The protection of geographic names in the new gTLDs process

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Prepared by Sub-working group for protection of geographic names in next rounds of new gTLDs

1. Mandate

During the 47 ICANN meeting in Durban the GAC recommended 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, in accordance with the 2007 GAC Principles on New gTLDs, as stated in section 7. a. GAC Durban Communiqué.

This document describes suggested steps in order to refine, for future rounds, procedures to be followed by applicants and changes to the Applicant Guide Book with regard to the protection of geographic names.

2. Background

The GAC of ICANN worked several months during 2006 and 2007 in the document called "GAC principles regarding new gTLDs" that was finalized by the GAC during the Lisbon ICANN meeting in 2007.

Full document can be found in this link:

http://archive.icann.org/en/topics/new-gtlds/gac-principles-regarding-new-gtlds-28mar07-en.pdf

Special attention was given to names with national, cultural, geographic and religious significance, as stated in the mentioned document:

- New gTLDs should respect national sensitivities regarding terms with national, cultural, geographic and religious significance
- New gTLDs should not prejudice the application of the principle of national sovereignty
- Internet naming system is a public resource and it must be administered in the public and common interest

Also other important reference in paragraph 2.2 of the same document:

- 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

These concerns were captured in the Applicant Guidebook ("AGB")

The AGB is a document that was always available for public comments and created in a bottom up process by the GNSO council and then reviewed by the whole community, including private companies and commercial brand owners.

Full text of the AGB can be found in this link:

http://newgtlds.icann.org/en/applicants/agb

In the case of geographic names, the Applicant Guidebook establishes what a geographic name is:

- Capital city names
- City names where applicants declare that they intend to use the gTLD for purposes associated with the city name
- Sub-national place names listed in the ISO 3166-2
- Regional names appearing on the list of UNESCO regions
- Regional names on the UN's "Composition of macro geographical (continental) regions, geographical sub-regions, selected economic and other groupings

Although these definitions of what is a geo name include approx. 5.000 names, it does not cover all the possible geo names in the world.

For this precise reason and in the event of any doubt or concern, the AGB establishes that:

> "It is in the applicant's interest to consult with relevant governments and public authorities and enlist their support or non-objection prior to submission of the application, in order to preclude possible objections and pre-address any ambiguities concerning the string and applicable requirements"

These consultations did not happen with some geographic names requested by applicants in the first round of newgTLDs.

The AGB establishes ways in which governments can express concerns related with community, geographic, religious or other scripts. These processes are all explained in the AGB:

- Early warning: message sent to the applicant expressing concerns of one or more governments.

- GAC Advice: message sent from the GAC to the Board expressing concerns from the GAC related with one string.
- Objection: Independent Objector - Governments – Private – ALAC

Finally, the recently Approved Resolution of the New gTLD Program Committee[1] about GAC adive on ".amazon" and the analysis made by the independent third-party expert, bring new considerations about new gTLDs, trademarks and geographic names, which are detailed in section 4 of this document.

3. The protection of Geographic Names

The protection of geographic names should be object of special concern within the new gTLD program[2] . ICANN as an institution is committed to acting on public interest[3] , and therefore 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.

Although there are references that prevent the use of geographic names in new gTLDs included in the Applicant Guidebook, this list is limited and not sufficient to avoid the misuse of other geographic names and to protect the public interest in its entirety. It includes a limited amount of names and it does not protect in any way the diversity of places and geographic names that can be found all around the world.

Special attention should be given to the issue of geographic gTLDs as a concept (in generic terms), as they intersect with core areas of interests of any state.

Contrary to the principle of freedom of use of geographic names, allowing private companies to register geographic names as part of gTLDs strings creates a high risk for these names to be captured by companies that want to use them to reinforce their brand strategy or to profit from the meaning of these names, limiting the possibility of utilizing them in the public interest of the affected communities. Besides, the request for identity between the geographic name and the one utilized in the string, allows room for confusion in the public and consumers, as it is unavoidable that a geographic name will evoke the related geographical site and its population.

Geographic 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 national community and geographic meaning of the requested strings as new gTLDs must prevail above any other interest.

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[1] See https://www.icann.org/resources/board-material/resolutions-new-gtld-2014-05-14-en

[2] See GAC Principles Regarding New gTLDs, of 28 March 2007.

[3] See ICANN ByLaws, Section 2, "Core Values", and ICANN AoC with the Departament of Commerce, of 30 Sep 2009.

4. Differences between trademarks and new gTLDs

There are differences between the concept and scope of a Trademark and a TLD.

Trademark rights are conferred by States to individuals for the sole purpose of protecting the bona fide use of a mark in a specific category of products or services. There is no system of brands in the world to grant general rights on the use of a sign or name. The applicant of a trademark registrant shall inform the agency of each country, which is the current use that does or intends to do with that mark. The State grants the exclusive right to such use and no more than that.

Requested trademark applications have been ordered for specific products and services which demonstrates its own recognition of the limitation of the company's rights. In the national nomenclature of goods and services, in accordance with the Treaty of Nice, there are 45 classes of goods and services.

The document prepared by Dr Jerome Pasa, as a third-party expert[4] to provide additional advice on the specific issues of application of law at the case of ".amazon", includes several paragraphs that are of high interest to the subject of this document, which are detailed as follows:

Paragraph 15.1:

…….

"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 regional – 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.

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."

……

"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

[4] See https://www.icann.org/en/system/files/correspondence/crocker-to-dryden-07apr14-en.pdf

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 document states that exclusive right held by a company in its trade mark "does not therefore necessarily give it the right per se either to use it in any other form it may choose, such as a new TLD".

The document also express that a trade mark held by an applicant do not in legal terms give it a right to the new TLD of the trade mark.

5. Avoiding misuse of geographic names in future gTLD rounds

The lists of prohibited strings detailed in the Applicant Guidebook should be considered as a general reference for the applicant and not as a strict and only criteria to determine whether a name is geographic or not.

Governments should keep the right to oppose the delegation of a top level domain (even if it is not included on that list) on the basis of its sensitivity to national interests. Furthermore, that right should be enhanced for future rounds.

The flexibility and openness of criteria that applicants should have in relation with geographic names, especially in contacting previously to the application the relevant communities, does not undermine the multistakeholder structure and processes of ICANN and will not erode the confidence of global businesses.

On the contrary, a previous early contact with relevant communities and the applicant will generate confidence in the whole process and could also generate new ways of agreements among parties, before the conflict is established.

As stated in section 4 of this document and, an enhanced procedure to protect geographic names should not upset global trademark norms.

ICANN and Governments should encourage the applicants to get touch with related local governments to try to reach agreements. Dialogue and communication based on the laws and regulations is a better way to solve any difficulties. Furthermore, if the agreement between the relevant governments and the applicants can not be reached, the public interest should be priority.

6. Next steps

a. At the National / Regional Level

All countries should be encouraged to enhancing the ISO 3166-2 list by submitting official requests from national administrations, in a way that regions and sub-regions are included in this important reference list.

Special efforts must be done by ICANN to the broader international community, which is not comprised by GAC today.

GAC representatives and ICANN regional managers can actively engage in outreach efforts focusing in those countries not active in GAC meeting, GAC lists and ICANN activities, in order for them to be aware of future impact of this process.

The ISO 3166-2 list includes different types of country subdivisions names: districts, cantons, provinces, states, regions, cities, territories, among several others. The national reference in the ISCO 3166-2 list can be enhanced with these different divisions and subdivisions in order to satisfy the country needs.

b. Best practices for future rounds of new gTLDs

To be developed (by GAC + cross constituency group?) for future rounds of new gTLDs:

- For the applicant:
    - Once a sting is selected to be requested as a new gTLD, a thorough search should be undertaken to determine whether the string is a geographic name, including but not limited to cities, countries, regions, subregions or other geographic related spaces.
    - Sources of information on geographic names could be the general available information on the Internet, embassies, regional organizations, international organizations, national, regional and city governments, among others.
    - If the selected string is directly related with a country, city, region, subregion or other geographic related spaces, the relevant authorities related with these denominations should be contacted.
    - Related information can be accessed using Internet searches.

- Previous research and investigation about different meanings of the applied for string, considering also the notion of protection of a name even if it is being translated to another language.
- In the case of doubts, encourage the applicant to establish contact previous to the application with the relevant authorities of the country – city – region – subregion.

- For ICANN:
  - Enhance outreach efforts to all countries and regions of the world previous to the next new gTLD round.
  - Governments should have an appropriate way to raise concerns about the use of geographic names associated with their territories
- For Governments / Applicants / ICANN:
  - Establish a clear process for governments to raise their concerns when their territories names used in the next new gTLD round.
  - Establish clear steps / way forward for both the applicants and government in reaching consensus with the applied gTLD
  - What's next if there is no consensus reached between both parties.

c. Suggested changes in the Applicant Guide Book

Taking into consideration that the Durban Communiqué states that "The GAC recommends 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, in accordance with the 2007 GAC Principles on New gTLDs", a new text is suggested regarding the geographic names, in the case that the same text of the present AGB will be used as ground document:

To include in the paragraph 2.2.1.4 of the AGB the following sentence:

> **"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".**

Also the following paragraph appears in the section "***2.2.1.4.2 Geographic Names Requiring Government Support***" of the AGB. It should be a general statement or principle regarding geographic names, in order to clarify and reinforce the importance of the previous communication between the Applicants and the Governments, even in case of any doubt.

> **"Nevertheless, in the event of any doubt, it is in the applicant's interest to consult with relevant governments and public authorities and enlist**

their support or non-objection prior to submission of the application, in order to preclude possible objections and pre-address any ambiguities concerning the string and applicable requirements."

A specific reference to the Geographic Names Repository described in section 6.b of this document must be also included.

The suggested changes in the Applicant Guide Book, paragraph 2.2.1.4 of the AGB should read as follows:

"2.2.1.4 Geographic Names Review

Applications for gTLD strings must ensure that appropriate consideration is given to the interests of governments or public authorities in geographic names, ***taking into consideration that, according with the 2007 GAC Principles regarding New gTLDs, 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***. The requirements and procedure ICANN will follow in the evaluation process are described in the following paragraphs. Applicants should review these requirements even if they do not believe their intended gTLD string is a geographic name. All applied-for gTLD strings will be reviewed according to the requirements in this section, regardless of whether the application indicates it is for a geographic name.

"Nevertheless, in the event of any doubt, it is in the applicant's interest to consult with relevant governments and public authorities and enlist their support or non-objection prior to submission of the application, in order to preclude possible objections and pre-address any ambiguities concerning the string and applicable requirements."