

Comments on the proposal:

The Protection of Geographic Names in the New gTLDs Process

October 2014

1. Background

Background

A Government Advisory Committee (GAC) sub-working group for protection of geographic names in future new gTLD rounds has, independently of the GAC as a whole, developed a draft proposal: "*The Protection of Geographic Names in the New gTLDs Process*" (the "Draft Proposal"). The Draft Proposal has been put out for early comment to the ICANN community with a deadline of 15 November 2014.

The essence of the Draft Proposal is to prohibit the use of geographic and certain other terms as top-level domain name registries in future domain name application rounds unless applicants obtain permission in advance from relevant governments. The Draft Proposal references the GAC 2007 [Principles for new TLDs](#) of which the following excerpt is relevant:

"2.1 b) New gTLDs should respect: 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"

In applying these Principles *inter alia*, Specification 5 of the current ICANN Registry Agreement provides for reservation of names that are defined by published lists: namely two UN lists and the ISO-3166 list. The Draft Proposal is to extend these defined lists to an undefined concept that is described as the names of:

"regions of countries, regions of continents, sub-regions of countries, rivers, mountains, among others."

And it suggests a change to the ICANN Application Guidebook:

"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".

As a basis for the Draft Proposal, reference is made to the concepts of:

"the principle of national sovereignty" "sensitivity to national interest" "public interest" and "the principle of freedom of use."

These concepts are not explicitly in the text of the GAC 2007 Principles and are not well defined in the Draft Proposal.

For convenience, the Brand Registry Group (BRG) will use the phrase "geographically-related names" for names that have a possible association with a location and "culturally-related names" for names with a possible association with a language or a people.

2. Relevance to BRG

Future .brand applicants, who are eligible for membership within the BRG as “transitional members”, might be affected by the Draft Proposal.

3. BRG comments

The BRG welcomes the opportunity to comment on this Draft Proposal.

The BRG appreciates the spirit behind GAC principle 2.1b which references sensitivities to: *“national, cultural, geographic and religious significance.”*

The BRG also supports GAC Principle 2.3:

“The process for introducing new gTLDs must make proper allowance for prior third party rights, in particular trademark rights”

In our response to the Draft Proposal the BRG wishes to explore the relationship between these two GAC principles.

Geographically-related names may typically have one of three uses:

- a location
- a generic term
- a trademark unrelated to the generic or geographic use.

For example, EARTH can be geographic (the third planet from the sun), generic (soil and dirt) or a trademark (Earth for amusement park services, US registration 3339608). These uses all co-exist because they are used in different ways and have different meanings.

Similarly, culturally-related names may typically have one of three uses:

- a language or a people etc.
- a generic term
- a trademark unrelated to the generic or cultural use.

For example, AFGHAN can be cultural (a person from Afghanistan), generic (a knitted coverlet) or a trademark (Afghan for bread, Australian registration 1350078).

Domain names, in as much as they direct traffic to hosting servers, are nicknames for the corresponding Internet protocol addresses. They are not geographic names or brands unless specifically used in that manner.

In relation to domain names, the question behind the Draft Proposal is essentially as follows:

Is there a rationale for saying that geographical or cultural uses of geographically-related and culturally-related names should prevail over the general principals of freedom of speech and the protection of consumers through trademarks?

These are fundamental questions that the Draft Proposal does not explore. The BRG proposes the following considerations in answer.

1. **No case for primacy.** Ever since the signing in 1883 of the Paris Convention, countries have recognised the importance of both geographic names and trademarks. In addition, since the signing in 1948 of the Universal Declaration Of Human Rights countries have recognised the right to "*impart information and ideas through any media.*"

2. **Some trademarks and geographic terms may be related while some may appear related but are not.** It is the very nature of many trademarks that they have chosen to provide their indication of origin or their brand-character by a geographical association. Other trademarks may coincide with geographic terms, but there is no relationship between the geographic term and the origin of the goods. For example CLEVELAND golf clubs which are made in the US State of California (by a company started by Roger Cleveland in 1979) have no relationship to the city of Cleveland in the US State of Ohio.

3. **It is all about context.** The BRG believes the answer to the question is not one that can ever be absolute but can only be relative. In other words it all depends on context. In the context of globally accessible domain names at the top level, the primary significance of a term to Internet users may well be its significance as a brand and not its geographically-related significance.

It makes sense for a global brand to be the registry operator of a global top-level domain name not only because it enables Internet presence but also because it enables a trusted space free from common forms of phishing and fraud. In other words, a branded domain name is a means of protection of consumers from many of the problems that exist in certain open domain name registries. A village, a tribe or language community sharing that name are not denied a presence on the Internet by such registry operation. They may register within the context of their geographically-related name at the second-level and choose from a country code or from hundreds of top-level domain names: a registration that will cost a few dollars not hundreds of thousands. Or they may be the first to apply collectively for a new top-level domain name should they wish to do so.

4. Legal considerations and business certainty

Legal

The BRG believes that its members truly attempt to abide by and support international law. Its members also expect that the forum for changes to international law on trademarks, including the interplay of trademarks with geographically-related and culturally-related terms, remain within the Treaty organisations such as the World Intellectual Property Organisation (WIPO) as the administrator of the 1883 Paris Convention, the 1989 Madrid Protocol, and the 1994 Trademark Law Treaty; and the World Trade Organisation (WTO) as the administrator of the 1994 TRIPS Agreement (Trade-Related Aspects of Intellectual Property Rights).

ICANN is ill-suited to be a legislative body that promulgates, rather than applies, international law and should not be used as a vehicle to change established principles of international law.

Business certainty

In the current round it was appropriate that the GNSO, as the policy making arm of ICANN, applied the GAC Principles in a way that created transparency, fairness and certainty with three separate and wide-ranging multi-lingual lists of country and territory names. If a name was on the list, it was reserved: a sure signal to the applicant.

In the Draft Proposal, the required level of transparency, fairness and certainty is absent, meaning almost any future application may be challenged. The creation of vagueness and uncertainty is not something the BRG can support. Indeed the essence of .brands is the creation of trusted spaces for consumers. It is the experience of brands that uncertainty and vagueness run contrary to the pursuit of trust and consumer confidence.

Further, the proposal that such names might only be used with agreement between the relevant government and the applicant is unworkable. The potential for multiple co-existing uses of many names makes it impossible for an applicant to identify which government or community to contact. And who would have the deciding voice?

5. Conclusion

In conclusion, the BRG understands the origin of the concern that the Draft Proposal is meant to address but believes the proposed solution does not address the issue of context nor does it take into account the symbiotic relationship that exists between geographically and culturally related names, on the one hand, and brands and the consumers that the brands protect, on the other.

In the off-line world geographically-related and culturally-related names and trademarks have happily co-existed. It is the BRG's recommendation that this co-existence should not be interrupted by the on-line opportunity for top-level domain names.

The BRG stands ready to provide the GAC any further information or comments that it may need as it considers the Draft Proposal.

About Us

The Brand Registry Group (BRG) is an independent membership organisation of owners of a top-level domain name that matches their existing brand. The turnover of the respective groups behind these domain names is some \$1050 billion. The BRG is registered by Royal Decree as an international not-for-profit under Belgian law. It represents members' common interests and offers services paid for from fees.