



LEADERSHIP AND
MARKETING EXCELLENCE

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COMMENTS OF THE ASSOCIATION OF NATIONAL ADVERTISERS (ANA) ON THE PROPOSAL OF THE GAC SUB-GROUP ON GEOGRAPHIC NAMES

On behalf of the Association of National Advertisers (ANA), whose more than 640 members and over 10,000 brands represent virtually every category and service sector and collectively spend over \$250 billion in marketing and advertising, we thank the GAC for the opportunity to present our comments on the proposal of the GAC Sub-Group on Geographic Names (“The Protection of Geographic Names in the New gTLD Process”, v.3 – August 29, 2014), hereafter the “Proposal”.

Executive Summary

The Proposal, however well-meaning, in our view, would create an unsafe new domain name environment for advertisers, consumers, and brand owners. This new environment would undermine the international and national legal protection systems for trademarks and consumer protection laws, would create extremely vague new sources of GAC and local government objections leading to uncertainty and confusion for users of the system, and create new global law and policy on how geographic (“geo”) names are protected outside of the usual channels of law and policy making.

International Protection for Trademarks with Geographical Significance

The Proposal ignores the balance created between various interests and rights as found in the Applicant Guide Book (“AGB”). AGB Articles 2.1 and 2.2 on geo names must be read in conjunction with Article 2.3 which requires ICANN to respect trademark rights, whether involving trademarks with geographical significance or not. It is fundamental in trademark law that (1) if a geo name has no “place-goods” nexus (e.g., ALASKA brand bananas) it can be an inherently distinctive and protectable trademark and (2) if a geo name does have a “place-goods” nexus but has acquired “secondary meaning” through extensive use and advertising as meaning a trademark to the consumer (e.g., ZURICH brand insurance services), it can also be a protectable trademark. In GAC Chair Schneider’s intervention on the issue of geo names at the October 2014 ICANN meeting in Los Angeles, he indicated that geo names such as “Swiss” cannot be trademarks without an accompanying design or logo. This comment belies a misunderstanding of the two principles stated above. Virtually any geo name can be a trademark without a design or logo, if there is no “place-goods” nexus or if there is sufficient use or advertising (see the ZURICH example above). Brand owners may protect their brands and register them as gTLDs as needed to protect their brand and the consumer. Any term which may have geographical significance should not be carved out and prohibited from becoming a domain name. Objections by the GAC cannot violate international law on protection of trademarks and consumer protection, particularly if the GAC has no legal basis to do so.

Certain GAC countries try to assert “sovereign” rights, human rights, indigenous rights, and public interest to try to control the content of new gTLDs. If anything, these actions indicate an attempt by governments to assert censorship and abridgement of freedom of speech on the Internet, such rights of the individual and company clearly being recognized by international law. There are no clearly defined rights in this

group of assertions (sovereign, human, or indigenous rights, or public interest) which give any government or the GAC the right to veto any term which may have geographical significance. If such terms are worthy of global protection by governments, there are various ways legally they can be protected, including trademark law, geographical indication law, regulatory law, etc.

Finally, the Proposal relies on the dubious international law assertions by the French professor Jerome Passa to assert that brand owners should not have the right to use their marks on products and services and in advertising for their protected marks, but only have the right to exclude others from doing so. Moreover, GAC Vice Chair Cavalli, referring to Professor Passa, stated at the Los Angeles meeting that: “If you own a mark you are protected from others from using it but you do not have the right to use it for other things for example a gTLD.” Professor Passa is asserting this view as if it is a universally accepted point of view, but that is far from the case. In fact, it is not a global view as appropriate for ICANN activities. Many countries in their trademark statutes provide for the right to exclude others as well as to use a protected brand, a fact Professor Passa has significantly overlooked. This particular legal point is very important to advertisers and marketers, since it is the clear understanding of the community which ANA represents that they have the right to use the protected brands of their companies and clients in advertising and marketing, including doing so in websites and as domain names absent countervailing legally protected rights, not just stopping others from using these protected brands.

If the subject of revised geo name examination for the second round of gTLDs is to be discussed, we should have procedures which clearly reconfirm current AGB Article 2.3 and the existing international legal safeguards for trademarks, other forms of intellectual property, and consumer protection laws.

Significant Expansion of GAC Control Coupled With Vague New Criteria

Although the Proposal recommends significantly expanding the geo names under GAC review beyond the AGB, the new criteria will lead to an extremely slippery slope of misinterpretation and confusion. The Proposal expands the scope of geo names far beyond the AGB thus creating the situation that virtually any term which may offend local sensibilities may be subject to GAC veto. For example, such expressions as “territory or regional language”, “people descriptions” and “sub-regions” are subject to any number of divergent interpretations. Such obscure terms will be virtually impossible to find by conventional search methods. In fact, GAC Vice Chair Cavalli conceded in her presentation at the Los Angeles meeting that even she did not know there was a Berlin, Argentina when the “.berlin” gTLD application was being examined, or that “bar” was a town in Montenegro, thus creating discussions with this town when the “.bar” gTLD was being reviewed.

If the subject of revised geo name examination for the second round of gTLDs is to be discussed, we should first have a clear definition of what a “geo name” is, as GAC Chair Schneider correctly pointed out at the Los Angeles meeting. We should also have objective, verifiable, definitive guidelines which can be discussed one by one, not vague assertions of national interest or protection of people descriptions which are difficult to understand and apply in a practical manner to the application review process.

GAC Creating New International Law on Geo Names

Perhaps the most serious issue with the Proposal is it is trying to create new international law on the subject of geo names, without proper authority. ICANN is not a global, supranational legislature operated

by the GAC, nor was it intended to be. The issue of whether geo names are protected or protectable, on the Internet or not, is not new. These issues have been discussed in various diplomatic fora since the mid-19th Century, resulting in major treaties including the Paris Convention of 1883 and the WTO TRIPS Agreement of 1994, among many other treaties, local statutes and regulations, and bilateral investment agreements.

If the subject of revised geo name examination for the second round of gTLDs is to be discussed, we should have any new GAC proposals clearly subject to current law and policy making procedures, including the clear understanding that the GAC will not be creating new legal treaties or statutes, but rather recommending changes to ICANN procedures in conformity and always subject to local and international law.

Conclusion

The Proposal recommends an unprecedented expansion of protection of terms which may have geographical significance, to the clear detriment of brand owners, advertisers, marketers, and perhaps most importantly, consumers. Although the Proposal is meant to be in the “public interest”, promoting the public interest should be pursued by promoting the rule of law concerning how geo names are and are not legally protected. There is a reason the AGB as well as the various treaties were written in the way they were. The current Proposal should be either rejected or significantly rewritten to address the concerns raised above.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Dan Jaffe', written in a cursive style.

Dan Jaffe
Group Executive Vice President, Government Relations
Association of National Advertisers (ANA)