geographical indication or result in a reduction in its attractiveness in the eyes of the public.

Thus, if the names ‘Amazonia’ and ‘Amazonas’ were geographical indications, it would, given the evident similarity of the names in question, be possible to protect them against the use of the name ‘Amazon’.

The simple fact that the names ‘Amazon’ on one hand and ‘Amazonia’ and ‘Amazonas’ on the other are not identical is not, therefore and as such, sufficient argument to exclude application of the geographical indications regime on which a rejection of Amazon’s application might be based.

6. However, the geographical name in question, ‘Amazonia’ or ‘Amazonas’ in this case, must constitute a **geographical indication within the meaning of intellectual property law**.

But this is not the case here.

Indeed, the geographical name of a place can constitute a geographical indication and be recognised and protected as such under intellectual property law only if there exists in the public mind a link between the place in question and particular qualities or a reputation for specific products of that place because these qualities or this reputation are attributed to this geographical origin.

Thus, Article 22(1) of the TRIPS Agreement, which forms Annex I C of the Agreement establishing the World Trade Organisation and is binding on a great number of states, provides that “geographical indications are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.”

Both European Union law and certain international conventions draw a distinction between such geographical indications based on the strength of the link between the geographical origin and the characteristics and qualities of the product in question. For example, the various European regulations on geographical indications draw a distinction between appellations of origin and geographical indications in the strict sense of the term.

Appellations of origin are the geographical names with the closest link between geographical origin and product characteristics or qualities. For example, Article 5(1) of Regulation (EU) No 1151/2012 of 21 November 2012 on quality schemes for agricultural products and foodstuffs¹ provides that “‘designation of origin’ is a name which identifies a product: (a) originating in a specific place, region or, in exceptional cases, a country; (b) whose quality or characteristics are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors; and (c) the production steps of which all take place in the defined geographical area.”

This definition is based closely on that given in Article 2(1) of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of October 31, 1958, an international convention which came into effect in 1966 and which defines the term ‘appellation of origin’ as “the geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment including natural and human factors.”

An appellation of origin is thus characterised by the fact that the particular quality or characteristics of products which represent their interest to the consumer are the result of local natural factors and local expertise.

¹ Please note that such Regulation excludes wine and spirits which are regulated by specific Regulations, *i.e.* Regulation (EU) n°1308/2013 of 17 December 2013 establishing a common organization of the markets in agricultural products (for wines) and Regulation (EC) n°110/2008 of 15 January 2008 on the definition, description, presentation, labeling and the protection of geographical indications of spirit drinks; both Regulations provide for similar provisions as Regulation (EU) n°1151/2012.

Geographical indications in the strict sense of the term differ from appellations of origin in that the link between the qualities or character of a product and its locality of origin is more tenuous. Indeed, Article 5(2) of the aforementioned EU Regulation provides that “‘geographical indication’ is a name which identifies a product: (a) originating in a specific place, region or country; (b) whose given quality, reputation or other characteristics is essentially attributable to its geographical origin; and (c) at least one of the production steps of which take place in the defined geographical area.” The effect of geographical provenance on product characteristics is thus required, but not specified, and may therefore relate to both natural or human factors.

7. In many legal systems the protection of geographical indications in its wider sense is dependent on the completion of certain formalities in the country or region – such as the European Union – of origin of the products in question. This may be through either statutory recognition or registration with an administrative authority. In both cases, the formalities will define the geographical area in which the products in question must be produced, manufactured or processed and specify the production or manufacturing conditions to be fulfilled in order for the products to be identified under the geographical indication in question.

However, in certain legal systems – including under French law, for example² – a geographical name which is not – or not yet – recognised either by statute or by registration can still be afforded a certain degree of protection where the products from the geographical area in question are deemed to have special characteristics or qualities.

8. Under intellectual property law, a geographical name enjoys no status, regime or particular protection where it designates a place which is not specially known by the public for its products and services, whatever they may be. This is the case where this place is not the origin of any particular products or services or where the products or services originating in it do not or are not deemed to have any particular characteristics due to this origin in the minds of the public.

Such conclusion clearly results from the law governing geographical indications. It also emerges from the rules governing the relationships – frequent in practice – between trade marks and geographical names in most legal systems and in particular under EU and French law.

For example, we know that a trade mark consisting of the geographical name of a place is misleading and will therefore be refused by the Trade Mark Office or invalidated by the courts if the products it covers do not come from the place in question and the public knows that the products which do come from the place in question possess particular characteristics or qualities. This rule is contained in substance in Article 22(3) of the TRIPS Agreement.

By contrast, it is accepted that a trade mark is not misleading if the products it covers do not come from the place in question but the place in question has no particular reputation for these products.

² Through the notion, not used in the law, of ‘indication of provenance’.

For example, it has been held in France – and the solution would be the same in most legal systems – that a trade mark registered for clothing can validly consist of or contain the name ‘Boston’ even if the products in question are not manufactured in Boston as long as this US city has no particular reputation for clothing³, which would only be the case if clothing made in Boston possessed particular characteristics or qualities because of its origin or a reputation in the minds of the public.

In this example the name ‘Boston’ is a **neutral geographical name** for clothing which has no impact under trade mark law.

It is also accepted that a trade mark consisting exclusively of the geographical name of a place will be refused or invalidated as being devoid of distinctive character if the place is the place of origin of the products covered by the trade mark, in this case the trade mark being, in effect, deemed to be descriptive of one of the characteristics of the products in question, i.e. their geographical provenance.

It has, however, also been held, notably by the General Court of the European Union, that this solution applies only where the geographical name has a certain reputation for the products in question in the minds of the public.

Thus in a judgment dealing with the trade mark *Port Louis*, consisting of the name of the capital of Mauritius, registered for textile products, the General Court underlined that “the registration as a Community trade mark of names designating certain geographical places already reputed or known for the category of products in question and which consequently have a link with this category in the eyes of interested parties”⁴ is not possible. The fact that the trade mark owner’s clothing comes or may come from this place is of no relevance and the trade mark is not considered to be descriptive since the town in question has no particular reputation for this category of products.

As in the case of the name ‘Boston’ dealt with above, the geographical name is neutral and therefore has no impact on the conditions of validity of the trade mark.

9. Supposing that, given its very large surface area and the fact that it comprises parts of various different countries, Amazonia constitutes the geographical area of a geographical indication within the legal meaning of the term – though this is already be disputed in view of the aforementioned definition of Article 22 (1) of the TRIPS Agreement which refers to products “originating in the territory of a Member” – Amazonia would appear to have no particular reputation for the production of specific products. Neither are products from this region known to have particular characteristics or qualities due specifically to their origin.

In fact, the objecting states are not claiming that the name of the Amazonia region would have been recognised in their legal systems as a geographical indication either by statute or by registration for any specific products .

³ Paris Appeal Court, 10 Jan. 2001, *PIBD* 2001, no. 721, III, 290 (*Boston-Création*). In the same vein, Paris Appeal Court, 6 Mar. 2002, *PIBD* 2002, no. 753, III, 545 in relation to the name *NYC* for clothing; Paris Appeal Court, 9 Mar. 2005, *PIBD* 2005, no. 809, III, 345 in relation to the name *Versailles* for sweets and confectionary.

⁴ General Court of EU, 15 Oct. 2008, case ref. T-230/06, no. 31. See also General Court of EU, 8 Jul. 2009, case ref. T-226/08 in relation to the trade mark *Alaska* for mineral water.

It is my view that the geographical names ‘Amazonie’, ‘Amazonia’ and ‘Amazonas’ do not constitute a geographical indication within the meaning of intellectual property law and in particular within the meaning of Article 22 (1) of the TRIPS Agreement, nor do they appear likely to become so in the near future for any specific products. However, ICANN may have specific information on this last point which might lead it to reach a different conclusion.

In consequence, I do not believe that assignment of the new gTLD ‘.amazon’ to the Amazon company could be rejected on the basis of international or even local law on geographical indications.

10. Even supposing, hypothetically, that the geographical names ‘Amazonie’, ‘Amazonia’ and ‘Amazonas’ constituted geographical indications for specific products, this geographical indication would not necessarily justify the rejection of the application for assignment of the gTLD to the Amazon company.

As has already been pointed out, it is true that the fact that the name ‘Amazon’ and the name of the geographical indication are not identical is unlikely to prevent the application of the law governing geographical indications.

However, legal recognition of a geographical indication does not in any way imply that the geographical indication enjoys absolute protection, that is to say, protection against **any type** of use of an identical or similar name by a third party.

11. On one hand, indeed, Article 22 of the TRIPS Agreement provides only for protection against use as an indication of the geographical provenance of a product where this use misleads the public as to the geographical origin of the product.

On this point, “in respect of geographical indications” Article 22 2(a) requires parties to the Agreement to provide the legal means for interested parties to prevent “the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good.”

However, given the nature of the Amazon company’s activities and the fact that the *Amazon* sign is neither used nor designed to be used by it as an indication of the geographical origin of a product or service, the reservation and use by Amazon of the gTLD ‘.amazon’ **does not fall within the scope of protection afforded to geographical indications** by the TRIPS Agreement.

Since this gTLD consists of the name and the trade mark of a company, it should not in principle be open to independent third parties carrying on various activities which might themselves infringe the geographical indication. Even if this were the case, such a risk, further down the process at the exploitation stage of the gTLD, would not justify a general refusal to assign it to the Amazon company. Any such infringement would be attributable to the third party and would fall within, notably, the contractual relationship between the Amazon company as registrar of the gTLD and the contracting third party (see section 23 below).

Article 22 2(b) of the Agreement also requires the parties to protect geographical indications against “any use which constitutes an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention”. However, in order for an “act of competition contrary to honest practices in industrial or commercial matters” within the meaning of this last provision (sub-section 2) and an act “of such a nature as to create confusion (...) with the establishment, the goods, or the industrial or commercial activities, of a competitor” (sub-section 3 (i)) or “indications or allegations the use of which (...) is liable to mislead the public as to the (...) characteristics” or the quality “of the goods” (sub-section 3(iii)) to exist, the name identical or similar to the geographical indication must, as above, necessarily be used as the indication of the geographical provenance of products.

To summarize, the legal protection afforded to a geographical indication – supposing that such geographical indication exists – by the provisions of the TRIPS Agreement and the Paris Convention does not, on its own, justify a rejection of the Amazon’s company application.

12. On the other hand, unlike the TRIPS Agreement, some legal systems do not limit the protection of geographical indications to cases in which an identical or similar name is used by a third party to indicate the geographical provenance of a product.

Thus, in the case of appellations of origin, Article 3 of the aforementioned Lisbon Agreement provides that “protection shall be ensured against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as “kind”, “type”, “make”, “imitation” or the like”.

Even though the Agreement does not specify what such “usurpation or imitation” consists of, its general nature and wording suggest that the protection extends beyond cases in which a third party uses an identical or similar sign to indicate the geographical provenance of a product. Given the broad language used in this provision, it is difficult however to know exactly what the conditions and terms of this protection are.

The provisions of the above mentioned European regulations protecting geographical indications of agricultural and food products⁵, wines⁶ and spirits⁷ are, however, more specific on this point.

This is the case, in particular, of Article 13(1) of the aforementioned Regulation (EU) No 1151/2012 on quality schemes for agricultural products and foodstuffs⁸, according to which:

“Registered names shall be protected against:

- a). any direct or indirect commercial use of a registered name in respect of products not covered by the registration where those products are comparable to the products registered under that name or where using the name exploits the reputation of the protected name, including when those products are used as an ingredient;

⁵ Regulation (EU) No 1151/2012 of 21 November 2012.

⁶ Regulation (EU) No 1308/2013 of 17 December 2013.

⁷ Regulation (EC) No 110/2008 of 15 January 2008.

⁸ Please note that similar provisions are provided for in (EU) Regulation n°1308/2013 (for wines) and (EC) Regulation n°110/2008 (for spirits).

- b). any misuse, imitation or evocation, even if the true origin of the products or services is indicated or if the protected name is translated or accompanied by an expression such as ‘style’, ‘type’, ‘method’, ‘as produced in’, ‘imitation’ or similar, including when those products are used as an ingredient;
- c). any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product that is used on the inner or outer packaging, advertising material or documents relating to the product concerned, and the packing of the product in a container liable to convey a false impression as to its origin;
- d). any other practice liable to mislead the consumer as to the true origin of the product.”

A joint reading of sub-sections a) and b) of this provision reveals that geographical names registered under the Regulation are protected against any direct or indirect commercial use of a sign identical or similar (imitation or evocation) to the protected name for products comparable to those covered by the registration or for an product or service where this use takes advantage of the reputation of the protected name.

Though, where not otherwise stipulated, protection extends to uses which do not indicate a geographical provenance, a number of conditions must nevertheless be fulfilled. Either the sign in dispute must be used for products comparable to those covered by the registration or – unlike for a comparable product – the use in dispute must take advantage of the reputation of the protected name.

Though the trade mark *Champagne* registered and exploited by Yves-Saint-Laurent for a luxury perfume, i.e. in a non-geographical manner, was invalidated and prohibited in France on the basis of comparable statutory provisions, it was because the use of this trade mark allowed its owner to take advantage of the reputation and prestige of the renown appellation of origin *Champagne* for a sparkling wine from the Champagne region⁹.

Supposing that ICANN were required to take account of the provisions of European Union law, even though I do not believe this to be so particularly since in this case the geographical names in question – Amazonia, Amazonas and Amazonie – is not registered under any EU regulation, the reservation of the gTLD ‘amazon’ would not in any case infringe a prior geographical indication, if one existed.

For, firstly, it would not in all likelihood be for the use of products comparable to those covered by this geographical indication – indeed it is hard to see just what these products might be – and, secondly, given the nature of its activities and the already great reputation of both its name and its trade mark, the Amazon company’s use of ‘amazon’ would be neither intended nor allow it to take advantage of the reputation of this geographical indication.

This reasoning can undoubtedly be applied to other national or regional protection system for geographical indications.

13. In conclusion, there is no rule of the law on geographical indications which obliges ICANN to reject the application for reservation of the gTLD ‘amazon’ filed by the Amazon company due to the existence of the geographical name of the Amazonia region.

⁹ Paris Court of Appeal, 15 Dec. 1993, *JCP* 1994, II, 2229; *PIBD* 1994, no. 560, III, 92.

Beyond the law of geographical indications, the assignment of ‘.amazon’ to Amazon would not in any event be prejudicial to the objecting states who, since they have no reason for linguistic reasons to reserve ‘.amazon’, could always if they so wished reserve a new gTLD such as ‘.amazonia’ or ‘.amazonas’ which would create no risk of confusion with ‘.amazon’.

Finally, the fact that neither the name ‘Amazon’ nor that of the Amazonia region appears in any language on the ISO 3166 list is irrelevant. It is true that the country and region names on this list, whether they are reproduced, imitated or translated into a foreign language, cannot be reserved¹⁰. However, the fact that there is no bar to reserving the TLD ‘.amazon’ on this ground does not mean that it could not be rejected on other grounds put forward by the objecting states or that Amazon could not claim a right to reserve it. On this last point, it is clear that no one can claim a TLD simply because the name it consists of is not included on the ISO list.

B.- Concerning the arguments put forward by the Amazon company in support of the assignment of the new gTLD ‘.amazon’

14. In response to the advice of the GAC reiterating the arguments of the objecting states, the Amazon company cites a certain number of rules of international law which, it claims, mean it must be assigned the TLD ‘.amazon’.

15. Firstly, and principally, the Amazon company cites its trade mark *Amazon* which is registered in almost 150 states around the world, including Brazil and Peru.

In substance, it contends that the intellectual property rights it holds in the name *Amazon* as a result of these registrations give it a *right to* the TLD ‘.amazon’ and that ICANN is therefore obliged to assign the TLD to it.

In support of this argument Amazon cites Article 16(1) of the TRIPS Agreement which gives the owner of a registered trade mark “the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trade mark is registered (...).”

15-1. However, it is my view that the argument advanced by Amazon is based on an incorrect understanding of the nature of the protection afforded by a registered trade mark and, more generally, by an intellectual property right.

Indeed, an intellectual property right, whatever its nature, affords its owner an exclusivity or monopoly of exploitation over the subject matter of the right within the limits stipulated by law – whether national or regional¹¹ – applicable to this right. This exclusive right allows its holder to prevent third parties from carrying out on this subject matter the acts of exploitation which the law reserves to him.

¹⁰ Applicant Guidebook, 2.2.1.4.1.

¹¹ Such as, in European Union law, Regulation (EC) No 207/2009 on the Community trade mark and Regulation (EC) No. 1/2002 on Community designs.

An intellectual property right is therefore, like any property, a right to exclude third parties and, in this case, a right to exclude unauthorised third parties from the scope of protection which the law grants to the owner of the intellectual property right.

Binding as against third parties, an intellectual property right never affords its owner **the right to exploit or to use the subject matter of its right.**

We know, for example, that a patent does not confer upon its owner the right to exploit the invention. Firstly, the exploitation of the invention may, for example, require him to obtain marketing approval as is the case for the marketing of pharmaceutical products. Secondly, if the patented invention in question represents an improvement of a prior invention which is itself also covered by a patent valid for the same territory, the patented invention cannot legally be exploited without the authorisation of the holder of the prior patent.

We also know that the holder of a copyright in a work is not necessarily able to exploit the work simply on the basis of this right. Firstly, its exploitation may come up against an administrative or legal prohibition based on reasons of public policy or a third party's right to privacy, for example. Secondly, if this work is derived from a prior work which is itself also protected, it cannot legally be exploited without the consent of the holder of the rights in the first work.

These simple examples demonstrate that an intellectual property right does not grant its owner a **right to use** the intangible subject matter in question. The right grants him ownership, ownership which is always binding on unauthorised third parties, but not, unless misinterpreting the notion of intellectual property, the possibility to exploit the subject matter of its ownership in any circumstances.

15-2. The same applies under trade mark law.

A trade mark right – the right associated with the registration of a trade mark – grants the owner a monopoly binding on third parties within the limits defined by law.

However, the holder cannot invoke this right as *a right to use* the sign, even for the products and services specified in the registration, or even as the right to use the sign in particular forms, such as a new gTLD.

The owner of a registered trade mark, though it is fully binding on third parties while it is in force, may, for example, be prevented from exploiting it due to a prior right held by a third party.

The Court of Justice of the European Union confirmed this in a recent judgment¹² in respect of a Community trade mark governed by Council Regulation (EC) No 207/2009. It held that the owner of a Community trade mark can be found guilty of infringing a prior Community trade mark and, consequently, be prevented from using its trade mark, even where no action for invalidity has been brought and therefore non cancellation of the trade mark ordered. Thus, a person may be the owner of a trade mark which is valid and therefore binding on third parties but be unable to exploit it due to a court order issued prohibiting such use so as to protect the prior right of a third party.

¹² CJEU, 21 Feb. 2013, C-561/11, *Fédération Cynologique*.

A few months earlier, the Court of Justice had already adopted the same solution with regard to Community designs¹³.

15-3. The exclusive right held by the Amazon company in its trade mark *Amazon* in various Member States under Article 16(1) of the TRIPS Agreement does not therefore necessarily give it **the right per se either to use it or to use the *Amazon* sign in any other form it may choose, such as a new TLD.**

In my belief, therefore, the Amazon company is wrong in citing its registered trademarks and its rights under Article 16(1) of the TRIPS Agreement and in deducing that ICANN is therefore obliged to assign it the new TLD to allow it to exploit, as a TLD, the *Amazon* sign which forms the subject matter of these trade marks.

The *Amazon* trade marks held by the applicant do not in legal terms give it a *right to the new TLD ‘.amazon’.* The fact that the objecting states did not cite any trade marks in support of their arguments is irrelevant in this respect.

Moreover, I would also add that all these *Amazon* trade marks, which are each subject to the principle of territoriality, are legally effective on a national – or regional in the case of a Community trade mark – territory only, in particular, if Amazon holds one of them and that in consequence none of these trade marks would be binding on ICANN, which is responsible for the assignments of new TLDs worldwide in any event.

15-4. At the very most, the Amazon company’s trademarks permit it to claim a **legitimate interest for applying for assignment** of ‘.amazon’.

However, this interest does not in any way guarantee it assignment of this new TLD in legal terms for there are other considerations to be taken into account in the ICANN decision.

16. The same can be said of the arguments put forward by Amazon based on Article 8 of the Paris Convention for the Protection of Industrial Property.

This very succinct article provides for the protection of trade names in the states party to the Convention without the need for any filing or registration formality.

Apart from the fact that it does not specify the conditions or the nature of this protection – a matter that is left to the appreciation of the states party to the Agreement – like Article 16(1) of the TRIPS Agreement on the protection of registered trade marks, this Convention protects trade names against acts of exploitation of the sign carried out by non-authorised third parties. It does not in any way confer upon the holder of a trade name either a general *right to use* the sign or a right to the sign in a particular form, such as a TLD, for example.

Like a registered trade mark, a trade name does indeed give its owner a **legitimate interest** in applying for the assignment of the new TLD corresponding to the sign at stake. However, as with a trade mark, this legitimate interest alone does not justify the assignment of the new TLD since ICANN can also take other considerations into account.

¹³ CJEU, 16 Feb. 2012, C-488/10, *Celaya Empananza*.

17. Finally, in this case Amazon cannot effectively rely on the provisions of international human rights law and, in particular, – supposing it were applicable to and binding on ICANN – the European Convention on Human Rights (ECHR).

It is true that Article 1 of the First Additional Protocol to the ECHR provides for an entitlement “to the peaceful enjoyment of (...) possessions”, while in its *Anheuser-Busch/Portugal* judgment of 11 January 2007¹⁴ the European Court of Human held that this provision “applies to intellectual property as such”.

However, Amazon cannot use this argument to claim a right to the registration of the new TLD ‘.amazon’.

Indeed, **firstly**, filing an application for assignment of this new TLD in no way guarantees it the assignment of the TLD.

In the aforementioned judgment, the European Court of Human Rights held that, given all the economic rights and interests attached to such an application, the owner of an application for registration of a trade mark is the holder of a substantial interest protected by Article 1 of the First Additional Protocol but that the Trade Mark Office’s rejection of the application did not constitute interference in the applicant’s right to the peaceful enjoyment of his possessions and thus a breach of Article 1 – thereby thankfully guaranteeing the freedom of offices to refuse trade mark or patent applications.

Supposing that an application for assignment of a new gTLD corresponding to a trade mark held by the applicant were to be qualified as a possession within the meaning of Article 1 of the First Additional Protocol, as is the case with an application for the registration of a trade mark – which in my view could be disputed –, according to the European Court’s analysis ICANN’s rejection of this application would not constitute a breach of the peaceful enjoyment of this possession.

Secondly, the Amazon company’s *Amazon* trade marks undeniably constitute goods within the meaning of the aforementioned provision.

However, given its subject matter and purpose, a registered trade mark does not in any way guarantee its holder (as set out in section 15-2 et seq. above) a **right to** the assignment of the corresponding new TLD. Since this assignment is not a prerogative of the owner of the trade mark, a refusal to assign the TLD could not be considered a breach of the right to peaceful enjoyment of the possession represented by the registered trade mark.

¹⁴ Req. n° 73049/01.

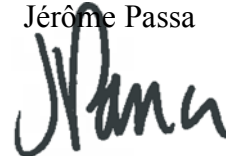
18. Therefore, there exists no provision in either international intellectual property law or in the field of fundamental rights which could oblige ICANN to assign the gTLD ‘.amazon’ to the Amazon company.

Conclusion

As regards the application for assignment of the new gTLD ‘.amazon’ filed by the Amazon company:

- i)* there is no rule of international, or even regional or national, law applicable in the field of geographical indications which obliges ICANN to reject the application;**
- ii)* there is no rule of international, or even regional or national, law applicable in the field of intellectual property and in particular of trade marks or in the field of fundamental rights, which obliges ICANN to accept this application.**

Jérôme Passa



Paris, March 31st, 2014