

## GAC Geo-names WG - Working Papers

This is a working document prepared by the ACIG GAC Secretariat for GAC's Working Group to Examine the Protection of Geographic Names in any Future Expansion of gTLDs.

ACIG team members accessed only publicly available information. ACIG team members are not lawyers and cannot provide legal advice.

### Overview

This document includes:

- The paper released in late August 2014 by the working group, in order to seek feedback from the community (page 2).
- A summary of the feedback received from the community (page 9)
- A summary of the legal basis for that feedback, where the person providing the feedback referenced it as such (page 16).

### Key Points

On 29 August 2014 the GAC's sub-working group for 'protection of geographic names in next rounds of new gTLDs' released a paper and sought feedback about it from the ICANN community. It was not a document formally endorsed by the GAC.

The paper describes "suggested steps in order to refine, for future rounds, procedures to be followed by applicants and changes to the Applicant Guide Book with regard to the protection of geographic names."

Deadlines for community input were extended, with input finally due by 31 December 2014. As at 2 January 2015, 20 inputs had been received. All were posted on the GAC's Community Input page at: <http://tinyurl.com/nc4knhn>.

### Document Administration

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## The protection of geographic names in the new gTLDs process

### V3 – August 29 2014

Prepared by Sub-working group for protection of geographic names in next rounds of new gTLDs

#### 1. Mandate

During the 47 ICANN meeting in Durban the GAC recommended 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, as stated in section 7. a. GAC Durban Communiqué.

This document describes suggested steps in order to refine, for future rounds, procedures to be followed by applicants and changes to the Applicant Guide Book with regard to the protection of geographic names.

#### 2. Background

The GAC of ICANN worked several months during 2006 and 2007 in the document called "GAC principles regarding new gTLDs" that was finalized by the GAC during the Lisbon ICANN meeting in 2007.

Full document can be found in this link:

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

Special attention was given to names with national, cultural, geographic and religious significance, as stated in the mentioned document:

- New gTLDs should respect national sensitivities regarding terms with national, cultural, geographic and religious significance
- New gTLDs should not prejudice the application of the principle of national sovereignty
- Internet naming system is a public resource and it must be administered in the public and common interest

Also other important reference in paragraph 2.2 of the same document:

- 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

These concerns were captured in the Applicant Guidebook ("AGB")

The AGB is a document that was always available for public comments and created in a bottom up process by the GNSO council and then reviewed by the whole community, including private companies and commercial brand owners.

Full text of the AGB can be found in this link: <http://newgtlds.icann.org/en/applicants/agb>

In the case of geographic names, the Applicant Guidebook establishes what a geographic name is:

- Capital city names
- City names where applicants declare that they intend to use the gTLD for purposes associated with the city name
- Sub-national place names listed in the ISO 3166-2
- Regional names appearing on the list of UNESCO regions
- Regional names on the UN's "Composition of macro geographical (continental) regions, geographical sub-regions, selected economic and other groupings"

Although these definitions of what is a geo name include approx. 5.000 names, it does not cover all the possible geo names in the world.

For this precise reason and in the event of any doubt or concern, the AGB establishes that:

"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"

These consultations did not happen with some geographic names requested by applicants in the first round of newgTLDs.

The AGB establishes ways in which governments can express concerns related with community, geographic, religious or other scripts. These processes are all explained in the AGB:

- Early warning: message sent to the applicant expressing concerns of one or more governments.
- GAC Advice: message sent from the GAC to the Board expressing concerns from the GAC related with one string.
- Objection: Independent Objector - Governments – Private – ALAC

Finally, the recently Approved Resolution of the New gTLD Program Committee<sup>1</sup> about GAC advice on ".amazon" and the analysis made by the independent third-party expert, bring new considerations about new gTLDs, trademarks and geographic names, which are detailed in section 4 of this document.

1 See <https://www.icann.org/resources/board-material/resolutions-new-gtld-2014-05-14-en>

2 See GAC Principles Regarding New gTLDs, of 28 March 2007.

3 See ICANN ByLaws, Section 2, "Core Values", and ICANN AoC with the Department of Commerce, of 30 Sep 2009.

### 3. The protection of Geographic Names

The protection of geographic names should be object of special concern within the new gTLD program<sup>2</sup>. ICANN as an institution is committed to acting on public interest<sup>3</sup>, and therefore new gTLDs that are related with words, strings and expressions that refer to different names of geographic references like regions of countries, regions of continents, sub-regions of countries, rivers, mountains, among others, should be protected in the name of public interest, due to their geographic, cultural and national relevance.

Although there are references that prevent the use of geographic names in new gTLDs included in the Applicant Guidebook, this list is limited and not sufficient to avoid the misuse of other geographic names and to protect the public interest in its entirety. It includes a limited amount of names and it does not protect in any way the diversity of places and geographic names that can be found all around the world.

Special attention should be given to the issue of geographic gTLDs as a concept (in generic terms), as they intersect with core areas of interests of any state.

Contrary to the principle of freedom of use of geographic names, allowing private companies to register geographic names as part of gTLDs strings creates a high risk for these names to be captured by companies that want to use them to reinforce their brand strategy or to profit from the meaning of these names, limiting the possibility of utilizing them in the public interest of the affected communities. Besides, the request for identity between the geographic name and the one utilized in the string, allows room for confusion in the public and consumers, as it is unavoidable that a geographic name will evoke the related geographical site and its population.

Geographic 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 national community and geographic meaning of the requested strings as new gTLDs must prevail above any other interest.

### 4. Differences between trademarks and new gTLDs

There are differences between the concept and scope of a Trademark and a TLD.

Trademark rights are conferred by States to individuals for the sole purpose of protecting the bona fide use of a mark in a specific category of products or services. There is no system of brands in the world to grant general rights on the use of a sign or name. The applicant of a trademark registrant shall inform the agency of each country, which is the current use that does or intends to do with that mark. The State grants the exclusive right to such use and no more than that.

Requested trademark applications have been ordered for specific products and services which demonstrates its own recognition of the limitation of the company's rights. In the national nomenclature of goods and services, in accordance with the Treaty of Nice, there are 45 classes of goods and services.

The document prepared by Dr Jerome Pasa, as a third-party expert<sup>4</sup> to provide additional advice on the specific issues of application of law at the case of ".amazon", includes several

paragraphs that are of high interest to the subject of this document, which are detailed as follows:

4 See <https://www.icann.org/en/system/files/correspondence/crocker-to-dryden-07apr14-en.pdf>

Paragraph 15.1:

.....

“an intellectual property right, whatever its nature, affords its owner an exclusivity or monopoly of exploitation over the subject matter of the right within the limits stipulated by law – whether national or regional – applicable to this right. This exclusive right allows its holder to prevent third parties from carrying out on this subject matter the acts of exploitation which the law reserves to him.

An intellectual property right is therefore, 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.”

.....

“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.

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

A trade mark right – the right associated with the registration of a trade mark – grants the owner a monopoly binding on third parties within the limits defined by law.

However, 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.

.....

The document states that exclusive right held by a company in its trade mark “does not therefore necessarily give it the right per se either to use it in any other form it may choose, such as a new TLD”.

The document also express that a trade mark held by an applicant do not in legal terms give it a right to the new TLD of the trade mark.

## **5. Avoiding misuse of geographic names in future gTLD rounds**

The lists of prohibited strings detailed in the Applicant Guidebook should be considered as a general reference for the applicant and not as a strict and only criteria to determine whether a name is geographic or not.

Governments should keep the right to oppose the delegation of a top level domain (even if it is not included on that list) on the basis of its sensitivity to national interests. Furthermore, that right should be enhanced for future rounds.

The flexibility and openness of criteria that applicants should have in relation with geographic names, especially in contacting previously to the application the relevant communities, does not undermine the multistakeholder structure and processes of ICANN and will not erode the confidence of global businesses.

On the contrary, a previous early contact with relevant communities and the applicant will generate confidence in the whole process and could also generate new ways of agreements among parties, before the conflict is established.

As stated in section 4 of this document and, an enhanced procedure to protect geographic names should not upset global trademark norms.

ICANN and Governments should encourage the applicants to get touch with related local governments to try to reach agreements. Dialogue and communication based on the laws and regulations is a better way to solve any difficulties. Furthermore, if the agreement between the relevant governments and the applicants can not be reached, the public interest should be priority.

## **6. Next steps**

### **a. At the National / Regional Level**

All countries should be encouraged to enhancing the ISO 3166-2 list by submitting official requests from national administrations, in a way that regions and sub-regions are included in this important reference list.

Special efforts must be done by ICANN to the broader international community, which is not comprised by GAC today.

GAC representatives and ICANN regional managers can actively engage in outreach efforts focusing in those countries not active in GAC meeting, GAC lists and ICANN activities, in order for them to be aware of future impact of this process.

The ISO 3166-2 list includes different types of country subdivisions names: districts, cantons, provinces, states, regions, cities, territories, among several others. The national reference in the ISO 3166-2 list can be enhanced with these different divisions and subdivisions in order to satisfy the country needs.

### **b. Best practices for future rounds of new gTLDs**

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

#### **- For the applicant:**

- Once a string is selected to be requested as a new gTLD, a thorough search should be undertaken to determine whether the string is a geographic name, including but not limited to cities, countries, regions, subregions or other geographic related spaces.

- Sources of information on geographic names could be the general available information on the Internet, embassies, regional organizations, international organizations, national, regional and city governments, among others.
- If the selected string is directly related with a country, city, region, subregion or other geographic related spaces, the relevant authorities related with these denominations should be contacted.
- Related information can be accessed using Internet searches.
- 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 doubts, encourage the applicant to establish contact previous to the application with the relevant authorities of the country – city – region – subregion.

**- For ICANN:**

- Enhance outreach efforts to all countries and regions of the world previous to the next new gTLD round.
- Governments should have an appropriate way to raise concerns about the use of geographic names associated with their territories

**- For Governments / Applicants / ICANN:**

- 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 with the applied gTLD
- What's next if there is no consensus reached between both parties.

**c. Suggested changes in the Applicant Guide Book**

Taking into consideration that the Durban Communiqué states that “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”, a new text is suggested regarding the geographic names, in the case that the same text of the present AGB will be used as ground document:

To include in the paragraph 2.2.1.4 of the AGB the following sentence:

**“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”.**

Also the following paragraph appears in the section **“2.2.1.4.2 Geographic Names Requiring Government Support”** of the AGB. It should be a general statement or principle regarding geographic names, in order to clarify and reinforce the importance of the previous communication between the Applicants and the Governments, even in case of any doubt.

**“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.”**

A specific reference to the Geographic Names Repository described in section 6.b of this document must be also included.

The suggested changes in the Applicant Guide Book, paragraph 2.2.1.4 of the AGB should read as follows:

#### “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. 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.”**



## Summary of Community Feedback

Community comments available in full at <http://tinyurl.com/nc4knhn>.

	Received From...	Summary of Comments
1	US Chamber of Commerce	<ul style="list-style-type: none"> <li>• Creates burden and uncertainty for business: <ul style="list-style-type: none"> <li>○ Limitless searches</li> <li>○ Unreliable approval process</li> <li>○ Skewed notions of 'public interest'</li> </ul> </li> <li>• Devalues existing legal rights and forums</li> <li>• Undermines the multistakeholder system</li> </ul>
2	Intellectual Property Constituency (IPC)	The IPC views the broad prohibition in the Proposal to be problematic for a number of reasons, most notably: (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.
3	Association of National Advertisers (US)	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.
4	Brunella Longo, Open Data Assurance, UK	Sympathises with the problems of specific communities but the protection of geo names is a technical and governance issue very different from any questions pertaining to the role, participation and specific peculiarities of some countries, economies and communities.
5	At-Large Advisory Committee (ALAC)	<p>1. The ALAC supports the scope of the draft document and recommends that protection of geographic names must be addressed in next rounds of new gTLDs.</p> <p>2. The ALAC advocates a strengthening of the nexus between an application for a geographic TLD and the public interest of the geographic area for which a TLD is sought:</p> <ol style="list-style-type: none"> <li>1) A compilation of experiences of the current (2012) round applicants for geographic TLDs should be made available to applicants for geographic TLDs;</li> <li>2) this compilation should detail the impact the 2012 geographic TLDs had on their respective areas;</li> <li>3) geographic areas should be required to demonstrate and certify their "Informed Consent" about the scope and impact a geographic TLD might have on their residents and organizations;</li> <li>4) this Informed Consent shall have been established through inclusive engagement of residents and organizations;</li> <li>5) the TLD application shall indicate an ongoing process for various Internet stakeholders to engage in the TLD's governance processes at the local, national, and global levels.</li> </ol>

		<p>3. The ALAC also suggests that the clause “2.2.1.4 Geographic Names Review” in the Applicant Guidebook (AGB) be modified to consider international treaties that address those rights of countries in relation with geographic names.</p>
6	Internet Service Providers and Connectivity Providers Constituency (ISPCP)	<ul style="list-style-type: none"> <li>• It is extremely unclear in this proposal what is intended to constitute a geographic name.</li> <li>• The proposal does an insufficient job of explaining public interest.</li> <li>• Does not define what authorities are considered relevant, nor does it define what constitutes an approval process.</li> <li>• Troublingly, does not specify who determines what the public interest is in the case of a disagreement</li> </ul>
7	GNSO Business Constituency	<ul style="list-style-type: none"> <li>• The proposal that business users applying for new gTLDs must perform a search to determine if a new string is any type of geographic name is impractical.</li> <li>• The proposal that an applicant should get agreement or non-objection from the relevant governments and public authorities before submission of an application sets an unclear burden for business users applying for new gTLDs</li> <li>• The proposals in the draft document are not compatible with current law.</li> <li>• The draft document is not clear on the definition of “public interest”, and what authority would determine the public interest in the event of a disagreement over a new gTLD.</li> </ul>
8	Marques (European association representing brand owners' interests)	<ul style="list-style-type: none"> <li>• Very concerned that this Sub Working-Group of ICANN's Government Advisory Committee has produced a set of proposals which misinterpret international law and nearly 150 years of jurisprudence because: <ul style="list-style-type: none"> <li>◦ Private property rights are recognised under international law</li> <li>◦ Governments do not have exclusive use of geographic name in any context</li> <li>◦ International law which protects sovereign names does not extend beyond national borders</li> <li>◦ The Paris Convention and TRIPS recognise private party rights in geographic names: there are jurisdictional limits on national interest in a geographic names.</li> </ul> </li> <li>• Concerned that this paper proposes vague processes which are unworkable. For example, the recommendation that potential applicants in future new gTLD rounds should use “internet searches” to identify conflicts with so-called sovereign terms is unworkable. Beyond the ISO 3166 lists, there are no authoritative global lists of “any and all names that are in the public interest”.</li> <li>• Similarly, the paper does not address how a conflict should be resolved should a brand owner find itself facing differing views from competing government interests in a name or, worse, where there are territorial ownership disputes between governments.</li> </ul>
9	Technology Policy Institute (US-based think tank)	<ul style="list-style-type: none"> <li>• Implementing the GAC's proposal would impose substantial additional administrative and logistical burdens and costs on applicants, governments and ICANN.</li> <li>• The potential domain names that might be affected, as well as the relevant communities or authorities from which</li> </ul>

		<p>applicants would have to receive approval, are ill-defined.</p> <ul style="list-style-type: none"> <li>• Governments would have to assign an agency the task of determining the validity of new gTLD applicants and establishing criteria to be used for approval or denial.</li> <li>• ICANN itself would have the added burden of determining whether a gTLD does indeed refer to a geographic area, “regional language or people descriptions,” and whether the correct approval was procured.</li> <li>• More concerning than the administrative issues listed above are the important principles involving the overall role of governments and ICANN in the domain name system. The GAC proposes that the “Internet naming system is a public resource and it must be administered in the public and common interest.” This is a vague and undefined standard that would invite politicized decision making in the allocation of gTLDs. This principle is also inconsistent with ICANN’s traditional limited technical role in the operation of the domain name system.</li> <li>• The process proposed by the GAC would insert governments into the operation of ICANN in an unprecedented way. The proposals would politicize the gTLD process and hinder the prospects for innovation on the Internet. They should not be adopted.</li> </ul>
10	Internet Business Council for Africa	<ul style="list-style-type: none"> <li>• All applicants’ geographic names and brand names that have been classified as geographic names of the current new gTLD process be allowed to give a documented review of their experiences for the particular names they have applied for. Proper questionnaires should be developed to guide their input, because without their valid input the GAC’s proposal will not be complete.</li> <li>• A panel of global external experts should be formulated to analyze the implications of the proposed and unprecedented expansion of the scope of protection of names with a geographical connotation.</li> <li>• A GAC manual of roles and competencies for GAC representatives should be created to prevent the possibility of governmental authorities blocking the internet development inadvertently</li> <li>• The existence and application of international legislative implications should also be looked into to avoid burdening commercial interests and rights.</li> <li>• Definitions of each clause be properly defined to determine implications on the scope</li> </ul>
11	United States Council for International Business	<ul style="list-style-type: none"> <li>• Questions about lawfulness and GAC scope</li> <li>• Problematic requirements for government approval</li> <li>• Procedural concerns and lack of definitional clarity</li> <li>• Lack of clarity concerning “public interest.” In particular the draft proposal assumes that “public interest” will comport with that of the objecting governments. That may not necessarily be the case.</li> </ul>
12	Internet Infrastructure Coalition (i2Coalition)	<ul style="list-style-type: none"> <li>• The draft document is unclear about what a geographic name is.</li> <li>• The proposed geographic search requirements for applicants of new gTLDs are unclear and overly broad.</li> <li>• The proposal sets an unclear burden for applicants seeking approval of a geographic string from relevant</li> </ul>

		<p>governments.</p> <ul style="list-style-type: none"> <li>The proposal does not define “public interest” and does not specify who determines the public interest in the case of a disagreement.</li> </ul>
13	International Association for the Protection of Intellectual Property (AIPPI)	<ol style="list-style-type: none"> <li>The GAC Proposal fails to balance governmental sensitivities and the rights of trademark holders in accordance with GAC principles and applicable laws</li> <li>The GAC Proposal’s definition of a “geographic name” over reaches and is unworkable</li> <li>The GAC Proposal places an undue burden on applicants</li> <li>The GAC Proposal places an undue burden on governmental authorities</li> <li>Mechanisms already exist to protect interests in geographical terms</li> </ol>
14	Dr Heather Ann Forrest, Legal Researcher and Academic, Australian Catholic University	<ol style="list-style-type: none"> <li>The Proposal does not take into account relevant existing ICANN cross-community initiatives;</li> <li>International law does not support the consent requirement recommended by the Proposal; and</li> <li>The Proposal’s recommendations are unworkable and inconsistent with foundational principles of ICANN.</li> </ol>
15	Dr Jacqueline D Lipton, David L. Brennan Professor of Law; Director, The Center for Intellectual Property Law and Technology The University of Akron School of Law	<ul style="list-style-type: none"> <li>There is no legal basis or precedent for creating pre-emptive rights in words and phrases an applicant may seek to secure as a new gTLD.</li> <li>There are a number of practical issues with the Proposal, including the following. <ol style="list-style-type: none"> <li>Inconsistent Regulatory Approach to Previous Domain Name Regulation.</li> <li>Difficulties regarding the Identification of Relevant Authorities.</li> <li>What constitutes Sufficient Consultation with/Support by Relevant Authorities.</li> <li>What would happen in a situation where relevant authorities disagree about whether an applicant’s proposal should be supported.</li> <li>Where different governments and public authorities are involved in pre-approval of applications and burdens are placed on applicants to consult with those authorities, significant language difficulties may come into play.</li> <li>Competing Government Interests, for example where multiple cities or cultural groups claimed an interest the same name</li> <li>Unclear Definitions of “Government” and “Public Authorities”.</li> </ol> </li> <li>Over burdensome to ICANN</li> <li>Overall the proposal is unnecessary, inconsistent with existing legal principles, inconsistent with the historical development of the domain name system under ICANN’s stewardship, and practically unworkable.</li> </ul>
16	ccNSO Council	<ul style="list-style-type: none"> <li>Notes that the scope of the Cross-Community Working Group on Use of Country/Territory Names as TLDs comprises only country and territory names as TLDs – not other geographical names, whereas the GAC WG treats geographical names as a whole. This difference is essential.</li> <li>Reminds GAC that country and territory names have special protection in the Applicant Guidebook.</li> </ul>

		<ul style="list-style-type: none"> <li>• The ccNSO has established a cross-community working group to: <ul style="list-style-type: none"> <li>◦ further review the current status of representations of country and territory names, as they exist under current ICANN policies, guidelines and procedures;</li> <li>◦ provide advice regarding the feasibility of developing a consistent and uniform definitional framework that could be applicable across the respective SOs and ACs;</li> <li>◦ Should such a framework be deemed feasible, provide detailed advice as the content of the framework.</li> </ul> </li> <li>• In the GAC paper all versions of geographic names are treated alike, including country and territory names. ccNSO Council agrees that the definitions in 2.2.1.4.2 of the Applicant Guide Book do not cover all the possible geo names in the world. However we sincerely doubt it will be possible to make lists to cover them all. Perhaps keep the list as a general reference for applicants but not a strict or the only criteria to determine whether a name is geographic or not.</li> <li>• The government should keep the right to oppose the delegation of TLD – even if it is not included on the list – on the basis of sensitivity to its national interests.</li> <li>• It will avoid time-consuming discussions and disagreement if ICANN and governments encourage the applicant to get in touch with related local governments to try to reach agreement in advance. Public interest should have priority.</li> <li>• As For suggested changes in the AGB Proposed by the GAC, we are of the opinion that as long as the work in the Cross-Community Working Group On Use Of Country/Territory Names As TLDs has not been concluded, it is premature to include country and territory names in paragraph 2.2.1.4. If the recommendation from this group is available before next rounds open, we will know whether the protection is in accordance with the GAC view. However, If the result of the Working Group Is not ready, and ICANN Board Does not agree to extend the protection for the next round, we agree that the GAC suggestion is the best possible solution. It will, however, be unfortunate if the recommendation from the Working Group and that from the GAC Is inconsistent. We therefore advise the GAC to keep close contact with the Working Group To coordinate the work.</li> <li>• Remind the GAC that the problem is visualized in the report from the Study Group, page 30, and showing inconsistencies creating user confusion.  <a href="http://ccnso.icann.org/workinggroups/unct---final---02jul13--en.pdf">http://ccnso.icann.org/workinggroups/unct---final---02jul13--en.pdf</a> </li> <li>• Allowing country and territory names as TLDs at all will result in some being ccTLDs in the future, and others as gTLDs, see table above. This will also create competition at an unfair level.</li> </ul>
17	Joint Civil Society	<ul style="list-style-type: none"> <li>• Proposal based on false understandings and misapplications of law</li> <li>• “Public Interest” presumed prematurely</li> <li>• Undermines freedom of expression rights</li> </ul>

		<ul style="list-style-type: none"> <li>• Unworkable practically: too broad, uncertain, and vague</li> <li>• A permission-required DNS is anti-innovation</li> <li>• ICANN is an inappropriate forum to undertake the creation of new “intellectual property like” global rights to geographic names.</li> <li>• Conclusion: an unbalanced proposal that should be rejected</li> </ul>
18	Domain Name Association	<ul style="list-style-type: none"> <li>• The GAC sub-group proposal is not ready for implementation: <ul style="list-style-type: none"> <li>◦ the treatment of geographic names in gTLDs must also be developed through the GNSO Policy Development Process,</li> <li>◦ geographic names merit protections that can be developed through policy development discussions and should include specifically enumerated lists and effective post-delegation protections.</li> </ul> </li> <li>• The premise of the GAC proposal is to attach claimed rights by governments to all geographic, cultural and place names to potential top-level domain names, however: <ul style="list-style-type: none"> <li>◦ It is well established as a matter of international law that no such rights exist,</li> <li>◦ The Applicant Guidebook, which protected enumerated geographical names as a matter of policy, did not create any such rights,</li> <li>◦ The proposal is unworkable and will stifle Internet growth; the consequence is that future new gTLD applicants will be required to undertake an impractical search to establish if a TLD name is also a geographic, cultural or place name (the potential list is in the millions of possible names) and then undertake multiple, costly, and impractical negotiations with relevant (possibly multiple) authorities to obtain approval to apply for the TLD.</li> </ul> </li> <li>• A predictable, fair TLD allocations process must balance the legitimate, domain-name related interests of individuals, entities and governments in domain names by: including a definitive list of protected names developed through a consensus-based, multi-stakeholder process; providing protections against abuses; and then allowing all those with a legitimate interest to apply for top-level domain names.</li> </ul>
19	Edwards Wildman Palmer UK LLP	<ul style="list-style-type: none"> <li>• The proposal would impose on Internet users a perspective which has never been accepted and which the ICANN community has specifically rejected.</li> <li>• The proposal has the potential to upset the balance of the Applicant Guide Book beyond the issue of place names.</li> <li>• The proposal penalises the digital economy and suggests a “solution” without providing any evidence that there is a problem to be solved.</li> </ul>
20	GNSO gTLD Registries Stakeholder Group	<ul style="list-style-type: none"> <li>• We agree with the Business and Commercial Users Constituency that it is impractical and unreasonable to use the general categories contained in the GAC Geographic Names Proposal, rather than the definitive lists referenced in the 2012 New gTLD Applicant Guidebook, to determine whether or not a string is a geographic name.</li> <li>• The categories proposed by the GAC are overly broad, have no basis in international law, and could be applied</li> </ul>



		<p>subjectively and unpredictably. That approach would give the GAC an effective right of approval over the use in the Domain Name System of terms within ill-defined and hard to apply categories, which could undermine legitimate commercial interests and free expression alike. Many such terms have multiple meanings and applications that would not go against the public interest.</p> <ul style="list-style-type: none"> <li>• Further, expanding the list of geographic names beyond defined and internationally recognized lists severely complicates the task of identifying and seeking support or non-objection from a relevant authority; for many names that could be deemed to fall under the categories put forward, the existence or scope of authority for any “relevant authority” would be open to debate.</li> <li>• Finally, the exclusive right of governments to use these broad categories of names within the DNS or to reject their use by third parties outside their national boundaries, is not provided for within international law.</li> <li>• The RySG is, additionally, concerned that the broad nature of the categories proposed and the lack of a clear basis provided for a “relevant authority” to reject a Generic Top Level Domain (gTLD) that is deemed to fall within the scope of the GAC Geographic Names Proposal creates the potential for disparate treatment of new gTLD applicants. While we respect the important role the GAC plays in the multi-stakeholder model, that role must not be exercised to compel ICANN Board and staff to take actions that violate ICANN’s governing documents.</li> <li>• The RySG would also like to express additional concerns with respect to the process by which the GAC Geographic Names Proposal is being brought forward. Acceptance of the GAC Geographic Names Proposal would require significant changes to policies developed by the Generic Names Supporting Organization (GNSO), and yield significant and material impacts for prospective applicants for new gTLDs. In accordance with the ICANN Bylaws – and consistent with the very foundation of the multistakeholder model – policies affecting the Generic Namespace must be developed through the GNSO Policy Development Process (PDP).</li> <li>• If the GAC wishes to further pursue the recommendations put forward in the GAC Geographic Names Proposal the requisite next step per the ICANN Bylaws is for the GAC to submit a request for an issues report to the GNSO Council.</li> </ul>
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## Legal Context for Respondent Feedback – The Protection of Geo Names in the new gTLD process Proposal

### Background

In August 2014 the GAC Working Group for the Protection of Geographic Names in the New gTLDs prepared a paper seeking additional protections for geographic names within the new gTLD program. The paper argued that new gTLDs that are associated with words, strings and expressions that refer to geographic references such as countries, regions, sub-regions, rivers, cities, towns, mountains and others should be protected in the public interest due to their geographic, cultural and national relevance.<sup>1</sup>

This paper was made available for community comment on 24<sup>th</sup> September, 2014. Comments were received between October and December 2014, with the comment period closing on 31<sup>st</sup> December, 2014. Twenty-six commenting submissions were received and posted on the [GAC website](#). The comments themselves and their summaries can be accessed via the [website](#).

### Issue/s

Several of the comments received during the community comment period referenced the legal context for any policy development or decision making about the protection of geo-names as part of ICANN processes. In particular, some members of the community felt that there was insufficient legal basis to proceed any further with the proposal as it has been developed.

This briefing note summarises the legal basis for this feedback. It is not a summary of the feedback received, but of the legal basis for the feedback, where the author referenced it as such.

### Legal Basis for Feedback

Approximately 50% of the feedback comments received related not to legal concerns with the proposal, but to concerns with practicality, ICANN rules and processes and the Applicant Guidebook. That feedback is not the subject of this briefing and can be read separately in the feedback itself.

The table on the following pages lists the specific legal concerns that various authors voiced with the proposal.

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<sup>1</sup> The protection of geographic names in the new gTLD's process. V. 3 29<sup>th</sup> August 2014



Nature of the Concern	Relevant Law/s	Who Expressed the Concern
<p>Sovereign states have no rights over the use of geographic names outside their own borders</p>	<p>Paris Convention (1883)</p> <p>Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS, 1994)</p>	<p>US Council for International Business</p> <p>MARQUES Ltd., U.K.</p> <p>US Chamber of Commerce</p> <p>AIPPI (International Association for the Protection of IP)</p> <p>Dr. Heather Anne Forrest, Australia</p> <p>Joint Civil Society</p> <p>Domain Name Association</p> <p>Intellectual Property Constituency (IPC)</p> <p>Association of National Advertisers (ANA), USA</p> <p>ICANN Business Constituency (IBC)</p>
<p>Geographic names may be used as Trademarks. Where this occurs, <i>within national borders</i>, states may claim a national interest, but not to the detriment of the trademark owners' rights</p>	<p>TRIPS</p>	<p>MARQUES Ltd., U.K.</p> <p>US Chamber of Commerce</p> <p>AIPPI</p> <p>Professor Jacqueline D. Lipton</p> <p>Joint Civil Society</p> <p>IPC</p> <p>IBC</p>

Nature of the Concern	Relevant Law/s	Who Expressed the Concern
<p>Trademark rights are legal property rights and existing international forums exist for resolving conflicts related to trademarked terms</p>	<p>WIPO as the administrator of the 1883 Paris Convention, 1989 Madrid Protocol, 1994 Trademark Law Treaty</p> <p>WTO as the administrator of the 1994 TRIPS Agreement</p>	<p>US Chamber of Commerce</p> <p>IPC</p>
<p>International Law has a defined set of sources. Geo names only feature in these laws for the way geo names can be described in product origination (product source such as 'Kenyan coffee');</p>	<p>Statute of the International Court of Justice, Article 38(1)</p> <p>Lisbon Agreement on the Protection of Appellations of Origin (1958)</p>	<p>Dr. Heather Ann Forrest</p> <p>IPC</p>
<p>By reason of government interest, some names and symbols are excluded from becoming private property (and therefore possibly subject to Trademark Laws); but these names and symbols <i>exclude</i> country or geographic names. Therefore governments can have no exclusive or priority rights over country or geo names. To have such rights would require the creation of a new international law.</p>	<p>Paris Convention for the Protection of Industrial Property Article 6ter</p> <p>WIPO Statement 2001 – The Recognition of Rights and the Use of Names in the Internet Domain Name System</p>	<p>Dr. Heather Ann Forrest</p> <p>Professor Jacqueline D. Lipton</p> <p>Domain Name Association</p> <p>IPC</p>

### Next Steps

This briefing note was provided to the Chair of the GAC Working Group on the Protection of Geographic Names in the New gTLDs. The next steps are at the discretion of the Working Group and its Chair.

### References

The protection of geographic names in the new gTLDs process paper – V.3, August 29<sup>th</sup>, 2014  
 Community Input – the protection of geographic names in the new gTLD's process - <https://gacweb.icann.org/display/gacweb/Community+Input+-+The+protection+of+Geographic+Names+in+the+New+gTLDs+process>