

**INTA Internet Committee Comments on  
“*The Protection of Geographic Names in the New gTLD Process*”**

**December 29, 2014**

**Introduction**

The Internet Committee of the International Trademark Association (INTA) welcomes this opportunity to present its views on the draft proposal entitled "*The protection of geographic names in the new gTLDs process*" (the Proposal) dated 29 August 2014 which was prepared by the Governmental Advisory Committee (GAC) Sub-group on Geographic Names. INTA welcomes the GAC's efforts to seek a dialogue on the potential issues arising out of the use of terms that have a national, cultural, geographic and religious significance in future gTLD applications rounds.

**Respect for Established Legal Norms**

Names that relate to geographic areas are understandably politically sensitive since they involve national pride and history. For 130 years since the Paris Convention for the Protection of Industrial Property in 1883, through the WTO TRIPS Agreement of 1994, the global community has debated how to best balance these national concerns with legitimate protection of trademarks, many of which have some form of geographical significance. Through the long line of global treaties, national statutes, bilateral and multilateral investment agreements, and court decisions since 1883, a vast body of international law has developed on how best to balance the sometimes competing interests of trademark owners and governments in this area of the law.

ICANN has acknowledged its obligations to operate within this body of law. In 2008, the Board of ICANN adopted a relevant 2007 GNSO Policy Recommendation on new gTLDs, stating:

Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law. Examples of these legal rights that are internationally recognized include, but are not limited to, rights defined in the Paris Convention for the Protection of Industry Property (in particular trademark rights), the Universal Declaration of Human Rights (UDHR) and the International Covenant on Civil and Political Rights (ICCPR) (in particular freedom of expression rights).

Moreover, the Applicant Guide Book (AGB) Article 2.3 requires that ICANN respect trademark rights, no matter what significance they may have. Thus, any proposal to amend the mechanisms for GAC treatment of geographic names must abide by international law and cannot infringe existing rights of trademark owners in their currently protected trademarks, both under national and international law. The Proposal, by allowing any government or the

GAC as a whole to object to any letter string which may have any possible geographical meaning or offend local sensibilities, goes far beyond current legal norms and in so doing, undermines longstanding protections for trademarks in international law as well as within ICANN itself.

In a [letter to the ICANN Board of Directors](#) dated 17 July 2013, INTA's Chief Executive Officer, Etienne Sanz de Acedo, provided input on the ".Amazon" application. This letter clearly stated INTA's position on this issue as follows:

INTA believes that the generally accepted principles of international law provide ICANN with a framework for assessing potential non-Community-based objections to the delegation of particular applied-for strings associated with geographic terms. These legal norms establish that states do not possess exclusive rights to geographic terms, and that the rights of trademark owners as established under international frameworks - including binding international treaties - must be recognized.

By this Proposal, the GAC (and by implication ICANN) would be able to create new law protecting geographical names that are not in themselves protectable under existing international legal frameworks. In so doing, ICANN will essentially create an unlawful power of veto, which has the consequence of nullifying trademark rights in circumstances where the governments have no legally recognized rights to assert.

Apart from the international legal issues, the Proposal itself is difficult to understand and implement even if there are countervailing governmental rights to assert. Such expressions as "territory or regional language", "people descriptions" and "sub-regions" create vast and vague new categories of strings that GAC members can object to with unchecked discretion. This form of open-ended grant of review to the GAC will create unfairness, uncertainty and illegality in the global domain name ecosystem.

To be sure, geographic names are a sensitive issue for governments. However, these same governments have obligated themselves to obey the rule of law, including protection of trademarks, and they must accept such rights even though they may find some aspects of such rights to be objectionable. The current Proposal, perhaps as an unintended consequence, attempts to re-write international law and policy on the protection of geographic names outside of proper international channels.

### **Competing Rights and Fair Balance**

INTA is keen to stress that there are a number of fundamental rights that are engaged when resolving conflict around the choice of string for new gTLD applications. These rights include, but are not limited to, nationals interests in geographic names, applicants' freedom to carry on business, applicants' trademark rights and Internet users' freedom to receive information. For example, the same name may have multiple legitimate uses and meanings, including:

- the same term may be used as a geographic name multiple times across different countries, or even within the same country;

- the same term may be both a geographic name and have other generic meanings;
- in some cases, the particular geographic name may have been adopted because the other generic meaning describes a characteristic of the place itself;
- many companies share their brand names, which are protected as registered or unregistered trademarks, with terms which are also used as a geographic name; and
- many companies share their brand names with other companies, sometimes used in respect of similar goods or services but in different legal jurisdictions, sometimes even in the same legal jurisdictions but in respect of different goods or services.

When dealing with competing rights, courts around the world are tasked with looking at the comparative importance of the rights engaged and the justifications for interfering with those rights. It is at this stage where public interest is taken into account in determining the "fair balance" to be struck. INTA believes that no single competing right should take priority over, or have a right of veto in respect of, another competing right as this would be contrary to established principles of international law. Accordingly, INTA asserts that no one stakeholder should have the right to prior consent over the choice of a particular string as this would ultimately be contrary to the public interest. Any attempt to carve out certain geographic terms based on a nation state's claim to have a sovereign right, where this is outside of the established intellectual property regimes, must be refused. It is by adhering to established legal principles that ICANN can ensure that its decisions will be aligned with promoting the public interest in the introduction of further rounds of new gTLDs.

### **Balanced Implementation of the GAC Principles**

The Proposal makes reference to the "GAC principles regarding new gTLDs" that were finalized by the GAC during ICANN's 2007 meeting in Lisbon<sup>1</sup> (the GAC Principles) and states that the concerns identified therein "were captured in the Applicant Guidebook." In fact, the reflection of aspects of the GAC Principles in the AGB was the result of significant policy development work on the part of the ICANN community as a whole in order to implement those principles in a manner intended to balance potentially competing interests fairly, and to create certainty for applicants by means of lists of specific terms.

Through the initial publication and subsequent iterations of the AGB, ICANN worked to develop the gTLD program by assimilating the GAC Principles, recommendations from the GNSO, internal consultations and public comments. This process resulted in the development of a framework that ensured that both principles of national sovereignty and private property rights were considered and balanced in the new gTLDs. This balancing exercise resulted in an AGB that prohibits the delegation of country and territory names as new gTLDs. In addition, the AGB identifies specific types of strings that are considered

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<sup>1</sup> <https://archive.icann.org/en/topics/new-gtlds/gac-principles-regarding-new-gtlds-28mar07-en.pdf>

"geographic names" as identified in section 2 of the Proposal, which must be accompanied by documented support or non-objection by the relevant government or public authority in order to be granted registration. Furthermore, ICANN developed Community Objection processes to address a government's potential concern with a specific new gTLD application.

The Proposal seeks to move away from these carefully balanced protections in a manner that would result in an unacceptable level of uncertainty for applicants as a result of the following factors, in particular:

- Lack of defined lists of geographic terms and the recommendation that potential future applicants should conduct their own investigations, including using internet searches to identify whether a term has any geographic connection whatsoever.
- Proposal that this should cover not just the name as used in the language of the country/region in question but all translations.
- Expectation that, having identified a geographic connection, or "in the case of doubts," the potential applicant will be able to establish contact with and obtain the permission from the correct person within "the relevant authorities of the country-city-region-subregion." This could be a multitude of different 'interested parties' who would all need to be identified and contacted, placing an undue burden on the applicant.
- Lack of acknowledgement of the fact that many names may have multiple uses, even in a geographic connection, and thus lack of any attempt to address how a conflict might be addressed where competing governments claim an interest in and take a different view on the treatment of a particular string.
- Expansion of the Proposal beyond geographic terms to the undefined "people descriptions" and terms of "national, cultural...and religious significance."

To illustrate the unacceptable burden this would place on a potential applicant, one should consider how an applicant would obtain permission in relation to a string that happens to match a geographic term relating to the name of a mountain or river that spans national borders, refers to a region that is also the home of one or more indigenous peoples or one that has been the subject of a longstanding and acrimonious territorial dispute as in the cases of Kashmir or Crimea. It seems almost inevitable that the governments engaged in such disputes would view ICANN as a new arena in which to fight a battle that has nothing to do with the applicant.

Even under the current rules set out in the AGB, the path to obtaining consent has hardly been clear, as is evidenced by the situation regarding .TATA. This application for a branded term was determined to also be a geographic name under 2.2.1.4 of the AGB, requiring documentation of support or non-objection. One assumes that the applicant believed it had duly obtained such support or non-objection, since the Extended Evaluation panel concluded "the documentation of support or non-objection provided has met all relevant criteria in Section 2.2.1.4.3 of the Applicant Guidebook." Notwithstanding this, the Director for Digital Economy at the Ministry of Industry, Trade, Investment and Digital Economy of the

Kingdom of Morocco has subsequently written ICANN stating that the Moroccan authority has not endorsed the application and objecting to the delegation of the string.

If situations like .TATA can occur even under the current rules, it is likely that significantly expanding the requirements for consent will result in greater lack of clarity and an unworkable procedure.

## **Conclusion**

Many of the safeguards that the GAC has called for, both in advance of the launch of new gTLDs and subsequently, have been for the benefit of brand owners, businesses and, importantly, have promoted consumer trust and Internet security. However, in light of the sweeping policy assertions in the current Proposal, it appears that the GAC representatives in the sub-working group have strayed from the objectives of these safeguards, disregarding relevant issues of international law. INTA encourages the GAC to abide by these existing constructs of national and international trademark law and stands ready to provide the GAC with whatever assistance and information it can on such matters.

It is important for INTA to point out that it is not just large corporations that will feel the impact of the Proposal. An overwhelming majority of the affected parties will be local businesses, which are even more likely to be using legitimate trademarks which are also geographic terms either in their own country or elsewhere.

With this in mind, INTA further emphasizes that it is important that the GAC consults with the entire ICANN Community in order to promote certainty, stability and fairness in the next application process, and to ensure that the consumer benefits that would be expected to flow from brand owner innovation in the gTLD space, such as the creation of secure and trusted online spaces free from counterfeits and fraudulent activity, do materialise. INTA welcomes the opportunity to work with the Community to ensure that this is achieved.

## **About INTA and the Internet Committee**

INTA is a 136 year-old global not for profit association with more than 6,400 member organizations from over 190 countries. One of INTA's goals is the promotion and protection of trademarks as a primary means for consumers to make informed choices regarding the products and services they purchase. During the last decade, INTA has also been the leading voice of trademark owners within the Internet Community, serving as a founding member of the Intellectual Property Constituency of the Internet Corporation for Assigned Names and Numbers (ICANN).

INTA's Internet Committee is a group of over 200 trademark owners and professionals from around the world charged with evaluating treaties, laws, regulations and procedures relating to domain name assignment, use of trademarks on the Internet, and unfair competition on the Internet, whose mission is to advance the balanced protection of trademarks on the Internet.