

The protection of geographic names in future rounds of New gTLDs

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Purpose of this presentation

- Work done by working group
- Explain contents of the new version of draft background paper
- Recieve comments from the community
- Define next steps

Mandate

Durban GAC Communique

7. Geographic Names and Community Applications

a. Geographic Names

- i. 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.

Background paper

- First draft prepared by Argentina and circulated within working group during February 2014.
- Comments received from working group and GAC before and during Singapore ICANN meeting.
- Second draft prepared by working group, based on comments received and after the Board decision about GAC advice for “.amazon”.

New draft background paper

- Background
- Protection of geographic names
- Differences between trademarks and new gTLDs: Analysis of the Expert Advice document requested by ICANN Board in relation with “.amazon”
- Avoiding misuse of geographic names in new gTLDs:
 - Possible actions at the national / regional level to protect geographic names
 - Suggested development of Best Practice Guidelines
 - Suggested refined text for AGB or other relevant document for new rounds of new gTLDs
- Next steps

Differences between trademarks and new gTLDs

Trademarks and new gTLDs

“Paragraph 15.1:.....

An intellectual property right is, 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.”

Differences between trademarks and new gTLDs

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

Differences between trademarks and new gTLDs

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

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.

Avoiding misuse of geographic names in new gTLDs

- Any lists must be considered only as a reference
- Governments should keep the right to oppose the delegation of a new gTLD even when not included in a list
- Dialogue and early contact between applicant and any authority related with the requested for string must be the first step before the application.
- A set of best practice rules can help enhancing the process and lowering uncertainties for the applicant
- Outreach efforts must be done by ICANN focusing in those countries not active in GAC meeting, GAC email lists and ICANN activities.

Possible Actions at the national - regional level

- Enhance the ISO 3166-2 and other lists that may be used as reference for future rounds, with those region names that are not included.
 - Every country must proceed independently.
 - No guarantee of success with ISO in order to safeguard the name of its cities, provinces, regions, subregions.
- Outreach efforts must be done by ICANN focusing in those countries not active in GAC meeting, GAC email lists and ICANN activities.

Development of Best Practice Guidelines

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

For the applicant should include:

- 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 any doubt, the applicant must establish contact previous to the application with the relevant authorities of the country – city – region – subregion.

Development of Best Practice Guidelines

For ICANN should include:

- Enhance outreach efforts to all countries and regions of the world previous to the next new gTLD round.
- 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 in relation with the applied gTLD.
- Embrace basic principles of international law.
- Inclusion of a pre-evaluation or pre-revision process.

Suggested text for future AGB or other future documents (1)

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.

Suggested text for future AGB or other future documents (2)

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.”

Next steps

Establish a cross community working group to develop policy in order to:

- Refine future AGB and relevant documents for future rounds of new gTLDs considering these issues.
- Develop a set of Best Practices rules for the use of geographic names in new gTLDs.
- Reinforce outreach initiatives.
- Define fair, effective and cost neutral dispute resolution procedures for governments to protect geographic names.

Comments?

Received:

- International law
- URDP
- ART Consumer protection AC

Welcome comments about:

- Document in general
- Geo Name lists: objective – limiting – confusing?
- Best practice rules: good idea?
- Cross community working group
- Ideas about concrete steps to move forward
- Consideration of geographic names at the second level
- Other issues?

Questions, comments?

Thanks!

Muchas Gracias!

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