

**Briefing on ICANN's proposed gTDL Policy
and the Relationship between Trademark Rights and Freedom of Expression**

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In response to a request of the ICANN's Non-Commercial Users Constituency (NCUC) and IP Justice, I respectfully submit this legal assessment of ICANN's Generic Names Supporting Organization's (GNSO) proposed generic top-level domain (gTLD) policy recommendations. This briefing shall address the proposal for Recommendations 2, 3 and 6.

Background

In addition to the existing generic top-level domains (gTLDs) (".com" or ".net" etc.) and the recently introduced top level domains (".biz" or ".prof" etc.), ICANN is will introduce new gTLDs. For the orderly distribution of new gTLDs it seems necessary that ICANN is seeking to establish a policy. Considering the fact that ICANN is a primarily technical organization, it is laudable that the proposed daft policy recommendations do make reference to the applicable international legal framework. It is also understandable that ICANN takes into account past experience with e.g. cyber-squatting. However, as NCUC's Comments of 12 June 2007 importantly point out, the policy does not yet adequately reflect all applicable international law. In particular, norms relating to freedom of expression need to be reflected in a more balanced fashion in the draft policy.

This briefing shall elaborate on this need from an International and European perspective. First, I will raise two important points relating to ICANN's position as monopolist and to ICANN's law-making powers. Second, I address the applicable international and European rules on trademark law and freedom of expression. Third, I will address Recommendation 3 and the problem of protection trademark interests within a TLD policy. Fourth, I shall briefly address Recommendation 2 and the question of importing unfair competition standards into TLD policy. And fifth, I shall address Recommendation 6 and the political and legal implications of introducing standards of morality and public order into ICANN's TLD policy.

1. ICANN & Policy Making

ICANN is a private non-governmental organization that is developing a policy for the orderly distribution of gTLDs. Of course, there is nothing extraordinary in the fact that a private organization draws up a policy for the distribution of its goods or services. However, for two reasons, the distribution of gTLDs differs significantly from the distribution of other goods. First, gTLDs are part of the addresses of an essential global communication facility, the Internet. Each gTLD is a unique resource and thus cannot be substituted like other ordinary goods. Second, there are no alternative entities from which an applicant may obtain a gTLD. ICANN will operate as a global monopolist in handing out TLDs. In addition, ICANN seems to position itself as the monopolist adjudicator of disputes over gTLDs. This means that ICANN's position vis-à-vis its clients is not horizontal as is the case between ordinary contracting parties, but it is more vertical like that between a government entity that issues permits and a citizen. This special position of ICANN has the significant implication that a gTLD policy has the quality of a law rather than of a business policy. Therefore, there is a strong need for the respect of basic rule of law concepts. Notably, policy-making should be democratically legitimized and the fundamental rights of people that are touched upon must be respected.

However, ICANN is not democratically empowered by the global Internet community to legislate,¹ nor is ICANN bound formally by human rights standards. In fact, ICANN as a private organization is not formally bound by any international law in its policy making process. It is no party to the Paris Convention for the Protection of Industrial Property, nor TRIPs, nor international human rights conventions such as the International Covenant on Civil and Political Rights, nor any other international legal instrument for that matter. Fortunately, ICANN's own Articles of Incorporation bind ICANN "to carry out its activities in conformity with the relevant principles of international law and applicable international conventions".² This does however not take away the problem surrounding the democratic legitimization of ICANN's policies.

Consequently, on the one hand that, at the very minimum, decisions of ICANN must be subject to review by national courts at all times if a party so wishes. This is not the least mandated by the human right to have one's case heard before a competent tribunal.³ On the other hand, many parties, including NCUC have argued that ICANN should restrict itself to regulating only what is required from a technical viewpoint and to abstain from regulating content-related issues, i.e. to keep the core neutral.

Past experience shows that ICANN does not restrict itself to regulating technical matters. Domain name policies that have been developed under the auspices of ICANN are providing significant protection to trademark interests.⁴ This is understandable and necessary, but if ICANN engages in non-technical policy making than all applicable norms must be considered. This includes norms of international trademark law⁵, freedom of expression,⁶ norms protecting designations of geographical origin,⁷ and possibly norms protecting indigenous/minority cultural heritage or language.⁸ None of these norms grant an exclusive, unchallengeable right in a domain name or a TLD. Instead, they need to be weighed carefully against each other. Here lies thus a significant challenge for ICANN as monopoly distributor and monopoly arbiter on gTLDs to consider adequately all applicable norms in a balanced decision making process.

I shall restrict my analysis to the relationship between trademark law and freedom of expression in TLD policy.

2. Freedom of Expression, Trademark Law and Top-level Domains

Freedom of expression is codified in international instruments that enjoy almost global recognition. Article 19 UDHR as international source of freedom of expression. Without a doubt, the UDHR is morally the most authoritative document on human rights. The legally binding counterpart of Article 19 UDHR is Article 19 of the 1966 International Convention on Civil and Political Rights (ICCPR).⁹ This convention is binding upon almost all countries around

¹ Compare, Nunziato, D. C., 'Freedom of Expression, Democratic Norms, and Internet Governance', *Emory Law Journal* (52) 187-279.

² Articles of Incorporation of Internet Corporation for Assigned Names and Numbers, 21 November 1998, Article 4 "The Corporation shall operate for the benefit of the Internet community as a whole, carrying out its activities in conformity with relevant principles of international law and applicable international conventions and local law and, to the extent appropriate and consistent with these Articles and its Bylaws ..."

³ In the international context this right is codified in e.g. Article 8 UDHR; Article 14 ICCPR; Article 6 ECHR.

⁴ See e.g. Paragraph 4, Uniform Domain-Name Dispute Resolution Policy. See also the WIPO paper on new gTLDs that advocates for the protection of trademark interests.

⁵ Article 6 and 7 of the 1967 Paris Convention, Articles 15 to 21 of the 1996 TRIPs Agreement

⁶ Article 19 Universal Declaration of Human Rights (UDHR) U.N. Doc A/810 at 71; Article 19 of the International Covenant on Civil and Political Rights (ICCPR) U.N. Doc. A/6316 (1966) ; Article 10 of the European Convention for the Protection of Human Rights and Fundamental Freedoms (ECHR) CETS No.: 005; Article 9 of the African Charter on Human and People's Rights, 21 I.L.M. 58 (1982); Article 13 of the American Convention on Human Rights, 1144 U.N.T.S. 123.

⁷ Article 10 Paris Convention; Articles 22 and 23 of TRIPs; The Madrid Agreement for the Repression of False or Deceptive Indications of Source (1981).

⁸ E.g. Article 27 ICCPR and Article 15 of the International Covenant on Economic Social and Cultural Rights (ICESCR), U.N. Doc. A/6316 (1966).

⁹ Article 19 ICCPR states :

1. Everyone shall have the right to hold opinions without interference.

2. Everyone shall have the right to freedom of expression; this right shall include freedom to seek, receive and impart information and ideas of all kinds, regardless of frontiers, either orally, in writing or in print, in the form of art, or through any other media of his choice.

3. The exercise of the rights provided for in paragraph 2 of this article carries with it special duties and responsibilities. It may therefore be subject to certain restrictions, but these shall only be such as are provided by law and are necessary:

(a) For respect of the rights or reputations of others;

(b) For the protection of national security or of public order (ordre public), or of public health or morals.

the world.¹⁰ Whereas the provisions of the ICCPR cannot be invoked by individuals in all countries,¹¹ governments in countries that have ratified the convention are bound by it at least in their law making processes. This includes the governments of countries that traditionally oppose freedom of expression, like China, Iran, or Tunisia.

In addition, several regional human rights conventions protect freedom of expression. In Europe, the European Convention for the Protection of Human Rights and Fundamental Freedoms (ECHR) is adhered to by 46 states. The ECHR takes a rather special position amongst human rights conventions, because its rights can be invoked in a national procedure by any person within the de-facto power of a Member State.¹² After exhaustion of domestic remedies, one may take one's case to the European Court of Human Rights (ECtHR) in Strasbourg. Article 10 ECHR protects freedom of expression, and there is an abundance of national and ECtHR case law on Article 10 ECHR.¹³ Other regional freedom of expression norms can be found in Article 9 of the African Charter on Human and People's Rights¹⁴ and Article 13 of the American Convention on Human Rights.¹⁵ The most influential national provision protecting freedom of expression is without a doubt the United States Constitution's First Amendment. All these provisions differ slightly concerning their scope of the subject matter they cover and the range of persons that is entitled to claim the right.

In the following discussion, I will focus on Article 19 ICCPR and Article 10 ECHR.

Similarly to freedom of expression trademark rights enjoy global recognition. Both the Paris Convention for the Protection of Industrial Property (Paris Convention)¹⁶ and the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs)¹⁷ are adhered to by most states worldwide. Within the European Union (27 Member States) national trademark laws have been harmonized by the Trademark Directive of 1989 (EU-TMD).¹⁸ In addition, a system of trademarks that are valid all throughout EU territory has been established by the Trademark Regulation of 1994 (EU-TMR).¹⁹

3. TLDs, Trademark Law and Freedom of Expression

¹⁰ See status of Ratification at www.unhchr.ch.

¹¹ Additional Protocol 1 provides individuals with a possibility to address claims to the Human Rights Committee, based in Geneva, Switzerland.

¹² Compare ECtHR, *Banković and Others v. Belgium and 16 Other Contracting States* (dec) [GC] no. 52207/99, ECHR 2001-XII, para. 80.

¹³ Article 10 ECHR states:

Freedom of expression

- 1 *Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises.*
- 2 *The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.*

¹⁴ African Charter on Human and People's Rights, 21 I.L.M. 58 (1982), Article 9.1 states: "Every individual shall have the right to receive information. 2. Every individual shall have the right to express and disseminate his opinions within the law."

¹⁵ American Convention on Human Rights, 1144 U.N.T.S. 123, Article 13 states:

"Freedom of Thought and Expression

1. *Everyone has the right to freedom of thought and expression. This right includes freedom to seek, receive, and impart information and ideas of all kinds, regardless of frontiers, either orally, in writing, in print, in the form of art, or through any other medium of one's choice.*
2. *The exercise of the right provided for in the foregoing paragraph shall not be subject to prior censorship but shall be subject to subsequent imposition of liability, which shall be expressly established by law to the extent necessary to ensure:*
 1. *respect for the rights or reputations of others; or*
 2. *the protection of national security, public order, or public health or morals.*
3. *The right of expression may not be restricted by indirect methods or means, such as the abuse of government or private controls over newsprint, radio broadcasting frequencies, or equipment used in the dissemination of information, or by any other means tending to impede the communication and circulation of ideas and opinions.*
4. *Notwithstanding the provisions of paragraph 2 above, public entertainments may be subject by law to prior censorship for the sole purpose of regulating access to them for the moral protection of childhood and adolescence.*
5. *Any propaganda for war and any advocacy of national, racial, or religious hatred that constitute incitements to lawless violence or to any other similar action against any person or group of persons on any grounds including those of race, color, religion, language, or national origin shall be considered as offenses punishable by law."*

¹⁶ Paris Convention for the Protection of Industrial Property, last amended 28 September 1979, to be found on www.wipo.int.

¹⁷ Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs), 15 April 1994, to be found on www.wto.org.

¹⁸ Directive no. 104/89/EEC.

¹⁹ Regulation no. 40/94/EC.

<p>GSNO Recommendation 3: 18 June 2007</p>	<p>Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law.</p> <p>Examples of these legal rights that are internationally recognized include, but are not limited to, rights defined in the Paris Convention for the Protection of Industrial Property (in particular trademark rights), the Universal Declaration of Human Rights and the International Covenant on Civil and Political Rights (in particular freedom of speech rights).</p>
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Discussion

Recommendation 3 seems fairly balanced. However, as experience with UDRP arbitrations and a range of national cases show, free expression rights are not always adequately respected in domain name disputes. On the contrary, trademark rights receive strong protection. Therefore, I share NCUC's concern that strengthening of free expression rights in gTLD policy is needed.

TLD Policy and Freedom of Expression

The majority of holders and applicants for domain names and TLDs are protected by freedom of expression. This follows from the broad interpretation of the scope of Articles 19 ICCPR and 10 ECHR. Article 19 ICCPR refers to the right to "receive and impart information and ideas of all kinds", Article 10 ECHR refers to the freedom "to hold opinions and to receive and impart information and ideas". The ECtHR ruled that Article 10 is not restricted to certain categories of information, ideas or forms of expression that are of a certain democratic value²⁰, but that e.g. economic reporting, radio programs with popular music, commercial information or advertisements are equally covered.²¹ Similarly, the European Court of Justice, the Supreme Court in matters concerning EU law accepted the applicability of Article 10 ECHR in cases concerning the application of EU law to media mergers (antitrust law)²² or advertising.²³

In Europe, the range of persons that can claim the right is broad. Under the ECHR, freedom of expression can be claimed by a person, organization or group of persons who are victims of a violation. This applies to natural and legal persons.²⁴ However, under Optional Protocol 1 to the ICCPR, only individuals may address the Human Rights Committee with a complaint. Still under national provisions, like the United States' First Amendment, entities and companies may claim freedom of expression.²⁵

Of course, none of the provisions that protect freedom of expression is absolute. Article 19.3 and Article 10.2 ECHR do allow for a range of restrictions. Amongst others these articles allow restrictions in order to protect the rights of others or for reasons of public policy or

²⁰ ECtHR 16 December 1992, *Hadjianastassiou v. Greece*, Series A-252, para 39.

²¹ In *Casado Coca v Spain*, the ECtHR held that the intention behind an expression does not have a bearing upon the entitlement to the right. "Article 10 guarantees freedom to 'everyone'. No distinction is made in it according to whether the type of aim pursued is profit-making or not." (para. 35). However, the rationale behind granting protection for commercial expression differs from the rationale for protecting political and artistic expression. Whereas in the case of artistic expression the self-development of the individual is protected (e.g. ECtHR 24 May 1988, *Mueller and others v. Switzerland*, Series A-133) and in case of political expression public debate and truth are at stake, it are the rights of the recipients, i.e. the consumers, that are protected in case of commercial expression (ECtHR 17 October 2002, *Stambuck v. Germany*, para. 39). This means that the scope of commercial expression is somewhat more limited than political expression. Information that serves to confuse or mislead will certainly not be covered.

²² E.g. Case 352/85 *Bond van Adverteerders and others v. The Netherlands State* [1988] ECR 2085; Case C-260/89 *Ellinki Radiophonia Tiléorassi AE and Panellinia Omospondia Syllogon Prossopikou v. Dimotiki Etairia Pliroforissis and Sotirios Kouvelas and Nicolaos Avdellas and others* [1991] ECR I-2925; Case C-288/89 *Stichting Collectieve Antennevoorziening Gouda and others v Commissariaat voor de Media* [1991] ECR I-4007; Case T-266/97 *Vlaamse Televisie Maatschappij NV v. Commission of the European Communities* [1999] ECR II-2329; Commission Decision 96/346/EC *RTL/Veronica/Endemol* [1996] OJ L 134/32.

²³ E.g. Case C-368/95 *Vereinigste Familiapress Zeitungsverlags- und vertriebs GmbH v Heinrich Bauer Verlag* [1997] ECR I-3689; Case C-71/02 *Karner* [2004] ECR I-3025.

²⁴ See *Casado Coca v. Spain*, para. 35; ECtHR 13 February 2003, *Cetin and others v. Turkey*, para. 57.

²⁵ E.g. U.S. Supreme Court, 9 September 1977, *First National Bank of Boston v. Belotti*, 435 U.S. 765.

morality. However, any restriction on freedom of expression must not reach further than necessary to achieve the aim. This requirement of proportionality under Article 19 ICCPR has been confirmed in General Comment 10 of the Human Rights Committee.²⁶ Under Article 10 ECHR this requirement is stated in paragraph 10.2 “*The exercise of these freedoms ... may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society*”. This has been confirmed and elaborated upon numerous times by the ECtHR.²⁷

Accordingly, norms protecting freedom of expression need to be respected in domain name and TLD policy, but trademark rights or prohibitions of cyber-squatting may put valid limitations upon the freedom.

TLD Policy and Trademark Rights

The main concern of trademark right holders with regard to domain names is cyber-squatting. It is understandable that ICANN responds to demand for protection by trademark right holders in the TLD policy. However, trademark rights provide only protection in part against cyber-squatting.

The aim of trademark law is to stimulate competition and to ensure fairness between parties in trade. To achieve this aim trademark law protects the function of trademarks to identify the source of a product.²⁸ This function produces two significant benefits. First, as indicators trademarks enable consumers to recognize qualities of a product and second as communicators trademarks enable companies to inform consumers about product qualities. In order to protect this function, trademarks are protected against confusing uses by other parties in trade. In addition, Article 6bis Paris Convention mandates that well-known trademarks are protected against dilution. This means that their distinctiveness and possibly their reputation must be protected. Article 5.2 EU-TMD and Article 9.1.c EU-TMR prohibit damage to the repute and distinctiveness of well-known trademarks. In addition, they prohibit the taking unfair advantage of the repute or distinctiveness of well-known trademarks.

In particular, the provisions relating to the protection of trademarks against dilution might be applicable to TLD registration processes. In certain cases in the Benelux countries (The Netherlands, Belgium and Luxembourg), confusion protection has been invoked in order to achieve protection against cyber-squatting.²⁹ But applying confusion standards of e.g. Article 5.1.b. EU-TMD to TLDs will not be possible, because, equal as under U.S. law,³⁰ they presuppose that the mark is used in a concrete case for particular goods or services. It is highly unlikely that TLDs will satisfy this requirement.

In general, I concur with the opinion expressed by Prof. Haight Farley and Prof. Lipton, that certain differences between trademarks and domain names must be considered, when granting trademark rights an influence on TLD policy. I shall briefly summarize them here.

- First, the scope of trademark rights is limited to the behavior of parties in trade.³¹ Trademark law is an offspring of the law sanctioning unfair competition. Parties that do not participate in trade remain outside the scope of trademark law. An important exception to

²⁶ Human Rights Committee, General Comment No. 10: Freedom of expression, Article 19, 29 August 1983: . “*Paragraph 3 expressly stresses that the exercise of the right to freedom of expression carries with it special duties and responsibilities and for this reason certain restrictions on the right are permitted which may relate either to the interests of other persons or to those of the community as a whole. However, when a State party imposes certain restrictions on the exercise of freedom of expression, these may not put in jeopardy the right itself. Paragraph 3 lays down conditions and it is only subject to these conditions that restrictions may be imposed: the restrictions must be "provided by law"; they may only be imposed for one of the purposes set out in subparagraphs (a) and (b) of paragraph 3; and they must be justified as being "necessary" for that State party for one of those purposes.*”

²⁷ E.g. ECtHR, 12 June 2001, *Feldek v. Slovakia*, where the court held: “This freedom is subject to the exceptions set out in Article 10 § 2, which must, however, be construed strictly.”

²⁸ See Directive no. 89/104/EEC (*OJ 1989, L 40/01*), Article 2.

²⁹ Alberdingk Thijm, C., *Domeinnamen vs. Merkenrecht*, in: *Het Nieuwe Informatierecht. Nieuwe regels voor het internet*, Academic Service: Den Haag 2004, p. 117.

³⁰ See the Statement of Prof. Haight Farley of 6 June 2007.

³¹ Article 5 of the European Trademark Directive (ETMD); Article 9 of the European Trademark Regulation (ETMR).

this rule is Article 5.5 EU-TMD. It allows for the optional enforcement of trademark rights outside the scope of trade. This provision has been implemented solely by Benelux countries where it has received criticism.³²

In contrast, TLDs will be used for all kinds of commercial and non-commercial purposes.

- Second, trademark law protects only signs that are distinctive of a source. TLDs might fulfill this function, but they might also just describe or refer to content on the page.

- Third, generic terms are not protected by trademark law, since they are not distinctive of source but distinctive of a product quality. Allowing a company to register a generic term deprives other companies to refer to that product quality and thereby hampers competition. The European Court of Justice held in a case concerning the use of geographic indication as trademark, that such is not allowed if this indication were to be associated by consumers with a certain product quality.³³

On the contrary, domain names often are linguistically generic, so might be gTLDs.

- Fourth, trademarks differ from TLDs because trademark rights are limited in scope. They are granted for a certain class of goods and they do apply with territorial limitations. Only well-known trademarks are protected in an overreaching manner and only as far as their fame reaches.

- And fifth, trademark law knows important exceptions that allow for referential or descriptive use.

Accordingly, with the exception of the Benelux countries, European trademark law applies to TLDs only where they are used by a third party in trade. Ordinary confusion protection of trademarks will not extend to TLDs. Therefore, only dilution protection extends to TLDs.

Conflicts between Freedom of Expression and Trademark Rights

Unlike United States trademark law, European Union trademark law does not provide for a fair use defense. The provisions that protect trademarks against dilution can only be overcome, if a defendant can demonstrate a 'due cause' for using the trademark.³⁴ Due cause has often been interpreted restrictively. It was held to apply only if no alternative means of expression were available.³⁵

The European Court of Human Rights has so far not ruled on the issue whether and when Article 10 ECHR can set aside dilution protection. In some cases it has ruled, that where an individual has access to a different terminology to express,³⁶ or where a different location to hold protests was available,³⁷ a prohibition to use a platform, to use a term, or to enter a shopping center was not violating Article 10 ECHR. This could mean that where alternative ways of expression are available, freedom of expression will not prevail over trademark rights. In *Appleby*, the ECtHR stated that "Article 10 ECHR does not grant a right to access to private property".

In my opinion, applying an alternative means of expression test in a conflict between freedom of expression and trademark rights is too restrictive. First, the cases about real property rights cannot be analogically applied to intellectual property rights cases. Real property rights

³² See e.g. Tsoutsanis, A. "The Biggest Mistake of the European Trade Mark Directive and Why the Benelux is Wrong Again: Between the European Constitution and European Conscience." *European Intellectual Property Law Review* (2006), p. 74-82.

³³ Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779.

³⁴ Directive no. 104/89/EEC, Article 5.2: "Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark."

³⁵ Benelux Court of Justice, 1 March 1975, 'Claerijn/Klarijn', NJ 1975, 472.

³⁶ ECtHR, 21 March 2000, *Andreas Wabl v. Austria*.

³⁷ ECtHR, 6 May 2003, *Appleby and others v. The United Kingdom*, 2003-VI.

grant wide exclusivity that is not bound by any aims. This includes the right to disallow access to protesters to a shopping-mall (Appleby). Trademark rights only grant limited exclusivity that is restricted by statutory limitations and the aim of trademark law, i.e. to increase competition in the market place and to ensure fairness between parties in trade.

Second, even in purely commercial cases, European rules on comparative advertising set aside an alternative means of expression test, if harm or drawing benefits is limited.³⁸

Third, applying such a test assumes that there are viable alternatives available to speakers. In many cases, there will be a no viable alternative to the use of a word-mark in a TLD. With regard to well-known trademarks it seems logical, that the more the trademark comes to represent an icon or a (social) phenomenon the greater is the need for protection of third parties' free expression rights.³⁹ This is in line with ECtHR jurisprudence that provides generally very strong protection to political expression and criticism, or parody.⁴⁰ I also think that generic uses of words should remain possible.

Criticism and Parody

In non-domain name cases, the right to criticize companies by the use and transformation of trademarks has been confirmed by various courts.⁴¹ The European Court of Human Rights states with regard to criticism:

*"Freedom of expression constitutes one of the essential foundations of such a society, one of the basic conditions for its progress and for the development of every man. Subject to paragraph 2 of Article 10 (art. 10-2), it is applicable not only to 'information' or 'ideas' that are favourably received or regarded as inoffensive or as a matter of indifference, but also to those that offend, shock or disturb the State or any sector of the population. Such are the demands of that pluralism, tolerance and broadmindedness without which there is no 'democratic society'."*⁴²

Jurisprudence with regard to domain name cases is divided on the issue of allowing criticism. In the light of the ECtHR's clear interpretation of Article 10, this is surprising, but it might be due to the fact that full recognition of freedom of expression by courts in this area of the law has yet to be achieved.

In France, the Supreme Court ruled in the "www.jeboycottedanone.fr" case, that a criticism site did not infringe the trademark right in "Danone".⁴³ In Germany, the right of e.g. Greenpeace to operate a critical website about the oil company Total-Fina Elf (www.oil-of-efl.de)⁴⁴ as well as a critical website about ESSO (www.stopesso.de) was upheld in two decisions.⁴⁵ In the latter case the German court held that "a company cannot use trademark law to prevent its name being used within the framework of a critical consideration of its activities".⁴⁶ Also, the Higher Regional Court of Hamburg confirmed the free expression right of ex-employees to operate a critical gripe website (www.awd-aussteiger.de).⁴⁷ In a case surrounding the website www.scheiss-t-online.de a German court,⁴⁸ and in a case about the website www.injeholland.nl a Dutch court⁴⁹ both found against the defendant's free expression right. Interestingly, in a "trademark.tld" case, the defendant's free expression right was held to trump applicant's trademark rights. The case involved the critical website

³⁸ Directive 97/55/EC; Case C-71/02 *Karner* [2004] ECR I-3025.

³⁹ Compare e.g. the judgment in *www.castor.de* (Regional High Court Hamm (Germany), 18 February 2003, 9U 136/02), where the court held that the name at stake had been come to signify a social problem rather than solely being a trademark.

⁴⁰ This protection not only accorded to journalists, but also to pressure groups or individuals that operate on the Internet. ECtHR, 15 February 2005, *Steel and Morris v. The United Kingdom*.

⁴¹ See e.g. Paris Court of Appeal, 16 November 2005 (Esso); Paris Court of Appeal, 17 November 2006 (Areva); German Supreme Court, 3 February 2005, BGH I ZR 159/02 (Milka).

⁴² ECtHR, 7 December 1976, *Handyside v. The United Kingdom*, Series A Vol. 24.

⁴³ Paris Court of Appeal, 30 April 2003, *Assoc. Le Réseau Voltaire pour la liberté d'expression v. Sté Gervais Danone*, 2003 D. AJ 1760.

⁴⁴ Kammergericht Berlin, 23 October 2001, KG5 U 101/01.

⁴⁵ Hamburg District Court 10 June 2002, 2002 MD 9, at 947.

⁴⁶ *Ibid.*

⁴⁷ Regional High Court Hamburg, 18 December 2003, 3U 117/03.

⁴⁸ Regional Court Düsseldorf, 30 January 2002, 2a O 245/01. The worrying reasoning of this court was that a private person operating a complaint forum, is furthering the interests of competitors, and is therefore operating "in trade".

⁴⁹ The Hague District Court, 21 June 2005, KG 05/447.

www.castor.de that lobbied against the company's involvement in atomic waste transportation. The court held that the name at stake had been come to signify a social problem rather than solely being a trademark.⁵⁰

Also under the Uniform Dispute Resolution Policy numerous decisions have been taken in cases where free expression and trademark rights were involved. In particular, disputes involving critical "trademark.com" and "trademarksucks.com" sites have been the subject of adjudication. The UDRP acknowledges that there has to be a balance between trademark rights and freedom of expression, but UDRP Panels seem split on the issue of allowing such sites. In some "trademark.tld" cases panels have found for the alleged infringer on grounds that they were engaging in legitimate criticism.⁵¹ However, panelists also often find "trademarksucks.tld" sites confusing and do not easily recognize that "legitimate criticism" was at stake.⁵²

With regard to a case involving commercial aims, the German Supreme Court recently confirmed that freedom of expression does provide a defense in trademark disputes. In a case involving a humorous post card, it clarified that, even where there are certain commercial aims involved, i.e. the sale of a postcard, a parody of a trademark can be justified by artistic freedom.⁵³ This court made it quite clear that *"if the postcard does not vilify the plaintiff's trade mark and if it is not shown that the defendant was solely pursuing a commercial objective, the protection of artistic freedom must prevail..."*⁵⁴

Generic Uses

Another key problem with extending trademark protection to domain names or TLDs is, that ordinary language, i.e. generic, uses will be sanctioned. In a Dutch case, Kimberly Clark, holder of the trademark "page" for toilet paper objected to the use of the domain name "page.nl".⁵⁵ The company lost because the court recognized that page is an ordinary English and French word and that this provided a "due cause" to use the trademark. This seems to be in line with the above argument that generic terms should remain available to domain name or TLD applicants.

Conclusion

To conclude, the relationship between trademark law and freedom of expression is far from settled in the European context. However some conclusions might be drawn from the preceding paragraphs.

- First, only trademarks that receive anti-dilution protection should be protected in TLD policy.
- Second, where no commercial aims are at stake, anti-dilution protection of trademark law should not apply.
- Third, in case of bad faith, like clear cut cyber-squatting (where a party has the intention to solely gain profit from registering a TLD without any expressive intention or effect what so ever) freedom of expression cannot set aside valid trademark rights.
- Third, in cases that are in between these extremes, a delicate balance must be sought. The presence of a commercial aim of the speaker is not sufficient to conclude that freedom of expression does not apply.
- Applying an "alternative means of expression" test may infringe free expression rights in particular with regard to well-known trademarks and generic words.
- According to the ECtHR criticism must receive strong protection.

⁵⁰ Regional High Court Hamm, 18 February 2003, 9U 136/02.

⁵¹ See e.g. WIPO Arbitration and Mediation Center, 22 April 2004, Case no. D2004-0014, "hja.com".

⁵² See e.g. WIPO Arbitration and Mediation Center, 12 November 2001, Case no. D2001-1195, "philipsucks.com"; WIPO Arbitration and Mediation Center, 20 July 2000, Case no. D2000-0477, "walmartsucks.com".

⁵³ German Supreme Court, 3 February 2005, BGH I ZR 159/02 (Milka).

⁵⁴ Ibid., translation taken from Geiger, C., *Trade Marks and Freedom of Expression*, IIC Vol. 38 (2007), p. 322.

⁵⁵ Regional Court Amsterdam, 17 October 2002, *Page.nl, Domjur.nl* nr. 2003, p. 32.

4. Importing Standards of Unfair Competition and Trademark Law into TLD Policy

Recommendation 2: - 18 June 2007	Strings must not be confusingly similar to an existing top-level domain.
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Discussion

Because of Prof. Haight Farley more elaborate answer on this point, I want to keep this discussion very short. This standard of confusion is simply too restrictive.

With this recommendation, ICANN is importing a standard from trademark law into TLD policy. However, ICANN needs to realize that these trademark standard may be misplaced in a TLD policy. As already elaborated in the preceding paragraphs, trademark law and domain names serve different functions. Notably, trademark law does not apply outside trade. In addition, trademark law knows various limitations and applies the confusion test only to concrete situations.⁵⁶ If ICANN applies this standard to all expression it will subject non-commercial expression to unduly stringent criteria that might violate applicant's free expression rights.

Accordingly, while situations of running bad faith typo-squatting registries should be avoided,⁵⁷ I must urge ICANN to amend Recommendation 6 with a reference to respect of applicant's free expression rights and to limit Recommendation 6 in line with trademark law, i.e. to apply it only to situations in trade and to make include limitations that allow referential use and free expression.

5. Freedom of Expression, Morality and Public Policy

Recommendation 6 18 June 2007	Strings must not be contrary to generally accepted legal norms relating to morality and public order that are enforceable under generally accepted and internationally recognized principles of law. Examples of such limitations that are internationally recognized include, but are not limited to, restrictions defined in the Paris Convention for the Protection of Industrial Property (in particular restrictions on the use of some strings as trademarks), and the Universal Declaration of Human Rights (in particular, limitations to freedom of speech rights).
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Discussion

In my opinion, this is the most problematic recommendation. It brings up two distinct problems. First, on a political level, it might be unwise for ICANN to adopt a provision on morality and public order. Second, on a judicial level, it seems that the GNSO is also here trying to apply restrictive unfair competition standards to all parties. I shall briefly elaborate on these two problems.

Opening the Gate for Restrictive Local Standards

⁵⁶ Compare the Statement by Prof. Haight Farley.

⁵⁷ A clever typo-squatter recently revealed that he had almost achieved this by concluding a deal with Cameroonian officials, country code ".cm", to register large number of sites with names identical to high traffic ".com" sites. People, who would wrongly enter "site.cm" in stead of "stie.com" in the address bar of their browser, would end up on his sites that showed no more than advertisements. www.cnnmoney.com, 22 May 2007.

ICANN must understand that it will be engaging in censoring expression on the basis of political preferences in an area where uniform international rules on free expression do exist, but where political opinion greatly diverges. If Recommendation 6 is introduced, states with repressive attitude towards free expression might feel called upon to aggressively lobby for the respect of their restrictive local standards.⁵⁸

Domain names are of global reach and domain name censorship does have global effects. Global minimum standards of freedom of expression, like Article 19 ICCPR, and not local standards must therefore apply to TLDs.⁵⁹ Even countries like China, Iran and Tunisia are bound by the ICCPR.⁶⁰ But if ICANN introduces Recommendation 6, it will open an easy procedure for governments to push forward restrictive policies.

The dilemma is that ICANN will likely be putting itself into a position, where it must defend free expression rights as granted by Article 19 ICCPR against the will of its constituents. I wonder whether ICANN will be able to provide the kind of judicial impartiality that is needed for this process. Experience with the “.xxx” domain would lead one to conclude the opposite.⁶¹

In light of this experience and in light of the democratic legitimacy problems raised under heading 1. above, I urge ICANN to reconsider adopting Recommendation 6. Should ICANN choose to regulate on basis of recommendation 6, adjudicators at ICANN need to understand how limits on freedom of expression must be assessed.

Morality, Public Order and Freedom of Expression

The GSNO states that Recommendation 6 is borrowed directly from trademark law. The GSNO also makes reference to Article 19.3 ICCPR and its provision on limitation of freedom of expression for reasons of morality. However morality in trademark law and in freedom of expression must be interpreted differently.

Morality, Public Order and Trademark Law

In Europe, provisions on morality and public order in trademark law are rarely used. European trademark law restricts the registration of trademarks that are contrary to morality or public order,⁶² but registration practice shows that numerous sexually explicit terms are registered as trademarks as well as terms that might be offensive to various religious groups.⁶³ In addition, as Prof. Haight Farley rightly points out, these provisions do only apply to trademark registration and not to trademark use *per se*. Accordingly, trademark law and practice does not mandate a general prohibition on terms that are contrary to morality or public order in TLDs.

Morality, Public Order and Freedom of Expression

Article 10 ECHR protects opinions that “*shock, awe or disturb*”. This is demanded by pluralism, tolerance, and broadmindedness “*without which there is no 'democratic society'*”.⁶⁴ Article 10.2 allows certain restrictions due to morality and public order. For instance, hate-speech (e.g. racist propaganda) is not protected under Article 10 ECHR. Hate-speech is considered to violate the values that underlie the ECHR itself (e.g. protection of the dignity of humans). Therefore, it is contrary to Article 17 that prohibits invoking the Convention for actions that are aimed at the destruction of rights under the same Convention. It is in this

⁵⁸ Compare the recent successful attempt by China to lay its will upon the United Nations Human Rights Council. www.bbc.co.uk, 19 June 2007.

⁵⁹ There is of course a difference with respect to national TLDs.

⁶⁰ See www.unhchr.ch.

⁶¹ See *ICANN Board Vote Signals Era of Censorship in Domain Names*, www.ipjustice.org, 2 April 2007.

⁶² Directive no. 104/89/EEC, Article 3.1.f; Regulation no. 40/94/ EC, Article 7.1.f.

⁶³ There are various E.U. trademark registration that feature sexually explicit terms or the words “God” or “Allah”. Compare also the U.S. Trademark Registration nr. 2806237 “Made in Allah’s Image” with the recent tensions arising from the publication of cartoon depicting Allah and the prophet Mohammed.

⁶⁴ ECtHR, 7 December 1976, *Handyside v. The United Kingdom*, Series A Vol. 24.

context that the ECtHR has tolerated criminal provisions that sanction holocaust denial.⁶⁵ Article 20 of the ICCPR is even clearer. It provides that “*any advocacy of national, racial or religious hatred that constitutes incitement to discrimination, hostility or violence shall be prohibited by law*”.

The ECtHR does however assess the kind of expression at stake always on a case by case basis. This means that it considers not all the facts of a concrete case including the expression itself, but also the identity of the speaker and the recipients. Applying this to TLDs that would mean that granting the right to run a registry of white supremacy sites under the TLD “.endloesung” (final solution) will not be protected by the ECHR, because it is racist. Granting the right to run a registry under the TLD “.holocaust” to a foundation that is devoted to the preservation of the memory of the holocaust may well be covered by freedom of expression.

Furthermore, morality has been successfully invoked before the ECtHR several times to restrict free expression.⁶⁶ It is worthwhile noting that the ECtHR leaves to states a “wide margin of appreciation” in cases concerning morality. This means that it conducts only limited review of national decisions because it realizes that standards of morality are not uniform around Europe. Still national courts must consider which restrictions on freedom of expression are strictly necessary in a democratic society and they must allow opinions that shock, awe and disturb.

In my opinion, the respect for diverse moral standards makes sense when dealing with cases coming from the 46 ECHR Member States. However, with respect to TLDs that have global reach, the argument of diverse moral standards is less convincing.

Conclusion

- For political reasons, ICANN might want to reconsider adopting Recommendation 6.
- Standards of morality and public order similar of those are included in trademark law cannot be applied to non-commercial TLD applicants. In addition, in Europe, these trademark standards seem to carry little force.
- Morality and public order are accepted as limitations upon freedom of expression in Europe. For instance, hate-speech is not protected under the ECHR. However, also in cases involving morality limitations must not go further than what is necessary in a democratic society. Opinions that shock, awe, and disturb must be allowed.
- The ECtHR respects moral diversity amongst ECHR Member States. However, with respect to TLDs that have global reach, the argument of diverse moral standards is less convincing.

6. Summary of the Arguments

ICANN’s Law-making capacity:

- ICANN’s legitimacy in law-making may be disputed.
- Therefore, at a minimum, there must be a possibility to appeal TLD decisions of ICANN.
- In addition ICANN might want to restrict its regulations to what is strictly necessary from a technical viewpoint.
- ICANN’s gTLD policy should respect all relevant international law. This is mandated by ICANN’s special position vis-à-vis applicant and by ICANN’s own Articles of Incorporation.

Recommendation 3:

- Only trademarks that receive anti-dilution protection should be protected in TLD policy.
- Where no commercial aims are at stake, anti-dilution protection of trademark law should not apply.

⁶⁵ CASE. Laws punishing holocaust denial exist for instance in Austria, Belgium, the Czech Republic, France, Germany, Israel, Lithuania, Poland, Slovakia, and Switzerland (source BBC).

⁶⁶ E.g. ECtHR, *Otto Preminger Institut v. Austria*, Series A 295-A; ECtHR, 10 July 2003, *Murphy v. Ireland*, 2003-IX.

- In case of bad faith, like clear cut cyber-squatting (where a party has the intention to solely gain profit from registering a TLD without any expressive intention or effect what so ever) freedom of expression cannot set aside valid trademark rights.
- In cases that are in between these extremes, a delicate balance must be sought. The presence of a commercial aim of the speaker is not sufficient to conclude that freedom of expression does not apply.
- Applying an "alternative means of expression" test may infringe free expression rights in particular with regard to well-known trademarks and generic words.
- According to the ECtHR criticism must receive strong protection.

Recommendation 2:

- ICANN should amend Recommendation 2 with a reference to respect of applicant's free expression rights and it should limit Recommendation 2 in line with trademark law, i.e. to apply it only to situations in trade and to make include limitations that allow referential use and free expression.

Recommendation 6:

- For political reasons, ICANN might want to reconsider adopting Recommendation 6.
- Standards of morality and public order similar of those are included in trademark law cannot be applied to non-commercial TLD applicants. In addition, in Europe, these trademark standards seem to carry little force.
- Morality and public order are accepted as limitations upon freedom of expression in Europe. For instance, hate-speech is not protected under the ECHR. However, also in cases involving morality limitations must not go further than what is necessary in a democratic society. Opinions that shock, awe, and disturb must be allowed.
- The ECtHR respects moral diversity amongst ECHR Member States. However, with respect to TLDs that have global reach, the argument of diverse moral standards is less convincing.

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