

## **Comments on the Proposal of the ICANN GAC Sub-Group on Geographic Names**

### *Introduction*

In response to ICANN's invitation to comment on the recent (8/29/14) proposal by the GAC Sub-Group in relation to the protection of terms with national, cultural, geographic and religious significance, I submit the following.

I am the David L. Brennan Professor of Law at the University of Akron, and Director of the Center for Intellectual Property Law and Technology. My areas of expertise are Internet law and intellectual property law. I have published many articles in these areas in leading law reviews in the United States, the United Kingdom and Australia as well as being co-author of a leading cyberspace law casebook and sole author of *Internet Domain Names, Trademarks and Free Speech* (Edward Elgar, 2010) and *Rethinking Cyberlaw* (Edward Elgar, forthcoming, 2015). I am a frequent media contributor on issues relating to cyberlaw and the development of the Internet domain name system in particular.

I am pleased to have this opportunity to raise a number of concerns in relation to the GAC Sub-Group's proposal to amend paragraph 2.2.1.4 of the Applicant Guidebook for new gTLDs (hereinafter, "the Proposal").

The Proposal suggests imposing an obligation on ICANN to avoid the use of country, territory or place names and country, territory or regional language or people descriptions as new gTLDs *unless in agreement with relevant governments or public authorities*. It further suggests that in the event of any doubt there should be an obligation on the applicant to consult with relevant governments or public authorities to enlist their support *prior to submission of an application*.

Both of these obligations are practically unworkable and unnecessary, and neither comports with any existing principles of trademark or other law at the domestic level. Thus, along with the practical problems, on which the bulk of the following comments focus, in the absence of legal support for these proposals, ICANN would be effectively creating new law at an international level with no basis for doing so.

### *Pre-Emptive Rights in Words and Phrases*

There is no legal basis or precedent for creating pre-emptive rights in words and phrases an applicant may seek to secure as a new gTLD. While various countries' laws have always recognized legal rights and interests in words and phrases (trademarks, personal names, politically and culturally significant words and phrases), none of these rights is absolute. They are typically balanced against competing rights and interests in the relevant words and phrases. Governments have never had absolute dominion over any word or phrase related to their activities in the same way that trademark holders do not have absolute rights in their marks. Establishing a system that requires pre-approval by anyone to an

application for a new gTLD string thus runs counter to existing law. It would be akin to requiring anyone seeking to apply for a string corresponding to an existing trademark or personal name to secure the support of all those with an interest in the mark or name throughout the world. Such an approach would be unprecedented and unworkable.

Those who hold rights or interests in given strings are provided ample opportunity under the current new gTLD process to raise objections to an application on the basis of their competing interest after the application has been made. The same approach should apply to governments and public authorities who raise objections to new applications on the basis of their own rights or interests in a given string.

### *Practical Concerns*

There are a number of practical issues with the Proposal, including the following.

- (a) *Inconsistent Regulatory Approach to Previous Domain Name Regulation.* Requiring ICANN and applicants to seek pre-approval from relevant governments and public authorities runs counter to the way new developments in the domain space have previously worked. The domain name system has effectively developed in the past by keeping guidelines simple for registration and use of gTLDs and lower level domains, and building in dispute resolution procedures to deal with issues that arise in practice. The current Applicant Guidebook does build in the need to balance governmental and cultural interests in new gTLDs against those of applicants, by post-application objection procedures. These procedures are already proving to be effective in practice and do not require augmentation, particularly at this early stage of the development of the system. Adding new pre-registration requirements on top of those already in the Applicant Guidebook simply increases costs for applicants and may well chill innovations in the domain spaces.
- (b) *Identification of Relevant Authorities.* Imposing obligations on ICANN and applicants to identify and consult with relevant government and public authorities is likely to not only add significant expense, but also great confusion in terms of identifying the relevant government groups and public authorities. Even in the most basic example, say, the name of a city, it would not necessarily be clear whether ICANN and the applicant should consult with the local city authorities, or the authorities of the state, province, and/or country in which the city is located. Many cities and towns in different states, provinces, and countries also have the same name, which would arguably obligate ICANN and applicants to liaise with multiple authorities in multiple countries under the Proposal.
- (c) *Sufficient Consultation with/Support by Relevant Authorities.* The Proposal also says nothing about what would count as sufficient consultation on behalf

of an applicant or sufficient agreement on behalf of ICANN. In situations where some governments or public authorities are unresponsive to a request to support an application, would this count as a bar to a successful application, or would it be simply something ICANN would take into account in making a final decision? The Proposal is simply not clear on this point.

- (d) *Disagreement by Relevant Authorities.* The Proposal is also unclear about what would happen in a situation where relevant authorities disagree about whether an applicant's proposal should be supported. It is not unusual for more than one stakeholder to claim an interest in a particular string, and for those stakeholders to disagree as to whether there should be an objection to its use. One need only look at the decades of disagreement amongst native-American groups about the registration of the Washington Redskins trademark in the United States to see that even groups with significant interests in a name do not necessarily agree as to its use as a trademark. When similar issues are considered at a global level in the gTLD space it is more than likely that there will often, if not always, be some level of objection to use of a certain string as a gTLD in situations where the string has some geographical or cultural significance. The Proposal is silent on what level of objection or non-support should be sufficient for ICANN to refuse the application.
- (e) *Language.* Where different governments and public authorities are involved in pre-approval of applications and burdens are placed on applicants to consult with those authorities, significant language difficulties may come into play. The current Proposal implicitly places the time and cost burden of engaging interpreters and negotiating with those speaking different languages and holding diverse cultural expectations squarely on applicants. This should be the job of ICANN or ICANN's authorized dispute resolution experts, rather than applicants. Thus, it may be somewhat reasonable to expect ICANN to shoulder such burdens (as suggested in the Proposal), but applicants should not be required to shoulder them.
- (f) *Competing Government Interests.* The Proposal seems to implicitly assume potential conflict between governments and commercial interests (trademarks, tradenames etc) in the new gTLD space. It would not likely be effective in resolving potential conflicts between competing governments or public authorities with respect to a given string. If multiple cities or cultural groups claimed an interest the same name (for example, Berlin, Paris, Native American, Columbia), and one applied for the corresponding gTLD, would the applicant be at a disadvantage in having to secure support by a group that would naturally oppose the application? What if the government in Paris, France applied for ".Paris" and the government in the much smaller Paris, Texas did not support the application? How would such a conflict be resolved under the Proposal? While it may seem sensible that the city with whom most Internet users would identify the name should prevail (ie the French

city), the Proposal suggests that the name should not be granted over the objection of a government or public authority with an interest in the string. Thus the government of a smaller city or town could block an otherwise unobjectionable, and possibly socially useful, application for registration of a new gTLD.

(g) *Definitions of “Government” and “Public Authorities”*. These key terms in the Proposal are themselves vague and undefined. The concerns raised in the Proposal encompass more than names of cities, states and countries, and extend to languages and people descriptions. Yet, the Proposal itself contemplates there will be “governments” and “public authorities” whose support may be enlisted in approaching an application for a relevant string. This will often not be the case in practice. In many situations, the government of the territory in which a language or people is situated are not necessarily supportive of the rights of a given group and may not be the most appropriate body to negotiate with for rights in the string. Territories that are divided by religious, political or cultural conflicts are examples of this situation. There are also many countries in which native peoples assert rights independent of the official government. In such circumstances, how would an applicant identify the relevant body, or bodies, to liaise with to seek support for an application? Does the concept of “public authority” include the leaders of religious or cultural groups? It is simply unclear on the face of the Proposal as currently drafted.

#### *Specific Burdens on ICANN*

As suggested in paragraph (e) above, while it may be appropriate to impose certain burdens of the Proposal on ICANN, applicants should not be required to go to the time and expense of locating, consulting with, and enlisting the support of governments and public authorities prior to submitting their applications for new gTLDs.

With respect to the burdens the Proposal would place on ICANN in particular, to some extent the suggestions of the Sub-Group seem to simply duplicate what is already in place but, to the extent they go further, the obligations are also burdensome and untenable. Governments and public authorities already have the right to object to an application and ICANN has already built in methods of dealing with those objections in the Applicant Guidebook. To this extent, the Proposal is duplicative of what already exists.

To the extent that the Proposal goes further and implicitly suggests that ICANN should proactively seek out governments and public authorities with whom to consult prior to making a determination on a particular application, that suggestion is untenable and over-burdensome for many of the reasons discussed above. ICANN has already engaged in a multi-stakeholder process involving representatives of governments in the original design of the new gTLD process. It is not incumbent

upon ICANN to go further to identify and secure agreement by any government or public authority who may claim an objection to a new gTLD application in the absence of the lodging of a specific objection by that government or public authority.

### *Historical Development of the Domain Name System*

In the absence of an international treaty or accepted principles of international law that balance specific governmental and public interests against competing interests in a given gTLD string, it would be inappropriate and inconsistent with principles that have guided the historical development of the domain space for ICANN to now adopt such an approach. Since the inception of the system, dispute resolution procedures have been put in place to adjudicate conflicts about who should control a particular string in a particular level of a domain name. While these procedures are not perfect, they have allowed the system to inexpensively and organically develop to meet the needs of various online communities. Adopting proscriptive rules at this point would be inconsistent with the way the system has developed in the past and may well chill new online innovations.

### *Conclusions*

Overall, the Proposal is unnecessary, inconsistent with existing legal principles, inconsistent with the historical development of the domain name system under ICANN's stewardship, and practically unworkable. While the current system as set out in the Applicant Guidebook leaves room for disagreement on particular applications, the processes do allow for governmental and public interest objections to specific applications and that approach has been widely publicized and is consistent with previous developments in the domain name system. No regulatory approach to a global naming system with multiple stakeholders will ever be perfect, but ICANN has never taken an overly proscriptive approach to the system in the past, and it should not start now in the absence of more evidence that there are significant problems with the operation of the system. It is simply too early in the new gTLD process to know for sure whether additional pre-registration conditions are necessary, or whether they would chill innovation without any attendant benefits to the online community.

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