THE INTERNATIONAL CENTRE FOR EXPERTISE OF THE

INTERNATIONAL CHAMBER OF COMMERCE

CASE No. EXP/384/ICANN/1

THE INTERNATIONAL UNION OF ARCHITECTS

(FRANCE)

vs/

SPRING FROSTBITE, LLC

(USA)

This document is a copy of the Expert Determination rendered in conformity with the New gTLD Dispute Resolution Procedure as provided in Module 3 of the gTLD Applicant Guidebook from ICANN and the ICC Rules for Expertise.

EXPERT DETERMINATION

issued in the

New gTDL Dispute Resolution Procedure

administered by the International Centre for Expertise (Centre) of the International Chamber of Commerce (ICC)

EXP/384/ICANN/1

between

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"Objector" or "UIA"

and

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by

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Expert

appointed by the Chairman of the Standing Committee on 12 June 2013, pursuant to Art. 3 (3) of Appendix I to the ICC Expertise Rules

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I. DEFINED TERMS

Applicant	Spring Frostbite, LLC (also referred to as SFB)
Application	Spring Frostbite, LLC application for gTLD "*.ARCHITECT*" (application ID 1-13427920)
Centre	the International Centre for Expertise of the International Chamber of Commerce (ICC)
Exhibit A-[number]	Exhibit submitted by Applicant[1]
Exhibit O-[number]	Exhibit submitted by Objector
Expert	Hon.-Prof. Dr. Andreas Reiner appointed on 12 June 2013 by the Chairman of the Standing Committee of the Centre as the Expert in these Expert Determination proceedings
GAC	ICANN's Governmental Advisory Committee
GAC Communiqué	ICANN Governmental Advisory Committee's Communiqué dated 11 April 2013
Guidebook	ICANN's gTLD Applicant Guidebook (version of 04.06.2012)
ICANN	Internet Corporation for Assigned Names and Numbers
ICC	International Chamber of Commerce
New gTLD	New generic Top-Level Domain

[1] The Parties did not number their Exhibits in sequential order, nor did they identify their exhibits by using letter prefixes before the exhibit number. However, for ease of reference in this Expert Determination: a) Exhibits are referred to by assigning them sequential numbering (please see paras 6, 11, 15, 20, 22, 23 and Footnotes No. 3, 4, 5, 6, 7, 8) and b) an Exhibit submitted by Applicant is referred to as Exhibit A-[number] (A for Applicant) and an Exhibit submitted by Objector is referred to as Exhibit O-[number] (O for Objector).

Objection	Community objection filed by the International Union of Architects (UIA) to Spring Frostbite LLC's (SFB's) application for gTLD "*.ARCHITECT*" (application ID 1-13427920)
Objector	the International Union of Architects (also referred to as UIA)
Procedural Instruction No. 1	Procedural Instruction No. 1 issued by the Expert on 9 July 2013
Procedural Instruction No. 2	Procedural Instruction No. 2 issued by the Expert on 18 July 2013[2]
Parties	Objector (UIA) and Applicant (SFB)
Procedure	Attachment to Module 3 of the gTLD Applicant Guidebook - New gTLD Dispute Resolution Procedure
Response	Response dated 15 May 2013 and submitted by Spring Frostbite, LLC (SFB) to the Objection of the International Union of Architects (UIA) regarding application for gTLD "*.ARCHITECT*" (application ID 1-13427920)
Rules	Rules for Expertise of the International Centre for Expertise of the International Chamber of Commerce
Supplemental Submission	UIA's Supplemental Submission dated 26 June 2013 and admitted by Procedural Instruction No. 1
SFB	Spring Frostbite, LLC (also referred to as Applicant)
UIA	the International Union of Architects (also referred to as Objector)

[2] Documents referred to in item 2 of Procedural Instruction No. 2 will be referred to as Exhibits 2.1 to 2.6 to Procedural Instruction No. 2.

UIA Accord	the UIA Accord on Recommended International Standards of Professionalism in Architectural Practice submitted by the UIA as Exhibit O-4

II. INTRODUCTORY PART

A. The Parties

1. The Parties to these Expert Determination proceedings are

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"Applicant" or "SFB"

2. The Objector and the Applicant are jointly referred to as "**the Parties**".

B. The Expert

3. On 12 June 2013 the Chairman of the Standing Committee of the Centre appointed

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as the Expert pursuant to Art. 3 (3) of Appendix I to the Rules.

C. The applicable rules and place of the proceedings

4. The rules applicable to the present Expert Determination proceedings are

- the ICANN's gTLD Applicant Guidebook, version of 04.06.2012 ("Guidebook") and in particular the new gTLD Dispute Resolution Procedure attached to the Module 3 of the Guidebook ("Procedure") and

- the Rules for Expertise of the ICC ("Rules"), supplemented by the ICC Practice Note on the Administration of Cases under the New gTLD Dispute Procedure and Appendix III – Schedule of Expertise Costs for Proceedings under the New gTLD Dispute Resolution Procedure.

5. According to Art. 4 (d) of the Procedure the place of these Expert Determination Proceedings is the location of the Centre as the Dispute Resolution Service Provider for Community Objections (Art. 4 (b) (iv) of the Procedure), i.e. Paris, France.

III. SUMMARY OF THE PROCEEDINGS

6. On 12 March 2013, the Centre received the Objection filed by the UIA pursuant to the Procedure and the Rules. Together with its Objection the UIA submitted Exhibits O-1 to O-16[3] according to the list of Annexes on page 16 of the Objection.

7. By letter, dated 13 March 2013, the Centre acknowledged receipt of the UIA's Objection and announced that it "*will now conduct its administrative review of the Objection for the purpose of verifying compliance of the Objection with the Procedure and the Rules*" and that it would revert to the Objector in due course.

8. On 28 March 2013, the Centre informed the Objector, following the administrative review of the Objection, that

- the Objection is in compliance with the Procedure and with the Rules,
- the Objection has been registered for processing,
- the required information regarding these proceedings will be published on the Centre's website in due course and
- the Applicant will be invited to file a response following ICANN's Dispute Announcement.

9. On 12 April 2013, ICANN published its Dispute Announcement pursuant to Art. 10 (a) of the Procedure.

[3] Initially marked by the Objector as Annexes 1 to 16 (regarding numbering of Exhibits please see Footnote 1).

10. On 15 April 2013, the Centre invited the Applicant to file a response to the Objection within 30 days.

11. The Applicant's Response is dated 15 May 2013. Due to technical difficulties encountered by the Applicant when submitting the Response to the Centre on 15 May 2013, the Centre informed the Applicant that it was permitted to re-submit its Response on or before 17 May 2013. The Response was received by the Centre on 17 May 2013 and the Centre confirmed that the Response was filed within the deadline set by the Centre. The Response included Exhibits A-1 to A-5.[4]

12. On 4 June 2013, the Centre informed the Expert that the Centre considered to appoint the Expert as the sole member of the Panel in the present proceedings.

13. On 10 June 2013, the Expert submitted his "*Declaration of Acceptance and Availability, Statement of Impartiality and Independence*" and his CV.

14. On 17 June 2013, the Centre informed the Parties that the Chairman of the Standing Committee had appointed the Expert on 12 June 2013, pursuant to Art. 3 (3) of Appendix I to the Rules and invited the Parties to make the necessary advance payments.

15. On 27 June 2013, the Objector submitted a Supplemental Submission including Exhibits O-17 to O-20[5].

16. On 28 June 2013, Counsel for the Applicant wrote to the Centre formally objecting to the admission and any consideration of the Objector's Supplemental Submission by the Panel. In the alternative the Applicant requested that it be given 14 days to file a reply.

17. The same day the Centre "*remind[ed] the parties that at this stage no further submissions are due from the parties*" and announced that "*[t]he Expert Panel, once appointed, will contact the parties after the file has been transferred to it, to*

[4] Initially marked by the Applicant as Annexes 1 to 5.
[5] Initially marked by the Objector as Annexes 1 to 4.

discuss the further conduct of the proceedings as well as additional submissions from the parties."

18. On Friday 5 July 2013, the Centre acknowledged receipt of the advance payments made by the Parties and transferred all the documents thus far received to the Expert.

19. On Tuesday 9 July 2013, the Expert issued his Procedural Instruction No. 1

- admitting UIA's Supplemental Submission
- inviting SFB to submit its rebuttal submission within one week and
- indicating that, in the event that it was particularly difficult or burdensome for SFB to comply with the time limit of one week, SFP would be permitted to file a reasoned request for a short time extension
  and
- reserving possible further instructions.

20. On Tuesday 16 July 2013, SFB submitted its Response to Objector's Supplemental Submission including Exhibits A-6 to A-8.[6]

21. On Thursday 18 July 2013, the Expert issued Procedural Instruction No. 2

- acknowledging receipt of SFB's submission of 16 July 2013
- giving the Parties the opportunity under Art. 17 and 18 of the Procedure to submit their observations regarding the documents which [listed in point 2 of the Procedural Instruction] the Expert came across while analysing the Parties' submissions by Thursday 25 July 2013, without prejudice to the question whether and, if yes, to what extent those documents may be relevant to the Expert Determination
- inviting the Parties under Art. 18 of the Procedure to submit written evidence and short comments (if any) in relation to certain statements indicated in Exhibit O-14.

[6] Initially marked by the Applicant as Annexes A to C.

22. On Wednesday 24 July 2013, UIA submitted Objector's Response to Procedural Instruction No. 2 together with Exhibits O-21 to O-25.[7]

23. On Thursday 25 July 2013, SFB submitted Applicant's Response to Procedural Instruction No. 2 together with Exhibits A-9 to A-10.[8]

24. The language of the proceedings, including all submissions of the Parties, was and is English (Art. 5 (a) of the Procedure). However, Objector submitted Exhibit O-21 and O-24 and Applicant submitted Exhibit A-10 in French. Pursuant to Art. 5 (b) of the Procedure and taking into account that

- both of the Parties had submitted (an) exhibit(s) in French
- neither of the Parties had any objections regarding the language of the other's exhibits
- one of the Expert's working languages is French

the Expert considered that no translation of Exhibits O-21, O-24 and A-10 into English is required.

25. All communications by the Parties, the Expert and the Centre were submitted electronically (Art. 6 (a) of the Procedure).

26. According to Art. 21 (a) of the Procedure

"[t]he DRSP and the Panel shall make reasonable efforts to ensure that the Expert Determination is rendered within forty-five (45) days of the constitution of the Panel. In specific circumstances such as consolidated cases and in consultation with the DRSP, if significant additional documentation is requested by the Panel, a brief extension may be allowed."

27. The 45 days time limit is complied with if the Expert Determination is submitted to the Centre for scrutiny within this time limit. The date of the "*constitution of*

[7] Initially marked by the Objector as Appendixes 1 to 5.
[8] Initially marked by the Applicant as Annexes A-9 to A-10.

the Panel" was 5 July 2013.[9] The Expert Determination was submitted to the Centre on 9 August 2013, i.e. prior to the expiry of the 45 days time limit on 19 August 2013.

IV. SUMMARY OF THE PARTIES' POSITIONS

A. The Objector's Position

28. The UIA objects to SFB's Application for new gTLD "*.ARCHITECT*" (application ID 1-1342-7920)[10] under ICANN's new gTLD program. The UIA's Objection is a Community Objection as defined under Art. 3.2.1 of Module 3 of the Guidebook, i.e. the UIA maintains that there is substantial opposition to the gTLD application from a significant portion of the community to which the gTLD string may be explicitly or implicitly targeted.[11]

29. The Objector submits that it has standing to object to the gTLD "*.ARCHITECT*" and that factual and legal grounds justify the Objection.

30. As to its standing to object, the UIA maintains that:

- it is a globally recognised institution with a clear identity[12], founded in 1948 and currently representing professional organizations of architects from 131 nations and - through these professional organizations - over 1 300 000 architects globally[13]
- participation in most activities of the UIA as well as leadership requires membership to the UIA or to a national association of the UIA as regulated by its Articles[14]
- the UIA's aims are clearly defined.[15] It performs regular activities such as international competitions for architecture and urbanism, programmes for a

[9] See the Centre's letter of the same date.
[10] Objection, p. 2-3.
[11] Objection, p. 3.
[12] Exhibits O-2, O-3.
[13] Objection, p. 4; Exhibit O-1.
[14] Objection, p. 5; Exhibit O-3.
[15] Objection, p. 5; Exhibits O-3, O-4.

better architecture and UIA World Congresses for the benefit of the associated community[16]

- the formal boundaries of the community are defined at two levels: required membership of a national architecture organization to the UIA and required membership of qualified licensed architects to their national architecture organizations.

31. The Objector submits that there is a substantial opposition to the Application by the community of architects (as defined by the Objector).[17] The opposition is based on the UIA's understanding of the term "architect". UIA submits that the term "*architect*" has the meaning as defined in UIA Accord [18]

"Architect Definition
The designation 'architect' is generally reserved by law or custom to a person who is professionally and academically qualified and generally registered/licensed/certified to practice architecture in the jurisdiction in which he or she practices and is responsible for advocating the fair and sustainable development, welfare, and the cultural expression of society's habitat in terms of space, forms, and historical context."[19]

and, therefore, "*so-called 'architects', or 'categories of architects', as listed in the Objected Application*" (i.e. landscaping architects, naval architects and those that support them - for example, architecture technology providers, construction managers, drafters, civil engineers, architecture historians, academics, and others, etc.) do not qualify and cannot "*be confused with an 'architect' (in one single word)*".[20]

32. The UIA submits that the use of the domain name "*.ARCHITECT*" by any individual or organization without the express commitment by such individual or organization that it is a recognized member of a national association, itself a

[16] Objection, p. 6-7.
[17] Objection, p. 6; Exhibits O-3, O-4.
[18] Objection, p. 9.
[19] Exhibit O-4.
[20] Objection, p. 9.

member of the UIA, and that it therefore abides by the UIA Accord, entails major risks and detriments,[21] including

- blurring, in terms of public awareness, of what an "*architect*" is
- false sense of official approval and endorsement
- loss of revenue of qualified licensed architects
- significant increase of the costs of obtaining insurance on the part of qualified licensed architects
- significant risk to the population at large in that via the Application to which the Objection is being raised, members of the public may unintentional hire unauthorized architects for architectural services restricted to qualified licensed architects, etc.[22]

33. UIA submits that the position of ICANN's Governmental Advisory Committee expressed in its Communiqué (GAC Communiqué) of 11 April 2013[23] also evidences that the string "*.ARCHITECT*" is linked to a regulated sector, architects form a community that has a right to object to the Application and that operating this string as an open and unrestricted string may harm both the community and the consumers.

B. The Applicant's Position

34. SFB submits that the UIA does not have standing to object to the Application for new gTLD "*.ARCHITECT*" and that there are no grounds to satisfy the submitted Community Objection.

35. As to the UIA's standing SFB maintains that

- UIA defines the community too narrowly and fails to take into account all other types of architects it does not represent, such as landscape, software or system architects and architect-related enthusiasts. UIA does not have standing to object on behalf of a community that is "*strongly associated*

[21] Objection, p. 9.
[22] For the full list of claimed detriments see UIA's Objection dated 5 March 2013, p. 12-13; the concrete economic damage that would result from the Applicant's operation of the objected Application is defined at p. 14-15.
[23] Supplemental Submission; Exhibit O-20.

with the applied-for gTLD string in the application" because there are multiple entities and groups that associate with the term architect and the UIA is but one segment of the community it claims to represent[24]

- UIA does not adequately represent the community of "structural architects" as not all organizations that serve structural architects and not all licensed structural architects (e.g. only 80,000 of at least 102,000 in the United States) are members of the UIA[25]
- the 64-year existence of the UIA is relatively short compared to that of the architectural profession.[26]

36. SFB submits that UIA has not met the high burden of proving substantial opposition by a significant portion of the architect community, since

- the UIA does not represent a delineated community[27]
- the term "*architect*" should be defined broadly[28] and not narrowly as the UIA does
- the UIA "*has no right to usurp a generic term to use only in connection with its own membership*"[29]
- the true motivation of the Objection is to prevent competition for the "*.archi*" gTLD which UIA has applied for.[30]

37. According to SFB, there is no material detriment to the rights or legitimate interests of a significant portion of the community to which the gTLD "*.ARCHITECT*" is targeted. Rather SFB's "*operation of an open gTLD would have the opposite effect and benefit the vast majority of global consumers who identify with a myriad of different architectural "communities," permitting them to use the .architect gTLD to promote their businesses, hobbies, and interests,*

[24] Response, p. 6.

[25] Response, p. 6; SFB's Response to Objector's Supplemental Submission, p. 1.
[26] Response, p. 6.
[27] Response, p. 7-8.
[28] Response, p. 8, Exhibit A-1.
[29] Response, p. 7-8.
[30] Response, p. 9.

which in turn furthers the goals of ICANN and the new gTLD program, namely, to promote consumer choice and competition."[31]

38. SFB submits that the UIA's concerns regarding consumers associating all websites using the "*.ARCHITECT*" gTLD with licensed structural architects are unfounded, because "*there is a general presumption that second level domains, not top level domains, indicate the source in the mind of consumers.*"[32] The UIA's alleged detriment regarding consumers' association relate to trademark-like rights which the UIA does not have.[33]

39. SFB argues that it will operate the "*.ARCHITECT*" gTLD with far stronger abuse protections than currently exist and will shut down any infringing website (if the registrant is conducting an illegal activity). "*[A]rchitects work in conjunction with contractors, builders, clients, government agencies to build structures. All of these individuals stand between architects and the completion of a building. Thus, if an unlicensed architect attempts to pose as an architect, the involvement of all of these individuals will mitigate any possible harm to consumers.*"[34]

40. According to SFB the UIA fails to provide any evidence as to the actual harm which would be incurred due to the use of the gTLD for which SFB has applied.[35]

41. SFB submits that Early Warnings of the Governments of Australia and France are not relevant as they have been superseded by the GAC Communiqué.[36] It submits that the GAC Communiqué does not support the UIA's Community Objection as it is separate from the objection process and GAC did not advise that SFB Application should be rejected or that SFB should not be permitted to operate the "*.ARCHITECT*" gTLD.[37]

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[31] Response, p. 9; SFB's Response to Procedural Instruction No. 2, p. 2.
[32] Response, p. 9.
[33] Response, p. 10.
[34] Response, p. 10.
[35] Response, p. 10-11.
[36] SFB's Response to Procedural Instruction No. 2, p. 2.
[37] SFB's Response to Objector's Supplemental Submission, p. 2-3.

V. THE EXPERT'S REASONING AND DETERMINATION

42. The subject matter of this Expert Determination is the Community Objection raised by the International Union of Architects ("UIA" or "Objector") to the new gTLD application for the string "*.ARCHITECT*" (the "Application") filed by Spring Frostbite, LLC ("Applicant" or "SFB").

43. A Community Objection is one of the four possible objections pursuant to the Procedure. It is further defined in Art. 3.2.1 of Module 3 of the Guidebook.[38] Art. 3.2.1 ("*Grounds for Objection*") provides the following summary definition of Community Objection:

"There is substantial opposition to the gTLD application from a significant portion of the community to which the gTLD string may be explicitly or implicitly targeted."

44. As to the "*rationales for the [...] objection grounds*" the Guidebook refers to the "*discuss[ion] in the Final Report of the ICANN policy development process for new gTLDs.*"[39]

45. The Final Report contains a "*SUMMARY - - PRINCIPLES, RECOMMANDATIONS & IMPLEMENTATION GUIDELINES*".[40]

46. These Principles which, as the Final Report indicates, were developed by reference to "*ICANN's Mission and Core Values*"[41] include

a) the following Principles:

"A: New generic top-level domains (gTLDs) must be introduced in an orderly, timely and predictable way.
[...]

[38] The other three grounds for or types of objection are "*String Confusion Objection*", "*Legal Rights Objection*" and "*Limited Public Interest Objection*".
[39] Module 3 of the Guidebook, Art. 3.2.1, p. 3-4.
[40] Exhibit O-18.
[41] Exhibit O-18, point 3 of the Summary.

C: *The reasons for introducing new top-level domains include that there is demand from potential applicants for new top-level domains in both ASCII and IDN formats. In addition the introduction of new top-level domain application process has the potential to promote competition in the provision of registry services, to add to consumer choice, market differentiation and geographical and service-provider diversity."*

b) the following Recommendations:

"1: ICANN must implement a process that allows the introduction of new top-level domains.
The evaluation and selection procedure for new gTLD registries should respect the principles of fairness, transparency and non-discrimination.
All applicants for a new gTLD registry should therefore be evaluated against transparent and predictable criteria, fully available to the applicants prior to the initiation of the process. Normally, therefore, no subsequent additional selection criteria should be used in the selection process.
[...]
20: An applicant will be rejected if an expert panel determines that there is substantial opposition to it from a significant portion of the community to which the string may be explicitly or implicitly targeted."

and, referring to Recommendation 20, the following "*Implementation Guidelines*":

"The task of the panel is the determination of substantial opposition.

a) ***substantial*** *– in determining substantial the panel will assess the following: signification portion, community, explicitly targeting, implicitly targeting, established institution, formal existence, detriment*

b) ***significant portion*** *– in determining significant portion the panel will assess the balance between the level of objection submitted by one or more established institutions and the level of support provided in the application from one or more established institutions. The panel will assess significance proportionate to the explicit or implicit targeting.*

c) ***community*** *– community should be interpreted broadly and will include, for example, an economic sector, a cultural community, or a linguistic community. It may be a closely related community which believes it is impacted.*

d) ***explicitly targeting*** *– explicitly targeting means there is a description of the intended use of the TLD in the application.*

e) ***implicitly targeting*** *– implicitly targeting means that the objector makes an assumption of targeting or that the objector believes there may be confusion by users over its intended use.*

f) ***established institution*** *– an institution that has been in formal existence for at least 5 years. In exceptional cases, standing may be granted to an institution that has been in existence for fewer than 5 years.*

Exceptional circumstances include but are not limited to a re-organization, merger or an inherently younger community.

[...]

g) ***formal existence*** *– formal existence may be demonstrated by appropriate public registration, public historical evidence, validation by a government, intergovernmental organization, international treaty organization or similar.*

h) ***detriment*** *– the objector must provide sufficient evidence to allow the panel to determine that there would be a likelihood of*

detriment to the rights or legitimate interests of the community or to users more widely."

47. In compliance with Recommendation 20 and the related Implementation Guidelines, the Guidebook states in Art. 3.5.4 ("*Community Objection*") of Module 3 that for an objection to be successful the Objector must satisfy the following four tests:

a) *"The community invoked by the objector is a clearly delineated community; and*

b) *Community opposition to the application is substantial; and*

c) *There is a strong association between the community invoked and the applied-for gTLD string; and*

d) *The application creates a likelihood of material detriment to the rights or legitimate interests of a significant portion of the community to which the string may be explicitly or implicitly targeted. Each of these tests is described in further detail below."*

48. I will now address those four requirements, one by one.

A. "The community invoked by the objector is a clearly delineated community"

1. Introduction

49. The Guidebook in Art. 3.5.4 of Module 3 expands on this first requirement as follows:

*"**Community** – The objector must prove that the community expressing opposition can be regarded as a clearly delineated community. A panel could balance a number of factors to determine this, including but not limited to:*

- *The level of public recognition of the group as a community at a local and/or global level;*

- *The level of formal boundaries around the community and what persons or entities are considered to form the community;*

- *The length of time the community has been in existence;*

- *The global distribution of the community (this may not apply if the community is territorial); and*

- *The number of people or entities that make up the community.*

If opposition by a number of people/entities is found, but the group represented by the objector is not determined to be a clearly delineated community, the objector will fail."

50. Art. 3.2.2 ("*Standing to Object*") of Module 3 of the Guidebook states that a Community Objection can be submitted by an "*Established institution associated with a clearly delineated community*". Art. 3.2.2.4 elaborates on that requirement as follows:

"Established institutions associated with clearly delineated communities are eligible to file a community objection. The community named by the objector must be a community strongly associated with the applied-for gTLD string in the application that is the subject of the objection. To qualify for standing for a community objection, the objector must prove both of the following:

It is an established institution *– Factors that may be considered in making this determination include, but are not limited to:*

- *Level of global recognition of the institution;*

- *Length of time the institution has been in existence; and*

- *Public historical evidence of its existence, such as the presence of a formal charter or national or international registration, or validation by a government, inter-governmental organization, or treaty. The institution must not have been established solely in conjunction with the gTLD application process.*

It has an ongoing relationship with a clearly delineated community *– Factors that may be considered in making this determination include, but are not limited to:*

- *The presence of mechanisms for participation in activities, membership, and leadership;*

- *Institutional purpose related to the benefit of the associated community;*

- *Performance of regular activities that benefit the associated community; and*

- *The level of formal boundaries around the community.*

The panel will perform a balancing of the factors listed above, as well as other relevant information, in making its determination. It is not expected that an objector must demonstrate satisfaction of each and every factor considered in order to satisfy the standing requirements."

2. On the definition of the terms "architect" and "structural architect"

51. The Applicant argues in essence that

a) "*structural architects*" are just "*one subset of an "architecture community*"
b) this "*architecture community*" covers also "*all other types of architects*" and "*architect-related enthusiasts*"[42] and
c) the Objector misappropriates the term "*architect*" for its members which are "*structural architects*".

[42] See Response, p. 5, 8 as well as the Applicant's Response to Procedural Instruction No. 2, p. 1.

52. The Objector disagrees with the Applicant's understanding of the term "*architect*" and argues that even without adding the adjective "*structural*", this term defines what the Applicant calls "*structural architect*".

53. Neither the Articles nor the Bylaws[43] of the UIA define the term "*architect*", but it is beyond doubt that the UIA understands the term "*architect*" as it is defined in the UIA Accord[44]:

> *"Architect Definition*
> *The designation 'architect' is generally reserved by law or custom to a person who is professionally and academically qualified and generally registered/licensed/certified to practice architecture in the jurisdiction in which he or she practices and is responsible for advocating the fair and sustainable development, welfare, and the cultural expression of society's habitat in terms of space, forms, and historical context."* [45]

i.e. what the Applicant calls "*structural architect*".[46]

54. In line with its understanding of the term "*architect*", the UIA Accord[47] defines the "*practice of architecture*" as follows:

> *"The practice of architecture consists of the provision of professional services in connection with town planning and the design, construction, enlargement, conservation, restoration, or alteration of a building or group of buildings.*
> *These professional services include, but are not limited to, planning and land-use planning, urban design, provision of preliminary studies, designs, models, drawings, specifications and technical documentation, coordination of technical documentation prepared by others (consulting engineers, urban planners, landscape architects and other specialist consultants) as appropriate and without limitation, construction economics, contract administration, monitoring of*

[43] Exhibit O-3, p. 15.
[44] Objection, p. 9.
[45] Exhibit O-4.
[46] See, for instance Response, pp. 4, 5.
[47] Exhibit O-4.

construction (referred to as "supervision" in some countries), and project management."

55. Under the heading "*architect-background*" the UIA Accord states that

"Architects are part of the public and private sectors involved in a larger property development, building, and construction economic sector peopled by those commissioning, conserving, designing, building, furnishing, financing, regulating, and operating our built environment to meet the needs of society."

and that

"[t]he designation "architect" is generally reserved by law or custom to a person who is professionally and academically qualified and generally registered/licensed/certified to practice architecture in the jurisdiction in which he or she practices and is responsible for advocating the fair and sustainable development, welfare, and the cultural expression of society's habitat in terms of space, forms, and historical context."

56. The "*fundamental requirements for registration/licencing/certification as an architect*" are defined by the UIA Accord to be

"the knowledge, skills, and abilities listed below that must be mastered through recognized education and training, and demonstrable knowledge, capability, and experience in order to be considered professionally qualified to practice architecture."

57. The difference of opinion between the Parties on the meaning of the term "*architect*" relates in reality not to the issue whether the UIA as the Objector has standing to object, but to the substantive issue raised by the present proceedings, i.e. whether

"[t]he application creates a likelihood of material detriment to the rights or legitimate interests of a significant portion of the community to which the string may be explicitly or implicitly targeted."

58. This is test No. 4 of the four tests for Community Objections defined in Art. 3.5.4 of Module 3 of the Guidebook.[48] Whether test No. 4 is satisfied or not will be discussed in point D below.

3. A delineated community – the UIA's standing to object

59. For the present purpose of determining whether the "*community invoked*" by the UIA "*is a clearly delineated community*", i.e. whether the UIA has standing to object, it is sufficient to note that the UIA invokes the community of the "*architects*" as understood by the UIA and which the Applicant calls "*structural architects*".

60. I will determine the objective meaning of the term "*architect*", on which the Parties disagree, in point D below. In the meantime, I will use the term "*(structural) architect*".

61. The community of (structural) architects is clearly delineated. It is the community of the (structural) architects of the entire world.[49]

62. Even if one was to assume, for the purpose of the examination of UIA's standing to object, that the term "*architect*" has the meaning advocated by SFB, i.e. that it includes landscape architects, naval architects, system architects etc., the "*structural architects*" (as understood by SFB) would still qualify as a "*clearly delineated community*" within a larger community of "*architects*" (as understood by SFB).

63. The Objector has submitted, uncontested by the Applicant, that the estimated number of (structural) architects worldwide is approximately 1.5 million. It is inconceivable to deny that group of professionals the qualification of "*a clearly delineated community*" even if they are or were, as argued by SFB, part of another, somewhat larger "*community*" of "*architects*" (including landscape architects, naval architects etc.).

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[48] See para. 47 above.
[49] See Art. 1.1 and 2.2 of the Articles of the UIA, Exhibit O-3.

64. The UIA's standing to object cannot be called into question either by the fact that not all of the world's (structural) architects are members of those national professional organizations which are, in turn, members of the UIA, which is a federation of national professional organizations of (structural) architects. Nor can the UIA's standing to object be called into question by the fact that international competitions that the UIA organizes as well as the UIA world congresses are limited to direct or indirect members of the UIA.[50] The first test for community objections does not require a match between "*the objector*" and "*the community invoked*". In other terms, the UIA as Objector, covering through its member-organizations approximately 1.2 to 1.3 million (structural) architects[51], can invoke the community of all (structural) architects of the world[52] (including (structural) architects that are not members of national professional organizations which are in turn members of the UIA).

65. The UIA is also manifestly an "*established institution associated with [the] clearly delineated community*", whether this community is defined as the community of "*(structural) architects*" or as a larger community of "*architects including landscape architects, naval architects etc.*".

66. The "*level of global recognition*"[53] of the UIA is considerable, as is demonstrated by the number of (structural) architects the UIA represents directly or indirectly.[54] Its level of global recognition is also illustrated by the list of World Congresses it has organized every two or three years since its foundation.[55]

67. The UIA has been in existence since 1948.[56] There is public historical evidence of its existence.[57]

68. In addition to the "*length of time the institution has been in existence*" and the "*public historical evidence of its existence*", the other factors that Art. 3.2.2.4 of

[50] This is argued by the Applicant in its Response, p. 6. It is therefore equally irrelevant whether, as SFB seems to admit, the "*UNESCO-UIA competitions*" were also open to non-UIA members (see Response, p. 6).
[51] See Exhibit O-7 and O-1.
[52] Approximately 1.5 million, of which approximately 83% are (indirect) members of the UIA.
[53] Module 3 of the Guidebook, Art. 3.2.2.4, p. 3-8.
[54] Exhibits A-1 and A-7.
[55] Exhibit O-5.
[56] See the preamble to the UIA's Articles and Bylaws, Exhibit O-3, p. 5.
[57] See Exhibit O-3 - UIA's Articles and Bylaws and its registration as a foreign association in France in 1958 following the transfer of its seat from Lausanne, Switzerland to Paris, France.

Module 3 of the Guidebook mentions in the context of analysing an objector's standing are equally satisfied, i.e.

- *"the presence of mechanisms for participation in activities, membership, and leadership"* and
- *"the institutional purpose related to the benefit of the associated community"*:

  see the UIA's Articles and Bylaws[58]; the UIA Accord[59] and the research "*Architectural Practice around the World*" carried out under the auspices of the Professional Practice Commission of the UIA and on behalf of the UIA's Spanish section.[60]

- *"the performance of regular activities that benefit the associated community"*:

  see the list of the UIA world congresses and their themes[61]

and

- *"the level of formal boundaries around the community"*:

  see the UIA-Accord on Recommended International Standards of Professionalism in Architectural Practice and the limitation to persons who are *"professionally and academically qualified and generally registered/licenced/certified to practice architecture in the jurisdiction in which he or she practices ..."*[62]

To conclude:

69. The UIA clearly has standing to object. The Guidebook instructs me to "*perform a balancing of the factors*" which I have addressed above and explicitly states that "*[i]t is not expected that an objector must demonstrate satisfaction of each and*

[58] Exhibit O-3.
[59] Exhibit O-4.
[60] Exhibit O-6.
[61] Exhibit O-5.
[62] Exhibit O-4, p. 15.

every factor considered in order to satisfy the standing requirements".[63] I do not have to do any balancing. The UIA satisfies each and every of the relevant factors.

B. "Community opposition to the application is substantial"

70. The UIA's objection to SFB's Application is "*substantial*", considering the fact that the UIA covers, through its member-associations, more than 1.2 million (structural) architects around the world, out of an estimated total of 1.5 million.[64]

71. Even if the relevant "*community*" includes/included, as argued by SFB, landscape architects, naval architects etc., the objection filed by the UIA would still fulfil the requirement of "*substantial*" opposition. "*Substantial opposition*" does not mean opposition by 100% of the members of the relevant community.

72. SFB argues that "*[a]ccepting the UIA's evidence of its own membership opposition as a 'substantial opposition' would render this factor effectively meaningless, because it would allow virtually any organization in the world to submit a community objection simply by having its membership object.*"[65]

73. In reality, SFB's position would make it de facto impossible to satisfy the test of "*substantial opposition*". It would mean that more than 83% of a concerned community (this is approximately the percentage of the UIA's (indirect) members compared to the total worldwide number of (structural) architects) would have to object in order to comply with the "*substantial opposition*" requirement.

74. The numbers for the United States which SFB mentions explicitly, i.e. "*only 80,000 [UIA members] of at least 102,000 [(structural) architects] in the United States*",[66] are very close to the ratio worldwide and show an "*opposition*" that is far more "*substantial*" than is required under the Guidebook, whatever the relevant minimum standard for "*substantial opposition*" may be.

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[63] Module 3 of the Guidebook, Art. 3.2.2.4, p. 3-8.
[64] Exhibits O-1 and O-7.
[65] Objection, p. 8.
[66] Objection, p. 6.

75. The non-exhaustive list of factors which panels "*could balance ... to determine whether there is substantial opposition*" includes

- *"[n]umber of expressions of opposition relative to the composition of the community;*
- *[t]he representative nature of entities expressing opposition;*
- *[l]evel of recognized stature of weight among sources of opposition;*
- *[d]istribution or diversity among sources of expressing of opposition"*

and

- *"[h]istorical defense of the community in other contexts"*[67]

76. Given the size of the UIA,[68] its history,[69] its position,[70] its nature as a worldwide organization with members on all continents and with worldwide activities,[71] as well as the activities of its member-associations,[72] all the above factors listed in Art. 3.5.4 of Module 3 of the Guidebook clearly speak in favour of and confirm the qualification of the UIA's opposition as "*substantial*".

77. Art. 3.5.4 of Module 3 of the Guidebook also mentions, as another factor to be considered in determining whether there is substantial opposition, "*[c]osts incurred by [the] objector in expressing opposition, including other channels the objector may have used to convey opposition.*"

78. I have not been shown "*other channels [which] the objector may have used to convey opposition*", but it is obvious that the UIA has incurred costs linked to the following of the new gTLD process and for the preparation of the present Objection.[73]

To conclude:

79. there is no doubt that the UIA's objection is "*substantial*".

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[67] Module 3 of the Guidebook, Art. 3.5.4, p. 3-23.
[68] Exhibits O-1 and O-7.
[69] Objection, p. 4 and Exhibit O-2.
[70] Exhibit O-3.
[71] Exhibits O-4 to O-6.
[72] See Exhibits O-9 to O-12.
[73] See point 2.6 of the Objection.

C. "There is a strong association between the community invoked and the applied-for gTLD string"

80. The Guidebook mentions in Art. 3.5.4 of Module 3 that in order to determine whether this third test is complied with, the factors that panel "*could balance [...] include but are not limited to*:

- *Statements contained in application;*
- *Other public statements by the applicant;*
- *Associations by the public.*"

81. In order to demonstrate the "*strong association*" the UIA refers to the UIA Accord[74] and the definition of the term "*architect*" it contains. "*Landscaping architects*", "*naval architects*" or "*software architects*" are not, in the UIA's view, "*architects*" (in one single word).[75] According to the UIA not only professionals, but also the general public "*clearly and unequivocally associate [...] an "architect" (in one word) with an individual qualified to constructing habitat.*"[76]

82. SFB contests the existence of "*a strong association between the community invoked and the applied-for gTLD string*" and argues that the UIA "*does not present any evidence that the public only perceives an architect to be an individual constructing a habitat.*"[77] UIA's definition of the term "*architect*" is too narrow and ignores that the term "*architect*" includes not only "*a person who designs buildings and advises in their construction*", but also "*a person who designs and guides a plan or undertaking*", such as "*the architect of American foreign policy*".[78]

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[74] Exhibit O-4.
[75] Point 2.7 of the Objection.
[76] Point 2.8 of the Objection.
[77] Point 4 of the Response.
[78] Point 4 of the Response and Exhibit A-1H.

83. SFB further argues that "*[t]he UIA's membership of structural architects have no legal right to monopolise the term 'architect' for themselves to the exclusion of all other architects*".

84. SFB also refers to "*more than 3,500 U.S. trademark applications*" filed that include the word "*architect*" in connection with non-structural architectural services, to which the UIA has not objected.[79]

85. Finally, SFB states that "*the UIA, through its surrogate Starting Dot, has applied for .archi as a community based application*" and that the UIA's true motivation to object to "*.ARCHITECT*" is "*to prevent competition with its applied-for .archi gTLD*".[80]

86. Both the arguments submitted by the UIA and the arguments submitted by SFB in relation to the third test ("*strong association*") relate in reality primarily to test No. 4 ("*likelihood of material detriment*") and in part to test No. 1 ("*the community invoked is a clearly delineated community*"), but not to test n° 3.[81]

87. The "*strong association*" between the community invoked by the UIA as Objector and the gTLD string "*.ARCHITECT*" applied for by SFB as Applicant is quite obvious.

88. The community invoked by the UIA is the community of the (structural) architects. There is manifestly a strong association with the gTLD string "*.ARCHITECT*", whether the group of (structural) architects is identical with the group of "*architects*" or whether they are a relevant part of the group of "*architects*" (as understood by SFB, i.e. including landscape architects, naval architects etc.).

To conclude:

89. The UIA's Objection also passes the third test successfully.

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[79] Point 4 of the Response.
[80] Point 4. of the Response.
[81] As to the list of the four tests see para. 47.

D. "The application creates a likelihood of material detriment to the rights or legitimate interests of a significant portion of the community to which the string may be explicitly or implicitly targeted."

Introduction

90. Applicants were invited to "*[d]escribe "in their applications" the mission/purpose of [their] proposed gTLD*".[82] Under this heading SFB made the following statement:

> *"THE .ARCHITECT TLD*
> *This TLD is attractive and useful to end-users as it better facilitates search, self-expression, information sharing and the provision of legitimate goods and services. Along with the other TLDs in the Donuts family, this TLD will provide Internet users with opportunities for online identities and expression that do not currently exist. In doing so, the TLD will introduce significant consumer choice and competition to the Internet namespace – the very purpose of ICANN's new TLD program.*
>
> *This TLD is a generic term and its second level names will be attractive to a variety of Internet users. Making this TLD available to a broad audience of registrants is consistent with the competition goals of the New TLD expansion program, and consistent with ICANN's objective of maximizing Internet participation. Donuts believes in an open Internet and, accordingly, we will encourage inclusiveness in the registration policies for this TLD. In order to avoid harm to legitimate registrants, Donuts will not artificially deny access, on the basis of identity alone (without legal cause), to a TLD that represents a generic form of activity and expression.*
>
> *The .ARCHITECT TLD is expecially inclusive. It will be attractive to registrants with a connection to architects, the building architecture or landscape architecture professions, as well as those with interest in or connections to the design of complex systems or products (e.g., a software architect or policy architect). This is a broad, diverse and international group that may include structural architects in various countries and jurisdictions, landscape architects,*

[82] Exhibit O-8, Point 18 (a) of the Application.

structural engineers, naval architects, and those that support them (for example, architecture, technology providers, construction managers, drafters, civil engineers, architecture historians, academics and others). The TLD will also be embraced by information technology designers, software architects and others that carry the "architect" title. The TLD also could become a platform for showcasing architectural accomplishments, sharing relevant information and data, and discussing various architecture-related issues, or simply for discussion of architecture among design and technology enthusiasts. The TLD should be operated in the best interest of registrants in all jurisdictions who approach the TLD from a variety of perspectives."[83]

91. According to SFB their "*operation of an open gTLD would ... benefit the vast majority of global consumers who identify with a myriad of different architectural "communities", permitting them to use the .architect gTLD to promote their businesses, hobbies and interests, which in turn furthers the goals of ICANN and the new gTLD program, namely, to promote consumer choice and competition. The UIA's alleged detriment is based on an assertion of trademark-like rights it simply does not have*"[84]

92. The UIA takes the position that precisely this "*open registry policy*" creates a number of material detriments to the architecture community.[85]

93. Concerning the test No. 4 the Guidebook sets out the following:

*"**Detriment** – The objector must prove that the application creates a likelihood of material detriment to the rights or legitimate interests of a significant portion of the community to which the string may be explicitly or implicitly targeted. An allegation of detriment that consists only of the applicant being delegated the string instead of the objector will not be sufficient for a finding of material detriment."*[86]

94. This text is important in several respects.

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[83] Exhibit O-8, extract from point 18 (a) of the Application.
[84] Response, p. 9.
[85] Objection, p. 11.
[86] Module 3 of the Guidebook, Art. 3.5.4, p. 3-24.

95. The objector does not have to prove actual material detriment. It is sufficient that the objector proves that the application creates *"a likelihood of material detriment"*. [emphasis added]

96. The application must create a likelihood of material detriment "*to the rights or legitimate interests*" [emphasis added]. The term "*legitimate interests*" is manifestly broader than the term "*rights*". Rights are legal entitlements, based on contract and/or on the law. "*Legitimate interests*" can be of (only) "*commercial/economic*" nature.

97. Furthermore, the rights or legitimate interests need not be those of the whole community. It is sufficient that the application creates a likelihood of material detriment to the rights or legitimate interests "*of a significant portion of the community*" [emphasis added].

98. Finally, the string needs not be "*explicitly*" targeted to the community, a significant portion of which must be potentially affected. "*Implicit*" targeting of a significant portion of the community is sufficient.

99. Factors that I am invited by the Guidebook to use in making the determination "*include but are not limited to:*

- *Nature and extent of damage to the reputation of the community represented by the objector that would result from the applicant's operation of the applied-for gTLD string;*

- *Evidence that the applicant is not acting or does not intend to act in accordance with the interests of the community or of users more widely, including evidence that the applicant has not proposed or does not intend to institute effective security protection for user interests;*

- *Interference with the core activities of the community that would result from the applicant's operation of the applied-for gTLD string;*

- *Dependence of the community represented by the objector on the DNS for its core activities;*

- *Nature and extent of concrete or economic damage to the community represented by the objector that would result from the applicant's operation of the applied-for gTLD string; and*

- *Level of certainty that alleged detrimental outcomes would occur."*[87]

1. Background and Policy Consideration

100. Before addressing the Parties' arguments and the issues that are relevant under test No. 4, it seems appropriate to recall briefly the background of and the policy considerations behind the introduction of new generic top-level domains.

101. The Final Report of the ICANN Generic Names Supporting Organization ("GNSO") dated 8 August 2007[88] recalls under the heading "*Background*"

"1. The Internet Corporation for Assigned Names and Numbers (ICANN) is responsible for the overall coordination of "the global Internet's system of unique identifiers" and ensuring the "stable and secure operation of the Internet's unique identifier systems". In particular, ICANN coordinates the "allocation and assignment of the three sets of unique identifiers for the internet". These are "domain names", Internet Protocol (IP) addresses and autonomous system (AS) numbers and Protocol port and parameter numbers

2 ...

3...

4. The finalisation of the policy for the introduction of new top – level domains" is, according to the Final Report, "part of a long series of events that have dramatically changed the nature of the Internet... The ICANN Staff Implementation Team, consisting of policy, operational and legal staff

[87] Module 3 of the Guidebook, Art. 3.5.4, p. 3-24.
[88] Exhibit O-18.

members, has worked closely with the Committee on all aspects of the policy development process.

...

7. *A key driver of change has been the introduction of competition in the registration of domain names through ICANN Accredited Registrars.*

...

13. *the Committee has opted to enable potential applicants to self-select strings that are either the most appropriate for their customers or potentially the most marketable."*

102. Among the "*five key drivers for the introduction of new top-level domains*" identified by the Committee, the Final Report mentions:

"(iii) Expanding the domain name space to accommodate the introduction of both new ASCII and internationalised domain name (IDN) top-level domains will give end users more choice about the nature of their presence on the internet. In addition, users will be able to use domain names in their language of choice.

(iv) There is demand for additional top-level domains as a business opportunity. The GNSO Committee expects that this business opportunity will stimulate competition at the registry service level which is consistent with ICANN's Core Value 6"

103. ICANN's Bylaws[89] mention in Art. I ("*Mission and Core Values*") the following "*core values*":

"1...

5. *Where feasible and appropriate, depending on the market mechanisms to promote and sustain a competitive environment.*

[89] Exhibit 2.2 to the Procedural Instruction No. 2, Art. I.

6. *Introducing and promoting competition in the registration of domain names where practicable and beneficial in the public interest."*

104. The last paragraph of the section on ICANN's "*Core Values*" states that

"these core values are deliberately expressed in very general terms, so that they may provide useful and relevant guidance in the broadest possible range of circumstances. Because they are not narrowly prescriptive, the specific way in which they apply, individually and collectively, to each new situation will necessarily depend on many factors that cannot be fully anticipated or enumerated; and because they are statements of principle rather than practice, situations will inevitably arise in which perfect fidelity to all eleven core values simultaneously is not possible. Any ICANN body making a recommendation or decision shall exercise its judgement to determine which core values are most relevant and how they apply to the specific circumstances of the case at hand, and to determine, if necessary, an appropriate and defensible balance among competing values".

105. ICANN is a non-government, non-profit organization. ICANN's Bylaws,[90] however, establish a "Governmental Advisory Committee" (GAC) which shall *"consider and provide advice on the activities of ICANN as they relate to concerns of governments, particularly matters where there may be an interaction between ICANN's policies and various laws and international agreements or where they may affect public policy issues."*[91]

106. At its recent meeting in Beijing in April 2013 GAC Communiqué was issued,[92] point IV of which ("*GAC Advice to the ICANN Board*") states:

"1. *New gTLDs*

a. GAC Objections to Specific Applications

i. The GAC Advises the ICANN Board that:

...

[90] Exhibit 2.2 to the Procedural Instruction No. 2.
[91] Exhibit 2.2 to the Procedural Instruction No. 2, Art. XI, Section 2.
[92] Exhibit O-19.

b. Safeguard Advice for New gTLDs

To reinforce existing processes for raising and addressing concerns the GAC is providing safeguard advice to apply to broad categories of strings (see Annex I)."

107. Annex I, entitled "*Safeguards on New gTLDs*", states that

"*The GAC considers that Safeguards should apply to broad categories of strings. For clarity, this means any application for a relevant string in the current or future rounds, in all languages applied for.*"

108. The GAC advised that six safeguards should apply to all new gTLDs and be subject to contractual oversight. The second safeguard reads as follows:

"*2.* ***Mitigating abusive activity*** *– Registry operators will ensure that terms of use for registrants include prohibitions against the distribution of malware, operation of botnets, phishing, piracy, trademark or copyright infringement, fraudulent or deceptive practices, counterfeiting or otherwise engaging in activity contrary to applicable law.*"

109. In addition, the GAC advised the ICANN Board that

"*Strings that are linked to regulated or professional sectors should operate in a way that is consistent with applicable laws. These strings are likely to invoke a level of implied trust from consumers, and carry higher levels of risk associated with consumer harm.*"

110. With regard to this category of strings in which the GAC included explicitly the string "*.ARCHITECT*" as a string linked to "*professional services*", the GAC advised the ICANN Board that "*the following safeguards should apply*":

"*1. Registry operators will include in its acceptable use policy that registrants comply with all applicable laws, including those that relate to privacy, data collection, consumer protection (including in relation to misleading and deceptive conduct), fair lending, debt collection, organic farming, disclosure of data, and financial disclosures.*

2. Registry operators will require at the time of registration to notify registrants of this requirement.

3. Registry operators will require that registrants who collect and maintain sensitive health and financial data implement reasonable and appropriate security measures commensurate with the offering of those services, as defined by applicable law and recognized industry standards.

4. Establish a working relationship with the relevant regulatory, or industry self-regulatory, bodies, including developing a strategy to mitigate as much as possible the risks of fraudulent, and other illegal, activities.

5. Registrants must be required by the registry operators to notify to them a single point of contact which must be kept up-to-date, for the notification of complaints or reports of registration abuse, as well as the contact details of the relevant regulatory, or industry self-regulatory, bodies in their main place of business."

111. Furthermore, the GAC advised the Board:

"*In addition, some of the above strings may require further targeted safeguards, to address specific risks, and to bring registry policies in line with arrangements in place offline. In particular, a limited subset of the above strings are associated with market sectors which have clear and/or regulated entry requirements (such as: financial, gambling, professional services, environmental, health and fitness, corporate identifiers, and charity) in multiple jurisdictions, and the additional safeguards below should apply to some of the strings in those sectors:*

6. At the time of registration, the registry operator must verify and validate the registrants' authorisation, charters, licenses and/or other related credentials for participation in that sector.

7. In case of doubt with regard to the authenticity of licenses or credentials, Registry Operators should consult with relevant national supervisory authorities, or their equivalents.

8. The registry operator must conduct periodic post-registration checks to ensure registrants' validity and compliance with the above requirements in order to ensure they continue to conform to appropriate regulations and licensing

requirements and generally conduct their activities in the interests of the consumers they serve."[93]

112. Prior to the GAC Communiqué the government of Australia had submitted an "*GAC Early Warning – Submittal Architect-AU-7920*" where with regard to the string "*.ARCHITECT*" under the heading "*Consumer protection*" it is stated that

"*The string (.architect) is linked to a regulated market sector, and Spring Frostbite, LLC does not appear to have proposed sufficient mechanisms to minimise potential consumer harm."*[94]

113. The Government of France had also submitted a "*GAC Early Warning – Submittal Architect-FR-7920*"

"*The proposed gTLD relates to an activity which is subject to certain legislation because of their statutory duties and responsibilities. The French government thinks that the use of this new string should be restricted to persons complying with the legal requirements to carry out the professional activities of an "architect".*[95]

114. As "*Reason/Rationale for the Warning"* the French Government indicated:

"The French government believes that services provided through websites using such gTLD should only be provided by architects.

The user having access to services through such websites will reasonably think that the service is provided by a person which regularly carried out its professional activities under the professional title of "architect". The user should not be misled by the domain name using this string. On the contrary, the user should be assured that the service made available is complying with duties and responsibilities of architects.

[93] SFB's Comment on GAC Advice on new gTLDs will be dealt with in the context of the specific discussion and analysis of the Parties' positions and arguments.
[94] Exhibit 2.4 to the Procedural Instruction No. 2.
[95] Exhibit 2.5 to the Procedural Instruction No. 2.

This warning urges the applicant to limit the access of the new registration of domain names using this string only to architects: the services available within websites using this extension shall exclusively be provided by a person which regularly carried out its professional activities under the professional title of an "architect"."

115. SFB replied to both the Government of Australia and the Government of France. These replies will be dealt with further below in the context of the specific discussion and analysis of the Parties' positions and arguments.

2. On the term "architect"

116. For the purpose of reaching a conclusion on the issue between the Parties I have to determine the meaning of the term "*architect*" and whether this term includes "*landscape architects*", "*naval architects*" etc.

117. From a purely abstract point of view it would appear to be justified – prima facie – to argue that "*landscape architects*", "*naval architects*", "*system architects*" are "*architects*", just like "*apple trees*", "*pear trees*", and "*olive trees*" are "*trees*".

118. Language, however, is not an exact science following principles of mathematical science or logic.

119. The term "*tree*" is clearly a generic term that covers all types of trees. Unlike the term "*tree*", the term "*architect*", however, is not a generic term that covers "*landscape architects*", or "*naval architects*" etc. The term "*architect*" has a very specific and limited meaning. SFB's Exhibit A-1-H defines "*Architect*" as "*a person who designs buildings and advises in their construction*". The same definition is found, although in somewhat different words, in the free encyclopaedia Wikipedia referred to by the UIA.[96] Wikipedia defines an "*architect*" as *"a person trained and licenced to plan, design, and oversee the construction of buildings."*

[96] Submitted by the UIA as Exhibit O-20.

120. According to both the definition of Merriam-Webster and the definition of Wikipedia, the term "*architect*" means what SFB calls "*structural architect*".[97] The term "*structural architect*" which SFB presents as a sub-group of "*architects*" however, does not exist as a common term. One understands what it means but the adding of the adjective "*structural*" is in my view tautological given the meaning of the term "*architect*".[98]

121. Finally, I wish to add that SFB has also submitted extracts from Wikipedia concerning the terms "*landscape architect*", "*naval architect*", "*software architect*" and "*systems architect*".[99] None of those terms or professions is defined as a sub-term of "*architect*" or a sub-group of "*architects*". A landscape architect is defined as "*a person involved in the planning, design and sometimes direction of a landscape, garden or distinct space.*" The "*naval architect*" is defined as "*an engineer who is responsible for the design, construction and/or repair of ships, boats etc.*" A "*software architect*" is defined as "*a computer programmer who makes high-level design choices and dictates technical standards, including software coding standards, tools and platforms*". The "*systems architect*" is defined as someone who "*establishes the basic structure of the computer system, defining the essential core design features and elements that provide the framework for all that follows ...*". None of the definitions says "*a landscape/naval/software/systems architect "is an architect, that ...*".

122. The Wikipedia Encyclopedia on "*systems architect*" uses, in the text, the term "*architect*" for "*system architect*". But the term "*architect*" is used as a shortcut for "*systems architect*", not in the sense of a generic term that would include (structural) architects, landscape architects etc. Under the heading "*References*" Wikipedia explicitly states, avoiding any possible confusion, that

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[97] This meaning of the term "*architect*" is also confirmed in those documents that SFB submitted as evidence for „*Structural Architect Organizations unaffiliated with UIA*" (Exhibits A-2-A to A-2-D). The National Council of Architectural Registration Boards, for instance, states under the heading "*Becoming an Architect*" - "*Architects are licenced professionals trained in the art and science of the design and construction of buildings and structures that primarily provide shelter. Additionally, architects may be involved with designing the total built environment – from how a building integrates with its surrounding landscape to architectural or construction details that involve the interior of the building to designing and creating furniture to be used in a specific space.*" (Exhibit A-2-A).

[98] I wish to add that none of the documents (Exhibits A-2-A to A-2-D) submitted by SFB as evidence for Structural Architect Organizations unaffiliated with UIA uses the term "*structural architect*", but simply the term "*architect*", as used and understood by the UIA. The last document is particularly interesting because it says under the heading "*related professions*" [of "*architects*"] - "*Architects often work with engineers, urban planners, interior designers, landscape architects, and a variety of other professionals.*"

[99] Exhibit A-6.

> *"[t]he term "architect" is a **professional title** protected by law and restricted, in most of the world's jurisdiction, to those who are trained in the planning, design and supervision of the construction of **buildings**. In these jurisdictions, anyone who is not a licenced architect is prohibited from using this title in any way. In the State of New York, and in other U.S. states, the unauthorized use of the title "architect" is a crime and is subject to criminal proceedings."*[100]

123. I also note in this context that organizations or associations of landscape architects or of naval architects are not sub-sections of some "*architect*"-associations, federations or unions, but independent organizations, associations or federations, such as "*The Global IT Architect Association*",[101] the "*International Federation of Landscape Architects*"[102] and the "*American Society of Golf Course Architects*"[103] and "*The Society of Naval Architects and Marine Engineers*".[104]

124. The term "*architect*" is also used in a figurative sense. Merriam-Webster[105] mentions as a second definition of "*architect*": "*a person who designs and guides a plan or undertaking < The architect of American foreign policy >*". I will come back to this second, figurative sense of the term "*architect*". For the time being it is sufficient to note that neither Merriam-Webster nor Wikipedia mention landscape architects or naval architects etc. as "*architects*".

125. Wikipedia mentions that *"[t]he terms **architect** and **architecture** are also used in the disciplines of landscape architecture, naval architecture and often information technology (for example a network architect or a software architect)."* This is absolutely true. The terms "*landscape architects*", and "*naval architects*", or "*software architects*" do exist, but they are not a sub-term of "*architect*". They are simply different terms.[106] Neither Merriam-Webster nor

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[100] Exhibit A-6 on "*Systems architect*", p. 5.
[101] Exhibit A-1-B.
[102] Exhibit A-1-C and A-1-D; see also Exhibit A-1-E - the "*Landscape Institute*" or "*Royal Chartered institute for landscape architecture*".
[103] Exhibit A-1-F.
[104] Exhibit A-1-G.
[105] Exhibit A-1-H.
[106] It is interesting to note, in this context, that Merriam-Webster mentions "*landscape architect*" and "*marine architect*" as separate terms and not as a sub-group of a larger group of "*architects*".

Wikipedia use the term "*structural architect*" to define what UIA understands and what I also understand to mean "*architect*".

3. Promotion of Consumer Choice and Competition/ Consumer Protection/ the Fundamental Right to Free Speech: Compatible or Incompatible goals?

126. It is often the case in life in general, and in the law in particular, that the public and decision makers at all relevant levels find themselves confronted with goals and policies which are or which appear to be conflicting or incompatible. The present dispute is a perfect illustration of that type of situation.

127. One of the aims of the introduction of new generic top-level domain names is clearly the promotion of consumer choice and competition.[107]

128. Promoting competition, however, is not an *absolute*, unlimited goal. This is reflected in ICANN's Core Value No. 6:

> *"Introducing and promoting competition in the registration of domain names where practical and beneficial in the public interest."* [emphasis added]

129. Similarly, free speech is not an absolute, unlimited right. Competition as well as free speech are subject to limitations in the public interest, which include limitations imposed for reasons of consumer protection.

130. The community of architects is an important community, not only because of their number and because of their own economic interests, but because architects are important to society. As indicated in Wikipedia "*[p]rofessionally an architect's decisions affect public safety...*".[108]

131. This public interest is confirmed in a document submitted by SFB issued by the National Council of Architectural Registration Boards, an institution unaffiliated with UIA.[109] This document states:

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[107] For example see Exhibit O-18, p. 3.
[108] Exhibit O-20.
[109] Exhibit A2-C.

"I. REGULATION OF THE PROFESSIONS

Since the early days of the Republic, it has been a recognized and accepted function of state governments to regulate activities which affect the public health, safety, or welfare. One aspect of this role has been the regulation of the professions, whose members are properly considered to have special responsibilities to the public as well as to the individuals receiving services. The essential rationale and standard for such regulation was set forth by the U.S. Supreme Court in Dent v. West Virginia, 129 U.S. 114, 122 (1889), when the Court wrote:

...

The goals of the architectural registration law have been threefold:

1. *To ensure at least a minimum level of competence;*
2. *To ensure appropriate standards of conduct [and continuing professional development]; and*
3. *To discourage unlicensed practice.*

II. WHO BENEFITS FROM THE REGULATION OF ARCHITECTS?

The activities of the Board benefit two categories of people.

First, regulation protects the consumers of architectural services. The necessity of ensuring that those who hire architects are not victimized by incompetent or dishonest architects is self-evident.

Second, regulation protects the public at large.

The primary responsibility of an architect is, of course, to design buildings so that they are safe, durable, and satisfy reasonable environmental standards.

...

It should be emphasized that the results of faulty design may injure the users of the building as well as the person who engaged the architect.

There are other less obvious reasons that the regulation of architecture benefits the public. An architect's actions shape the social and physical environment. The design and siting of a building and its relationship to its surroundings will affect the safety, comfort, and convenience of passers-by and users of neighboring buildings. The siting and design together will determine to a considerable degree what demands the building will make on public services, such as power, water, sewerage, and fire protection. In

many locations, the design will determine, for good or ill, the immediate impact of the building on physical characteristics of the environment; the building may change the water table, the soil support of surrounding buildings, the availability of open space, and the pattern of wind current, to cite a few examples.

The architect's decisions may well also have subtle long-range effects, particularly where very large projects are involved.

..."

132. Beyond concerns of public safety, habitat for human beings is of essential importance in society, at the human-social level, at the economic level and at the environmental level (including at the level of energy-policy, energy saving etc.).

133. It is unsurprising that, as indicated by Wikipedia, "*an architect must undergo a specialized training consisting of advanced education and a practicum (or internship) for practical experience to earn a licence to practice architecture*" and that "*[i]n most developed countries, only qualified persons with appropriate licensure, certification, or registration with a relevant body, often governmental, may legally practice architecture*" and that "*[t]he use of terms and titles, including derivatives such as architectural designer, and the representation of one-self as an architect is restricted to licenced individuals by law.*"

134. These public interests are reflected in the UIA Articles and Bylaws[110] and in the UIA Accord.[111] This UIA Accord emphasises the "*social and ecological imperatives*" linked to the practice of architecture,[112] the architect's "*responsib[ility] for advocating the fair and sustainable development, welfare, and the cultural expression of society's habitat in terms of space, forms, and historical context*"[113] and the aim of "*meet[ing] the needs of society.*" [114]

[110] Exhibit O-3.
[111] Exhibit O-4.
[112] Exhibit O-4, p. 15 under "*Practice of Architecture - Background*".
[113] Exhibit O-4, p. 15 under "*Architect - Definition*" .
[114] Exhibit O-4, p. 15 under "*Architect - Background*".

135. The UIA consequently takes the position that these public interest concerns are violated by the Applicant's intended "*open registry policy*" with regard to the applied-for domain name "*.ARCHITECT*".

136. SFB clearly announced in its Application that it does not intend to limit the use of the domain name "*.ARCHITECT*" to (licensed) architects but rather intends to open its use to "*landscape architects*", "*naval architects*", etc. and more generally to any and all "*professionals whose work supports and advances the work of architects*",[115] as well as to "*architecture enthusiasts*". [116]

137. Given the specific nature of the new generic top-level domain name "*.ARCHITECT*" and the specific meaning of the term "*architect*",[117] it would be incompatible with the above referenced public interests linked to the work of architects and with the related consumer protection concerns, to allow the domain name "*.ARCHITECT*" to be used by anyone other than "*architects*" who, by definition, need to be licensed, even if the type of license and the requirements for such licenses may not be exactly the same in each and every country or jurisdiction.

138. The UIA has demonstrated the risk of persons who do not fulfil the necessary requirements and who are not licensed, but who claim to be (licensed) architects.

139. Exhibit O-9 shows several examples of complaints/enforcement actions related to the misuse of the term "*architect*".[118]

140. These concerns are confirmed by other evidence submitted by the Objector.[119] They were confirmed by the GAC Early Warning of the Australian

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[115] Response, p. 9.

[116] SFB admits that (structural) architects "*are licenced according to specific governmental standards, unlike "landscape architects, software architects, system architects, naval architects, and golf course architects*", see Response, p. 7.

[117] SFB has submitted evidence on "*Architecture Critics and Non-UIA Publications*", i.e. to "*Architectural Digest*" (Exhibit A-3-A), to "*architectural record*" (Exhibit A-3-B) and to the "*Chicago Architecture Foundation Facts*" (Exhibit A-3-C). SFB, however, has not filed an application for "*architecture*" or "*architectural*" but for "*.ARCHITECT*".

[118] From the US State of Ohio, from the US States of Texas, Washington, New York, Florida and others and from India.

[119] See Exhibit O-10 – a brochure of the UK Architects Registration Board; Exhibit O-11 – a publication by the Architectural Institute of British Columbia on the "*Right to Title*" and Exhibit O-12 – a publication of the NSW

Government[120] and the French Government,[121] as well as by the GAC Communiqué.[122]

141. Consumers should be entitled to assume that anybody using the generic top-level domain name "*.ARCHITECT*" is a licensed architect. I do not see how any other use of the generic top-level domain name "*.ARCHITECT*" could "*promote consumer choice and competition.*"

142. SFB also argued that upholding the UIA's objection would have "*an inhibiting effect on new gTLDs' ability to fairly compete*" since „*no such restrictions now exist or are demanded of most existing gTLDs or ccTLDs*".

143. I find this argument to be very general, too general in order to allow me to address it. I can say, however, that my role is not to express a view on other top-level domain names than "*.ARCHITECT*".

144. It is, however, certainly not required, as suggested by the UIA,[123] that those who use the domain name "*.ARCHITECT*" be members of the UIA or of any association or organization affiliated with the UIA. The UIA cannot "*monopolize*" the term "*architect*" for its (direct or indirect) members.

145. In the context of the "*abuse*" discussion, SFB has referred to its "*Public Interest Commitments*"[124] in which SFB states under the heading "*Anti-Abuse Policy*":

> "*Registry Operator will monitor the gTLD for abusive behaviour and address it as soon as possible if detected.*"

146. It its "*comments on GAC Advise on New gTLDs*"[125] SFB took the position that

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Architects Registration Board, Sydney, concerning the Architects Act 2003 and the *"illegal use of the title "architect""*.

[120] Exhibit 2.4 of the Procedural Instruction No. 2.

[121] Exhibit 2.5 of the Procedural Instruction No. 2.

[122] Exhibit O-19.

[123] Objection, p. 9, see also para. 32 above.

[124] Exhibit A-8.

[125] Exhibit 2.6. of Procedural Instruction No. 2.

"*Registrants must operate within the law ... It is very unlikely, for example, that registry operators know anything substantive about organic farming. ...*"

"*Placing limitations on gTLDs before they're launched, solely in anticipation of a possible type of abuse, will stifle innovation.*"

147. The use of the top-level domain name "*.ARCHITECT*" by non-licenced architects is in itself an abuse. This top-level domain refers to a regulated professional service. Therefore all safeguards must be adopted to prevent its use by a non-licensed person. Otherwise the door would be open for abuse, examples of which were shown by the UIA.[126] Why one would have to wait until after the actual use of that top-level domain name to find out that the user is not a "*licenced architect*". SFB itself stated "*...it would be grounds for domain name deletion if an unlicensed structural architect tried to confuse consumers by using a.ARCHITECT registration to present himself as licensed*".[127] Why should one wait for all those who "*stand between architects and the completion of a building*", such as "*builders, ... and government agencies*" in order to "*mitigate any possible harm to consumers*" in case "*an unlicensed architect attempts to pose as an architect*"?[128]

148. SFB argued that an "*identity based control*", i.e. an *ex ante*-limitation would be *ineffective and difficult to enforce*". To illustrate this position SFB referred to the example that a certified public accountant "*could use his or her credential to register multiple names in .CPA and then licenses their use to any person of his or her choosing, credentialed or not*".[129] The likelihood of such an abuse by a licensed CPA or, in our case, by a licensed architect appears to be very limited, in any case far too limited in order to support SFB's position.

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[126] Exhibit O-9.

[127] Exhibit O-14 – SFB's Reply to the Government of France.

[128] Response, p. 10: "*There are additional safeguards to prevent substantial harm to consumers. As the UIA notes on page 14 of its Objection, structural architects work in conjunction with contractors, builders, clients, and government agencies to build structures. All of these individuals stand between architects and the completion of a building. Thus, if an unlicensed architect attempts to pose as an architect, the involvement of all of these individuals will mitigate any possible harm to consumers. The existence of these safeguards are what prevents consumers from suffering harm as a result of believing that an unlicensed architect is actually licensed.*"

[129] Exhibit O-13 – SFB's Reply to the Government of Australia, p. 8.

4. Only second level domains indicate source?

149. The Applicant has submitted that *"there is a general presumption that [only] second level domains not top-level domains, indicate source in the mind of consumers."* In this context the Applicant referred me to *Interstellar Starship Serv. Ltd. v. Expix, Inc.*[130]

150. The important passage in this Interstellar case is:

"The district court correctly recognized that a word used as a second-level domain name in a web-site address can present a cause of action for trade mark infringement."

151. The Interstellar case deals with trademark infringement issues under US law and is, therefore, inapposite to the present matter. In addition, neither the district court nor the court of appeals expressed the view that "*only*" a "*second-level domain name*" "*indicate[s] source in the mind of consumers*". In addition, the relevant generic top-level domain name in the Interstellar case was "*.com*". Such very general top-level domain names cannot, in terms of their effects, be compared to or subsumed under such very specific generic top-level domain names as "*.ARCHITECT*".[131]

5. The US Patent Trademark Office's Trademark Manual of Examining Procedure

152. The Applicant's reference to the US Patent Trademark Office's Trademark Manual of Examining Procedure (Section 1215.02 (d)) is equally unhelpful to the Applicant's position. The relevant passage in this Trademark Manual of Examining Procedure reads as follows:

"If a mark is composed solely of a TLD for "domain name registry services" (e.g., the services of registering .com domain names), registration should be

[130] Response, p. 9, Footnote 24 (184 F. 3d 1107, 1110 (9th Cir. 1999)).
[131] It is therefore not relevant that, as argued by SFB in its Reply to the Government of France, Exhibit O-14 "*in the .COM namespace alone, ..., there are over 12,000 of the word "architect"* and that *"there is little evidence that these have generated abuse."*

refused under Trademark Act §§1, 3, and 45, 15 U.S.C. §§1051, 1053 and 1127, on the ground that the TLD would not be perceived as a mark."

153. Whether a domain name can be registered as a trademark is irrelevant in the present context. In addition, that Trademark Manual of Examining Procedure was last updated in June 2007, i.e. prior to the Final Report published by the ICANN Generic Names Supporting Organization in August 2007.[132] In 2007 the list of top-level domains was quite limited and did not contain specific top-level domains such as "*.ARCHITECT*".

6. Internet users and consumers expect correct information

154. Finally, the public interest and consumer protection concerns cannot be overcome by the argument "*that consumers visiting websites registered under the .architect gTLD will receive additional information about the services offered based on the content of the website itself.*"[133] Consumers are entitled to get the information and the service that they reasonably expect.

155. The top-level domain name "*.ARCHITECT*" raises the legitimate expectation that the related website is the website of a licensed architect (or a group of licensed architects). Correct information is essential to consumers visiting websites.

156. The Applicant has drawn my attention to a passage in Toyota Motor Sales, U.S.A, Inc. v. Tabari[134] quoted in Network Automation, Inc. v. Advanced Systems Concepts, Inc.[135] That passage reads as follows:

"*[I]n the age of FIOS, cable modems, DSL and T1 lines, reasonable, prudent and experienced internet consumers are accustomed to such exploration by trial and error. They skip from site to site, ready to hit the back button whenever they're not satisfied with a site's contents. They fully expect to find some sites that aren't what they imagine based on a glance at the domain name or search engine summary. Outside the special case of ... domains that actively claim affiliation*

[132] Exhibit O-18.
[133] Response, p. 10.
[134] Response, p. 10, Footnote 26 - 610 F. 3d 1171, 1179 (9th Cir. 2010).
[135] Response, p. 10, Footnote 26 - 638 F. 3d 1137, 1152-53 (9th Cir. 2011).

with the trademark holder, consumers don't form any firm expectations about the sponsorship of a website until they've seen the landing page- if then."

157. I do not think these two cases, which are both trademark cases and are as such anyway not or at least not directly applicable here, support the Applicant's position.

158. The Toyota v. Tabari decision had to address the question whether the domain names of a distributor of Lexus cars *"buy-a-lexus.com"* and *"buyorleasealexus.com"* *"suggests [...] sponsorship or endorsement by the trademark holder"*, thereby infringing Toyota's Lexus trademark. I fully agree with the court's answer that the use of those domain names did not infringe the Lexus trademark, but simply used the trademark to refer to the trademarked good itself which the distributor was entitled to sell. I also agree that the use of the string *"lexus"* in those domain names was not *"likely to cause confusion as to the source of the [distributor's] website"*.[136]

159. The extract from the court's decision quoted above relates to the assumption that an internet user will enter the search term *"lexus"* and to the question whether that internet user/customer would assume that the sites that pop up are sites (of companies) affiliated with the trademark holder.

160. There is nothing shocking about the fact that the search engine results would include the website of a legitimate, rightful distributor of Lexus cars. If the internet user or consumer wanted to get to a Toyota website, but arrived at the Tabari lexus-distribution website, the internet user/consumer will of course *"hit the back button"*.[137] The situation that I have to address in my Expert Determination is completely different, however.

161. More likely than not, somebody who searches *"architect"* expects to get to the website of licenced architects, but is not interested in landscape architects, naval architects or system architects. The internet user/consumer would simply lose valuable time by having to go through a totally unnecessary *"exploration by trial*

[136] Toyota Motor Sales, U.S.A., Inc. v. Tabari, 610 F. 3d 1171, 1179 (9th Cir. 2010).
[137] Toyota Motor Sales, U.S.A., Inc. v. Tabari, 610 F. 3d 1171, 1179 (9th Cir. 2010).

and error", [138] which would be time consuming, annoying, if not indeed irritating. This would neither be in the interest of the internet user/consumer nor in the true interest of the internet system as a whole.

7. The figurative sense of "architect"

162. I am aware, as indicated above[139], that the term "*architect*" is also sometimes used in a figurative sense ("*the architect of the foreign policy of country X*"[140]). However, this very limited use of the term "*architect*" does not affect my Expert Determination. I cannot imagine that anybody searching on the internet for the foreign policy of country X and more specifically searching who is or may have been the "*architect*" of that country's foreign policy would search under the term "*architect*" or would expect an answer to that question under a website with the top-level domain name "*.ARCHITECT*".

163. SFB has argued, in support of its "*Open Registry Policy*" that a specialist for the repair or the maintenance of rugs may hold himself out as a "*rug-doctor*"[141]. I do not say that this would be an illicit use of the term "*doctor*", but I am equally of the opinion that somebody who is looking for "*doctors*" would not expect – nor would he want - to be referred to a "*rug-doctor*"[142], a "*car-doctor*", etc. Quite to the contrary, such internet users/consumers would be presumably quite annoyed and feel that the internet system is not as efficient and as helpful as it should be and that it is causing them to lose valuable time.

8. Assertion of trademark-like rights by the UIA / relevance or irrelevance of the UIA's failure to object to trademarks including the term "architect" in connection with non-structural architectural services

164. SFB argues that "*[t]he UIA's alleged detriment is based on an assertion of trademark-like rights it simply does not have.*"[143]

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[138] Toyota Motor Sales, U.S.A., Inc. v. Tabari, 610 F. 3d 1171, 1179 (9th Cir. 2010).
[139] See para 124 above.
[140] See Exhibit A-1-H.
[141] Exhibit O-13.
[142] Applicant's Reply to the Government of Australia, Exhibit O-13, p. 8.
[143] Response, p. 9.

165. I have not seen any reliance by the UIA on trademark rights. In addition, I have already said in para 144 above that the UIA cannot request that the use of the gTLD "*.ARCHITECT*" be limited to UIA members.

166. SFB also states that "*the UIA has not objected to the more than 3,500 U.S. trademark applications that had been filed that include the word "architect" in connection with non-structural architectural services*".[144]

167. In this context SFB has submitted the results of various searches in the Trademark Electronic Search System[145] as well as one specific trademark "*Portal Architects*".[146]

168. These records show a number of trademarks including the term "*architect*" or "*architects*".

169. I obviously cannot go through 3,500 trademark applications. But I don't think this is necessary either.[147] The question of whether or not the UIA has objected to any trademark applications including the word "*architect*" in connection with "*non-structural architectural services*" does not affect the UIA's Objection to the top-level domain name "*.ARCHITECT*".

170. SFB has provided details only for one trademark, i.e. for the trademark "PortalArchitects"[148], but the reference to this trademark does not support SFB's position in the present Expert proceedings.

171. As the reproduction from SFB's Exhibit A-4-B shows,

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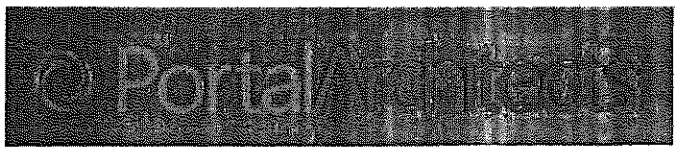
[144] Response, p. 9.
[145] Exhibit A-4-A.
[146] Exhibit A-4-B.
[147] Just for the sake of record I note that a) among the 3,379 records found under the search „*architect*" many of the trademarks are indicated to be "*dead*", b) many trademarks do not include the term "*architect*" or "*architects*"and c) that I do not have to express a view as to whether the term "*architect*" as such, i.e. without any additional words, without the use of any stylised letters or elements and without the use of any colours, could be protected as a trademark for services of an architect.
[148] Exhibit A-4-B.



this trademark is not a pure "*word*" trademark, but includes the colours red, black and white which "*are claimed as a feature of the mark*". Furthermore, this trademark "*consists of a red stylized swirl design next to the word "PORTAL ARTCHITECTS". "PORTAL"* is displayed in stylized red letters and "*ARCHITECTS*" is displayed in stylized white letters.

172. The trademark is registered for "*downloadable software for improving the productivity of portals*".

173. In light of the above, I consider the trademark evidence presented by SFB as unpersuasive.

9. The right of free expression

174. SFB has relied on the fundamental right of free expression. This right is, of course, a fundamental right but it is not an "*absolute*" right. The right of free expression is subject to a number of limitations based on conflicting rights or interests.

175. SFB also relied on the reference made to "*freedom of expression*" in the report on the world conference on international telecommunications[149] and to the Internet being "*un bien commun, qui devrait rester libre et ouvert*".[150] But these texts do not suggest to give priority to the right of free expression over other public interests, including consumer interests. They referred to the discussion whether or not the technical operation (and control) of the Internet should be transferred via the International Telecommunications Union to the States.[151]

[149] Exhibit A-9.
[150] Exhibit A-10.
[151] See the discussion at the World Conference on International Communication ("WCIT") in Dubai in December 2012 and related Exhibits O-21 and O-25.

10. The string "*.archi*" applied for by the UIA

176. SFB has also submitted on various occasions[152] that the UIA has objected to SFB's Application "*.ARCHITECT*" because the UIA itself has filed an application for the top-level domain name "*.archi*" through an affiliated entity. On that view, the UIA simply wants to protect its own application for a domain name and to avoid competition by the domain name "*.ARCHITECT*" for which SFB has applied.

177. The application "*.archi*" may have influenced/contributed to the UIA's decision to file an objection to "*.ARCHITECT*". But even assuming that this was/is the case, this does not affect the strength of the UIA's Objection. Moreover, I am not called upon to deal with the "*.archi*" application.

To conclude:

178. Returning now to the various factors which the Guidebook invites me to take into account in my Determination, I have reached the following conclusions:

- The operation of the generic top-level domain "*.ARCHITECT*" as suggested by the Applicant in its Application would lead to considerable damage to the reputation of the community of architects. Internet users would necessarily assume that those who use the domain name "*.ARCHITECT*" are licensed architects. There is a considerable risk that internet users would be misled and this would, in term, cause harm to the reputation of the community of architects.

- For the reasons set out above I also conclude that if the Applicant acted as per its stated intention, it would not be acting in accordance with the interests of the community of architects or of internet users more widely. Given the importance of the work of architects it would be insufficient, in my view, to address possible abuse by non-licenced architects *ex post*. I see

[152] Response, p. 9; Response to Objector's Supplemental Submission, p. 1 and Response to Procedural Instruction No. 2, p. 2.

no reason why any non-licensed architect should have access to the domain name "*.ARCHITECT*" in the first place.

- Opening the domain name "*.ARCHITECT*" to others than licensed architects, including for instance "*landscape architects*", "*naval architects*", "*system architects*", would create an interference with the core activities of the community of architects.

- Given the specificity and the precise meaning of the term "*architect*", the opening of the top-level domain name "*.ARCHITECT*" to "*architecture*"-related businesses or activities, such as, for instance, the supply of special software to architects or the supply of special photocopying machines or printers or of paper and pens for architects, would both interfere with the core activities of the community of architects and would run counter to the interests of the broader community of internet users.

- The community of architects is clearly dependent on the DNS for its core activities, as nearly any community is nowadays.

- The evidence submitted by the Objector on the illegal use of the title "*architect*"[153] as well as the early warnings by the Governments of Australia and France as well as the GAC Communiqué[154] show the relevant nature and extent of concrete or economic damage to the community. They also confirm, to a relevant level of certainty, that the alleged detrimental outcomes would occur.

VI. DISPOSITIVE SECTION

In light of the current version of the Application and according to Art. 21 (d) of the Procedure I hereby render, for all the above reasons, the following

[153] See Exhibits O-9 to O-12.
[154] Exhibit O-19.

EXPERT DETERMINATION

1. The International Union of Architects prevails and I, therefore, state that their Objection is successful.
2. The Centre is invited to refund to the International Union of Architects their Advance Payment of Costs pursuant to Art. 14 (e) of the Procedure.

Place of the Expert Determination proceedings: Paris, France

Date: 3 September 2013

Andreas Reiner

Expert