



SUMMARY OF INTELLECTUAL PROPERTY CONSTITUENCY COMMENTS ON “THE PROTECTION OF GEOGRAPHIC NAMES IN THE NEW GTLDS PROCESS”

INTRODUCTION

The Intellectual Property Constituency (“IPC”) welcomes the opportunity to provide this summary of its comments on “The Protection of Geographic Names in the New gTLDs Process,” which was prepared by the GAC sub-working group for protection of geographic names in future new gTLD rounds and proposes that “[g]eographic names should not be allowed to be registered as gTLDs, unless requested by the relevant communities where they belong or after a specific authorization given by the government or community to the applicant” (the “Proposal”). This proposed protection would extend to any and all names that in a government’s view are of national interest, including names of “regions of countries, regions of continents, sub-regions of countries, rivers, mountains, among others.” The Proposal identifies the bases for this prohibition as “the principle of national sovereignty,” “sensitivity to national interest,” “public interest,” the “principle of freedom of use,” and international law as a general concept. The IPC has concerns about several aspects of this Proposal, most notably because: (1) it appears to be based on an inadvertent misunderstanding or mischaracterization of trademark law; and (2) it prioritizes vague and indefinite government interests over rights that are explicitly and unequivocally recognized in international law.

The IPC has carefully reviewed the Proposal and is developing comments to further inform the ICANN community’s discussion of this critical issue affecting all internet users. We expect to finalize these comments over the next few weeks and will provide them to the ICANN community. In the meantime, we summarize these comments here.

- 1. International law and existing treaties explicitly recognize the property rights (i.e., trademark rights) at issue.**
 - a. The Proposal seems to accord improper legal weight to “the principle of national sovereignty” “sensitivity to national interest”, the “public interest”, and the “principle of freedom of use” which would prejudice and disadvantage private property rights that are explicitly recognized under international law and existing treaties.
- 2. International law does not provide a basis for the governmental consent requirement set forth in the Proposal.**
 - a. International law does not confer exclusivity upon governments relating to the use of geographic names in the Internet DNS, trademark law, or any other context. Instead, international law expressly rejects government exclusivity by requiring the recognition of private parties’ rights in trademarks and service marks, and geographical indications.
 - b. National borders limit the exercise of governmental rights on the basis of national sovereignty.
 - i. International law concerning protection of sovereign names and identifiers does not recognize geographic names outside a particular nation’s borders.
 - ii. Existing intellectual property treaties explicitly recognize and require nations to protect private parties’ intellectual property rights. Only through international law can there be recognition of rights in a geographic name outside a particular nation’s borders.

- 3. International law does not confer priority on governments relating to the use of geographic names in the Internet DNS, trademark law, or any other context.**
 - a. Several treaties of longstanding global effect such as the Paris Convention and TRIPS, to which numerous GAC members are parties, specifically recognize private parties' rights in geographic names as they comply with specific regimes of intellectual property such as trademarks and geographical indications. Examples of geographic trademarks are provided in Schedule One.
 - b. International law does not recognize governments' interests in geographic names. Prioritizing the government interests asserted in the Proposal over internationally recognized rights is inconsistent with international law.
- 4. The use of geographic names as gTLDs is not inherently contrary to the public interest and is entirely dependent on context.**
 - a. The Proposal assumes that use of geographic names such as gTLDs will evoke the geographic location and its population, thus inevitably leading to public and consumer confusion.
 - i. Context of use will be essential to consumer perception.
 - ii. The same geographic name may have multiple legitimate uses and meanings unrelated to a specific geographic location, or geography at all.
- 5. International law and the recognition of intellectual property rights provided by existing treaties embody jurisdictional limits on any potential national interest in a geographic name that must be acknowledged. Similarly, the multiple co-existing uses of many geographic names further underscores such limits.**
- 6. New gTLDs that correspond to trademarks serve the public interest as well as the interests of the trademark owner.**
 - a. Trademarks, and by extension new gTLDs of trademarked names, serve the public interest by preventing consumer confusion in the marketplace, thereby improving consumer trust and confidence in the domain name space.
 - b. International and national law recognize the ability of any term, including terms that in certain contexts may have geographical significance, to serve as trademarks, and by extension serve the public interest functions of trademarks as new gTLDs.
 - c. In many contexts, the primary significance of a term is its significance as a trademark and not its geographical significance. Thus, government interests in protecting geographical terms do not, and should not, have a *per se* primacy over private property rights in trademarks and corresponding new gTLDs, which also serve the public interest.
- 7. The international legal framework promoting trademark rights and the commercial realities associated with trademark use do not justify demoting or excluding trademarks as new gTLD strings based on commercial limits on trademark rights or the jurisdictional nature of trademarks.**
 - a. There is no international legal basis for elevating protection of geographical place names above geographical trademarks in the context of new gTLDs or indeed any other context.
 - b. Elevating geographic name protections above protections for trademarks that happen to be geographic terms in certain contexts is inconsistent with and contrary to global trademark norms.

- 8. The inclusion in the Proposal of terms which fall outside of geographic terms, namely “regional language or people descriptions”, could lead to unjustified suppression of a wide range of otherwise lawful potential gTLDs, to the detriment of any future new gTLD rounds.**
- a. Because the Proposal loosely refers to the 2007 GAC Principles, there is a very real possibility that “terms with national, cultural [or] religious significance” could also be excluded as potential new gTLD strings - despite having other meanings that do not have national, cultural, or religious significance.
 - b. Including these broad categories of terms creates a slippery slope that further undermines international legal principles and could result in unjustified exclusion of potential gTLDs that could deliver value to the community in future rounds.

The IPC appreciates this opportunity to provide its input on the Proposal. We anticipate providing our more detailed comments in the coming weeks, and look forward to continuing to participate in the discussion of this topic.

SCHEDULE ONE

NON-EXHAUSTIVE LIST OF FAMOUS BRAND NAMES THAT ARE ALSO GEOGRAPHIC NAMES.

DRAMBUIE –liqueur
KENT – cigarettes
BOURNVILLE – chocolate
IBIZA –clothing, leather goods, cars
DARTINGTON – glass
OLYMPUS – camera
PICCADILLY – CTM for watches
WATERFORD – crystal
CASABLANCA –computing, cigarettes, fans, food products – all owned by unrelated companies
TOLEDO – watches; flooring; tobacco products and services– all owned by unrelated companies
EMIRATES – airline
SANTANDER – bank
HALIFAX – UK building society
CARIBBEAN – binoculars and sports scopes
PERITO MORENO – beer and alcoholic drinks
MENDOZA – snack foods
BARILOCHE – food products; fungicides; jewellery – all owned by unrelated companies
BUXTON – water
YELLOWSTONE – scaffolding
TEXAS – clothing; semiconductors - both owned by unrelated companies
ANGLIA – windows
PERRIER -- water
EVIAN – water
SANTIAGO – scientific instruments
MONTEVIDEO – UK registration for sound recordings
MEISSEN – china products
AVON – cosmetics and skin care products
EVEREST – windows
STANLAKE PARK – wine
RUSCOMBE – another village in Berkshire as brand for wine
TY NANT – bottled water
MONTE CARLO – cookies
ANGUS – restaurant services
MARS – confectionery
VICHY - cosmetics (and water)
TUAREG – Car
CORTINA – Car
GRANADA - car
USHUAIA – showers
FUJI – photographic film
BRISTOL – planes and cars
BROMPTON – bicycles

WELL-KNOWN ARGENTINE BRANDS THAT ARE ALSO GEOGRAPHIC NAMES

Trademark	Class	Goods	Reg N°
Aconcagua Peaks	32	Beers and none alcoholics beverages	2,352,211
Aconcagua	5	Pharmaceutical and veterinary preparations	2,410,949
	42	Scientific and technological services and research and design relating thereto	2,018,123
	25	Clothing, footwear, and headgear	2,110,556
	39	Services or goods carrying people from one place to another by heavy truck and bus	2,036,491
	1	Essences for making perfumes and beverages	2,203,614
AAA Aconcagua	9	Data processing equipment and computers;	2,462,299
Aconcagua Park	41	Entertainment; sporting and cultural activities	2,471,178
Padrillos del Aconcagua	32	Beers; mineral and aerated waters and other non-alcoholic drinks	2,594,776
Conde de Aconcagua	33	Alcoholic beverages (except beers)	2,559,200
Bariloche	30	Sweets, candies and preparations made with cocoa.	2,180,949
Sierra de los padres	30	Coffee, tea, cocoa, sugar	2,002,283
	31	Agricultural, horticultural and forestry products	2,033,158
	32	Beers; mineral and aerated waters and other non-alcoholic drinks	2,586,687
Dulces de Tandil	29	Jellies and jams	2,618,217
Salame de Tandil	29	Charcuterie	2,639,740
Sancor Tandil	29	Cheese type Tandil.	2,674,744
Los Glaciares	39	Transport of passengers and travel agencies	2,482,780
Perito Moreno	32	Beers; mineral and aerated waters and other non-alcoholic drinks	2,224,719
Cerro Perito Moreno	38	Telecommunications	2,526,555
Talampaya	18	Leather and imitation leather products, and suitcases	2,397,108
Rio Iguazú	39	Transport, packaging and storage of goods only by ground.	2,451,913
Peninsula de Valdes	41	Education; providing of training; entertainment; sporting and cultural activities	2,038,670
Epuyen	9	Data processing equipment and computers	2,030,457

Trademark	Class	Goods	Reg N°
Arrayanes	33	Alcoholic beverages (except beers)	2,376,139
Guaymallen	29	Meat, jellies, jams, compotes; eggs, milk and milk products.	2,095,846
Rio Mendoza	33	Alcoholic beverages (except beers)	2,163,224