



AIPPI Position Paper

Comments and Recommendations on the proposal dated 29 August 2014 of the GAC sub-working group for the protection of geographic names in next rounds of new gTLDs

AIPPI and background to this Position Paper

The International Association for the Protection of Intellectual Property, generally known under the abbreviated name AIPPI, is the world's leading international organization dedicated to the development and improvement of the regimes for the protection of intellectual property.

It is a politically neutral, non-profit organization, domiciled in Switzerland which currently has almost 9000 Members representing more than 100 countries.

The objective of AIPPI is to improve and promote the protection of intellectual property on both an international and national basis. It pursues this objective by working for the development, expansion and improvement of international and regional treaties and agreements and also of national laws relating to intellectual property.

AIPPI operates by conducting studies of existing national laws and proposes measures to achieve harmonisation of these laws on an international basis.

AIPPI's Standing Committee on Trademarks has monitored and studied the discussion surrounding the 29 August 2014 ICANN Governmental Advisory Committee sub-working group (GAC) Proposal (the "**Proposal**") concerning the protection of geographic names in the new gTLDs process. The committee is particularly interested in the GAC Proposal as it has the potential to impact the rights of trademark owners who may wish to participate in future application rounds for new gTLDs and the committee has agreed on a position.

Although AIPPI as a whole has not officially adopted a position on the matter, in this Position Paper the views of AIPPI's Standing Committee Trademarks are presented by the AIPPI Bureau with the belief that they are useful and likely to represent the views of AIPPI as a whole.

Background to and summary of the GAC Proposal

The GAC in its Proposal refers to its 2007 document entitled "*GAC principles regarding new gTLDs*", in particular noting that "*[s]pecial attention was given to names with national, cultural, geographic and religious significance*". The 2007 document relevantly states:

"2.1 New gTLDs should respect:

...

(b) *The sensitivities regarding terms with national, cultural, geographic and religious significance.*

2.2 ICANN should avoid country, territory or place names, and country, territory or regional language or people descriptions, unless in agreement with the relevant governments or public authorities.

2.3 The process for introducing new gTLDs must make proper allowance for prior third party rights, in particular trademark rights as well as rights in the names and acronyms of inter-governmental organizations (IGOs)."

The GAC notes that these concerns “*were captured in the Applicant Guidebook*”. The Applicant Guide Book (AGB) defines “geographic names” with reference to several explicit lists and situations, and includes instructions for applicants who may wish to apply for related geographic names. The AGB also established ways in which governments could express concerns related to community, geographic, religious or other strings, including through “*early warnings*”, “*GAC Advice*”, and objection procedures.

The GAC subsequently issued Advice to the ICANN Board in its Durban Communiqué recommending that ICANN collaborate with the GAC in refining, for future rounds, the Applicant Guidebook with regard to the protection of terms with national, cultural, geographic and religious significance.

The GAC released its Proposal as a description of suggested steps in order to refine, for future rounds, procedures to be followed by applicants and changes to the AGB with regard to the protection of geographic names.

The GAC’s primary motivation for its Proposal appears to be that in the current gTLD application round, “*consultations did not happen with some geographic names requested by applicants*” despite a provision in the New gTLD Applicant Guidebook noting that “*[i]t is in the applicant’s interest to consult with relevant governments and public authorities*”.

The essence of the GAC’s Proposal is that “*[g]eographic names should not be allowed to be registered as gTLDs, unless requested by the relevant communities where they belong or after a specific authorization given by the government or community to the applicant.*” The GAC Proposal suggests that names of geographic references like “*regions of countries, regions of continents, sub-regions of countries, rivers, mountains, among others*” should be protected.

Fundamentally, the GAC Proposal would provide that in any situation whereby an applied-for gTLD string matches a “geographic name”, it is both in the public interest and the relevant government’s right to require that the applicant receive approval for the gTLD application.

Analysis

1. The GAC Proposal fails to balance governmental sensitivities and the rights of trademark holders in accordance with GAC principles and applicable laws

The GAC Proposal is motivated to provide protection to geographical names in response to government sensitivities. The Proposal seeks to accomplish this by requiring all applicants for strings with any geographic connotation to obtain the support of a relevant government authority/ies. The Proposal goes beyond the current protections affected in the AGB, where governmental support was required only in limited situations. All in all, the GAC Proposal fails to balance governmental

sensitivities and the rights of trademark holders in accordance with GAC principles and applicable laws.

It is important to note that no international legal instrument provides for the absolute protection of names of geographical significance. Specific protections which may be afforded by governmental authorities are limited to its sovereign jurisdiction, and do not have force internationally. The protections being proposed, in addition to those already in place in the AGB, do not accord with any internationally-recognized legal principle or document. The GAC, by referring to “*national sensitivities*” and “*public interest*”, is relying on a much more subjective, albeit legitimate, basis of concern.

In contrast, it is a recognized principle that geographic names may be used as trademarks under certain circumstances. Indeed, the GAC Proposal fails to appreciate that in many instances a geographic name may have several, unrelated connotations of a generic or descriptive nature or may be used in an arbitrary manner. The protection of marks with geographic significance which are afforded under trademark law is a recognition of the several connotations such terms may have, and the protection of such marks benefits the public interest through its function as a designator of the source or origin of products or services.

The GAC recognized in its 2007 “*GAC principles regarding new gTLDs*” that the introduction of new gTLDs should respect sensitivities regarding terms with national, cultural, geographic and religious significance, and that ICANN should avoid using geographic names unless in agreement with relevant governments or public authorities. The same document furthermore provides that the process for introducing new gTLDs must make proper allowance for prior third party rights, in particular trademark rights.

The concerns of governments and trademark holders are both legitimate and must be balanced, as recognized in the “*GAC principles regarding new gTLDs*”. This balance is also reflected in the ICANN Bylaws at Article I, Section 2.6, which states that ICANN should “[i]ntroduc[e] and promot[e] competition in the registration of domain names where practicable and beneficial in the public interest.”

The GAC Proposal in essence would provide governments with a unilateral ability to control the use of a geographic name, which does not make adequate provision for the legitimate interests of trademark owners and runs counter to the public interest established in trademark law and invoked by the GAC and ICANN.

2. The GAC Proposal’s definition of a “geographic name” over reaches and is unworkable

The GAC Proposal suggests that new gTLDs “*that are related with words, strings and expressions that refer to different names of geographic references like regions of countries, regions of continents, sub-regions of countries, rivers, mountains, among others, should be protected in the name of public interest, due to their geographic cultural and national relevance.*” The Proposal further indicates that the meaning of the applied-for gTLD string should be considered in multiple languages. Therefore, in stark contrast to the explicit definition of protected geographic names in the AGB, the current Proposal lacks any definite bounds about what may be considered a “geographic name”. The GAC Proposal’s definition of a “geographic name” thus over reaches and is unworkable.

Whereas ICANN may have a stronger argument for making general restrictions as to the use of country names as gTLDs, the broader question of the protection of other geographic names is a complex matter. The protection afforded to the range of geographic names within the GAC Proposal definition is subject to considerations on the international, national, and local level, and may be applied inconsistently among separate gTLD applications.

Diverse considerations and potentially inconsistent application of the general principles of “public interest” and “national sovereignty” invoked by the GAC Proposal equally apply.

Further, a geographic term may be of concern to several, possibly unrelated governmental units, creating ambiguity as to the appropriate governmental authority/ies and applicable laws.

In any event, it is clear from the foregoing that the proposed definition of “geographic name” and reference to vague notions of “public interest” and “national sovereignty” extends governmental influence far beyond what is necessary to address “sensitivities regarding terms with national, cultural, geographic and religious significance”. The GAC Proposal furthermore creates in many circumstances a complex and potentially unresolvable conflict of interests among governmental authorities.

The GAC Proposal therefore over reaches and is unworkable, as it extends government influence in a potentially indeterminable manner beyond what is necessary to address government sensitivities without balancing the legitimate interests of trademark holders.

3. The GAC Proposal places an undue burden on applicants

The GAC Proposal that a gTLD applicant must perform research to determine whether a chosen gTLD string has any possible meaning or connotation of geographic, national or cultural significance in multiple languages and thereafter to obtain the approval, support, or non-objection of relevant governments puts an undue burden on applicants.

Practically, given the open-ended definition of “geographic name” and the requirement on the applicant to consider all possible meanings of the applied-for string, applicants will be forced to undertake significant research and cannot be ensured that such research is completely exhaustive and sufficient to discharge its burden.

If some connotation of geographic significance is discovered, the applicant would then need to identify the appropriate authority/ies and obtain approval, support, or the non-objection of the relevant authority/ies. Again, given the ambiguity, the applicant may need to undertake significant research and cannot be ensured that any support or non-objection it may receive is sufficient to discharge its burden.

Furthermore, given that a chosen gTLD string may be discovered to have only limited geographic, national or cultural significance and where the relevant government body may have no desire or ability to support or object to the use of such term, the GAC Proposal places an undue and disproportionate burden on the applicant relative to the government sensitivity, if any, that may exist.

4. The GAC Proposal places an undue burden on governmental authorities

By extending the definition of “geographic name” as proposed, the GAC Proposal places an undue burden on governmental authorities who must respond to applicant queries.

The broad conception of protection envisioned by the GAC Proposal will expose an indeterminate number of government representatives, likely uninformed as to the nature of the ICANN process of gTLD application, to applicant requests for legal documentation that may be difficult or impossible to produce. This may require government representatives to consult with other authorities and require significant effort for resolution. Additionally, the applicable time constraints may require government representatives to operate in an expedited fashion.

Accordingly, GAC should consider that any obligation to engage with government authorities be tailored so as to reduce the burden on both government representatives and the applicants who may be required to engage them.

5. Mechanisms already exist to protect interests in geographical terms

Lastly, while the GAC Proposal appears to be motivated by concerns arising during the current gTLD application round that consultations did not happen regarding some geographic names, the GAC does not explain how such concerns warrant a significant and unilateral increase of restrictions during the application process.

The GAC acknowledges that the concerns raised by the 2007 “*GAC principles regarding new gTLDs*” were incorporated into the AGB, and that the AGB provided for a range of opportunities for governments and concerned community members to object to the use of certain, sensitive strings.

The GAC Proposal does not explain how the balance achieved in the AGB between applicants and governments through the AGB restrictions, early warnings, GAC Advice, and objection procedures failed to provide adequate protection for government sensitivities. It seems that for the vast majority of applications, no significant research or consultation was undertaken or needed, and in the event that increased scrutiny was required, it occurred in an environment which allowed for expert consideration and deliberation by relevant governments at an appropriate time.

As the GAC Proposal identifies interests which are significant to both governments and applicants, and the AGB already incorporates protections in a manner which balances the rights and obligations of governments and applicants without placing undue burden on either, it is suggested that the GAC’s concerns should rather be incorporated in a manner which takes advantage of the protections which are already afforded under the AGB.

Conclusion

Concluding, the GAC Proposal is problematic on a number of levels. Although the motivation of the GAC and its sensitivity to issues of a geographic nature is understandable to some extent, the GAC Proposal places an unfair burden on trademark owners and is practically unworkable for the above-mentioned reasons.

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