

# GAC Advice Response Form for Applicants



The Governmental Advisory Committee (GAC) has issued advice to the ICANN Board of Directors regarding New gTLD applications. Please see Section IV of the [GAC Durban Communiqué](#) for the full list of advice on individual strings, categories of strings, and strings that may warrant further GAC consideration.

Respondents should use this form to ensure their responses are appropriately tracked and routed to the ICANN Board for their consideration. Complete this form and submit it as an attachment to the ICANN Customer Service Center via your [CSC Portal](#) with the Subject, “[Application ID] Response to GAC Advice” (for example “1-111-11111 Response to GAC Advice”). All GAC Advice Responses to the GAC Durban Communiqué must be received no later than 23:59:59 UTC on 23-August-2013.

## Respondent:

Applicant Name	Amazon EU S.à r.l.
Application ID	.AMAZON (1-1315-58086) .アマゾン [AMAZON] (1-1318-83995) .亚马逊 [AMAZON] (1-1318-5591)
Applied for TLD (string)	As displayed above

## Response:

August 23, 2013

Dr. Steve Crocker, Chairman of the Board  
Mr. Fadi Chehadé, President & CEO  
Mr. Cherine Chalaby, Chair of the New gTLD Committee  
Members of the New gTLD Program Committee  
Internet Corporation for Assigned Names and Numbers  
12025 Waterfront Drive, Suite 300  
Los Angeles, CA 90094-2536

Re: **Amazon’s Response to the ICANN Board of Directors on the GAC Durban Communiqué**

Dear Dr. Crocker, Messrs. Chehadé and Chalaby, and Members of the ICANN Board of Directors New gTLD Program Committee,

Thank you for the opportunity to respond to the Governmental Advisory Committee’s (“GAC”) Advice set forth in the Durban Communiqué (the “GAC Advice”). Amazon respects the vital role of the GAC and its contribution to the multi-stakeholder model of governance. Under the Applicant Guidebook (“AGB”), GAC advice creates a rebuttable presumption for the ICANN Board of Directors New gTLD Program Committee (“NGPC”) that the application

should not proceed. Not only is that presumption plainly rebutted here, but following that advice would violate national and international law and upend the settled international consensus embodied in ICANN's Bylaws, Articles of Incorporation, and Affirmation of Commitments (the "Governing Documents").

Advice provided by the GAC to the NGPC is just that: advice. Of course, ICANN must act in accordance with its Governing Documents and international and national laws. The GAC Advice as it relates to the .AMAZON, .アマゾン and .亚马逊 applications (collectively the "AMAZON Applications") ignores both of these key limitations on ICANN's power to do precisely what the advice advocates – selectively rejecting an application for a new gTLD.<sup>1</sup> Instead, contrary to those limitations, the GAC has injected into the ICANN process political issues already addressed and rejected by international consensus in the ICANN rulemaking process in contravention of the objecting governments' own national laws and international laws to which they themselves are signatories.

In short, the GAC Advice as it relates to the AMAZON Applications should be rejected because it (1) is inconsistent with international law;<sup>2</sup> (2) would have discriminatory impacts that conflict directly with ICANN's Governing Documents; and (3) contravenes policy recommendations implemented within the AGB achieved by international consensus over many years. Failure to reject the GAC Advice will fundamentally undermine the multi-stakeholder model and place at risk, and destroy trust in the fairness of, the gTLD process for both current and future applicants.<sup>3</sup>

## I. Background

Amazon and the Amazonia region of South America have coexisted amicably, both regionally and globally, with no interference on regional matters or consumer confusion or harm for more than seventeen years. We have been and continue to be pleased to serve countless customers in the region throughout much of that period. Amazon is not the recognized term for the region in most of South America, which use Amazonas or Amazonia.

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<sup>1</sup> See, generally, *ICM Registry, LLC v. ICANN*, ICDR Case No. 50 117 T 00224 08, Judge Stephen M. Schwebel, Presiding. (Feb. 19, 2010).

<sup>2</sup> For the convenience of the NGPC, the Board of Directors, and ICANN legal team as a whole, Amazon has attached as Appendix A Chapters 5-9 of Heather Ann Forrest's recently published book Protection of Geographic Names in International Law and Domain Name System Policy by Heather Ann Forrest (Wolters Kluwer Law International 2013). Professor Forrest's research clearly supports the Amazon position that there are no legal rights by a country in a sub-regional or geographic feature name, or any geographical name per se.

<sup>3</sup> See, e.g., Lisa Schuchman, "Amazon's Domain Name Trouble Threatens ICANN Program", CORPORATE COUNSEL (Aug. 7, 2013), available at: <http://www.law.com/corporatecounsel/PubArticleCC.jsp?id=1202614276487&slreturn=20130719190909>.

Although geographic denominations may be registered with the local trademark offices, the term AMAZON is not registered as a geographical denomination by either the Brazilian or the Peruvian trademark offices (or any other government trademark offices in the Amazonia region).<sup>4</sup>

AMAZON, along with AMAZON-formative marks such as AMAZON.COM and AMAZON and Design (collectively the “AMAZON Marks”) is a trademark registered by Amazon more than 1300 times in over 149 countries world-wide – including registrations in the trademark offices and in the ccTLDs of the very regions that now claim Amazon should not be allowed to use its global mark as a gTLD.<sup>5</sup> Amazon has never used its mark as a geographic term. Nor have the governments of South America ever themselves used the names of their geographic regions – “Amazonia,” “Amazonas,” or “Amazon”<sup>6</sup> – or any variation of these terms, as trademarks for Internet services or any other goods and/or services.

The AGB, which was “the result of years of careful implementation of GNSO policy recommendations and thoughtful review and feedback from the ICANN stakeholder community,”<sup>7</sup> does not prohibit or require government approval of the terms .AMAZON, .アマゾン and .亚马逊. Amazon submitted the AMAZON Applications in January 2012 after careful review of, and fully consistent with, those rules.<sup>8</sup>

Despite our long-standing presence throughout the region, the Governments of Brazil and Peru opposed the AMAZON Applications (first through an Early Warning against only the .AMAZON application, and later seeking GAC consensus advice against .アマゾン and .亚马逊 as well). In response, Amazon actively engaged with the governments of the Amazonia region and the Organización del Tratado de Cooperación Amazónica (“OTCA”), the treaty

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<sup>4</sup> See discussion infra starting at p. 4.

<sup>5</sup> See the list of Amazon Trademarks and domain names issued in countries of the Amazonia region, attached as Appendix B.

<sup>6</sup> Guyana is the only country in the Amazonia region to use the term “Amazon” in reference to the region.

<sup>7</sup> “About the Program”, ICANN. <http://newgtlds.icann.org/en/about/program> (visited Aug. 12, 2013).

<sup>8</sup> .AMAZON, .アマゾン and .亚马逊 are not country or territory names, and thus are not prohibited as gTLD strings under Section 2.2.1.4.1 of the AGB, nor are they geographic names that require documentation of support or non-objection from any government or public authority pursuant to Section 2.2.1.4.2 of the AGB. Five specific categories of strings are considered “geographic names” requiring such government or public authority support, including “any string that is an exact match of a sub-national place name, such as a county, province, or state, listed in the ISO 3166-2 standard.” AGB §2.2.1.4.2. Despite the Peruvian GAC representative’s statement to the contrary during the Durban Meeting, .AMAZON, .アマゾン and .亚马逊 do not fall within any of the five categories, including the ISO 3166-2 list. The Geographic Names Panel has never contacted Amazon regarding its AMAZON Applications, and has not taken the position that the applied-for strings are “geographic names”. In addition, the AMAZON Applications have all passed Initial Evaluation with perfect scores of 100%, putting them in the top 5% of all applications passing evaluation.

organization that represents the Amazonia region, through letters, video-teleconference, and an in-person meeting in Brasilia leading up to the ICANN meeting in Beijing. Despite a number of proposals presented by Amazon, including support of a future gTLD to represent the region using the geographic terms actually used by the Brazilian and Peruvian regions, such as .AMAZONIA or .AMAZONAS, the GAC representatives for Brazil and Peru insisted that Amazon withdraw its application or change the strings to “.AMAZONINCORPORATED”, “.AMAZONINC” or “.AMAZONCOMPANY.”

Despite knowing the Community Objection process is the appropriate avenue designated by ICANN for governments wanting to contest geographic terms not included in the AGB, no representative from Brazil or Peru (or any of the other Amazonia region countries or the OTCA) filed a Community Objection. Instead, a third party – the “Independent Objector” (a person known to represent the Government of Peru) – filed a Community Objection on behalf of the region.<sup>9</sup>

At the Beijing meeting, GAC representatives from Brazil and Peru sought GAC consensus advice against the AMAZON Applications. After failing to achieve consensus through that process to block the applications outright, Brazil and Peru instead requested (via the GAC) that the AMAZON Applications – instead of being allowed to proceed as the AGB requires – be delayed so the GAC could “further consider” the strings at the Durban meeting. This Board agreed to the delay.

At the ICANN Durban Meeting the Brazilian and Peruvian GAC representatives asked the GAC to revisit its objection to the AMAZON Applications. Both the Brazilian and Peruvian GAC representatives made public statements emphasizing the attention the Applications had drawn by their own governments and governmental organizations.<sup>10</sup> In its second consideration of the AMAZON Applications, from our understanding following political and economic discussions by several of the objecting countries to persuade others to not block

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<sup>9</sup> As noted in our response to the Beijing GAC Advice and for completeness, the “Independent Objector” (“IO”) represents the Government of Peru in an ongoing case at the International Court of Justice, arguing on its behalf as recently as December 2012. We have separately raised serious concerns over the potential issue of conflicts with ICANN’s legal department – by telephone, in three separate letters, and in two in-person meetings (both before and after the IO filed his objection) – but have yet to receive a response from ICANN.

<sup>10</sup> Indeed, in mid-June a Brazilian Senator held widely-publicized hearings on the issue and created an online petition to gather signatures against the AMAZON Applications. The petition was supposed to be delivered to the ICANN Community at the Durban meeting, purportedly evidencing large scale community support against the AMAZON Applications. The Brazilian GAC representative referenced the petition when requesting the renewed objection be upheld – “we had a huge reaction from the civil society which is organizing a document signed by thousands of people to be sent to the ... ICANN Board” – but the petition itself was never delivered.

their objection, the GAC agreed on consensus advice to reject the AMAZON Applications that are before this Board.

## II. The GAC Advice is Inconsistent with International Law

ICANN is required to “operate for the benefit of the Internet community as a whole, carrying out its activities *in conformity with relevant principles of international law and applicable international conventions and local law*”.<sup>11</sup> While the GAC has an appropriate role to play in providing advice to the ICANN Board on matters related to government policy and international and national laws, the GAC Advice here substantially oversteps those bounds. ICANN’s failure to reject that advice would plainly violate relevant principles of international law and applicable conventions and local law, and therefore violate ICANN’s Governing Documents.

Governments do not have a per se national or global exclusive right to terms that are also used to represent a geographic area – be it a country, city, town, mountain, river, tributary, volcano, or other. Any rights in geographic terms are granted by law and, generally, cannot prohibit other uses of the term in a non-geographic manner. Indeed, the international legal system has well-established mechanisms for protecting terms, including use of geographical names. These mechanisms fall into one of four major categories: (1) Intellectual Property; (2) Regulatory Recognition; (3) National Sovereignty; and (4) Indigenous Rights. None of these mechanisms has ever been used by the objecting countries to protect the geographic term “Amazon” or any other translation or variation (as opposed to Amazon’s non-geographic use of the separate trademark AMAZON for Internet and e-commerce services).

### 1. Intellectual Property: Trademark Rights

The Paris Convention of 1883 (“Paris Convention”) is the basic building block for modern international intellectual property law. Importantly, the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS”) incorporates by reference Paris Convention Articles 1-12 and 19, and mandates that all World Trade Organization members enforce these provisions whether they are members of the Paris Convention or not. Under TRIPS and the Paris Convention, several forms of intellectual property protections and rights are recognized.

First, trademark protection is provided to terms that may act separately as geographic references, but are for trademark purposes distinctive of particular goods or services and

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<sup>11</sup> Articles of Incorporation of ICANN, § 4.

indicate a particular source of these goods or services.<sup>12</sup> The AMAZON Marks use the term AMAZON not as a geographic reference, which locally would be AMAZONIA and/or AMAZONAS, but as a fanciful term unrelated to the region. In fact, on July 26, 2013, the Peruvian trademark office, in considering the registrability of a third party's trademark applications for AMAZONAS, AMAZONASPERU and AMAZONAS.PE, and related oppositions, noted no similarities between these marks and AMAZON *"since the denomination AMAZONAS makes reference to one of the regions located north of Peru, while the denomination AMAZON will be perceived by the average consumer as a fanciful sign."*<sup>13</sup>

Here, Amazon holds trademark rights in and to the mark AMAZON as it relates to Internet and e-commerce services, among others. Amazon does not use the AMAZON Marks in any way that references or relates to the Amazonia region (in other words, the AMAZON Marks are not geographic terms; they are trademarks). The AMAZON Marks have been registered more than 1300 times in over 149 countries world-wide, *including in Brazil and Peru*. The very governments that now object to Amazon's use of the AMAZON Marks globally in connection with Internet and e-commerce services are now trying to ignore and erase not only the fact that Amazon has existed on the Internet for more than 17 years, but the fact that *these and other governments outside of their region have already expressly granted Amazon the right to use its marks for these services*.

Article 16(1) of TRIPS gives the owner of a registered trademark certain exclusive rights in that mark. Such rights can legally prevent other parties from using the same mark, including objecting countries or other parties, in the course of trade. The objecting governments have no superior legally recognized trademark rights in the term AMAZON for Internet-related services.

Second, Article 8 of the Paris Convention also gives international rights to protect trade names of commercial entities. To the best of Amazon's knowledge, none of the objecting countries owns legally recognized trade name rights in the term AMAZON.

Third, Article 6-ter of the Paris Convention protects various official names, insignia, flags, emblems, or hallmarks which indicate warranty and control. Brazil and Peru have sought to protect several of their insignia in this manner, but not the term AMAZON. For example, a design mark for CAFÉ DO BRASIL and the Official Seal of Peru, owned by Peru, were filed by Brazil and Peru respectively in the US Patent and Trademark Office under 6-ter. No such action was taken for the term AMAZON.

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<sup>12</sup> Examples are LONDON FOG for raincoats (the capital city of the United Kingdom), TSINGTAO for beer (a city in China), and HAWAIANAS for flip flops (Hawaiian in Portuguese).

<sup>13</sup> *Maribel Portella Fonseca v. Amazon Technologies, Inc.*, Resolución N. 2154-2013/CSD-INDECOPI.

Fourth, Articles 10 and 10 *bis* of the Paris Convention mandate that Member States undertake to protect against all acts of unfair competition and to give infringed parties remedies to protect their rights. Unfair competition protects against acts which deceive the public and are used by competitors in bad faith to undermine each other's businesses. Unfair competition protection could theoretically be available for geographical names if such names were used in a commercial activity. Because they have no commercial use of the term AMAZON, the objecting governments have no legally recognized unfair competition rights in the term AMAZON.

Fifth, another way that a geographical term may receive intellectual property protection is as an "appellation of origin" or "geographical indication" (hereinafter, collectively, "geographical denomination"). The principal methods for protecting geographical denominations arise under national law, bilateral treaties and global treaties. The most well-known geographic denomination is CHAMPAGNE for a sparkling wine from a particular region of France produced under strict protocols. In the international context, the principal global treaties that include references to geographical denominations are the Paris Convention of 1883, the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods of 1891, the Lisbon Agreement on the Protection of Appellations of Origin, and the WTO TRIPS Agreement of 1994. The objecting governments have not protected and have not sought to protect the term AMAZON as a geographical denomination under the framework provided by any of these treaties.<sup>14</sup>

The principal treaty recognizing geographical denominations (which it terms "geographical indications") is the TRIPS Agreement,<sup>15</sup> which provides relative protection against false geographical indications that are misleading (including misleading use of a previously recognized geographical indication as a trademark). Even if the objecting governments were now to establish geographical indication rights in the term AMAZON (which, as noted above, they presently do not hold), these rights would be limited to a particular set of goods or services that these governments had shown to "originate" in the Amazonia region or for which "a given quality, reputation or other characteristic...[were] essentially attributable to" the Amazonia Region.<sup>16</sup> Internet-related services would certainly not qualify.

As a result, none of the objecting governments can claim intellectual property rights in and to the term AMAZON, nor take advantage of geographical denominations protections under

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<sup>14</sup>Some of the objecting governments have protected geographic indications for other terms. Peru, for example, has protected over 700 geographic indications under the Lisbon Agreement, but none is for AMAZON.

<sup>15</sup> All members of the WTO are members of the TRIPS Agreement. As of the date of this letter, 159 countries are members of the WTO.

[http://www.wto.org/english/thewto\\_e/whatis\\_e/tif\\_e/org6\\_e.htm](http://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm).

<sup>16</sup> TRIPS Agreement, Article 22(1).



national and international laws. Even under the narrowest interpretation of Amazon’s trademark rights, Amazon’s right to use the term AMAZON for Internet-related services would prevail under existing national and international laws. Respect of well-established national and international intellectual property laws alone requires rejection of the GAC Advice.

## 2. Regulatory Recognition

In many legal systems, certain commodities have specific naming protocols to avoid confusion in the international marketplace. For example, the term NAPA is protected for wines from the Napa Valley in California, USA, under the U.S. system of “American Viticultural Areas.” This type of governmental protection is a helpful system for protection of geographical names that do not fall within the various intellectual property rights granted nationally and internationally. In addition, geographical names are protected under international, national, and municipal laws as they relate to consumer protection, such as regulations designed to prevent consumer confusion and harm.

The objecting countries have no legally recognized regulatory rights in the term AMAZON.

## 3. National Sovereignty

Under international law, sovereign states have certain rights to control their national boundaries and be represented in international organizations and related interests. These rights, however, do not extend to preventing use of terms in a non-geographic manner (i.e., as a trademark or for use in connection with services that bear no relation to a physical, geographic region), particularly when their own national laws allow such use. The very countries objecting to Amazon’s use of AMAZON for Internet services – as well as numerous other sovereign countries – granted registrations in the AMAZON Marks under their own laws on this very basis. Indeed, there is no international consensus as to whether sovereign rights over boundaries extend to country names, let alone any sub-region or physical feature such as a river, nor are there any current global mechanisms for recognizing such rights, but there is consensus on the protection of a trademark owner’s rights through the treaty provisions found in the TRIPS Agreement.

The objecting countries have no legally recognized independent sovereignty rights in any sub-regional names for the term AMAZON.



## 4. Indigenous Rights

Certain human rights are protected under international law (and even under ICANN policy where the Universal Declaration of Human Rights and the International Covenant on Civil and Political Rights are mentioned). In addition, consideration is given to the UNESCO cultural indicia, human rights in property ownership, self-determination, and free expression, and other inherent political rights. However, the objecting countries have no legally recognized rights in the term AMAZON.

To the contrary, corporate ownership of trademarks is clearly protected under human rights. In the European Union case *Anheuser-Busch, Inc. v. Portugal*, Application No. 73049/01 (1/11/2007), the Grand Chamber of the European Court of Human Rights upheld trademarks as valid possessions ruled by human rights law. It is important to note as well that human and indigenous rights under these doctrines belong to the individual, not the state, and these rights protect individuals from state action to take away their rights and property. In this matter, not only do the objecting governments not have any human or indigenous rights in the word AMAZON, but international law forbids them from globally limiting and devaluing this well-known trademark.

Despite all the methods listed above to provide protection for geographical names, the objecting countries have pursued none of them in connection with the term AMAZON. Amazon does not dispute this region's importance to its inhabitants and their governments. This importance, however, does not grant the region – or national governments – per se rights to prevent use of an otherwise unprotected geographic term, nor does it give the GAC or ICANN the right to create extraterritorial, sui generis, per se rights in geographic terms. Indeed, to the extent that this is a “matter of principle,”<sup>17</sup> the principle at stake is the obligation of WTO Member states and the ICANN Board to follow international law as set out in the applicable treaties, including most pertinently the TRIPS Agreement administered by the WTO. As noted above and further discussed below, such treaties carefully balance the competing interests in protecting geographic denominations and trademarks. It is to these international treaties that the ICANN Board must look for guidance, not the vague and unsubstantiated concerns upon which the GAC Advice is grounded.

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<sup>17</sup> The Peruvian GAC representative in Durban stated, “dot Amazon is a geographic name that represents important territories of some of our countries which have relevant communities with their own culture and identity directly connected with the name. Beyond the specifics, this should also be understood as a matter of principle.” Quotes taken from the live scribe feed as provided by ICANN: <http://icann.adobeconnect.com/p2y1517vnt2/>. Transcripts attached as Appendix C.

Both the TRIPs Agreement and the Lisbon Agreement contain provisions relating to the resolution of conflicts between trademarks and geographical denominations. International discussions and negotiations on ways to interpret, reshape, or amend these treaty provisions remain ongoing. Many third-party organizations and NGOs active in the protection of trademarks or geographical denominations have also weighed in with their opinions on ways to address situations where one party's trademark rights appear to conflict with another party's interest in protecting a geographical denomination. *Not once in the history of debate and discussion of this issue has a nation or organization with an interest in this topic advanced the extreme position now taken by the governments of Brazil and Peru with respect to the term AMAZON: that a local region's newly-expressed interest in a particular geographical term **per se** – which is not used or commonly recognized as a source identifier for any product or service – be privileged over a third-party's longstanding, established trademark rights that the countries of this very local region have themselves recognized, registered and protected for over a decade.*

To the contrary, where a trademark has been protected in a particular jurisdiction before the date on which the TRIPs Agreement becomes effective in that jurisdiction, or before the protection of a conflicting geographical indication in its country of origin, Article 24(5) of the TRIPs Agreement further specifies that the implementation of the provisions of the section on Geographic Indications “shall not prejudice eligibility for or the validity of the registration of [such] trademark, or the right to use [such] trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.”<sup>18</sup>

A 2005 WTO Panel addressed whether the exception provided for in Article 24(5) of the TRIPs Agreement amounts to a “first in time, first in right” rule or mandates coexistence of the relevant trademark and geographical indication. In that case, Australia and the United States challenged a 1992 European Union regulation for protecting geographical denominations for agricultural products and foodstuffs.<sup>19</sup> The WTO Panel concluded that in

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<sup>18</sup> TRIPs Agreement, Article 24(5). The full text of this section reads: “Where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith either: (a) before the date of application of these provisions in that Member as defined in Part VI; or (b) before the geographical indication is protected in its country of origin; measures adopted to implement this Section shall not prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.”

<sup>19</sup> *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs*, WT/DS290/R (15 March 2005) (hereinafter “WTO Decision 290”). Full information on this case, including a copy of the Report of the WTO Panel, is available at: [http://www.wto.org/english/tratop\\_e/dispu\\_e/cases\\_e/ds290\\_e.htm](http://www.wto.org/english/tratop_e/dispu_e/cases_e/ds290_e.htm). See also Council Regulation (EEC) No. 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (hereinafter “E.U. Foodstuffs Regulation”), available at: <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=CELEX:31992R2081:EN:HTML>. This E.U. Regulation was subsequently amended to comply with the WTO panel's decision in the case

accordance with Article 17, the TRIPs Agreement allows for a limited exception to a trademark owner's rights – namely, that the trademark owner may be compelled to accept coexistence when trademark and geographical indication rights conflict.<sup>20</sup> Notably, this decision does not suggest that geographical indication rights should be allowed to trump trademark rights.

Peru, Brazil and the other South American countries of the Amazonia region that support the objection to the AMAZON Applications are WTO members and therefore legally bound to implement the terms of the TRIPs Agreement and to follow the rulings of the WTO on its interpretation of the TRIPs Agreement. *Under the rule of international law established by the WTO's decision discussed above, it is clear that even if Brazil and Peru were to now recognize the term AMAZON as a protected geographical denomination, such protection would not permit them to prohibit or limit the use of the previously recognized trademark AMAZON.* In other words, neither Brazil nor Peru, and likely no other governments, could bar the AMAZON Applications in their own countries under their own laws, and to do so would violate international laws.

Ironically, the Brazilian government filed third-party arguments in the WTO case discussed above that were far more sympathetic to trademark-owner concerns than the position it is now taking regarding the AMAZON Applications. Brazil's arguments stressed the importance of maintaining the value of trademarks and referred dismissively to “a theoretical hypothesis of coexistence between a trademark and a geographical indication.”<sup>21</sup> As Brazil candidly and correctly concluded at that time:

Brazil believes that without disregarding the peculiar features surrounding the use of a geographical indication and the need to protect it, one must not do so at the expense of both the trademark owners and the consumers. Otherwise, the commercial value of a trademark may be undermined, which runs contrary to the ‘exclusive rights’ of a trademark owner provided for in Article 16.1 of the TRIPs Agreement.<sup>22</sup>

The Brazilian government further elaborated that in its view, resolution of conflicts between trademarks and geographical denominations should:

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discussed here; the replacement regulation is Council Regulation (EC) No. 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (hereinafter “E.U. Amended Foodstuffs Regulation”), available at: <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2006:093:0012:01:EN:HTML>.

<sup>20</sup> *Id.* at 143-50.

<sup>21</sup> WTO Decision 290, Annex C, C-7.

<sup>22</sup> *Id.* at C-7 - C-8.

[T]ake due account of the fact that (a) geographical indications do not *a priori* prevail over registered trademarks[.]<sup>23</sup>

Thus, under Brazil's *own* interpretation of the TRIPs Agreement, one thing is clear: any rights that Brazil or any of its neighboring countries may have accrued in the geographical term AMAZON should not *a priori* prevail over Amazon's registered trademark rights in the term AMAZON, which have long been recognized in the region. A government cannot selectively use ICANN to override the protections found in TRIPs and other international laws.

The ICANN Board had it right when it approved the policy recommendations resulting in the AGB. It was – and is – essential that the new gTLD application process be transparent, predictable, and non-discriminatory. *The ICANN Board recognized that allowing governments to retroactively determine names that are of concern because of geographic connotations would lead to discriminatory and chaotic consequences.*<sup>24</sup> To provide the GAC with an effective veto power over individual strings injects unpredictability<sup>25</sup> and politics<sup>26</sup> into the gTLD application process. It allows governments to use the ICANN Board to take actions the governments could not take – and have not taken – under their own laws, creating a new form of *sui generis* rights along the way.

At minimum, Amazon requests that, pursuant to the authority reserved to itself in AGB Section 3.1, the NGPC obtain, before it considers the GAC Advice against the AMAZON Applications, independent expert advice on the protection of geographic names in international law generally and the violations of relevant principles of international law and applicable conventions and local law represented by the GAC Advice. Amazon believes that the legal treatise cited in notes 1-2 above and the discussion in Section II above provide

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<sup>23</sup> *Id.* at C-9.

<sup>24</sup> See the attached highlighted communications between the ICANN Board and the GAC from the period 2009 to 2011 on the issue of geographic names, attached as Appendix D.

<sup>25</sup> From the Ugandan GAC representative in Durban: "We're going through a process of generating similar strings which may be of concern to us. So I'm wondering should we always have to come here and make statements like this or there's going to be a general way of protecting those strings that we think are sensitive to us."

From the Brazilian GAC representative in Durban: "Now we have dot amazon. But in the future, maybe you can have dot sahara, dot sahel, dot nile, dot danube. I don't know if the names are there. I don't have the list by heart. But maybe the names are not there. But it doesn't mean they're not important for national culture and traditional concerns in your countries."

Quotes taken from the live scribe feed as provided by ICANN:

<http://icann.adobeconnect.com/p2y1517vnt2/>. Transcripts attached as Appendix C.

<sup>26</sup> From the Sri Lankan GAC representative in Durban: "This issue of dot amazon has reached our foreign ministry and has gone to the highest level of attention between discussions with the Brazilian government on a lot of bilateral trade related issues." Quotes taken from the live scribe feed as provided by ICANN: <http://icann.adobeconnect.com/p2y1517vnt2/>. Transcripts attached as Appendix C.

material information to the NGPC that demonstrate why the NGPC should not accept GAC Advice against the AMAZON Applications, and why it should allow the AMAZON Applications to proceed.

NGPC acceptance of the GAC Advice would destroy hard fought international consensus and well-settled expectations on geographic names. It would impermissibly place ICANN above accepted international and national laws at the behest of individual governments in ways that will not hold up on review in other forums.

### **III. ICANN Must Act in a Predictable, Transparent, and Non-Discriminatory Manner**

In addition to violating various international laws, accepting the GAC Advice would violate ICANN's Governing Documents. The right to provide advice on individual applications based on sensitivities, as granted by the Community, could not have intended such consequences. If so, the entire process itself may be in violation of ICANN's guiding principles.

#### **A. GAC Advice Throws Out the Transparency and Predictability Carefully Balanced in the Development of the AGB**

ICANN's Governing Documents require ICANN to operate in an "open and transparent" manner.<sup>27</sup> At the outset, the GNSO Council New gTLD Policy Recommendations emphasized the need to support these requirements and to provide new gTLD applicants with a transparent and predictable process.<sup>28</sup> Both the GAC<sup>29</sup> and the ICANN Board<sup>30</sup> itself adopted and endorsed the importance of providing new gTLD applicants with a transparent and predictable process.

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<sup>27</sup> Articles of Incorporation of ICANN, § 4. ICANN Bylaws, Article II, §2(7). Affirmation of Commitments, §9.1.

<sup>28</sup> "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." ICANN GNSO Final Report, Policy Recommendation 1, Aug. 8, 2007.

<sup>29</sup> "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." Annex B, "GAC Principles Regarding New gTLDs", §2.5, GAC Communique – Lisbon, Mar. 28, 2007.

<sup>30</sup> "Resolved (2008.06.26.02), based on both the support of the community for New gTLDs and the advice of staff that the introduction of new gTLDs is capable of implementation, the Board adopts the GNSO policy recommendations for the introduction of new gTLDs." Adopted Board Resolutions – Paris, June 26, 2008.

The ICANN Community and Board underscored the importance of predictability for applicants during discussions about blocking terms that governments determined caused “sensitivities” to a region.<sup>31</sup> The GAC repeatedly requested that the Board and ICANN Community afford the same protections to names that do not appear in the AGB-referenced ISO lists as to names that do appear. To ensure predictability and fairness to applicants – and prevent precisely the sort of ad hoc undermining of ICANN’s rules now playing out here – the Board expressly rejected these requests.<sup>32</sup> To address government concerns over strings that raise “national, cultural, geographic, religious and/or linguistic sensitivities or objections that could result in intractable disputes”, the AGB was revised to include section 2.2.1.4.2 of the AGB and the ability by individual governments to file both Community and Limited Public Interest Objections.<sup>33</sup>

In order to ensure transparency and predictability, the ICANN Board specifically precluded the GAC and/or governments from having broad post-application discretion to block applications based on non-geographic use of specific terms. Advice must be based on more than a “principle” of dislike.

The GAC would now have the Board sweep away years of multi-stakeholder input and policy developments, retroactively implementing the proposed but never adopted GAC’s 2007 Principles in connection with geographic names, and reject applications in violation of ICANN’s Governing Documents. If the Board accepts the GAC Advice on the AMAZON Applications, no applicant can ever be sure that its application – and the significant resources needed to support it – meets the requisite standards for filing. Applicants instead become pawns in politics unrelated to the DNS or Internet, subject to negotiations with governments over business models and branding that they would not otherwise be required to undertake under national laws.

## B. GAC Advice Has A Discriminatory Effect on Amazon

Pursuant to ICANN’s Governing Documents, ICANN must act in a non-discriminatory, neutral

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<sup>31</sup> “The Board’s intent is, to the extent possible, to provide a bright line rule for applicants. . . . It is felt that the sovereign rights of governments continue to be adequately protected as the definition [of geographic names] is based on a list developed and maintained by an international organization.” Letter from ICANN (Dengate-Thrush) to GAC (Karklins), Sept. 22, 2009.

<sup>32</sup> “The Board has sought to ensure [...] that there is a clear process for applicants, and appropriate safeguards for the benefit of the broad community including governments. *The current criteria for defining geographic names as reflected in the Proposed Final Version of the Applicant Guidebook as considered to best meet the Board’s objectives* and are also considered to address to the extent possible the GAC principles.” ICANN Board – GAC Consultation: Geographic Names, Feb. 21, 2011 (emphasis added).

<sup>33</sup> ICANN Board – GAC Consultation: Objections, Feb. 21, 2011. See also ICANN Board – GAC Consultation: Geographic Names, Feb. 21, 2011.

and fair manner.<sup>34</sup> Indeed, one of the core values guiding ICANN’s decisions and actions is “[m]aking decisions by applying documented policies neutrally and objectively, with integrity and fairness.”<sup>35</sup> The GAC now asks this Board to ignore these requirements.

In his July 16, 2013 public statement to request GAC Consensus Advice against the AMAZON Applications, the Brazilian GAC representative stated that the AMAZON Applications are of “deep concern” to the Brazilian Society and create a “risk to have the registration of a very important cultural, traditional, regional and geographical name related to the Brazilian culture.” The Brazilian GAC representative contended that there is concern over “the registration of this very important name to the Brazilian Society.” He claimed that representatives from Brazil and other countries met with Amazon in good faith – that Amazon is willing to “make a good job” – but “*for a matter of principle*, [Brazil] cannot accept this registration” and asked the GAC to “reinforce the Brazilian demand to the GAC members to approve a rejection on the registration of dot amazon by a private company in name of the public interest.”<sup>36</sup>

Notably, neither the objecting countries nor the GAC objected to another gTLD application with a nearly identical fact pattern. Ipiranga Produtos de Petroleo S.A. (“Ipiranga”), the applicant for .IPIRANGA, Appl. No. 1-1047-90306, is a Brazilian private, joint stock company. Ipiranga is “one of the largest oil distribution companies in Brazil and is the largest private player in the Brazilian fuel distribution market.”<sup>37</sup> Ipiranga “holds various trademarks in Brazil to protect its brand. . . . [as well as] various trademarks in South America” and various domain names to protect its brand, such as *ipiranga.com.br* and *ipiranga.net.br*. “Ipiranga’s operations also include a successful, promotion-based e-commerce website *ipirangashop.com*.” Ipiranga states it has invested heavily in brand awareness and has received extensive recognition, including “Second Most Remembered and Preferred Trademark” in the field of oil distribution in Brazil, and “Most Well-Known and Preferred Brand in the field of fuels.”

According to the .IPIRANGA Application, Ipiranga applied for a gTLD to, (1) “secure and protect the Applicant’s key brand” (“IPIRANGA”) as a gTLD; (2) “reflect the IPIRANGA brand

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<sup>34</sup> ICANN shall not apply its standards, policies, procedures, or practices inequitably or single out any particular party for disparate treatment unless justified by substantial and reasonable cause, such as the promotion of effective competition. ICANN Bylaws, Article II, §3.

<sup>35</sup> ICANN Bylaws, Article I, §2(8).

<sup>36</sup> Quotes taken from the live scribe feed as provided by ICANN: <http://icann.adobeconnect.com/p2y1517vnt2/>. Transcripts attached as Appendix C (emphasis added).

<sup>37</sup> New gTLD Application Submitted to ICANN by: Ipiranga Produtos de Petroleo S.A. Taken from the public portion of the application as found at <https://gtldresult.icann.org/application-result/applicationstatus/applicationdetails/1509> (hereinafter “.IPIRANGA Application”), Response to Question 18(a).



at the top level of the DNS' hierarchy"; (3) provide "stakeholders of the Applicant with a recognizable and trusted identifier on the Internet"; (4) provide "stakeholders with a secure and safe Internet environment, under the control of the Applicant;" and (5) "use social communities to increase brand awareness and consumer trust." Ipiranga stated that its .IPIRANGA Application was not a geographic name.

Ipiranga is a district of São Paulo.<sup>38</sup> The Ipiranga Brook is a river in the São Paulo state in southeastern Brazil where Dom Pedro I declared independence in 1822, ending 322 years of colonial rule by Portugal over Brazil.<sup>39</sup> Indeed, the Ipiranga is so important to Brazilian culture and heritage that it is included in the first stanza of the national anthem.<sup>40</sup>

Nowhere in the .IPIRANGA Application does Ipiranga state that it obtained approval (or non-objection) from the Brazilian government for its application.<sup>41</sup> Nowhere in the application does Ipiranga state that it will act in any interest but the protection of its rights as a private company. The Brazilian GAC representatives did not issue an Early Warning against the .IPIRANGA Application nor did Ipiranga submit a Public Interest Commitment.<sup>42</sup>

Notwithstanding the obvious importance of the term "Ipiranga" to Brazil's heritage, the GAC did not object to the .IPIRANGA Application nor, to Amazon's knowledge, did the GAC even discuss the .IPIRANGA Application during the GAC sessions in Beijing<sup>43</sup> or Durban.

Amazon does not believe the .IPIRANGA Application should be rejected; quite to the contrary. Just like Ipiranga, the oil company, Amazon is a company that has a globally established reputation separate and distinct from a geographic term.<sup>44</sup> Amazon does not believe that the Brazilian government is purposefully acting in a discriminatory way towards non-Brazilian companies, but the facts - intentional or not - highlight the discriminatory effect of allowing governments to retroactively decide "winners" and "losers".

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<sup>38</sup> See Ipiranga, Wikipedia <<http://en.wikipedia.org/wiki/Ipiranga>>. Attached as Appendix E.

<sup>39</sup> See Ipiranga Brook, Wikipedia <[http://en.wikipedia.org/wiki/Ipiranga\\_Brook](http://en.wikipedia.org/wiki/Ipiranga_Brook)>. Attached as Appendix E.

<sup>40</sup> English translation: "The placid shores of Ipiranga heard; the resounding cry of a heroic people; and in shining rays, the sun of liberty; shone in our homeland's skies at this very moment." See Brazilian National Anthem, Wikipedia <[http://en.wikipedia.org/wiki/Brazilian\\_National\\_Anthem](http://en.wikipedia.org/wiki/Brazilian_National_Anthem)>. Attached as Appendix E.

<sup>41</sup> Even if the oil company has received permission, it would again show a potential bias toward local companies over foreign companies in approving applications.

<sup>42</sup> See New gTLD Current Application Status <<https://gtldresult.icann.org/application-result/applicationstatus/viewstatus>>. Attached as Appendix F.

<sup>43</sup> The majority of the GAC sessions held in Beijing were closed to the community.

<sup>44</sup> And unlike in the .IPIRANGA Application, the AMAZON Applications are not matches of the geographic term at issue with the Government of Brazil.

Other gTLD applicants have applied for strings that also could be considered “geographic” strings or may cause cultural sensitivities, but have not been the subject of GAC Advice.<sup>45</sup> Indeed some of these applicants not only provided no documentation of governmental or regional support or non-objection, and received no GAC advice, but have even successfully sought trademark registrations in the region.<sup>46</sup> Again, Amazon does not suggest that the NGPC should reject these and all other applications that may fit one country’s definition of “geographic” or “sensitive.” But the Board has a legal and institutional duty to ensure that the rules set forth in the AGB are applied in a consistent, non-discriminatory way. It was for these very reasons the ICANN Community insisted on a definition of geographic names and a clearly defined process for considering any objections.

Instead of applying the clear definitions on geographic names set forth in the AGB, the GAC is attempting to apply the 2007 GAC Principles retroactively and selectively – principles never approved or adopted by ICANN and that have no effect as policy – and ask the NGPC, in violation of the Bylaws, to uphold its decision. The intent behind GAC advice on individual applications was not to allow the GAC to override the rules set forth regarding geographic names in the AGB; to override years of multi-stakeholder created policy; and to apply a discriminatory veto against certain applications in direct violation of the ICANN Bylaws.<sup>47</sup> ICANN should not permit GAC Advice to be used to achieve any individual government’s political goals – be it *de facto* protections a government is unable to get under ongoing intergovernmental treaty negotiations or under its own national laws or as part of a wider discussion on Internet governance. The Board should reject the GAC Advice against the AMAZON Applications.

#### **IV. GAC Advice Contravenes Policy Recommendations as Implemented in the AGB**

Years of policy development led to the creation of the AGB. Despite retroactive characterizations by various GAC representatives, the 2007 Principles proposed by the GAC were never approved or adopted by the multi-stakeholder ICANN Community or Board. Instead, they were recommendations that were taken into account by the Generic Names Supporting Organization (“GNSO”) and Board and considered as part of the multi-stakeholder process that developed the AGB, which was adopted by the Board. Attempts to reinstate the 2007 Principles as ICANN policy contravene the Policy Development Process (“PDP”) set forth in ICANN’s Bylaws and undermine the entire multi-stakeholder process. If

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<sup>45</sup> For example, applications were submitted for LATINO, LAT, CHESAPEAKE, JAVA, LINCOLN, DODGE, EARTH, and others.

<sup>46</sup> For example, a Chilean trademark registration, Registration Number 1.008.605, issued on May 6, 2013 to a gTLD applicant for the mark LATINO in connection with domain name registration services in class 45.

<sup>47</sup> See, generally, *ICM Registry, LLC v. ICANN*, ICDR Case No. 50 117 T 00224 08, Judge Stephen M. Schwebel, Presiding. (Feb. 19, 2010).

the ICANN Board accepts this advice, it will unravel years of policy development in violation of the ICANN Bylaws and have far reaching effects on the whole program.

Under the ICANN Bylaws, “there shall be a policy-development body known as the [GNSO], which shall be responsible for developing and recommending to the ICANN Board substantive policies relating to generic top-level domains.”<sup>48</sup> ICANN relies on the GNSO to create gTLD policy, and its advisory committees, including the GAC, to provide *advice* on policy recommendations before the Board.

The GNSO spent several years developing the policy recommendations for the introduction of new gTLDs, including limitations to potential entrants. The PDP involved numerous debates, changes, and variations, which included stakeholders from the entire ICANN Community (including the “Principles” proposed by the GAC in 2007), and resulted in the final new gTLD policy recommendations. These recommendations were accepted by a supermajority of both the GNSO and the ICANN Board of Directors. The AGB represents the implementation of these policy recommendations.<sup>49</sup>

Among many of the topics that were considered as part of the PDP was the question of “geographic terms” and governments’ rights to object to strings representing geographic terms. In 2007 the GAC issued a set of “public policy” principles that the GAC advised should be implemented in the new gTLD process, including the avoidance of “country, territory or place names, and country, territory or regional language or people descriptions” and that new gTLDs should “respect” “sensitivities regarding terms with national, cultural, geographic and religious significance.”<sup>50</sup> These principles, however, are not policy and neither the ICANN Board nor the ICANN Community wholesale adopted them.

Instead, the ICANN Board took the principles as advice – as per the role of the GAC – and individually adopted or modified them over the course of several years. The Board and the ICANN Community identified the GAC principles on geographic names, in particular, as problematic. No list of geographic terms (beyond the AGB definition) could be agreed upon – *including by the GAC itself* – to provide applicants with the relevant transparency and predictability that all parties agreed Applicants needed, and which ICANN’s Governing Documents require.

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<sup>48</sup> ICANN Bylaws, Article X, §1.

<sup>49</sup> Amazon is not making separate comments on the policy versus implementation debate. It is clear, however, that GNSO policy recommendations, accepted by the ICANN Board, must be the subject of a PDP before they can be modified.

<sup>50</sup> Annex B, “GAC Principles Regarding New gTLDs”, §2.1-2.2, GAC Communique – Lisbon, Mar. 28, 2007.

As late as February 23, 2011, the GAC requested a mechanism to protect governmental interests and define names considered geographic. The GAC requested clarification that “ICANN will exclude an applied for string from entering the new gTLD process when the government formally states that this string is considered to be a name for which this country is commonly known as.”<sup>51</sup> The ICANN Board responded:

The process relies on pre-existing lists of geographic names for determining which strings require the support or non-objection of a government. Governments and other representatives of communities will continue to be able to utilize the community objection process to address attempted misappropriation of community labels. . . . *ICANN will continue to rely on pre-existing lists of geographic names for determining which strings require the support or non-objection of a government.*<sup>52</sup>

Section 3.1 of the AGB states that “GAC Advice on new gTLDs is intended to address applications that are identified by governments to be problematic e.g., that potentially violate national law or raise sensitivities.” Section 3.1 of the AGB was not intended to give government broad retroactive discretion to block any term in any language/script based solely on a government’s general “principle” or dislike, nor for a non-geographic, fanciful use for a term not included in the lists of banned terms found in the AGB.<sup>53</sup> Otherwise the GAC would have “an automatic veto” over the outcome of a PDP that was adopted by two super majorities on a string-by-string basis (as “sensitivities” could include any potential issue to a government). Indeed, communications between the GAC and the Board make it clear the opposite is true. “While freedom of expression in gTLDs is not absolute, those claiming to be offended on national, cultural, geographic or religious grounds do not have an automatic veto over gTLDs.”<sup>54</sup>

Amazon followed the rules set forth in the AGB and submitted its AMAZON Applications in full compliance with and reliance on the policies developed and agreed upon by the ICANN Community and reflected in the AGB. The GAC Advice now asks that the ICANN Board ignore this multi-year, multi-stakeholder process. Providing the GAC with the veto power that this GAC Advice represents, and adoption of such Advice, puts in to play violations of ICANN’s own founding principles and Governing Documents not only for this round of applications, but future rounds as well. Rejection of the GAC Advice on the Amazon Applications by the NGPC is the correct course of action.

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<sup>51</sup> Letter from ICANN (Dengate-Thrush) to GAC (Dryden), March 5, 2011.

<sup>52</sup> *Id.* (emphasis added).

<sup>53</sup> And it certainly was not intended to create new rights in a government in opposition with international law. See discussion above starting at p. 4.

<sup>54</sup> Letter from ICANN (Dengate-Thrush) to GAC (Dryden), November 23, 2010.

## V. Summary

Amazon has no doubt that individual country representatives believe they are representing the best interests of their regions. These same countries had the option to file for a new gTLD or file a Community Objection to the AMAZON Applications. They did neither. Instead, they now seek to use the GAC Advice process as a means to (1) override years of Community policy development; (2) violate ICANN's Governing Documents; and (3) violate both international and national law.

Individual governments have an important role in the multi-stakeholder model. But they plainly cannot exercise veto power over multi-stakeholder policy and ICANN's Governing Documents or use ICANN to override the very laws under which the same governments operate.<sup>55</sup> The NGPC should not allow any government to accomplish through the GAC what they have not – and cannot – accomplish through their national legislatures.

ICANN has already independently “reaffirmed its commitment to be accountable to the community for operating in a manner that is consistent with ICANN's Bylaws, including ICANN's Core Values such as ‘Making decisions by applying documented policies neutrally and objectively, with integrity and fairness.’”<sup>56</sup> Amazon respectfully requests that the NGPC stand by that commitment, abide by relevant international and national law, and reject the GAC Advice on the AMAZON Applications.

We thank the NGPC for its time and consideration of our comments. We request an opportunity to meet with the New gTLD Program Committee and the ICANN General Counsel to discuss this submission in more detail.

With best regards,

Stacey King  
Sr. Corporate Counsel, Amazon

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<sup>55</sup> This is one of the reasons preserving a multi-stakeholder model, where no one entity – including government – can use the process for political means and/or inject external issues into the process, is so important.

<sup>56</sup> Letter from ICANN (Dengate-Thrush) to GAC (Dryden), November 23, 2010.

## **APPENDIX A**

## Chapter 5

# Intellectual Property Rights in Geographic Names

Domain names are not intellectual property rights.<sup>548</sup>

### 5.1 GEOGRAPHIC NAMES AS 'INTELLECTUAL PROPERTY'

Governments at national and sub-national levels have used the phrase 'legitimate interests'<sup>549</sup> when asserting exclusive rights in geographic names, but it has yet to be determined what rights international law actually recognizes in respect of geographic names, let alone their exclusivity. Intellectual property rights are an obvious potential basis of recognition of rights in geographic names due to the strong similarities between geographic names and other intellectual property subject matter, as well as the fact that names have long been protected through intellectual property law as trademarks. The fundamental aim of this study is, however, to dispel reliance on assumptions regarding geographic names. A thorough analysis is therefore undertaken to determine conclusively whether geographic names fall

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548. Smith, *Internet Law and Regulation* 89, 3-042.

549. See for example, *St Moritz v. StMoritz.com*, WIPO Case No. D2000-0617; *Sydney Airport v. Crilly*, WIPO Case No. D2005-0989; *Her Majesty the Queen, in right of her Government in New Zealand v. Virtual Countries*, WIPO Case No. D2002-0754. The use of this particular phrase is owed at least in part to the possession of 'rights or legitimate interests' in the name in question being a ground of contention under the UDRP (clause 4(a)(ii)). The exclusivity of State interests in geographic names is explored in-depth in Part III, Chapter 6.



within the general subject matter of intellectual property law as recognized in international law, or within the specific subject matter protected by trademark law.

It is a mistake to assume from the outset that all intangibles that derive value from their contribution to human culture, information or entertainment fall within the scope of what is broadly termed 'intellectual property'. Intellectual property is not a refuge for all creative or potentially profit-generating expression or innovation. While rights in certain types of names have long been recognized as 'intellectual property', this does not mean that all names are or should be characterized as such. Rather than be assumed, the obviousness or common-sense nature of an intellectual property right in geographic names should be questioned. In the context of similar assumptions about a right of publicity it has been said: "What appears to be "common sense" may be nothing but the particular view of a matter that most strongly supports and expresses the interests of powerful social groups, or that fits most snugly with other deeply rooted and unexamined beliefs."<sup>550</sup> So may it be for geographic names as intellectual property.

The first part of this chapter examines the scope and definitions of intellectual property. It is shown that geographic names are not expressly provided for as intellectual property subject matter save in a strictly limited context. Their inclusion as a general category of names falling within the general notion of intellectual property subject matter hinges upon States' taking the initiative to do so. The second part of this chapter explores geographic names' imperfect fit within trademark law. Even if '[m]arks indicating the geographic origin of goods were the earliest type of trademark',<sup>551</sup> trademark law (as distinguished from rights in geographical indications, which are separately recognized in international law and therefore addressed as a separate chapter of this book) has to date largely prevented geographic names from receiving protection.<sup>552</sup> It is curious, therefore, that contemporary concerns about the use of geographic names in the DNS should be primarily characterized in terms of trademark law. Conclusions as to the recognition within international law of intellectual property rights generally and trademark rights particularly in geographic names are summarized at the end of this chapter.

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550. Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 Cal. L. Rev. 127, 136 (1993).

551. Bernard O'Connor, *The law of geographical indications* 21 (Cameron May 2004), citing F. I. Schechter, *The Historical Foundation of the Law Relating to Trade-Marks* (1925). See also S.A. Diamond, *The Historical Development of Trademarks*, 73 Trademark Rep. 22 (1983); M.G. Coerper, *The Protection of Geographical Indications in the United States of America, with Particular Reference to Certification Marks*, Industrial Property July/August 1990, 232.

552. See Albrecht Conrad, *The Protection of Geographical Indications in the TRIPS Agreement*, 86 Trademark Rep. 11, 40 (1996).

5.1.1 CHARACTERISTICS OF INTELLECTUAL PROPERTY AND GEOGRAPHIC NAMES

It is true that geographic names possess certain common characteristics attributed to intellectual property subject matter generally. Names, like other intellectual property subject matter, are intangible in the sense that they are merely human expression and not something that has physical embodiment, such as a house, a car, or a chair. Names are ideas that have as their raw material the human mind rather than such physical, tangible raw materials as wood, steel or clay. This is the case for all names, geographic or otherwise. Like intellectual property generally, all names are non-perishable; they will not rot or spoil if left unused and they can be used over and over again without physical depletion, damage or depreciation.

Names are also non-rivalrous resources: the use of a name by one person, like the use of language<sup>553</sup> or ideas but unlike the use of a car, plot of land or machine, does not prevent others from using it simultaneously.<sup>554</sup> While the physical materials in or onto which names are expressed are constrained by exclusivity of use (in other words, the can onto which the brand name of a soft drink is printed or a book on whose pages ideas are expressed can be exploited by only one individual at a time), the ideas themselves are not.

That said, perhaps the DNS, with its technical requirement of absolute name uniqueness, forces re-thinking this long-held belief about the nature of names as non-rivalrous resources. When they are components of a domain name, names are in fact constrained by a certain degree of exclusivity because there can only be one registrant of the name *www.myname.com*. There is no technological impediment to another party's registering the name 'myname' in another top-level domain (e.g., *www.myname.org*), but absolute name uniqueness demands simply that there cannot be more than one *www.myname.com*. In this example, the name 'myname' is not subject to exclusivity, but the complete domain name *www.myname.com* can be registered by only one registrant. In the context of the DNS, names do not entirely lose their characteristic of non-exclusivity, but they do sacrifice some of it.

Another divergence of names from the broad conceptual characteristics of intellectual property is that in order to receive protection, they need not be the product of creative genius or original thought. This is an interesting characteristic that the law has traditionally been willing to overlook in the

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553. See Lawrence Lessig, *The future of ideas: the fate of the commons in a connected world* 21 n. 6 (Random House 2001).

554. On the rivalrous nature of intellectual property, see Christine Greenhalgh & Padraig Dixon, *The Economics of Intellectual Property: A review to identify themes for future research*, University of Oxford Department of Economics Discussion Paper Series No. 135, December 2002, 4-5 (available at <http://www.economics.ox.ac.uk/Research/wp/pdf/paper135.pdf>).

case of trademarks but require in respect of other intellectual property subject matter.<sup>555</sup> Geographic names have nevertheless not historically been considered registrable as trademarks, as will be explained in detail in the next section of this chapter.

### 5.1.2 INTELLECTUAL PROPERTY SUBJECT MATTER

With the exception of geographical indications, which are a specifically defined category of origin-connoting geographic names (these are discussed in detail in Chapter 7), geographic names are not expressly stated to fall within the scope of the TRIPS Agreement's definition of 'intellectual property' in Article 1(2) as: 'all categories of intellectual property that are the subject of sections 1 through 7 of Part II.' This definition has been characterized as 'pragmatic', but it 'excludes from general TRIPS obligations forms of intellectual property (or of protection that some would consider as being a part of intellectual property) not covered by TRIPS. Certain *sui generis* or new forms of protection may be concerned.'<sup>556</sup> Geographic names generally, not simply the narrow sub-set in geographical indications, may be one such exclusion. It is also relevant to note as a tangential matter that in terms of the ownership of rights recognized under the TRIPS Agreement, governments' claims as rights holders under that agreement are not contemplated in the wording of Article 1(3) or 42.<sup>557</sup>

The interpretation of the definition of 'intellectual property' in Article 1(2) was directly at issue in the WTO dispute *United States – Section 211 Omnibus Appropriations Act of 1998*.<sup>558</sup> The Panel in that case concluded that trade names did not fall within the list of categories articulated in Article 1(2), but the Appellate Body disagreed, interpreting 'intellectual property' to

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555. See Rosemary J. Coombe, *The cultural life of intellectual properties: authorship, appropriation, and the law* 61 (Duke University Press 1998). Coombe explains: 'Although trademarks are not conventionally understood to have "authors" because they require no necessary genius, originality, or creativity, the legal recognition that trademark "owners" have a proprietary interest in marketing signs increasingly relies upon a reenactment of the author-function as described by Foucault. This is evident in judicial acceptance of the belief that through investment, labor, and strategic dissemination, the holder of a trademark creates a set of unique meanings in the minds of consumers and that this value is produced solely by the owner's efforts' (internal citations omitted).

556. Daniel Gervais, *The TRIPS Agreement: Drafting history and analysis* 166 (3d ed. revised, Sweet & Maxwell 2008).

557. Art. 1(3) of the TRIPS Agreement identifies beneficiary rights holders as 'the nationals of other Members.' Note 1 to Art. 1 indicates that 'nationals' means 'persons, natural or legal, who are domiciled or who have a real and effective industrial or commercial establishment in that customs territory.' Note 11 to Art. 42 of the TRIPS Agreement clarifies that 'federations and associations having legal standing to assert' rights are considered rights holders for the purposes of enforcement.

558. *United States – Section 211 Omnibus Appropriations Act of 1998*, 41 I.L.M. 654 (W.T.O. D.S.B. App. Body 2 Jan. 2002).

## Chapter 5: Intellectual Property Rights in Geographic Names

include not only the categories indicated in each title of each Section of Part II of the TRIPS Agreement but also categories of intellectual property subject to each Section of Part II. Applying this reasoning, trade names can be distinguished because geographic names (other than geographical indications) are not even mentioned in the TRIPS Agreement. Furthermore, as the Appellate Body pointed out, trade names are expressly recognized in Article 8 of the Paris Convention for the Protection of Industrial Property, which is incorporated into the TRIPS Agreement by reference.

Geographic names, by contrast, are not expressly provided for in the Paris Convention, the definition of 'industrial property'<sup>559</sup> in which is considered:

a traditional but not entirely exact denomination for certain exclusive rights, resembling property rights, regarding creative ideas or distinguishing signs or designations in the industrial or commercial field, supplemented by certain rules against unfair behavior in the same field. The term is inexact because 'industrial property' presents no more than an analogy with normal property; further, because it covers more than industrial subjects only; and, finally, because the rules against unfair behavior are not necessarily related to property at all.<sup>560</sup>

This interpretation allows for the recognition of rights in non-commercial names by the Paris Convention, but beyond their possible recognition as trademarks, geographic names fall within that agreement's covered subject matter only insofar as they constitute indications of source or appellations of origin, or give rise to an unfair competition claim. Their ability to do this is explored in detail in Chapter 8 of this book, but at this stage it can be concluded that geographic names are not provided for as such within the protected subject matter of the Paris Convention.

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### 559. Paris Convention Art. 1

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(2) The protection of industrial property has as its object patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellations of origin, and the repression of unfair competition.

(3) Industrial property shall be understood in the broadest sense and shall apply not only to industry and commerce proper, but likewise to agricultural and extractive industries and to all manufactured or natural products, for example, wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers and flour.

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560. Bodenhausen, 20. See also WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *Report Adopted by the Standing Committee*, WIPO Doc. SCT/21/8 (26 Nov. 2009) para. 317 (comments of South Africa) (available at [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_21/sct\\_21\\_8.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_21/sct_21_8.pdf)).

Nor do geographic names as such fall expressly within the scope of the broader definition of 'intellectual property' set out at Article 2 of the Convention Establishing the World Intellectual Property Organization.<sup>561</sup>

- (viii) 'intellectual property' shall include the rights relating to:
- literary, artistic and scientific works,
  - performances of performing artists, phonograms, and broadcasts,
  - inventions in all fields of human endeavor,
  - scientific discoveries,
  - industrial designs,
  - trademarks, service marks, and commercial names and designations,
  - protection against unfair competition,
- and all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields.

Their primarily non-commercial use separates geographic names from classification as 'industrial' alongside trade and service marks, while the fact that their creation requires no particularly creative or inventive thought isolates them from the other catch-all 'intellectual' fields.

There is therefore scant express support for a claim to rights in the nature of intellectual property in geographic names at the international level. This does not stop WTO Member States from treating geographic names as protectable intellectual property, yet for this to be considered a general principle of international law it must be relatively consistent and widespread. The most obvious means by which States might do so is through registrability as a trademark.

## 5.2 GEOGRAPHIC NAMES AS TRADEMARKS

The recognition of rights in names under international law has historically focused primarily on the intellectual property subject matter of trademarks and trade names; these have been expressly protected since 1883 by the Paris Convention on the Protection of Industrial Property (the 'Paris Convention'). In addition to the minimum standards framework laid down in the Paris Convention, trademarks' protection at the international level was helpfully clarified<sup>562</sup> and harmonized by the TRIPS Agreement, while administrative measures pertaining to the international recognition of rights in trademarks are provided for by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of

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561. Convention Establishing the World Intellectual Property Organization (14 Jul. 1967, entered into force 26 Apr. 1970), 828 U.N.T.S. 3.

562. See Thomas Cottier, *The Prospects for Intellectual Property in GATT*, 28 Common Mkt. L. Rev. 383, 403-404 (1991).

Marks,<sup>563</sup> the Madrid Agreement concerning the International Registration of Marks,<sup>564</sup> the Protocol relating to the Madrid Agreement concerning the International Registration of Marks,<sup>565</sup> and the Trademark Law Treaty.<sup>566</sup>

Geographic names have long struggled to satisfy trademark registration criteria, which today are harmonized by Article 15(1) of the TRIPS Agreement:

Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.

From this provision can be distilled the three fundamental requirements of trademark registrability: first, the subject matter of protection must be a sign; second, that sign must be distinctive; third, it must be used on or in connection with commercial goods or services. It is clear from the second sentence of Article 15(1) that word names fall within the meaning of the term 'sign'; this criterion has never proved an obstacle to geographic names being protected as trademarks. The remaining two criteria of trademark registrability have, however, historically been and continue to be obstacles. The reasons for this are explored in the sub-sections that follow.

### 5.2.1 THE REQUIREMENT OF DISTINCTIVENESS

The heart of a trademark's registrability lies in its capacity to distinguish the goods or services of one trader from those of another, termed 'distinctiveness'.<sup>567</sup> Article 15(1) of the TRIPS Agreement provides that protectable signs may either be 'inherently capable of distinguishing the relevant goods or services' or acquire distinctiveness through use. Inherent distinctiveness refers to whether a mark on its face indicates that the goods or services to

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563. Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 Jun. 1957, as revised at Stockholm on 14 Jul. 1967 (entered into force 12 Nov. 1969), 828 U.N.T.S. 191.

564. Madrid Agreement Concerning the International Registration of Marks (14 Apr. 1891, entered into force 23 Oct. 1983) 828 U.N.T.S. 389.

565. Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (28 Jun. 1989, entered into force 1 Dec. 1995), 82 Trademark Rep. 58.

566. Trademark Law Treaty (27 Oct. 1994, entered into force 1 Aug. 1996) 2037 U.N.T.S. 35.

567. See generally, Charles Martin, *The Meaning of Distinctiveness in Trade-mark Law*, 45(5) Ill. L. Rev. 535 (1950-1951).

which it is applied refer to those of the applicant and no one else. Acquired distinctiveness offers signs with multiple meanings an opportunity to crystallize in the mind of the consuming public the identity of the applicant in connection with the goods or services to which the sign is applied. Yet it has not always been the case that applicants have had this opportunity to demonstrate acquired distinctiveness, and this proved fatal for many applications for geographic trademarks.

Geographic names lack inherent distinctiveness because – irrespective of any other connotations a commercial enterprise might wish for them – they bring to mind a particular geographic location. Names of actual or even likely places of production, manufacture or origin of goods are unavoidably inherently descriptive of the goods they represent rather than indicative of the trader responsible for putting them on the market. This historically rendered geographic marks unregistrable.<sup>568</sup> Distinctiveness can only come about, if at all, because the consuming public learns over time to associate the geographic name in question with something other than a geographic location: specifically, a link must be made in the consumer’s mind between a geographic name and a particular trader and its particular offering of goods and/or services.

Following revisions to the Paris Convention in 1967 at Stockholm, Article 6 *quinquies* (B)(2) provided for the invalidation or refusal of registrations of marks ‘when they are devoid of any distinctive character’. This was qualified by sub-section (C)(1), which provided: ‘In determining whether a mark is eligible for protection, all the factual circumstances must be taken into consideration, particularly the length of time the mark has been in use.’ This required the consideration of circumstances in which ‘a trademark which originally was not distinctive has, in the long run, through use, acquired a “secondary meaning” which makes it distinctive.’<sup>569</sup>

Today, the opportunity provided by Article 15(1) of the TRIPS Agreement to demonstrate acquired distinctiveness makes it possible (although by no means simple) for geographic names to be registered as trademarks. A geographic name always calls to mind a geographic location and therefore leads the consumer to question whether a connotation of origin or some other connection to the geographic location is the primary message being conveyed. Still, it is open to the trader through extensive commercial use of the name in connection with particular goods or services to try to override that inherent connotation of geography and put in its place a branding-type message that brings to mind the trader and its offering. There is no guarantee that these efforts will be successful, and this helps to explain why trademarks constituted only of geographic names are not particularly

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568. See Heather A. Forrest, *The new frontier: Country brands and their legal status under Australian trade mark law*, 20(3) *Austl. Intell. Prop. J.* 127, 138-140 (2009).

569. Bodenhausen, 118.



## Chapter 5: Intellectual Property Rights in Geographic Names

common.<sup>570</sup> If the recent changes to Swiss trademark law<sup>571</sup> to create a new geographic type of trademark are indicative of a future general domestic law trend, then in time this will change. The practical benefits arising out of such changes to the owners of geographic marks, which include their being actionable under the UDRP and other priority rights accorded trademark holders in DNS policy, should not be underestimated.

### 5.2.2 THE REQUIREMENT OF USE IN CONNECTION WITH GOODS OR SERVICES

Another obstacle to geographic names' registrability as trademarks is the requirement that a sign be used on or in connection with particular goods or services. The protection of names at the level of international law has always been based upon use in a commercial context. This can be deduced from the negotiating history of the Paris Convention for the Protection of Industrial Property, which records the Chair of the convention as opening the drafting conference with reference to the scope of their work: 'Messieurs, vos études et vos recherches auront un vaste champ: brevets d'invention, dessins et modèles industriels, marques de fabrique, noms et raisons de commerce, tells seront les sujets principaux de vos entretiens.'<sup>572</sup> Indeed, the name of the resulting convention is suggestive of, even if not definitive on,<sup>573</sup> the sorts of subject matter that the convention's drafters set out to protect.

The requirement that signs be used on or in connection with particular goods or services is a logical extension of the requirement of distinctiveness, which demands recognition by the consumer of a triangular relationship between a mark, a particular trader and its particular goods or services. Registered marks receive protection only in respect of the goods or services specified in their registration, and it is principally only in connection with those goods or services that the mark's use is protected.<sup>574</sup> While geographic and cultural names can be used to identify commercial goods or services, more often they are used to identify a place or cultural concept. The

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570. For specific data on the presence of geographic marks on the Australian trademarks register, for example, see Forrest, *The new frontier*.

571. Loi fédérale sur la protection des marques et des indications de provenance, nouveau Art. 27a. See detailed discussion below at Part III, Chapter 5, section 5.4.

572. Ministère des Affaires Étrangères de la France, *Conférence Internationale pour la Protection de la Propriété Industrielle* 13 (Imprimerie Nationale 1880).

573. See n. 560 above and accompanying discussion.

574. Defensive registrations and the protection of well-known marks are notable exceptions to this general rule that marks are only protected against competing use in relation to the same or similar goods and services. Arguments for treating well-known marks specially in the DNS are explored in Part II Chapter 3, section 3.2.1.3 above. The protection offered to well-known marks under international law against dilution is discussed in detail in Part III Chapter 8, section 8.2.1 below.

commercial uses of geographic names must logically outweigh their non-commercial uses, and this is rare; most commonly, they serve an informational purpose on maps and globes, on road signs and in official documents. The infrequency with which they come to signify in the consumer's mind a link between a particular trader and its particular goods or services prevents such names not only from meeting the requirement of distinctiveness but also the requirement of use in connection with goods or services.

In the specific context of the DNS it was asked early on whether the simple act of registering a domain name constitutes commercial use. When domain name disputes began to arise, it became clear to the trademark community that the emerging activity of 'cybersquatting', the act of registering a domain name comprised or constituted of a registered mark by someone other than the mark's owner,<sup>575</sup> had to be fit into the existing rubric of trademark infringement, which requires proof of use of the allegedly infringing mark as a trademark. This then necessitates proving commercial use. In many cases, domain names comprising registered trademarks were being registered without mark owners' authorization, but the websites operated under those domain names (if any website was operated at all) were not being used to engage in commercial activity. The names were not, in other words, being used on or in connection with goods or services.

What allowed courts to find trademark infringement was where the domain name registrant offered to sell the domain name, in most cases to the trademark owner. In one of the earliest 'cybersquatting' decisions in United States courts, it was said of the defendant, Dennis Toeppen: 'At no time did Toeppen use intermatic.com in connection with the sale of any available goods or services. At no time has Toeppen advertised the intermatic.com domain name in association with any goods or services.'<sup>576</sup> It was nevertheless found that 'Toeppen's intention to arbitrage the "intermatic.com" domain name constitutes a commercial use.'<sup>577</sup> The same result could also be achieved by simply treating everything having to do with the internet as commercial in nature. This was suggested in a 1996 manual of trademark law and practice which was quoted by the court in its decision against Toeppen: 'Because Internet communications transmit instantaneously on a worldwide

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575. In one of the early United States court decisions on 'cybersquatting' facts, *Avery Dennison Corp. v. Sumpton*, 999 F. Supp. 1337, 1338 (C.D. Cal. 1998) the court described the practice in question as follows: 'Like all "cybersquatters," defendants merely "squat" on their registered domain names until someone else comes along who wishes to use them. Like all "cybersquatters," defendants usurp *all* of the accepted meanings of their domain names, so as to prevent others from using the same domain names in *any* of their accepted meanings. And like all "cybersquatters," defendants seek to make a financial return by exacting a price before consenting to allow others to use the domain names on which they have chosen to "squat."' See discussion in Heather A. Forrest, *Drawing a Line in the Constitutional Sand Between Congress and the Foreign Citizen 'Cybersquatter'*, 9(2) Wm. & Mary Bill Rts J. 461, 470-472 (2001).

576. *Intermatic Inc. v. Toeppen*, 947 F. Supp. 1227, 1233 (N.D. Ill. 1996).

577. *Intermatic Inc. v. Toeppen*, 947 F. Supp., at 1239.

basis there is little question that the “in commerce” requirement would be met in a typical Internet message, be it trademark infringement or false advertising.<sup>578</sup>

In the years since, the United States has devised specific legislative solutions such as the Anticybersquatting Consumer Protection Act to address the problem of cybersquatting and other activities characterized as DNS name-hijacking so that it is no longer necessary to fit such round peg problems into the square hole of trademark infringement. In that country and others, understanding of the internet has developed, as evidenced by the fact that not all registrations of trademarks as second-level domain names by someone other than the trademark owner are falling afoul of the UDRP, to which the majority of second-level domain registrants are bound.<sup>579</sup> It must be clarified, however, that commercial use is not a factor directly required under the UDRP as it is in trademark infringement. Offending domain name registrations under the UDRP are those that are, *inter alia*, used in bad faith pursuant to Clause 4(a)(iii). Three of the four non-exclusive examples of evidence of bad faith provided by Clause 4(b) are, however, based on commercial activity:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

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578. *Ibid.*, quoting Jerome Gilson, *Trademark Protection and Practice* vol. 1, § 5.11[2], 5-234 (1996).

579. See for example, *St Moritz v. StMoritz.com*, WIPO Case No. D2000-0617; *New Zealand v. Virtual Countries*, WIPO Case No. D2002-0754.

The notion that all internet activity and therefore all uses of domain names are inherently commercial seems to have predominated.<sup>580</sup> Instances in which registration of domain names used on non-commercial, information-providing websites is deemed to constitute bad faith are not uncommon.<sup>581</sup> This is perhaps part of a broader trend in the field of intellectual property law attributable to the TRIPS Agreement and its origins in the WTO towards viewing all intellectual property subject matter as inherently commercial. In a seminal analysis of the TRIPS Agreement, only moral rights are offered as a clear example of ‘the aspects of intellectual property that are not, in one form or another “trade-related”’ and thus potentially not falling within the scope of the TRIPS Agreement.<sup>582</sup>

The international intellectual property treaty framework has historically drawn a line with respect to the recognition of rights in names between commercial and non-commercial use, those falling within the latter category being left available for public use and not subject to private property claims.<sup>583</sup> In taking the view that names in the DNS are inherently used commercially, the door is opened to proprietary claims even where names are not used on or in connection with goods or services, where they are used only in connection with the provision of information, commentary or opinion, as geographic names often are. Perhaps this is one reason to treat domain names as being a new type of property distinct from intellectual property, focusing only on the commercial interest of the subject matter in question.<sup>584</sup>

The far-reaching effects of the commercial characterization of otherwise non-commercial names are highlighted by the primarily commercial bases of rights relevant to geographic names. These are explored in particular in Chapter 8 below, but at this stage it suffices to highlight the fact that it is easier for otherwise non-commercial names such as geographic names to receive protection as trademarks where the context in which they are used is considered inherently commercial. On the other hand, if the use of geographic names is not considered inherently commercial, the protection available to them under existing intellectual property and related frameworks is automatically rendered quite limited.

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580. Commonly adopted definitions of the term ‘domain name’ underscore this. See for example, Io Montes, Doctoral Dissertation in Law, Zürich, *Legal framework for domain names* 112 (2005) (defining the term ‘domain name’ as ‘the virtual presence of a business in the on-line world that gives access to the cyber-market-place’).

581. In the context of celebrity names, for example, see Chik, 46 (observing that ‘[e]ven when [use in commerce] was “weak”, UDRP panels have largely been willing and able to find a protectable right’).

582. Gervais, 12 n. 40.

583. This concept, called the ‘public domain’, is discussed in detail in Part III, Chapter 9, section 9.2.5.2.2 below.

584. See Chik, 44.

5.3 COLLECTIVE AND CERTIFICATION MARKS

The traditional obstacles to registering geographic trademarks discussed above apply to what are termed 'standard' trademarks. The Paris Convention recognizes in Article 7bis another form of mark, called a 'collective mark'. The sole condition articulated in Article 7bis is that collective marks must belong to an association, but sub-paragraph (1) makes clear that associations need not 'possess an industrial or commercial establishment.' This has been interpreted to exclude States and other public bodies, whose marks are nevertheless likely to 'be protected by virtue of the rule of "national treatment" embodied in Article 2 of the Convention, and ... if these marks are at the same time official State signs or hallmarks indicating control and warranty – also by Article 6ter.'<sup>585</sup>

The criteria of collective marks' registrability are not harmonized by either the Paris Convention or the TRIPS Agreement to the same degree that standard trademark registration criteria are, but rather have been left to be determined by domestic legislation. Still, collective marks are a form of trademark, and as such they are required to be distinctive. This means that they must be capable of distinguishing goods or services – in this case, those of the members of an association from those of other associations. Conceptually similar to collective marks are certification marks, which connect a mark not with a particular association but with goods meeting particular, specified standards (which may, but need not, relate to geography).<sup>586</sup>

Registration of a collective or certification mark offers geographic names that communicate geographic characteristics (particularly geographic origin) distinct advantages.<sup>587</sup> Foremost, registration serves as proof of ownership just as it does for standard marks, despite the fact that ownership is an incongruous concept in this context: the association owns the mark and members of the association are authorized to use it. As such, some domestic laws prohibit or limit the transfer of collective marks.<sup>588</sup> It has also been suggested that registration may prevent a geographical indication from becoming generic.<sup>589</sup> Because they are forms of trademark, in the DNS

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585. Bodenhausen, 130 (internal citations omitted).

586. See for example, Lanham Act, 15 U.S.C. §1054 (US); Trade Marks Act 1995 (Austl.) s. 169; Trade Marks Act No. 194 of 1993 (S. Africa) s. 42. On the protection of geographical indications as certification marks under US law, see Lynne Beresford, *Geographical Indications: The Current Landscape*, 17 Fordham Intell. Prop. Media & Ent. L.J. 979, 983-984 (2006-2007).

587. See Conrad, 21 (advocating the use of certification marks on an international level).

588. See for example, Trade Marks Act 1995 (Austl.) s. 166. On restrictions under US law, see David Snyder, *Enhanced Protections for Geographical Indications Under TRIPS: Potential Conflicts under the U.S. Constitutional and Statutory Regimes*, 18 Fordham Intell. Prop. Media & Ent. L.J. 1297, 1308 (2008).

589. See O'Connor, *The law of geographical indications*, 73 (citing by way of example the United States Lanham Act §1127, pursuant to which registered marks cannot be deemed generic provided the name remains geographically descriptive).

context, collective or certification mark registration gives rise to standing to bring a claim under ICANN's Uniform Domain Name Dispute Resolution Policy (UDRP) and the new Uniform Rapid Suspension (URS) procedure, and it would also give standing to object to a new gTLD application on the basis of existing legal rights. Registration as a collective or certification mark thus has the practical effect of transforming some geographic names from a situation of no recognition in the DNS to a situation of priority recognition.

#### 5.4 GEOGRAPHIC TRADEMARKS: THE SWISS MODEL

The Swiss legislative project approved in late 2011<sup>590</sup> proposing amendments to the federal trademark law, RS 232.11 *Loi fédérale sur la protection des marques et des indications de provenance*, provides a model approach to protecting geographic names. In the new Chapter 2a, headed *Marque géographique*, nationally registered indications of source and geographical indications, protected cantonal wine designations and geographical indications regulated in a Federal Council ordinance are deemed registrable.<sup>591</sup> The geographic mark is intended to apply beyond the scope of food and beverages to manufactured goods and services. Rather than confer exclusive rights, the mark would function similar to a collective mark.

It is likely significantly easier (although by no means a non-issue) to achieve the consensus needed to amend domestic law than international law to expressly protect geographic names as trademarks. The domestic law solution removes the need for international consensus, but of course the rights created are limited to the territory in which they are recognized. This is nevertheless likely in the context of the DNS to be satisfactory as an immediate solution to the problem of unauthorized use of geographic names as domain names, since local concerns can be addressed in local law without loss of sovereignty.

This approach, if adopted by other Member States, will result in a less-harmonized global trademark law landscape. The TRIPS Agreement permits this given its nature as a minimum standards agreement that allows members to provide for higher levels of protection. The minimum standard of Article 15(1) requires that signs 'capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark.' Enabling other signs that may not be

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590. L'Assemblée Fédérale, 'Loi sur la protection des marques et loi sur la protection des armoiries: Vers une réglementation différenciée', 11 Nov. 2011, <http://www.parlament.ch/f/mm/2011/pages/mm-rk-n-2011-11-11.aspx> (accessed 15 Oct. 2012).

591. RS 232.11 *Loi fédérale sur la protection des marques et des indications de provenance*, Art. 27a (nouveau), Feuille fédérale No 50, 15 Dec. 2009, at [http://www.admin.ch/ch/f/ff/2009/index0\\_50.html](http://www.admin.ch/ch/f/ff/2009/index0_50.html).

able to meet this minimum standard to be capable of constituting a trademark provides a higher level of protection for such other signs. Further, recognition in domestic law of a specific category of geographic trademark effectively enables the recognition of geographic names beyond a country's borders through ICANN contract-based policies such as the UDRP and the new URS. Both procedures are actionable only in respect of trademarks and neither makes a distinction between types or forms of trademark.

## 5.5 CONCLUSIONS ON INTELLECTUAL PROPERTY RIGHTS IN GEOGRAPHIC NAMES

As the analysis of existing rights protection mechanisms undertaken in Chapter 3 reveals, there is a significant advantage to be gained in the online environment by having offline rights recognized, in particular as trademarks, given that existing rights protection mechanisms are almost exclusively based on trademark rights. Consistent with this, in ICANN's New gTLD Program, applicants of new gTLDs consisting of geographic names that are already protected in domestic trademark law are far better placed to have these rights transposed to the top-level of the DNS and resist their use by others. Achieving such protection has, however, traditionally been a difficult exercise.

While it is conceptually not implausible to associate geographic names with intellectual property generally and trademarks specifically, it should nevertheless not be assumed that geographic names fall within either of these characterizations. Geographic names share many of the traditional characteristics of intellectual property subject matter, but they are not expressly mentioned within authoritative definitions of 'intellectual property' save for the special category of geographical indications. This does not stop States from protecting geographic names within domestic intellectual property law, but neither does it require them to do so.

Geographic names are also not expressly included within the scope of registrable trademarks as harmonized by the TRIPS Agreement. Standard trademark registration criteria, in particular the requirements of distinctiveness and use in connection with goods and services, clash with the primary function of geographic names as identifying a geographic location rather than a trader and its goods or services. Distinctiveness is less problematic in relation to collective and certification marks, which require instead a link in consumers' minds between a mark, particular goods and services, and a particular association or set of characteristics rather than a particular trader. In this way, rights can be recognized in geographic names but only in the limited context of origin connotations, which may otherwise receive (as is discussed in Chapter 7) *sui generis* protection as geographical indications. Before narrowing the focus to examine the sub-set of geographic names that is geographical indications, the next chapter considers whether international law recognizes rights more broadly, in geographic names as such.

## Chapter 6

# Rights in Geographic Names as Such

This is my country

Land of my choice

This is my country

Hear my proud voice. – ‘This is My Country’, American folksong, lyrics  
by Don Raye

### 6.1 THE CHANGING USE AND REGULATION OF GEOGRAPHIC NAMES

Regulation of the use of geographic names is difficult to characterize as a purely domestic matter in the face of increasing use of geographic names as internet domain names. Prior to the introduction of the DNS, outside of the diplomatic context geographic names had a relatively limited, territory-bound scope of use that could effectively be controlled through domestic law: they appeared principally in maps, road signs and official documents, in published works such as encyclopaedias, newspaper articles, scholarly works, academic texts, and less often in advertising, trademarks and trade names. When they began to be used online, geographic names came unmoored from the territory, and thus the legal jurisdiction, that they identify. Now they are potentially registrable as domain names by anyone, anywhere. As active domain names they are potentially accessible by everyone, everywhere. Domestic legislation is ill-equipped to manage this situation.

International trademark law has also proven ill-equipped to regulate the use of geographic names, whether online or offline. As discussed in the previous chapter, geographic names have not traditionally been afforded



trademark status due to their ordinarily non-commercial nature and, even where they are used in a commercial context, their lack of an inherent capability to link in consumers' minds the particular goods or services of one trader from those of another. It is further acknowledged by even the most ardent supporters of rights at the international level that domestic trademark legislation evidences anything but a consistent approach to recognizing trademark rights in geographic names. A recent survey shows a significant number of WIPO Member States have in place laws preventing the registration of country names as trademarks.<sup>592</sup> This speaks against the existence of a general principle of international law recognizing protection of geographic names as trademarks. Looking at these results another way, the fact that many States do allow registration of country name trademarks also weighs against the existence of a general principle of international law recognizing an exclusive right of governments to geographic names.

If international law recognizes rights in geographic names as such, it seems that it must do so outside of trademark law. Nevertheless, most efforts to date regarding the recognition of rights, at least in respect of country names, have been directed at interpretations of or amendments to Article 6*ter* of the Paris Convention for the Protection of Industrial Property. That Article 'concerns *trademarks*, but its purpose is not to regulate their *protection as subjects of industrial property* but rather to *exclude them from becoming such subjects* in certain circumstances.'<sup>593</sup> From its proscription against 'use, without authorization by the competent authorities' is derived the position that their unavailability for registration by the public as trademarks equates to country names belonging exclusively to the State they identify. Yet WIPO has interpreted Article 6*ter* as not pertaining to country names, leading to the conclusion that their use in the DNS cannot be prevented under that Article.<sup>594</sup>

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592. WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *Summary of the Replies to the Questionnaire Concerning the Protection of Names of States against Registration and Use as Trademarks*, WIPO Doc. SCT/24/6 (14 Feb. 2011) (available at [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_24/sct\\_24\\_6.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_24/sct_24_6.pdf)). For an example at the supra-national level, see First Directive 89/104/EEC of the Council, of 21 Dec. 1988, to approximate the laws of the Member States relating to Trade Marks, OJ/L 40 of 11 Feb. 1989, p.1., which provides at Art. 3(2)(b) and (c) for refusal on grounds of 'high symbolic value' or inclusion of 'badges, emblems and escutcheons other than those covered by Art. 6*ter* of the Paris Convention and which are of Public interest, unless the consent of the appropriate authorities to its registration has been given in conformity with the legislation of the Member State'. Another example is the Protocol on Harmonization of Norms on Intellectual Property in Mercosur in matters of Trademarks, Indications of Source and Appellations of Origin (5 Aug. 1995, entered into force 6 Aug. 2000), 2145 U.N.T.S. 40. Art. 9(2) of the Protocol requires that Member States prohibit the registration of signs that, *inter alia*, 'are formed with national symbols or symbols of any country; signs that are susceptible of falsely suggestion a relation with ... national symbols of any country, or that offend their value or respectability.'

593. Bodenhausen, 95 (emphasis in original).

594. See WIPO, *WIPO II Report*, para. 284.

Others have lent support to this conclusion,<sup>595</sup> but practice in notification of Article 6*ter* emblems in the time since the WIPO II Report warrants reconsideration of this issue. Because Article 6*ter* has featured so strongly in the discussion as the most likely source of rights in country names as such, it features first in this chapter.

Looking beyond international intellectual property law as a basis of rights in geographic names as such, this chapter also addresses the situation of States' claims to exclusionary rights in country names being articulated on the basis of sovereignty, as if possession of a State's name is linked to the status of statehood. Indeed, the rights conferred by Article 6*ter* of the Paris Convention are said to be directed at 'emblems constituting the symbol of the sovereignty of a State.'<sup>596</sup> Section 6.3 of this chapter considers the possible link between country names, sovereignty and statehood to determine whether claims to rights on this basis are supported by international law. Two separate questions are asked: first, whether having a name is a condition of statehood and second, whether having a name is a right of statehood. The limits of sovereignty are explored to delineate the authority of a State to select and use a name and interfere with others' selection and use of a name. Conclusions as to the existence under international law of rights in geographic names as such are summarized at the end of this chapter.

## 6.2 PARIS CONVENTION ARTICLE 6*TER* AND COUNTRY NAMES

### 6.2.1 ARTICLE 6*TER* (1)

#### 6.2.1.1 Interpretation

The protection of country names under Article 6*ter* of the Paris Convention hinges upon the difference in wording between sub-sections (1)(a) and (1)(b)<sup>597</sup> of that Article. Article 6*ter* (1)(a) requires that Paris Union members

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595. See for example, Froomkin, *When We Say US<sup>TM</sup>, We Mean It!*; Mueller, *Governments and Country Names*.

596. See WIPO, *General information on Article 6*ter**, [http://www.wipo.int/article6ter/en/general\\_info.htm](http://www.wipo.int/article6ter/en/general_info.htm) (accessed 15 Oct. 2012).

597. **Paris Convention Art. 6*ter***

(1)(a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other state emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.

(b) The provisions of subparagraph (a), above, shall apply equally to armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental

prohibit registration as a trademark of emblems of national significance such as armorial bearings and national flags. Article 6ter (1)(b) contains a similar proscription in relation to IGOs except that it also expressly excludes the names of such organizations from trademark registration. This serves to highlight the absence of States' names in the wording of sub-section (1)(a).<sup>598</sup> Relying on the principle of *expressio unius exclusio alterius*, WIPO has interpreted this subtle yet significant difference as not requiring that Member States exclude country names from registration as trademarks.<sup>599</sup> This interpretation is consistent with:

the duty of a treaty interpreter to examine the words of the treaty to determine the intentions of the parties. This should be done in accordance with the principles of treaty interpretation set out in Article 31 of the Vienna Convention. But these principles of interpretation neither require nor condone the imputation into a treaty of words that are not there or the importation into a treaty of concepts that were not intended.<sup>600</sup>

Interpretations of the terms 'armorial bearings', 'other State emblems', 'official signs and hallmarks indicating control and warranty', and 'heraldic symbols' as including country names have been rejected. South Africa was an enthusiastic proponent of this interpretation, but the remark that this 'view has not been universally and definitely accepted'<sup>601</sup> suggests rather more support than may actually exist and conflicts with the acknowledgement made elsewhere that:

other members of the Paris Union had made very laudable efforts at ensuring protection against the use of official State names as elements of

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organizations of which one or more countries of the Union are members, with the exception of armorial bearings, flags, other emblems, abbreviations, and names, that are already the subject of international agreements in force, intended to ensure their protection. (emphasis added)

598. See WIPO, *WIPO II Report*, paras 278-285. See also Bodenhausen, 94-99.

599. WIPO, *WIPO II Report*, para. 281.

600. India – Patent Protection for Pharmaceuticals and Agricultural Chemical Products, WT/DSS0/AB/R (W.T.O. App. Body Report 19 Dec. 1997). See also Susy Frankel, *WTO Application of 'the Customary Rules of Interpretation of Public International Law' to Intellectual Property*, 46 Va. J. Int'l L. 365, 388-389 (2005-2006). An alternative interpretation of Art. 6ter (1) is defended by Matthew Rimmer in *Virtual Countries: Internet Domain Names and Geographical Terms*, February 2003 Media Int'l Austl. Incorp. Culture & Pol'y 124, 132 (2003). Rimmer posits that an alternate interpretation of Art. 6ter 'is justified, on the one hand, in light of its spirit and underlying objectives, and, on the other hand, in view of recent technological evolutions, in particular the emergence of the Internet as a commercial medium and the importance of domain names as valuable signposts in this context.'

601. WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *The Protection of Country Names in the Domain Name System: Comments Submitted by the Government of the Republic of South Africa*, WIPO Doc. SCT/S2/6 (17 May 2002) (available at [www.wipo.int/edocs/mdocs/sct/en/sct\\_s2/sct\\_s2\\_6.doc](http://www.wipo.int/edocs/mdocs/sct/en/sct_s2/sct_s2_6.doc)).

trademarks, where such use constituted grounds for refusal of requests for trademark protection. However, the continued prevalence of such use in other countries provided clear evidence of the inconsistency of the efforts to provide protection to official State names.<sup>602</sup>

The 'prevalence of such use' offers support for WIPO's interpretation of Article 6ter (1)(a), as do attempts prior and subsequent to the WIPO II Report to revise this article to expressly include country names.

### 6.2.1.2 Proposed Revisions

A proposal<sup>603</sup> to revise Article 6ter (1)(a) to include country names as part of the 1980 Diplomatic Conference for the Review of the Paris Convention, though adopted,<sup>604</sup> did not ultimately result in amendments. This signifies an understanding amongst WIPO States that, at that time, country names were not included in the scope of Article 6ter. At the same time, this evidences a desire to achieve such an outcome by creating new law. The question thus arises as to the current legal significance of that previous state of affairs; despite the failure to achieve codification then, has new law since been created? Renewals of the effort to amend Article 6ter (1)(a) by the Jamaican delegation to WIPO's Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (the 'WIPO Standing Committee') offer insight. The Jamaican delegation's proposal notably goes beyond the earlier attempt at revising Article 6ter, in that it seeks to impose a government consent requirement upon all applications for trademarks of official country names and homonymous representations of official names.<sup>605</sup>

It is clear from the Jamaican delegation's remarks that it is believed as a starting point that new law is needed to protect country names.<sup>606</sup> From this

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602. WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *Report Adopted by the Standing Committee*, WIPO Doc. SCT/21/8, para. 309.

603. See WIPO, *WIPO II Report*, paras 281-283 (discussing WIPO, *Basic Proposals (Supplement to Document PR/DC/3), Memorandum by the Director-General*). See also WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *Submission by the Russian Federation*, WIPO Doc. SCT/21/5 Annex 1, para. 1 (2 Mar. 2009) (available at [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_21/sct\\_21\\_5.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_21/sct_21_5.pdf)).

604. See WIPO, *Diplomatic Conference on the Revision of the Paris Convention*, WIPO Doc. PR/SM/9, discussed in WIPO, *WIPO II Report*, para. 282.

605. WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *Proposal by Jamaica*, WIPO Doc. SCT/21/6 (30 Mar. 2009) (available at [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_21/sct\\_21\\_6.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_21/sct_21_6.pdf)).

606. WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *Report Adopted by the Standing Committee*, WIPO Doc. SCT/21/8, para. 309 (reporting the Jamaican delegation as speaking to 'the clear absence of provisions specifically prohibiting the use of official State names' and the proposed amendment to Art. 6ter being 'not only warranted, but timely'). A finding of *opinio juris*

can be extrapolated the view that protection is not already extant. With the exceptions of the delegations of Brazil and Austria, who expressed the view that Article 6ter offers sufficient protection to country names,<sup>607</sup> other members of the WIPO Standing Committee voiced no specific opposition to Jamaica's assessment. This can be interpreted as evidence of a general belief among members of the WIPO Standing Committee that international law on this issue does not yet exist, though it bears noting that not all members commented, nor was a vote on this specific point taken, nor was this issue debated in the General Assembly.

On the specifics of Jamaican delegation's proposed amendments to Article 6ter, members were more divided. The delegations of Iran (paragraph 312), Cuba (paragraph 314), Spain (paragraph 316), Greece (paragraph 325), Serbia (paragraph 328), Kenya (paragraph 329) and India (paragraph 332) expressed support.<sup>608</sup> The delegations of Colombia (paragraph 313), Australia (paragraph 315), South Africa (paragraph 317) and Germany (paragraph 318) expressed non-support.<sup>609</sup> In light of this it was decided<sup>610</sup> that the next step would be information-gathering through the drafting and circulation of a questionnaire<sup>611</sup> of members' domestic laws restricting the registration and use of country names (specified to include official State names, short-form names, common use names, translations, transliterations and adjectival use) as trademarks.

Responses to this questionnaire evidence a lack of consistency in the exclusion of country names from registration and use as a trademark, with a near 60/40 split.<sup>612</sup> That so many Member States responded in the negative to having in place limitations on country names – through trademark law,

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as to existing customary law cannot be based upon such forward-looking assertions: Michael Akehurst, *Custom as a source of international law*, 47 British Y.B. Int'l Law 1, 37 (1974-1975).

607. WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *Report Adopted by the Standing Committee*, WIPO Doc. SCT/21/8, para. 320 (comments of Brazil that it 'believed that the existing legal framework established under the Paris Convention and the TRIPS Agreement already provided enough grounds for the protection of State names') and para. 323 (comments of Austria that it saw 'no need to amend Article 6ter, the existing legal framework being sufficient to protect State names').

608. *Ibid.*, para. 309.

609. *Ibid.*, paras 308-343 (comments by Austria, Australia, Brazil, Colombia, Denmark, Germany, and the Republic of Korea).

610. *Ibid.*, para. 343.

611. See WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *Draft Questionnaire Concerning the Protection of Names of States Against Registration and Use as Trademarks*, WIPO Doc. SCT/23/4 (15 Feb. 2010) (available at [http://www.wipo.int/edocs/mdocs/stlt/en/sct\\_23/sct\\_23\\_4.pdf](http://www.wipo.int/edocs/mdocs/stlt/en/sct_23/sct_23_4.pdf)).

612. The results broadly found that 61% of survey respondents exclude country names from registration and 42% from use as trademarks for goods. In addition, 64% of survey respondents exclude country names from registration and 41% from use as trademarks for services.

unfair competition law, general tort law or otherwise – supports the non-existence at this time of protection though Article 6*ter* (1)(a) for country names. This also weighs against the existence a general principle of international law of exclusive State control or ownership of country names. The revised proposal submitted by Jamaica, which takes into consideration the survey responses, acknowledges this lack of consistency. Jamaica (joined by Barbados) proposes that ‘there could be convergence among Members on an agreed approach to the protection of country names in the trademark/IP system having regard to differences that now exist in the protection afforded to country names across Member States.’<sup>613</sup>

As to those States that have opted to exclude country names from trademark registration, this is not prohibited under the Paris Convention, but also not something they are obliged by that instrument or otherwise to do. The case studies submitted to the Standing Committee by Jamaica, Lithuania, Mexico, Poland, Republic of Moldova, Turkey, Uganda and the United States<sup>614</sup> evidence the varied ways in which countries which have opted to protect country names do so. A WIPO-developed ‘nation branding tool’ intended to guide Member States in developing a nation branding strategy and inform them of the role of country names within that strategy is projected to be published in late 2012.<sup>615</sup>

It is interesting to note the resemblance between Jamaica’s proposal to restrict country names from registration as a trademark without government consent and the recommendation of the Governmental Advisory Committee (GAC) to ICANN to restrict creation of geographic new gTLDs without government consent. As to why the consent mechanism has come to be included in the *gTLD Applicant Guidebook* (and in less time) but not yet the Paris Convention, certain distinctions can be made. First, as new gTLD policy was being drafted, there was only one geographic gTLD already in existence: .asia. The *gTLD Applicant Guidebook*’s imposition of a policy of exclusion of country and territory name new gTLDs and consent to geographic new gTLDs does not threaten the viability of vast numbers of existing registrations in the way that existing trademarks would be threatened

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613. WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *Proposal by the Delegations of Barbados and Jamaica*, WIPO Doc. SCT/27/6 para. 8 (18 Jun. 2012) (available at [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_27/sct\\_27\\_6.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_27/sct_27_6.pdf)).

614. Case studies are accessible through the Standing Committee’s electronic forum. See WIPO, *Browse Comments: 2012 Country Names*, <http://www.wipo.int/sct/en/comments/> (accessed 15 Oct. 2012). See also WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *Information on Cases and Case Studies Relevant to the Protection of Names of States and on Nation Branding Schemes*, WIPO Doc. SCT/27/5, (18 Jul. 2012) (available at [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_27/sct\\_27\\_5.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_27/sct_27_5.pdf)) (hereinafter ‘*Information on Cases and Case Studies*’).

615. See WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *Information on Cases and Case Studies*.

by such a change.<sup>616</sup> It is worth noting, however, that had the *gTLD Applicant Guidebook* restrictions on geographic strings applied at the time that the .asia gTLD was created, the application would have been rejected as an application for the name of a macro-geographical (continental) region unless it secured authorization from the relevant governments throughout that region.<sup>617</sup>

Context is a second major difference: the GAC is an advisory body within ICANN of representatives who provide advice to a private corporation's Board of Directors. The WIPO Standing Committee, by contrast, is an advisory body within a United Nations specialist agency. There is the obvious difference (discussed in Chapter 4, above, in the context of non-State actors in the DNS norm-setting environment) in terms of the law-making capacity of WIPO and ICANN; the potential for actions of the former to create binding legal obligations may serve as a disincentive to taking decisive action, while no such obligations are created by GAC advice. Different membership, voting procedures, expertise of participants, and the relative ability of what may be perceived as stronger or weaker members to influence or drive the recommendation-making process may also contribute to different outcomes.<sup>618</sup>

A further distinction can potentially be made as to the intended consequence of restrictions on geographic names from registration as trademarks or gTLDs. The Jamaican delegation has curiously stated that 'the intention of [its] proposal was not to create proprietary rights for States but rather to prevent unauthorized use of its name by individuals and companies.'<sup>619</sup> It is not clear how giving States the exclusive authority to prevent others' registration and use as a trademark of country names by means of a consent requirement underpinned by Article 6*ter* does not, by conventional understanding, equate to a property-type right in the name as such. WIPO's own articulation of the purpose of Article 6*ter* as being 'to

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616. See Mueller, *Governments and Country Names*, 10 (positing that 'WIPO's caution was prodded in part by business trademark holders concerned about the potential confusion, and possible erosion of their rights, that might be caused by proliferating claims to names by governments, regions, and administrative entities').

617. See ICANN, *gTLD Applicant Guidebook*, section 2.2.4.1.2 (4) (referring to the UN's 'Composition of macro geographical (continental) regions, geographical sub-regions, and selected economic and other groupings' list, at <http://unstats.un.org/unsd/methods/m49/m49regin.htm>).

618. It has been suggested that both ICANN and WIPO suffer from sporadic attendance at meetings, particularly as regards developing country members, and this may have an impact on voting outcomes for both. On WIPO, see Coenraad Visser, *International intellectual property norm setting: Democratising the World Intellectual Property Organization?*, 32 S. Afr. Y.B. Int'l L. 222, 223-224 (2007). On the GAC, see Froomkin, *When We Say US<sup>TM</sup>, We Mean It!*, 865-866.

619. WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *Report Adopted by the Standing Committee*, WIPO Doc. SCT/21/8, para. 311.

protect<sup>620</sup> emblems falling within its scope is indicative of a proprietary-type right in the name as such rather than a non-proprietary limitation on the behaviour of others through, for example, consumer protection or unfair competition laws. Other provisions of the Paris Convention than *6ter* are directed at behavioural limitations;<sup>621</sup> if the intention were to restrict use that is likely to confuse, amendment to Article *6ter* should not be necessary. By contrast, no such denial has been expressed in the context of ICANN's exclusion/authorization mechanism for geographic new gTLDs. One gets the sense from GAC members' comments that the exclusion/authorization mechanism is driven by a desire to exert control of a proprietary nature over geographic names at the very least in order to prevent the creation of property or other rights belonging to others.

In summary, the prevailing view is that Article *6ter* does not require States to prevent the registration of country names as trademarks. Yet neither does that Article or other provisions of the Paris Convention prevent States from excluding country names from trademark registration on their own initiative. A survey of WIPO members' domestic law reveals a mixed practice in this regard, lending current support to WIPO's interpretation of Article *6ter* (1)(a) as not encompassing a right to protect country names. It further lends support to the non-existence of a general principle of international law of excluding country names from trademark registration and by corollary, to the non-existence of a general principle of international law of recognizing exclusivity of States' rights in country names.

### 6.2.2 ARTICLE 6TER (3): INTERPRETATION

In order to facilitate the exclusion of national emblems from national trademark registers, Paris Convention Article *6ter* (3) establishes a notice system whereby WIPO Member States communicate their national emblems to other members of the Union.<sup>622</sup> Communications pursuant to this provision are made by completing a 'Draft Request for Communication Under Article *6ter* 3(a) of the Paris Convention for the Protection of

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620. WIPO, *Article 6ter of the Paris Convention: Protection of State Emblems, and Names, Abbreviations and Emblems of International Intergovernmental Organizations*, <http://www.wipo.int/article6ter/en/> (accessed 15 Oct. 2012).

621. Unfair competition and related laws limiting commercial behaviour are the focus of Chapter 8.

622. **Paris Convention Art. 6ter**

(3)(a) For the application of these provisions, the countries of the Union agree to communicate reciprocally, through the intermediary of the International Bureau, the list of State emblems, and official signs and hallmarks indicating control and warranty, which they desire, or may hereafter desire, to place wholly or within certain limits under the protection of this Article, and all subsequent modifications of such list. Each country of the Union shall in due course make available to the public the lists so communicated. Nevertheless such communication is not obligatory in respect of flags of States.



Industrial Property by a State'.<sup>623</sup> Consistent with the prevailing interpretation of Article 6ter (1)(a) just discussed, the request form does not invite notification of country names.<sup>624</sup> Notable, therefore, are the notifications made in 2008 by Iceland of its name in the English, Spanish/Castilian, French, Chinese, Arabic and Russian languages as State emblems.<sup>625</sup> The legal significance of Iceland's actions is ripe for consideration in light of the conclusions reached above as to the non-support of Article 6ter for encompassing country names.

Iceland's actions could only be supported by a restrictive interpretation of Article 6ter 3(a) (and thus Article 6ter (1)(a)) giving 'extreme deference to the sovereignty of states'.<sup>626</sup> The actual use of the restrictive approach by the PCIJ and ICJ is, however, limited and on this and other bases its use has been cautioned against.<sup>627</sup> Furthermore, the United States is recorded as having objected to Iceland's notifications.<sup>628</sup> Given that it is the only State to have done so, it could be questioned whether this signals tacit acceptance by other States. This is unlikely given that other States have not availed themselves of the notification process to notify State name-only emblems, although notifications have been made in which a country name is the prominent feature with the addition of a small emblem or sign.<sup>629</sup> These have essentially the same effect as name-only notifications because notified emblems 'are protected ... against registration and use of trademarks which are identical to them or incorporate them as elements thereof'<sup>630</sup> (emphasis added). They function as stylized marks, however, and do not unambiguously

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623. WIPO, *Procedure to be Followed by States Wishing to Avail Themselves of Article 6ter of the Paris Convention for the Protection of Industrial Property*, <http://www.wipo.int/article6ter/en/states.htm> (accessed 15 Oct. 2012).

624. The notification provides: 'On behalf of the Government of [official name of the country], I would like to request the communication, under Article 6ter(3)(a) of the Paris Convention for the Protection of Industrial Property (Paris Convention), to the States party to the Paris Convention and to the Members of the World Trade Organization (WTO) not party to the said Convention, of the [armorial bearings], [flag], [State emblem] and/or [official sign or hallmark indicating control and warranty] adopted by [official name of the country].'

625. Art. 6ter Numbers IS8, IS9, IS10, IS11, IS12 and IS13, Notified as State Emblems in Circular Number 7596, 02 Apr. 2008, available at WIPO, *Article 6ter Structured Search*, <http://www.wipo.int/ipdl/en/6ter/> (accessed 15 Oct. 2012).

626. Richard K. Gardiner, *Treaty Interpretation* 53 (Oxford University Press 2008).

627. See Hersch Lauterpacht, *Restrictive Interpretation and the Principle of Effectiveness in the Interpretation of Treaties*, XXVI British Y.B. Int'l L. 48, 62-67 (1949), discussed in Gardiner, *Treaty Interpretation*, 60-62.

628. Objections by the United States are recorded as having been made on 30 Mar. 2009 for each of Art. 6ter notification Numbers IS8, IS9, IS10, IS11, IS12 and IS13. Available at WIPO, *Article 6ter Structured Search*, <http://www.wipo.int/ipdl/en/6ter/> (accessed 15 Oct. 2012).

629. An example is Canada's notification of State emblem CA16, available at WIPO, *Article 6ter Structured Search*, <http://www.wipo.int/ipdl/en/6ter/> (accessed 15 Oct. 2012).

630. Bodenhausen, 97.

evidence an intention to reserve a country name as the notification of an unstylized name only.

Looking beyond treaty obligations to the formation of custom, although practice by the entire international community of States is generally not seen as required, and although it may even in certain situations be considered sufficient that only a minority of States have acted in a particular way,<sup>631</sup> it is surely the case that the action of one State is insufficient evidence of a general or even specific custom of recognizing rights in country names through Article 6ter (3). Only if other States were doing so and these notifications consistently went unchallenged, and further if these actions were the product a sense of legal obligation and not simply diplomatic courtesy, could this be a basis for customary law recognizing States' rights in country names.

At this time, Iceland's appears the only example of notification under Article 6ter (3) of a State emblem featuring only a country name. One reason for the isolation of this practice may be that States believe it too obvious to bother with an administrative process of notifying a desire to protect a name that they view as indisputably their own. Could it be that country names are so well-known that communication of an intention to assert exclusivity in them would be considered unnecessary because it is so obvious? Such a position is not so illogical when one considers that national flags have been exempt from the process of Article 6ter notification since the 1958 Lisbon Conference of the Paris Union for precisely this reason.<sup>632</sup> It would likewise not be unreasonable to suggest that in the modern world order, countries' names are just as, if not even more well-known than their flags. Perhaps the very obviousness of the ownership of both belies not merely a desire to preserve friendly relations but the observance of a legal obligation. Then again, the opposite may be true, where 'the absence of legal obligation *in such a context* is regarded as self-evident, just as, in municipal law, questions of good manners are treated as self-evidently not a matter for legal regulation.'<sup>633</sup>

Article 6ter (3)(a) of the Paris Convention expressly accommodates the fact that a flag so obviously belongs to the State that adopts it that the adopting State need not tell other States that it wishes to prevent its use or registration as a trademark.<sup>634</sup> This reasoning depends on an understanding

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631. See Vladimir Duro Degan, *Sources of International Law* 182, Martinus Nijhoff 1997.

632. See Gervais, 503 n. 819, citing Bodenhausen, *Guide to the Application of the Paris Convention*, 100.

633. International Law Association, *Statement of Principles Applicable to the Formation of General Customary International Law: Final Report of the Committee on Formation of Customary (General) International Law*, section 17(i) Commentary.

634. **Art. 6ter (3)(a)**: For the application of these provisions, the countries of the Union agree to communicate reciprocally, through the intermediary of the International Bureau, the list of State emblems, and official signs and hallmarks indicating control and warranty, which they desire, or may hereafter desire, to place wholly or within certain limits under

that a flag, once adopted, is assumed to be easily and immediately identifiable as a particular State's own, not only by other heads of State and the diplomatic community but by people all over the world near or far from the State in question who would otherwise have contact with the flag if used as a trademark. Exclusion of flags from registration as a trademark is justified because their 'registration or use would violate the right of the State to control the use of symbols of its sovereignty'.<sup>635</sup> Yet are not country names symbols of sovereignty just as much as, if not more so than, flags? If so, is there a custom or general principle of international law recognizing States' rights in country names, even if the Paris Convention does not explicitly require this? To answer this question, this study now turns to a fundamental principle of international law that is the cornerstone of the international legal order itself: sovereignty.

### 6.3 SOVEREIGNTY AND COUNTRY NAMES

Both the proposal made by the Jamaican delegation to the WIPO Standing Committee to expand the scope of Paris Convention Article 6*ter* (1) and the recommendation made by ICANN's GAC to limit applications for new geographic gTLDs rely on sovereignty to justify restricting others' use of country names.<sup>636</sup> Sovereignty has also been asserted as a basis for national control of country code top-level domains.<sup>637</sup> Acknowledging the imprecision with which the term 'sovereignty' is used, as will be discussed further below, the impression one gets is that these are assertions of an inherent right of States to possess and control the use of their representative symbols, including their name. The seemingly inherent nature of the right suggests that it is derived from principles of natural law and the very conceptual and philosophical underpinnings of the international legal order. This is at least

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the protection of this Article, and all subsequent modifications of such list. Each country of the Union shall in due course make available to the public the lists so communicated. *Nevertheless such communication is not obligatory in respect of flags of States.* (emphasis added)

635. Bodenhausen, 96.

636. See comments of the Delegation of Jamaica 'that its proposal was intended to protect the integrity and sovereignty of a State' in WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *Report Adopted by the Standing Committee*, WIPO Doc. SCT/21/8 (26 Nov. 2009) para. 311. The GAC's view is expressed in the context of Internationalized Domain Names (IDNs) that 'ICANN should consult with the Government or relevant public authority of the territory concerned to determine whether there may be any potential infringement of their sovereign rights regarding their country or territory name'. GAC, *GAC Communiqué: New Delhi, 2*, <https://gacweb.icann.org/display/gacweb/GAC+31+Meeting+New+Delhi+%2C+India+9-14+February+2008> (February 2008, accessed 15 Oct. 2012).

637. See Von Arx & Hagen, 68.

how the protection of State emblems by means of Article 6*ter* of the Paris Convention has been explained.<sup>638</sup>

Even if the protection of State emblems has as its origin the principle of sovereignty, one need look no further than the Paris Convention in order to identify international law expressly recognizing States' rights. It has been determined in the preceding section of this chapter that country names do not fall within this ambit; they are not specifically recognized in the Paris Convention or indeed any other international convention of universal scope as symbols of sovereignty meriting protection as such by means of an exclusion from trademark registration or other form of proprietary rights. States' names are nevertheless just as powerful and likely more universally recognizable identifiers than flags or other national symbols. The question therefore arises as to whether possession and protection of States' rights in their names can alternatively be based on the status of statehood, either as a condition of statehood or a consequence of it.

Various sources identify a link between national flags as expressions or 'emblems' of sovereignty and national identity,<sup>639</sup> but less clearly articulated is a link between country names and sovereignty. If it were clear that sovereignty encompasses a right to possess and prevent others' use of a name, the issue of States' rights in country names would not be the open question that it is today. An answer can only be reached by piecing together historical and contemporary understandings of statehood in order to demarcate the legal connection, if any, between sovereignty, statehood and country name. This section of this chapter considers first whether having a name is a condition of statehood, and second, whether having a name is a right of statehood.

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638. See Bodenhausen, 96.

639. See *for example*, Am. Jur. 2d *Flag* §1 ('A national or state flag is an emblem of that nation or state's sovereignty and authority.');

Michael Billig, *Banal Nationalism* 40-41 (Sage Publications 1995) (discussing the powerful impact of even unwaved flags as symbols of nationality and nationhood); Arundhati Virmani, *National Symbols Under Colonial Domination: The nationalization of the Indian flag, March-August 1923*, 164 *Past & Present* 169 (1999); Yael Navaro-Yashin, *Confinement and the Imagination: Sovereignty and Subjectivity in a Quasi-State*, in *Sovereign bodies: citizens, migrants and states in the postcolonial world* 103-104 (Thomas Blom Hansen & Finn Stepputat eds., Princeton University Press 2005) (discussing the importance of the flag of the Turkish Republic of Northern Cyprus to its sovereignty); *Sovereignty flag should fly, says Maori Party*, nzherald.co.nz (31 Jan. 2007) (available at [http://www.nzherald.co.nz/waitangi-day/news/article.cfm?c\\_id=1500878&objectid=10421769](http://www.nzherald.co.nz/waitangi-day/news/article.cfm?c_id=1500878&objectid=10421769)).

### 6.3.1 NAME AS A CONDITION OF STATEHOOD

#### 6.3.1.1 Statehood and Possession of a Name

Foundational historical works on sovereignty and statehood offer little support for the position that statehood is conditioned on having a name. For example, Emerich de Vattel, whose seminal work *Le Droit des gens; ou, Principes de la loi naturelle appliqués à la conduit et aux affaires des nations et des souverains* is considered one of the foundations of modern nation-State theory, saw only self-government as necessary.<sup>640</sup> Yet where specific territories are identified as having achieved the status of sovereign statehood, they are commonly referred to by name. For example, Franciscus de Vittoria, another influential early contributor to international legal theory, described a 'perfect State' as 'one which is complete in itself, that is, which is not a part of another community, but has its own laws and its own council and its own magistrates, such as is the Kingdom of Castille and Aragon and the Republic of Venice and the like'.<sup>641</sup> Little can be drawn from this, however, because the examples to which Vittoria points are States in possession of a name rather than States lacking names. The latter situation is not contemplated.

Contemporary scholars have experienced difficulty in articulating a definition or identifying attributes of statehood. This is at least partly due to the traditionally complex question of the need for recognition; that issue<sup>642</sup> must be set aside as separate from a possible link between statehood and country name.<sup>643</sup> The definition of 'State' provided by Article 3 of the Montevideo Convention on Rights and Duties of States<sup>644</sup> (hereinafter the 'Montevideo Convention') is viewed as setting the standard despite that convention being a regional agreement only.<sup>645</sup> From it can be extrapolated

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640. Emerich de Vattel, *Le Droit des Gens, ou Principes de la loi Naturelle, Appliqués à la conduite aux affaires des Nations et des Souverains*, vol. 1 Introduction, Bk I, ch I, §4 (1758).

641. Franciscus de Vittoria, *De Indis et de lure Belli Relectiones*, in *Relectiones Theologicae XII* (Ernest Nys ed.), reprinted in *The Classics of International Law* 169 para. 7 §§425-426 (James Brown ed., 1917).

642. On recognition, see James Crawford, *The creation of states in international law* 38, 89-95 (2d ed., Clarendon Press 2007).

643. See Matthew C. R. Craven, *What's in a Name? The Former Yugoslav Republic of Macedonia and Issues of Statehood*, 16 *Austl. Y.B. Int'l L.* 199, 238 (1995) (arguing that a link between name choice and recognition 'offends the notion of sovereignty itself'). See also Louis Henkin et al., *International Law: Cases and Materials* 253 (3d ed., West 1993).

644. Convention on Rights and Duties of States adopted by the Seventh International Conference of American States (26 Dec. 1933, entered into force 26 Dec. 1934), 165 *L.N.T.S.* 19.

645. The definition of 'State' in the Restatement (Third) of Foreign Relations Law of the United States almost precisely mirrors that of the Montevideo Convention, and in comments to the Restatement it is said that this definition 'is well-established in international law'. See *Restatement (Third) of the Foreign Relations Law of the United*

four principal criteria: a permanent population; a defined territory; government; and capacity to enter into relations with other States.<sup>646</sup> Clearly, possession of a name is not one of these four criteria. Nor is it one of the other criteria that have been suggested over time, including permanence, willingness and ability to observe international law, civilization, and legal order.<sup>647</sup> The requirements of membership in the United Nations are based first and foremost on having achieved statehood, but even these do not expressly require that aspiring members have a name.<sup>648</sup>

It is only plausible to take the position that possession of a name is a condition of statehood if it can be said that having a name, while not an express criterion of statehood, is a necessary or inherent aspect of a criterion of statehood. Considering in turn the four criteria identified by the Montevideo Convention as just noted, it could only be possible to interpret possession of a name as a necessary aspect of having the capacity to enter into relations with other States; the crux of this argument is that having a name is a necessary aspect of legal personality.<sup>649</sup> This will now be considered.

### 6.3.1.2 Name as a Necessary Aspect of Legal Personality

Having legal personality means being treated by the law as possessing the capacity to enter into formal relations with other legal persons and be held

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*States* § 201 Comment a (1987). As to the effectiveness of the definition, see John Dugard, *Recognition and the United Nations* 123 (Cambridge University Press 1987) ('Although Rhodesia, Transkei, Boputhatswana, Venda, Ciskei and, possibly, the Turkish Republic of Northern Cyprus met or meet the traditional requirements of statehood expounded in the Montevideo Convention of 1933, it is absurd to contend that any of these entities [ ... ] acquired the status of "State".')

646. Even those who deem it inappropriate to view determinations of statehood as a checklist-based activity nevertheless tend to accept that certain fundamental characteristics 'constitute in legal terms the core of the concept of statehood'. Crawford, 42. Crawford qualifies this by arguing that the strictness of the elucidation of these characteristics in individual cases depends upon context and 'that the exclusive attributes of States do not prescribe specific rights, powers or capacities that all States must, to be States, possess: they are presumptions as to the existence of such rights, powers or capacities, rules that these exist unless otherwise stipulated. This must be so, since the actual powers, rights and obligations of particular States vary considerably. The legal consequences of statehood are thus seen to be—paradoxically—matters of evidence or rather of presumption.'

647. *Ibid.*, 89-95.

648. Art. 4(1) of the Charter of the United Nations requires that applicants: (1) be a state; (2) be peace-loving; (3) accept the obligations of the UN Charter; (4) be able and willing to carry out these obligations.

649. See Igor Janev, *Legal Aspects of the Use of a Provisional Name for Macedonia in the United Nations System*, 93 *Am. J. Int'l L.* 155, 160 (1999).

accountable for one's actions, as are natural, living persons.<sup>650</sup> States are 'the principal examples of international persons.'<sup>651</sup>

Without a name, it has been argued, it is not possible to be identified and therefore not possible to engage and transact with others:

From the point of view of legal theory, the inherent right of a state to have a name can be derived from the *necessity* for a juridical personality to have a *legal identity*. In the absence of such an identity, the juridical person (such as a state) could – to a considerable degree (or even completely) – lose its capacity to conclude agreements and independently enter into and conduct its relations with other juridical persons. Therefore, the name of a state appears to be an *essential element of its juridical personality* and its statehood.<sup>652</sup> (emphasis in original)

This use of the term 'legal identity' helps to highlight that beyond their undeniably symbolic function, names primarily play a practical function in serving to identify things and distinguish them from others. Having some means by which to be identified and differentiated is certainly facilitative of engaging in relations with others, and contract law seeks as a general matter that parties be identifiable. A name is one means of distinguishing a party from another, but it is certainly not the only means; reference to geographical location, numbers and symbols could all be used, even if not as easily and memorably as names.<sup>653</sup> Each State could, for example, be assigned a number according to its order of accession to the United Nations, or it could be identified by its longitudinal and latitudinal coordinates or an image of its national flag. It could also be assigned a completely random and meaningless number. An analogy can be drawn with transactions between persons, in which context it is not strictly necessary that a party be referred to by name as opposed to another identifier or that the identifiers used have semantic value or be unique as against all others. It is simply necessary to provide sufficient information to distinguish one from others.<sup>654</sup>

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650. See *Restatement (Third) of the Foreign Relations Law of the United States* § 206 comment c.

651. Henkin et al., 241. See also Vattel, 1 §2 ('[L'Etat] deviant une personne morale, qui a son etendement et sa volonté propre, et qui est capable d'obligations et de droits').

652. Janev, *Legal Aspects of the Use of a Provisional Name for Macedonia in the United Nations System*, 160; Igor Janev, *Some Remarks of the Legal Status of Macedonia in the United Nations Organization*, 53 Rev. Int'l Aff. 1108 (2002).

653. Reference can be made here to domain names and the early decision to assign a name in addition to a number to identify hosts in the network. This is discussed in detail in Part I, Chapter 2, section 2.1.3 above.

654. See Janev, *Some Remarks on Legal Status*, 2 ('In the absence of such an identity, the juridical person, such as a state, could to a large extent (or even completely) lose [sic] its capacity to interact with other such juridical persons (e.g., conclude agreements, etc.) and independently enter into and conduct its external relations. The name of a state is, thus, an essential element of its juridical personality and, consequently, of its statehood.').

Nor is a name required of a legal person in order to express consent to be bound, bearing in mind that the voluntary expression of State consent is the cornerstone of positive international law. Just as illiterate persons can indicate their willingness to be bound to a legal instrument by stamping their fingerprint upon it or inscribing the letter 'X', so too could States communicate consent to be bound in a variety of visible ways. It is the expression of consent that is of consequence, not the form that expression takes or the possibility that others' expression of consent takes a similar form.

Another key aspect of relations between legal persons is participation in dispute resolution. In the international context one can look to the Statute as well as the Rules of the ICJ (hereinafter, the 'ICJ Rules'),<sup>655</sup> the latter of which specify the manner in which proceedings are to be initiated and conducted. Article 38(1) of the ICJ Rules requires in relevant part that an application to commence proceedings before the Court must 'indicate the party making it, the State against which the claim is brought, and the subject of the dispute'. Considering subject matter first, the *Island of Palmas Case (or Miangas)*<sup>656</sup> demonstrates that territorial disputes are resolvable even where the territory the subject of the dispute is referred to by multiple names.

Turning to the naming of State parties, while Article 38(1) of the ICJ Rules does not expressly require that State parties have a name, names are typically used for this purpose. Article 38(1) does not preclude commencing proceedings before the Court against, for example, 'the State whose application for membership in the United Nations was made' on a particular date or in a particular numbered document or 'the fiftieth State to join the United Nations', but these are not things that ordinarily occur in practice. One need look no further than the ICJ's docket for evidence of the practice and consistency of the use of States' names in proceedings.<sup>657</sup> It must be noted, however, that not all States have come before the ICJ and its predecessor, the Permanent Court of International Justice,<sup>658</sup> with a name of their own choosing. An example of this is the ongoing case brought by the

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655. Rules of Court (14 Apr. 1978, entered into force 1 Jul. 1978, as amended 14 Apr. 2005), I.C.J. Acts & Docs 4.

656. *Island of Palmas Case (or Miangas)*, Hague Court Reports 2d. 83 (1932), (Perm. Ct. Arb. 1928), 2 U.N. Rep. Intl. Arb. Awards 829.

657. On the significance of practice in treaty interpretation, see Vienna Convention on the Law of Treaties, Art. 31(3)(b). The ICJ docket is available at ICJ, *List of Cases referred to the Court since 1946 by date of introduction: List of contentious cases and advisory proceedings*, <http://www.icj-cij.org/docket/index.php?p1=3&p2=2> (accessed 15 Oct. 2012).

658. Publications of the Permanent Court of International Justice are available at ICJ, *Permanent Court of International Justice: Publications of the Permanent Court of International Justice (1922-1946)*, <http://www.icj-cij.org/pcij/index.php?p1=9> (accessed 15 Oct. 2012).



‘former Yugoslav Republic of Macedonia’ against Greece,<sup>659</sup> a dispute which is comprehensively discussed in the next section of this chapter. The applicant’s name in that case is a provisional one recommended by the UN Security Council, and not the name under which that country sought membership in the United Nations. The relevant question at this point in the enquiry is whether, without the provisional name, this country would have been prevented from raising its claim against Greece. In other words, was possession of a name (provisional or permanent) procedurally necessary to commencing the case?

Article 38(1) of the ICJ Rules requires identification of ‘the party making’ the application. It does not demand a particular format that identification must take. Identification of a party other than by its name would not run counter to ordinary meaning or defeat the object and purpose of the treaty as prescribed by Article 31(1) of the Vienna Convention, but the existence of a consistent subsequent practice ‘in the application of’<sup>660</sup> Article 38(1) of the ICJ Rules supports an interpretation of this as calling for use of a State party’s name.<sup>661</sup> Because all parties before the Court have had names, it is difficult to envisage what might otherwise occur. Presumably, names are used unless the party in question does not have a name, in which case some other identifier must – from a purely practical standpoint – be an acceptable substitute. Unless otherwise specified in the Rules, standing could not logically be denied of the basis of non-possession of a name if possession of a name is not itself a condition of statehood.

This discussion reveals that a distinction must be made between practical necessity and legal necessity. It is undeniably the case that names facilitate the functions of the UN, and so much so that this could be characterized as necessary (as opposed to simply desirable) from a perspective of operational convenience. Yet from the ease of using names does not automatically follow a legal obligation. Neither can a general sense of legal obligation be easily inferred from existing evidence of practice in the functions of the UN. Rights in country names as such derived from States’ possession of legal personality, or indeed derived from any other condition or right of statehood, cannot be based upon practicality or ‘(mere) comity (*courtoisie, comitas gentium*)’.<sup>662</sup>

Even if it is the case that State parties are required to be referred by name in ICJ proceedings, this does not equate to a strict prohibition against nameless parties’ participation in proceedings, nor does it speak to exclusive

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659. *Case Concerning the Application of Article 11, Paragraph 1, of the Interim Accord of 13 September 1995 (The Former Yugoslav Republic of Macedonia v. Greece)*, Memorial (I.C.J. 20 Jul. 2009) (available at <http://www.icj-cij.org/docket/files/142/16354.pdf>).

660. Vienna Convention on the Law of Treaties, Art. 31(3)(b).

661. See Gardiner, 225-232.

662. International Law Association, *Statement of Principles Applicable to the Formation of General Customary International Law: Final Report of the Committee on Formation of Customary (General) International Law*, Commentary to section 2(vi).

rights of States in their names. There is no clear evidence of a felt sense of legal obligation to possess a name in order to participate as a UN member, and such a legal obligation is not expressly articulated in UN instruments. From these things and from the fungible nature of identifiers in legal transactions it can be concluded that possession of legal personality does not require possession of a name, and thus that States' claims to exclusive rights in country names should not be based upon their possession of legal personality.

### 6.3.2 NAME AS A RIGHT OF STATEHOOD

#### 6.3.2.1 A Right of States to Select a Name

Even if not required in order to achieve the status of statehood, possession of a name may alternatively be a right that accrues as a consequence of having achieved statehood. This reasoning makes a distinction between the capacities that must be possessed in order to achieve the status of statehood from capacities or rights that, once statehood is achieved, are imputed to the State. This bifurcated approach is reflected, for example, in the Restatement (Third) of the Foreign Relations Law of the United States<sup>663</sup> (the 'Restatement'), which sets out the required elements of statehood in § 201 and then separately in § 206 the 'capacities, rights and duties of States' as:

- (a) sovereignty over its territory and general authority over its nationals;
- (b) status as a legal person, with capacity to own, acquire, and transfer property, to make contracts and enter into international agreements, to become a member of international organizations, and to pursue, and be subject to, legal remedies;

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663. The Restatements are treatises prepared and published by the American Law Institute on a variety of legal topics. They have the primary aim of providing guidance to judges and lawyers by clarifying and explaining fundamental legal subjects. The Third Restatement of the Foreign Relations Law of the United States captures international law as applicable to the United States, which 'stems largely from customary international law and international agreements to which the United States is a party.' ALI, *Publications Catalog: Restatements of the Law – Foreign Relations Law of the United States*, [http://www.ali.org/index.cfm?fuseaction=publications.ppage&node\\_id=33](http://www.ali.org/index.cfm?fuseaction=publications.ppage&node_id=33) (accessed 15 Oct. 2012). The Restatement of the Foreign Relations Law of the United States of course offers the perspective of only the United States as to international law, but the high regard in which its reporters are held mean that it has significance beyond that one country's borders: 'It should and will be consulted by lawyers in all parts of the world. For the lawyer in the United States, it may be a kind of authoritative codification. For lawyers in other countries, it is a valuable source of information about the foreign relations power in the United States and prevailing American views on international law.' Rudolf Bernhardt et al., *Book Review*, 86(3) *Am. J. Int'l L.* 608, 609 (1992) (reviewing *Restatement (Third) of the Foreign Relations Law of the United States*).

- (c) capacity to join with other states to make international law, as customary law or by international agreement.

The wording of § 206 of the Restatement is illustrative of the general absence in international law and scholarship of an express attribution to States of a right to select or use a name. It is necessary, therefore, to consider whether such a right is implied because it is inherently an aspect of sovereignty, bearing in mind that sovereign rights derive from the 'simple fact' of the State's 'existence as a person under international law.'<sup>664</sup>

In determining whether possession and exclusive use of a name is a sovereign right of States, the advice offered by Justice Haynes of the High Court of Australia should be borne in mind: 'Sovereignty is a concept that legal scholars have spent much time examining. It is a word that is sometimes used to refer to very different legal concepts and for that reason alone, care must be taken to identify how it is being used.'<sup>665</sup> Similar concern is expressed, for example, in the comments to § 206 of the Restatement, which specify that its use in this context of States' rights 'implies a state's lawful control over its territory generally to the exclusion of other states, authority to govern in that territory, and authority to apply law there.'<sup>666</sup> The exercise of this control is a core right to inhere in all States.

As to whether there are more specifically articulated rights of States (which could include a right to a name), there are divergent views. Vattel's reliance in the eighteenth century on natural law to explain the origin of States' rights echoes in modern arguments supporting an inherent, 'inalienable right' of States to select and use a name.<sup>667</sup> These arguments can also be linked to a right to culture and heritage, similar to what was termed by an early twentieth century diplomat the right to 'national distinctiveness'.<sup>668</sup> Contrasting with these is the view that 'statehood does not involve any inherent substantive rights' but is 'rather a form of standing'.<sup>669</sup> The works of historical and contemporary scholars who support the notion of States' rights offer little support for a specific right of States to select and use a name. Nevertheless, it is difficult to oppose the idea that a State may choose and use a name by virtue of the exercise of sovereignty and further that when it does so, it is free by virtue of that authority to place restrictions on others'

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664. Convention on the Rights and Duties of States, Art. 4.

665. *Joosse v. Australian Securities and Investment Commission*, 159 A.L.R. 260, 263-264 (High Ct. Aust'l 1998).

666. *Restatement (Third) of the Foreign Relations Law of the United States* §206 comment (b).

667. See for example, Janev, *Legal Aspects of the Use of a Provisional Name for Macedonia in the United Nations System*, 160.

668. F.A. Pezet, *The Future Relations of the United States with Latin America from the Latin American Viewpoint*, 7(2) Nat'l Conf. Foreign Rel. U.S. 287, 287 (1917).

669. Crawford, 44-45.

## Chapter 6: Rights in Geographic Names as Such

use of its chosen name within its sovereign territory. The same can be said of national flags and domestic laws prohibiting their desecration.<sup>670</sup>

In other words, sovereignty does not require that a State select and use a name to identify itself, but rather bestows States with the inherent authority to do so if they so choose.<sup>671</sup> In practice, States do select a name. This is evidenced by the United Nations Terminology Bulletin Country Names (from which, not coincidentally, the names of ccTLDs are derived).<sup>672</sup> Though not expressly required under the UN Charter or the Rules of Procedure of the General Assembly to do so, applications for UN membership refer to applicants by name:<sup>673</sup> indeed, compliance with Rule of Procedure 134<sup>674</sup> would be difficult as a practical matter if this were not done. The would be UN member is then acknowledged by that name on acceptance.<sup>675</sup>

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670. An interesting comparative analysis of flag desecration laws is provided by Ute Krüdwagen, *Political Symbols in Two Constitutional Orders: The Flag Desecration Decisions of the United States Supreme Court and the German Federal Constitutional Court*, 19(2) *Ariz. J. Int'l & Comp. L.* 679 (2002).
671. See Janev, *Legal Aspects of the Use of a Provisional Name for Macedonia in the United Nations System*, 160 ('every state naturally has an inherent right to a name').
672. UN Terminology Bulletin No. 347/Rev. 1, *United Nations Terminology Bulletin Country Names* (available at <http://unstats.un.org/unsd/methods/m49/m49alpha.htm>). On the naming of ccTLDs, see Part I, Chapter 2, section 2.4.2 above.
673. Recent examples include the Application of the Republic of Bosnia and Herzegovina at U.N. Doc. A/46/921 S23971 Annex (19 May 1992) ('On behalf of the Presidency of the Republic of Bosnia and Herzegovina and in conformity with the United Nations Charter, I am submitting the request of the Republic of Bosnia and Herzegovina to be admitted to the United Nations Organization as a full Member State.');
- Application of the Democratic Republic of East Timor at U.N. Doc. A/56/953-S/2002/558 Annex (20 May 2002) ('In connection with the application by the Democratic Republic of East Timor for membership in the United Nations, we have the honour, on behalf of the Democratic Republic of East Timor and in our capacities as the President of the Republic and the Prime Minister, to declare that the Democratic Republic of East Timor accepts the obligations contained in the Charter of the United Nations and solemnly undertakes to fulfil them.');
- Application of the Republic of Montenegro, U.N. Doc. A/60/890-S/2006/409 Annex (16 Jun. 2006) ('In line with the results of the referendum held in the Republic of Montenegro on 21 May 2006, organized in accordance with Article 60 of the Constitutional Charter of the State Union of Serbia and Montenegro, in my capacity as President of the Republic of Montenegro, I have the honour to request the admission of the Republic of Montenegro to membership in the United Nations.').
674. Rule 134 of the Rules of Procedure of the General Assembly of the United Nations provides: 'Any State which desires to become a Member of the United Nations shall submit an application to the Secretary-General. Such application shall contain a declaration, made in a formal instrument, that the State in question accepts the obligations contained in the Charter.'
675. Continuing with the above examples, see the Admission of the Republic of Bosnia and Herzegovina to membership in the United Nations, U.N. Doc. A/Res/46/237 (22 May 1992); Admission of the Democratic Republic of East Timor for admission to membership in the United Nations, U.N. Doc. A/Res/57/3 (2 Oct. 2002); Admission of

Sovereignty gives the State not only the authority to choose a name, but also to limit others' use of the selected name within its territory. There are, for example, reportedly 'thousands' of laws in Canada and 'probably millions' in the United States, that "bestow upon "public authorities" (which are often not elected bodies but government agencies, state-owned corporations, or non profit organizations) an absolute right to control particular signifiers.'<sup>676</sup> All States have the authority to select names and regulate their domestic use in this way, and have this authority equally, as articulated in the Montevideo Convention at Article 4: 'States are juridically equal, enjoy the same rights, and have equal capacity in their exercise.' Yet equality among States raises certain challenges in this context in that it does not prevent a State from selecting another State's name as its own; indeed, equality suggests that they are each equally entitled to make a particular selection.

The question of States' rights in country names therefore does not end with name selection and use within the sovereign territory. It must further be considered whether States' authority to select a name is somehow limited by the rights of other States and relatedly, whether States have a right to be referred to by their chosen name.

### 6.3.2.2 A Right of States to Object to Another State's Name

It is entirely possible that one State might choose to be identified in the same or similar way as another. This duplication of identifiers could be said to have a direct impact on the States in question and those transacting with them. While on the one hand it might be said that the only limit to name choice is imagination, in practice, geographic name choices are drawn from a relatively limited field of reference that is, by its very nature, shared with neighbouring States: 'The names of the countries are usually associated with their geographical location and dimension. Geography, at any rate, political geography, as reflected in the boundary making and delimitation of frontiers, territorial, maritime and aerial or atmospheric, changes with time.'<sup>677</sup> As borders fluctuate and time passes, so too are history, culture, language and environmental conditions shared, and it is from this pool of shared experience that geographic names are often drawn. Thus the very same reasoning behind one State's choice of name could also underpin another (particularly neighbouring) State's choice of name.

It is clear why a State would prefer that other States not choose the same name, and this bears out in practice. The relative infrequency with which naming conflicts have arisen is nevertheless surprising when one considers

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the Republic of Montenegro for admission to membership in the United Nations, U.N. Doc. A/Res/60/264 (12 Jul. 2006).

676. Coombe, 135-136.

677. Sompong Sucharitkul, *The Inter-temporal Character of International and Comparative Law Regarding the Rights of the Indigenous Populations of the World*, 50 Am. J. Comp. L. 3, 10 (2002).

the frequency with which new States have been created and old ones extinguished in modern times: it has been noted that more than 125 new States have been created or reconstituted since the coming into force of the United Nations Charter in 1945, not including name changes.<sup>678</sup> Even in this highly dynamic environment, the only major conflict is the ongoing dispute between Greece and the country provisionally referred to as the 'former Yugoslav Republic of Macedonia', or 'FRYOM'. This dispute will next be critically analysed, but first, some comments must be made about its uniqueness. One conclusion to potentially be drawn from the scarcity of name choice disputes is that there is a customary rule of avoiding selecting a conflicting State name. The existence of such a rule is undermined, however, by the number of States with shared names<sup>679</sup> and the simple fact that in none of these cases has conflict arisen to the level of the Macedonia name dispute. What drives name choice (and, by corollary, avoidance of choosing what others have already chosen) may not be a sense of legal obligation but rather simply an overriding interest in avoiding confusion with other States – a practical preference to not be confused with others. Although (as concluded in the previous section of this chapter) possession of a name is not a necessary aspect of legal personality, it does make transacting with other legal persons more convenient. Where similar names can be differentiated, these can be used without serious issue.

What then would lead a State to select a name insufficiently distinctive from or objectionable to others? One possibility already alluded to in the previous paragraphs is that shared history and experiences could lead multiple States to select the same or similar representations and symbols of their sovereignty. Objection on this basis is defensible in principle only for neighbours or States otherwise currently or historically related. Exemplary of such a situation are neighbours Greece and the FRYOM, one of the new nations borne out of dismembered Yugoslavia.

Responding to Greece's objection to Macedonia's application<sup>680</sup> for UN membership, the UN Security Council recommended that the country be 'provisionally referred to for all purposes within the United Nations as "the Former Yugoslav Republic of Macedonia" pending settlement of the difference that has arisen over the name of the State'.<sup>681</sup> The name is but one

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678. See Crawford, 715 and Appendix 1.

679. Examples of identical or materially similar country names include: (a) the Democratic Republic of the Congo and Republic of the Congo, (b) the Republic of Equatorial Guinea, the Republic of Guinea, the Republic of Guinea-Bissau, and the Independent State of Papua New Guinea, (c) the Democratic People's Republic of Korea and the Republic of Korea, and (d) Niger and Nigeria.

680. U.N. Doc. A/47/876-S/25147 (1992), discussed in detail in Michael C. Wood, *Participation of Former Yugoslav States in the United Nations and in Multilateral Treaties*, in *Max Planck Y.B. U.N. L.* 236-241 (Armin von Bogdandy ed., Martinus Nijhoff Publishers 1997).

681. S.C. Res. 817, 7 Apr. 1993, U.N. Doc. S/INF/49 (1993), at para. 2.

aspect of this now long-running dispute; in earlier proceedings before the European Court of Justice (ECJ) Greece complained of large scale efforts to promote 'the idea of a unified Macedonia' through that country's chosen name (Republic of Macedonia), the wording of its constitution, and such activities as 'the circulation of maps, calendars and car stickers' and 'school history books' depicting the FRYOM as encompassing Greek territory.<sup>682</sup> Also concerning to Greece was the FRYOM's adoption of the 'Sun of Vergina' on its flag, this emblem having been discovered in excavations on Greek territory.<sup>683</sup> Greece demanded that the FRYOM cease use of its chosen name and symbols and related activities, all of which it interpreted as territorial claims amounting to a threat of war.<sup>684</sup>

The ECJ's decision went not to resolving the name dispute but rather to interim measures requested by the European Commission to suspend economic sanctions imposed by Greece against the FRYOM, which request was ultimately rejected by the Court.<sup>685</sup> A subsequent Interim Accord between Greece and the FRYOM required only undertakings to continue negotiation 'with a view to reaching agreement' on this matter.<sup>686</sup> In 2008, the FRYOM instituted proceedings before the ICJ asserting that the Interim Accord had been breached by Greece by its objection to the FRYOM's application to join the North Atlantic Treaty Organization.<sup>687</sup> In December 2011, the Court found<sup>688</sup> that Greece's objection violated the Interim Accord. The applicant's clear intentions to refer to itself by its constitutionally chosen name within NATO (which ultimately resolved to delay a decision on admission pending resolution of the name dispute) was considered not to render Greece's objection lawful. The Court seized the opportunity to highlight the fact that the dispute has been ongoing for sixteen years, and to remind the parties of their obligation under the Interim Accord to make good faith efforts towards its resolution.

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682. *Commission of the European Communities v. Hellenic Republic*, C-120/94 R I-03037 (E.C.J. 29 Jun. 1994), at para. 8.

683. *Ibid.*, para. 9.

684. *Ibid.*, para. 31.

685. *Ibid.*, para. 48.

686. Interim Accord (with related letters and translations of the Interim Accord in the Languages of the Contracting Parties), Greece-the former Yugoslav Republic of Macedonia, signed in New York 13 Sep. 1995, 1891 U.N.T.S. I-32193; 34 I.L.M. 1461 (13 Oct. 1995).

687. ICJ, Press Release, *The former Yugoslav Republic of Macedonia institutes proceedings against Greece for a violation of Article 11 of the Interim Accord of 13 September 1995*, No. 2008/40 (17 Nov. 2008) (available at <http://www.icj-cij.org/docket/files/142/14881.pdf>).

688. *Application of the Interim Accord of 13 September 1995 (the former Yugoslav Republic of Macedonia v. Greece)*, Judgment of 5 Dec. 2011.

This dispute is a unique constellation<sup>689</sup> and though it remains unresolved, an attempt can be made to draw conclusions from the legality of Greece's demand that its neighbour avoid adopting the name 'Macedonia' in order to broadly articulate limitations upon States' sovereign rights to select a name. Notably, leading scholars have avoided doing so.<sup>690</sup> One highly regarded text characterizes the matter as one of 'political guarantees ensuring that [the FRYOM] had no territorial claims towards a neighbouring Community state'.<sup>691</sup> Another sees the dispute as illustrative of the potential problems inherent in States' sovereign authority, but makes no statement as to the legality of Greece's demands.<sup>692</sup> The problem, it has been said, is that this dispute:

both clarifies and obscures the status of country names in international law. On the one hand, both the UN's and the EU's reactions suggest that Greece's claim that a country's choice of name could be a form of aggression was not, as an abstract matter, per se unreasonable. Thus, it appears that international law recognizes the theoretical possibility that a country's choice of name might amount to hostile propaganda against a neighbour, such as in 'the use of a denomination which implies territorial claims.' In so doing, it suggests that the presumed norm that countries control their names has been weakened; conversely, it suggests that the idea that one country has rights regarding another country's use of names might theoretically have more merit than many had previously suspected.<sup>693</sup>

These comments attribute to States a right to select a name, but posit that this right is not absolute. This is consistent with the principle of sovereignty, which gives the State supreme but not absolute authority within its territory. Interference in domestic matters is permitted by Article 2(7) of the United Nations Charter, as well as by customary international law. Further, the Friendly Relations Declaration requires that 'every State shall refrain from any action aimed at the partial or total disruption of the national unity or

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689. Craven, *What's in a Name?*, 238 (characterizing this as 'the first occasion in which it has ever been suggested that a State, or for that matter a people, should not be the exclusive determinants of their own cultural and political symbols').

690. See Demetrius Andreas Floudas, *Pardon? A Name for a Conflict? FRYOM's Dispute with Greece Revisited*, in *The new Balkans: disintegration and reconstruction* (George A. Kourvetaris et al. eds., East European Monographs 2002).

691. Malcolm N. Shaw QC, *International Law* 452 (6th ed., Cambridge University Press 2008).

692. Colin Warbrick, *States and Recognition in International Law*, in *International Law* 241 (Malcolm D. Evans ed., Oxford University Press 2006).

693. Froomkin, *When We Say US<sup>TM</sup>, We Mean It!*, 856, quoting the European Commission's 16 Dec. 1991 Guidelines on the Recognition of New States in Eastern Europe and in the Soviet Union, as reprinted in Danilo Türk, *Declaration on Yugoslavia*, 4(1) Eur. J. Int'l L. 73, 73 (1993).



territorial integrity of any other State or country.’<sup>694</sup> If the right of a State to select and use a name is based on sovereignty, then this limitation must correspondingly apply, meaning that one State’s name choice cannot constitute an unlawful interference with the sovereignty of another State. Such an interpretation is supported by the general principle of abuse of rights, which serves to limit a State’s choice of name to the extent that the choice had the effect of ‘inflict[ing] upon another State an injury which cannot be justified by a legitimate consideration of its own advantage.’<sup>695</sup> A link to the general principle of good faith is equally clear given that ‘[a] state that acts in good faith is unlikely to abuse its rights.’<sup>696</sup> A related principle of ‘good neighbourliness’ was raised by Judge ad hoc Roucounas and suggested in his dissenting opinion to have been breached by the FRYOM.<sup>697</sup>

The determination of whether one State’s choice of name constitutes an unlawful interference with the sovereignty of another State or a breach of the principles of good faith, abuse of rights or good neighbourliness depends entirely on the facts in question.<sup>698</sup> As a result, it is impossible to develop universal rules around the selection of country names. In the Macedonia dispute, the European Commission Declaration on Yugoslavia required each former Yugoslav republic to declare that it had agreed, *inter alia*, ‘to adopt constitutional and political guarantees “ensuring that it has no territorial claims” against a neighboring E.C. country and that it would not use a name (e.g., Macedonia) that implied such claims and would conduct “no hostile propaganda activities” against a neighbouring E.C. country.’<sup>699</sup> This is likely as precise as rules could be articulated. This difficulty, along with the infrequency with which naming disputes have arisen,<sup>700</sup> may help to explain

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694. *Declaration on Principles of International Law concerning Friendly Relations and Cooperation among States in accordance with the Charter of the United Nations*, GA/RES/2625(XXV), U.N. Doc. A/8082 (1970).

695. L. Oppenheim, *International Law: A Treatise* 345 (8th ed., H. Lauterpacht ed., Longmans, Green & Co. 1955).

696. M. Byers, *Abuse of Rights: An Old Principle, a New Age*, 47 McGill L.J. 389, 406 (2002).

697. *Application of the Interim Accord of 13 September 1995 (the former Yugoslav Republic of Macedonia v. Greece)*, Judgment of 5 Dec. 2011 (Dissenting opinion of Judge ad hoc Roucounas).

698. See Craven, *What’s in a Name?*, 234, citing *Case Concerning Military and Paramilitary Activities in and Against Nicaragua (Nicaragua v. United States of America)*, I.C.J. Rep. 1986 (I.C.J. 27 Jun. 1986).

699. European Community, *Declaration on Yugoslavia and on the Guidelines on the Recognition of New States (Extraordinary European Political Cooperation Ministerial Meeting, Brussels, 16 Dec. 1991)*, 31 I.L.M. 1485 (1992).

700. There is another reported instance of a naming dispute in recent history, in which proposed changes to the name of the country of Uzbekistan were rejected on the basis of their being interpreted as territorial claims. See Crawford, 68 n. 141, citing Karen Dawisha & Bruce Parrott, *Russia and the new states of Eurasia: the politics of upheaval* 85 (Cambridge University Press 1995).

the non-existence of expressly acknowledged, detailed rules of international law on name selection.

There is no denying the potential for the choice of name by a State and even the purely internal, domestic use of the name to provoke (intentionally or unintentionally) changes in the world order. That part of the population in State A might be motivated by State B's choice of name to exercise a right of self-determination is a realistic possibility. Yet self-determination in its contemporary form is a right of peoples to be involved in a meaningful way in the constitution and maintenance of the systems that govern their lives.<sup>701</sup> The possibility that, as a right of peoples, self-determination encompasses a right to self- or group-identify using geographic names is explored in Chapter 9, below, along with other potential human rights bases of rights in geographic names.

### 6.3.2.3 A Right of States to be Referred by Their Chosen Name

A separate but related question is whether States have a right to be referred to by their chosen name. As discussed above, there is a strong practical and diplomatic incentive for States to have a name, but this does not necessarily speak to the existence of a legal obligation to have a name either generally or for a particular purpose. It has been noted earlier in this chapter that there is a practice of using names in the functions of the UN, though there are no provisions in the UN Charter that require members to have a name. The use of names is directed in certain UN procedures, for example in General Assembly plenary voting.<sup>702</sup> Yet use of *a* name is one matter, while use of a State's *chosen name* is another; the issue here is specifically whether, to give one specific example, the United States of America is obliged to use the name 'Russian Federation' when referring to that country within or even beyond the UN context.

For the most part, the practice of using names in the UN is axiomatic. Names are ordinarily used – and without any special emphasis on their being used – in accordance with the wishes of the named UN member. One notable instance of special emphasis is the General Assembly's pronouncement 'that, in accordance with the desires of its people, South West Africa shall henceforth be known as "Namibia".'<sup>703</sup> Applications are ordinarily accepted using standardized language,<sup>704</sup> and the new member is then referred to by

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701. See Rupert Emerson, *Self-Determination*, 65 Am. J. Int'l L. 459, 465-466 (1971).

702. General Assembly of the United Nations, *Rules of Procedure and Comments*, Rule 87.

703. *Question of South West Africa*, G.A. Res. 2372(XXII), U.N. Doc. A/Res/2372(XXII) (12 Jun. 1968).

704. General Assembly resolutions on administration are worded as follows:

*The General Assembly,*

*Having received the recommendation of the Security Council of [date] that [State name] should be admitted to membership in the United Nations,*

other members accordingly. The case of the FRYOM is in this context again a unique constellation: the UN Security Council avoided making use of that country's chosen name when resolving on its membership application, instead recommending admission of the 'State whose application is contained in document S/25147', and then recommending the use of a provisional name.<sup>705</sup> The General Assembly then admitted the so-called 'former Yugoslav Republic of Macedonia' using the standardized language just noted.

The Russian Federation provides an example of a different situation, that of an existing UN member changing its name. Leaving aside questions of continuation of membership<sup>706</sup> which lie outside the scope of this study, the Russian Federation's assumption of the Union of Soviet Socialist Republics' seat at the United Nations was characterized by then-President Yeltsin as a simple name change. He simply requested 'that the name "Russian Federation" should be used in the United Nations in place of the name "the Union of Soviet Socialist Republics".'<sup>707</sup> There is no record of objection to this request,<sup>708</sup> and the name 'Russian Federation' has accordingly since been used in the UN General Assembly and Security Council.<sup>709</sup>

Looking beyond these forums to the ICJ, it has been noted in the previous section of this chapter in the context of legal personality that there is uniform practice in referring to parties by name in ICJ disputes, and that this practice is supported at least to some extent by the wording of Article 38(1) of the ICJ Rules. That Article does not expressly require that an official name be used, but presumably the name of a UN member as per its admission is the name that will be used. The 'Macedonia' case is illustrative: it was docketed as '*the former Yugoslav Republic of Macedonia v. Greece*'. That case nevertheless offers no particular support to the existence of a legal obligation to refer to parties by their chosen name except insofar as it evidences a sense of felt obligation on the FRYOM's part to refer to itself by its provisional name as recommended by the UN Security Council. More assistance would have been offered were the roles of the parties in that case reversed (in other words, it would be interesting to see whether Greece would identify the respondent as something other than the 'former Yugoslav Republic of Macedonia'). Greece's counter-memorial and rejoinder did refer

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*Having considered the application for membership of [State name],  
Decides to admit [State name] to membership in the United Nations.*

*See for example, Admission of the Republic of Montenegro to membership in the United Nations.*

705. S.C. Res. 817, para. 2.

706. On continuation, see Yehuda Z. Blum, *Russia Takes Over the Soviet Union's Seat at the United Nations*, 3(2) Eur. J. Int'l L. 354 (1992).

707. U.N. Doc. 1991/RUSSIA, 1, excerpted in Blum, at 356.

708. See Crawford, 677.

709. See for example, U.N.G.A. Res. A/RES/65/281 (17 Jun. 2011).

to the 'former Yugoslav Republic of Macedonia',<sup>710</sup> which is procedurally sensible, given that Greece was the respondent, but not expressly required by Article 49 of the ICJ Rules. It is also interesting to note that the respondent in the case against Greece before the ECJ was not identified as 'Greece' but rather as the 'Hellenic Republic' (the name under which it entered the Treaty Establishing the European Community).<sup>711</sup>

Of these instances just discussed, the language that is most strongly supportive of a right of members to be referred to by their chosen name is that of the UN Security Council in directing other members to refer to the 'former Yugoslav Republic of Macedonia' and do so 'for all purposes within the United Nations'.<sup>712</sup> This, ironically, is not a case of a State being referred to by its chosen name, but rather a provisional name to be used pending a dispute involving the name. Even if this or perhaps the Namibia case or standard practice offers a basis upon which a right of States to be referred to by their chosen name can be asserted, this is an extremely limited right which would prevent only alternative name use within and for UN purposes. This would not prevent the use of alternative names (e.g., a reference to the United Kingdom of Great Britain and Northern Ireland by the slang name 'Old Blighty',<sup>713</sup> or even a reference to that country as 'Britain' or 'the UK') by a member of the GAC in ICANN discourse, a government official from commenting to the press, or even in international relations outside of the UN context, while acknowledging the potential detriment such actions might in some instances have in terms of good international relations. Much of State conduct around naming appears to have as its basis not clearly identifiable legal rules but rather good international relations with the aim of avoidance and resolution of disputes through good faith negotiations. The United Nations Security Council has encouraged this from Greece and the FRYOM,<sup>714</sup> though as-yet those States have been unable to achieve resolution of their dispute.

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710. *Case Concerning the Application of Article 11, Paragraph 1, of the Interim Accord of 13 September 1995 (The Former Yugoslav Republic of Macedonia v. Greece)*, Counter-Memorial by Greece (I.C.J. 19 Jan. 2010) (available at <http://www.icj-cij.org/docket/files/142/16356.pdf>); *Case Concerning the Application of Article 11, Paragraph 1, of the Interim Accord of 13 September 1995 (The Former Yugoslav Republic of Macedonia v. Greece)*, Rejoinder of Greece (I.C.J. 27 Oct. 2010) (available at <http://www.icj-cij.org/docket/files/142/16356.pdf>).

711. Treaty Establishing the European Community (Consolidated Version) (25 Mar. 1957).

712. S.C. Res. 817, para. 2.

713. Michael Quinion, *World Wide Words: Blighty*, <http://www.worldwidewords.org/qa/qa-bli1.htm> (accessed 15 Oct. 2012).

714. See S.C. Res. 817.

6.4 CONCLUSIONS ON RIGHTS IN GEOGRAPHIC NAMES AS SUCH

Two related bases have been explored in this chapter as potential sources of rights in geographic names under international law: Article 6*ter* of the Paris Convention for the Protection of Industrial Property and the principle of sovereignty. First, Article 6*ter* requires that States prohibit the registrability as trademarks of State flags and other emblems, as well as the emblems of IGOs. In this chapter, the interpretation of Article 6*ter* (1)(a) by WIPO has been confirmed with reference to recent survey evidence and as-yet unsuccessful attempts to amend that Article. The results of the questionnaire drafted by the WIPO Standing Committee indicate that many States are reserving country names from trademark registration even though they are not obliged under Article 6*ter* to do so. An isolated instance of the use of the notification procedure specified in Article 6*ter* (3) by Iceland has also been highlighted, but other actions in this space suggest that this is a unique interpretation of Article 6*ter* which does not constitute evidence of a custom of reserving rights in country names.

From discussions around proposed amendments to widen the scope of Article 6*ter* to include country names can be extrapolated the conclusion that there currently is no international law recognizing rights in country names as such that could be called upon to justify their exclusive use by States and the prevention of their use by others. The analysis documented in this chapter supports that view. It is only logical to reach the same conclusion as respects sub-national names. That said, Article 6*ter* does not prevent States from reserving rights in geographic names as such; it simply does not require that they do so. The protection offered by ICANN through the *gTLD Applicant Guidebook* is therefore not inconsistent with Article 6*ter*.

The second basis of rights evaluated in this chapter is the foundational international law principle of sovereignty. Governments have looked to the principle of sovereignty in order to justify what they view as an inherent right to prevent others' use of 'their' names. While there may be a growing body of examples of conflict over private parties' use of geographical names,<sup>715</sup> there are surprisingly few examples of name conflicts between States. As a result, there are very few constellations from which support of States' rights in country names can be drawn. In this chapter it has been considered that there are actually three rights potentially encompassed in a right of States to country names: a right to select a name, a right to object to another State's name, and a right to be referred to by a chosen name. In relation to none of these is there an express right contained in any international convention, though the ICJ Rules do refer to the identification of party names, while the UN General Assembly Rules refer to plenary voting according to name. At

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715. For examples, see discussion of UDRP cases involving geographic names at Part II, Chapter 3, section 3.3.1.2 above.

the same time, in relation to none of these is there an express denial of a corresponding right in any international convention.

From the as-yet unresolved dispute between Greece and the FRYOM over the name 'Macedonia' can be extracted certain conclusions about States' rights to select and object to a name. This dispute is the manifestation of a rational tendency to select a name that happens to be based upon an identity or history shared with neighbouring States. The escalation of this dispute into an international legal dispute is, however, unique. From it and other instances of name similarity not escalated into international disputes it can be deduced that there is no rule of international law preventing one State from selecting the same or similar name as another State's. This dispute suggests that a State's right to select a name is not absolute, but rather is limited by obligations not to encroach upon another State's sovereignty and to act in good faith. There are no clear rules to determine when this occurs, nor is it practicable to attempt to develop rules beyond the general proscription imposed upon the FRYOM not to interfere with the territorial integrity of another State. Nor for the same reasons is it practicable to develop rules around objections to States' choice of name. These situations can only be resolved on a case-by-case basis, having due regard to the facts at issue.

As to the implications of these conclusions in the context of domain names, conflicting applications for new geographic gTLDs are inevitable: there are already in existence several constellations of similar country names which, although they have not previously been disputed in the offline context, could be the subject of a future challenge in the online context due to the technical requirement of absolute name uniqueness and the policy decision to prevent confusingly similar TLD strings. Although conflicting applications for a .macedonia new gTLD were not made in the initial round of top-level expansion under the New gTLD Program, these remain a real possibility in future expansion rounds if the prohibition on applications for country and territory names is lifted. It would be inappropriate to develop a single rule of priority on the basis of sovereignty, simply because sovereignty does not support such a rule. On this basis, as a matter of policy and to preserve the stability of the internet and its DNS, ICANN should consider refusing the creation of any geographic new gTLD for which competing applications have been submitted.

Finally, to the extent that a right to be referred to by one's chosen name can be derived from practice within the UN and before the ICJ, these are limited to those specific contexts and will not serve to prevent failures to properly identify a State in other contexts such as the DNS. Further, the recognition of a right in that limited context is not alone determinative of the exclusivity of a State's rights in a particular name in that particular context, or certainly in any other context.

## Chapter 7

# Rights in Geographical Indications

The protection of geographical indications is not only about the protection of names. It is about the protection of a certain quality and reputation that is attributable to a product that is made in a defined place. A mere name does not necessarily capture that concept of quality.<sup>716</sup>

### 7.1 GEOGRAPHICAL INDICATIONS AND WHY THEY PRESENT CHALLENGES

Geographic names that are used to denote the particular geographic origin of particular comestible products have since the early days of the Paris Convention for the Protection of Industrial Property held a special legal status separate from their potential registrability as trademarks. That status is, however, nowhere near as clearly defined or harmonized as it is for trademarks. When it comes to the recognition of rights under international law in geographical indications and related origin-connoting names, the question is therefore not whether rights are recognized, but whether the extent of their recognition is sufficient to have any impact upon their unauthorized use in a particular context such as the DNS.

The TRIPS Agreement contains provisions respecting ‘geographical indications’, but since long before its coming into force there have been two separate international treaty frameworks directed at the recognition of rights in origin-connoting geographic names. Entirely different agreements, one thing they have in common is a low number of signatories, as a result of

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716. O'Connor, *The law of geographical indications*, 18.

which they can both reasonably be characterized as failures. A different picture emerges at the regional level, where the European Union in particular has constructed a robust protection framework out of Member States' traditions of recognizing rights.<sup>717</sup> Discussions on the issue of international recognition of geographical indications suggest that efforts are driven by Europe's eagerness for other members of the international community to embrace its framework or something closely resembling it.<sup>718</sup>

All members<sup>719</sup> of the WTO are required by the TRIPS Agreement to provide the means to protect geographical indications against use that would mislead the public or constitute unfair competition. It is up to members to determine how to meet this requirement. There is a vast range of approaches, including:

unfair competition and consumer protection, passing off, *sui generis* protection of geographical indications via registration, passive protection where the concept of geographical indications is defined and protection available through courts but no registration system, trademarks with geographical references, collective, guarantee and certification trademarks, and administrative schemes of protection.<sup>720</sup>

What the TRIPS Agreement provides is not a right in geographical indications as such but rather a limited right to prevent particular kinds of uses depending on the type of product to which the name relates. Importantly, as will be explored in detail throughout this chapter, a distinction is made between indications relating to wine and spirits and indications relating to other types of products.

This is as much as the WTO has – as-yet – managed to achieve in terms of reaching agreement among its members, and even getting to this point was difficult.<sup>721</sup> For those countries whose laws offer greater protection to geographical indications, including protection of indications as such, the TRIPS Agreement compromise offers little comfort because they see what is at stake as being much more than mere names, but national identity.<sup>722</sup> On the other hand, for those countries in which geographical indications have not traditionally been protected, the TRIPS compromise represents the edge of a slippery slope; members' ability to offer greater protection than that required under the Agreement (the so-called 'minimum standards framework') gives

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717. *Ibid.*, 123.

718. See for example, Cottier, *The Prospects for Intellectual Property in GATT*, 404.

719. See WTO, *Understanding the WTO: The Organization, Members and Observers*.

720. O'Connor, *The law of geographical indications*, 67.

721. See Cottier, *The Prospects for Intellectual Property in GATT*, 404.

722. See Tomer Broude, *Taking 'Trade and Culture' Seriously: Geographical Indications and Cultural Protection in WTO Law*, 26 U. Pa. J. Int'l Econ. L. 623, 661-622 (2005).



rise to 'a clear risk of excessive protection' and of needing to make fundamental changes to existing law.<sup>723</sup>

As with geographic names generally, recent discussions about an international standard of protection for geographical indications have been motivated by the use of these names in the online environment. The World Intellectual Property Organization's WIPO II Report offered specific examples of unauthorized registrations of second-level domain names comprised of geographical indications, but as with geographic names generally, it was concluded that the TRIPS Agreement offered insufficient support for preventing this activity.<sup>724</sup> A decade later, the registration of second-level domain names comprised of geographical indications remains problematic. With the expansion of the DNS through the New gTLD Program, this problem will quickly and inevitably spread to the system's top-level, as well as into the lower levels of newly created gTLDs. It is therefore imperative to examine the status of geographical indications under international law in order to anticipate, and in at least some instances preventatively address, specific issues with potential to arise during the DNS expansion process.

This chapter begins with an introduction to the legal concept of a geographical indication and the international framework of protection that remains in development after more than one hundred years. Mirroring the way in which geographical indications are separated in this framework, the analysis of legal rights that follows is divided into two parts, the first exploring rights in wine and spirit geographical indications, and the second exploring rights in geographical indications for other products.

### 7.1.1 GEOGRAPHICAL INDICATIONS, INDICATIONS OF SOURCE AND APPELLATIONS OF ORIGIN

The term 'geographical indication' is one of three legal terms used to describe geographic names that identify a particular product as originating from a particular geographical location. 'Geographical indication' is the term used by the TRIPS Agreement, Article 22(1) of which states: 'Geographical indications are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.' Key to this definition are three points: first, its limitation to 'goods'; second, the required nexus of the good with a particular territory; and third, the demonstration of nexus through a 'quality, reputation or other characteristic' being 'essentially attributable' to geographical location. These three points

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723. Thomas Cottier, *The Agreement on Trade-Related Aspects of Intellectual Property Rights*, in *Trade and Intellectual Property Protection in WTO Law: Collected Essays* 145 (Cameron May 2005).

724. WIPO, *WIPO II Report*, paras 223-228 and 237-245.

differentiate geographical indications from 'indications of source' and 'appellations of origin', the two other legal terms used to describe geographic names that identify a particular product as originating from a particular geographical location.

The precise characteristics of each of these types of names are identified immediately below, but as an initial matter the existence of significant points of overlap between the three terms should be emphasized: all 'appellations of origin' are considered to fall within the definition of 'geographical indication' while at the same time are also 'considered to be a *species* of the *genus* "indications of source".<sup>725</sup> It is nevertheless unwise to consider 'geographical indication' an 'umbrella term'; 'not all indications of source are covered by the definition of geographical indications since not all of them would necessarily have the "quality, reputation or other characteristic of the good which is essentially attributable to its geographical origin".<sup>726</sup>

Of the three terms, 'indication of source' is the broadest and longest in use at the international level. What started as draft Article 6 at the 1880 Paris Conference would ultimately take shape in Article 10 of the Paris Convention for the Protection of Industrial Property as a prohibition on the use of false indications of the source of goods.<sup>727</sup> This prohibition was limited to the use of false indications only to the extent that they were used in conjunction with a false, fictitious, or deceptive trade name.<sup>728</sup> Such narrow drafting provoked a separate agreement in 1891, the Madrid Agreement for the Repression of False or Deceptive Indications of Source (the 'Madrid (Indications of Source) Agreement'), which made actionable any 'false or deceptive indication', whether direct or indirect, of the country or place of origin.<sup>729</sup> Notably, no nexus to the territory in the form of characteristics or reputation specifically attributable to the geographical location was required under the Madrid (Indications of Source) Agreement. More than eighty years later, the World Intellectual Property Organization's Model Law for Developing Countries on Appellations of Origin and Geographical Indications maintained this position, defining 'indication of source' as 'any expression or sign used to indicate that a product or service originates in a country or region or a specific place'.<sup>730</sup>

Despite the liberalization of Article 10 achieved at the 1958 Paris Convention Revision Conference at Lisbon,<sup>731</sup> interest in yet stronger protection led to another, separate agreement, the Lisbon Agreement for the

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725. Bodenhausen, 23 (internal citations omitted).

726. O'Connor, *The law of geographical indications*, 24.

727. See Conrad, 23.

728. *Ibid.*

729. Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, Art. 1(1) (14 Apr. 1891), 828 U.N.T.S. 163.

730. WIPO, *Model Law for Developing Countries on Appellations of Origin*, PJI/91/2, No. 809(E)(1975).

731. See Conrad, 23.

Protection of Appellations of Origin and their International Registration (the 'Lisbon Agreement').<sup>732</sup> Article 2(1) of the Lisbon Agreement defines the term 'appellation of origin' as 'the geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographic environment, including natural and human factors'. Unlike the Paris Convention and Madrid (Indications of Source) Agreement, the Lisbon Agreement applies only to geographic names and protects them as such; symbols and other signs are not protected. Thus it offers stronger protection than the previous agreements, but to a narrower set of indications.

Although Articles 22, 23 and 24 of the TRIPS Agreement were based on the Lisbon Agreement, its definition of 'geographical indication' marks a return to a broader scope of covered indications. The TRIPS Agreement does not require that an indication be a geographic name, but where an indication is geographic, it must relate to a single Member State only: country names qualify, but cross-border regional names like 'Caribbean' do not.<sup>733</sup> Further, the TRIPS Agreement requires that an indication 'identify' a 'good' rather than 'designate' a 'product', though it has been concluded that this change in wording is of no legal effect.<sup>734</sup> Finally, the TRIPS Agreement allows for a good's non-physical reputation to be the basis of its nexus to the geographical location, while the Lisbon Agreement requires a physical tie in the form of quality and characteristics of a product as directly resulting from its geographical location.

By reason of its inclusion in the TRIPS Agreement, to which all WTO members are bound, the term 'geographical indication' is the most authoritative of these three terms for origin-connoting names. Neither the Madrid (Indications of Source) Agreement nor the Lisbon Agreement has a critical mass of contracting parties, the former with thirty-five and the latter with twenty-seven.<sup>735</sup> In terms of an up-to-date exposition of rights, 'geographical indication' is also the most appropriate term by reason of its use in the TRIPS Agreement and in the Doha trade round agenda.<sup>736</sup> This chapter thus primarily focuses on 'geographical indications' as these are defined in the TRIPS Agreement, with the goal of determining their status under international law at the point of launch of ICANN's New gTLD Program. Where

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732. Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (31 Oct. 1958, entered into force 25 Sep. 1966), 923 U.N.T.S. 205.

733. See O'Connor, *The law of geographical indications*, 52-53.

734. See Gervais, 294 n. 378.

735. WIPO, *Lisbon Agreement (Total Contracting Parties: 27)*, [http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=10](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=10); WIPO, *Madrid Agreement (Indications of Source) (Total Contracting Parties: 35)*, [http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=3](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=3) (accessed 15 Oct. 2012).

736. *Doha WTO Ministerial Declaration*, Art. 18, WTO Doc. WT/MIN(01)/DEC1 (20 Nov. 2001) (available at [http://www.wto.org/english/thewto\\_e/minist\\_e/min01\\_e/mindecl\\_e.htm](http://www.wto.org/english/thewto_e/minist_e/min01_e/mindecl_e.htm)).

specific issues of overlap or conflict with the other two forms of rights ('appellations of origin' or 'indications of source') are present, these are identified.

### 7.1.2 THREE CONVENTIONS, THREE GROUPS OF GOODS

The immediately preceding section of this chapter identifies three conventions that specifically address geographic names used to identify a particular product as originating from a particular geographical location: the Madrid (Indications of Source), Lisbon and TRIPS Agreements. These three conventions are distinguishable not only by the subject matter they protect ('indication of source', 'appellation of origin' and 'geographical indication', respectively) but also by the level of protection extended to their respective subject matters.

Of the three conventions, the Lisbon Agreement offers the highest level of protection by recognizing rights in appellations of origin through a registration system comparable to the trademark system. Members are required by Article 1(2) to protect through domestic law all appellations of origin 'as such', meaning that only rights in the nature of exclusive property are recognized and recorded in the register. Mere limitations on the use of appellations through, for example, consumer protection, tort, unfair competition law or equitable principles are not sufficient. Specifically, domestic law must prohibit, pursuant to Article 3, all usurpation or imitation, including 'style' or 'type' indications. All appellations are treated equally, without regard to type of product, and appellations protected in the home country are immunized under Article 6 from 'genericization' in all signatory States. This means that protection can never be lost on the grounds that the public has come to equate the geographic name with a general type of product, unless this happens in the country of origin or for some other reason protected status is lost there. This high level of protection, and in particular the protection against genericization, helps to explain the relatively low number of signatories<sup>737</sup> to this agreement of whom several, not coincidentally, are the strongest advocates of increasing geographical indication protection in the WTO Doha trade negotiations round. These efforts are discussed in detail later in this chapter.

The Madrid (Indications of Source) Agreement, by contrast, covers a broader scope of indications but offers them a lower standard of protection, preventing only false and misleading use. Use includes representations on a

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737. Contracting parties comprise: Algeria, Bulgaria, Burkina Faso, Congo, Costa Rica, Cuba, Czech Republic, Democratic People's Republic of Korea, France, Gabon, Georgia, Greece (not in force), Haiti, Hungary, Iran (Islamic Republic of), Israel, Italy, Mexico, Montenegro, Morocco (not in force), Nicaragua, Peru, Portugal, Republic of Moldova, Romania (not in force), Serbia, Slovakia, Spain (not in force), the former Yugoslav Republic of Macedonia, Togo, Tunisia, Turkey (not in force). WIPO, *Lisbon Agreement (Total Contracting Parties: 27)*.

product as well as advertising and related communications – what the Agreement terms at Article 1(1) ‘direct’ and ‘indirect’. Other than its broadening of protection to not merely false but misleading indications, there are few substantive differences between the Madrid (Indications of Source) Agreement and the protection offered under the Paris Convention.<sup>738</sup> On the issue of genericization, members are prevented by Article 4 from treating any indications for wine as generic terms. This protection is not extended to other products.

TRIPS Agreement members, by far the most numerous of these three conventions, are required to prevent the importation of goods that directly or indirectly use false indications under Article 10 of the Paris Convention, by virtue of that convention’s inclusion by reference. This is despite the fact that Article 10 was not initially geared toward origin statements: Article 10(1) requires no nexus to a geographical location; false indication of the ‘identity of the producer, manufacturer, or merchant’ is actionable. Given the necessarily commercial nature of this right and its broader applicability to geographic names other than geographical indications, Article 10 is discussed in the next chapter, which focuses on unfair competition and related rights arising out of the commercial use of geographic names.

Articles 22 through 24 of the TRIPS Agreement are, on the other hand, specifically focused on geographical indications and are set out in that Agreement under a separate heading of that name. Nexus to territory is required, but ‘any aspect or element of geographical origin, known or unknown, physical or human, may underpin a quality, reputation or other characteristic of a good identified as originating in a particular place.’<sup>739</sup> More clearly than the Madrid (Indications of Source) Agreement but unlike the Lisbon Agreement, protected indications are divided into two groups by the type of product they identify: wines and spirits, and other products. The scope of protection afforded under the TRIPS Agreement to these two groups of products is explored next, and areas of conflict between this protection and the use of protected names in the DNS are identified.

## 7.2 RIGHTS IN GEOGRAPHICAL INDICATIONS UNDER THE TRIPS AGREEMENT

### 7.2.1 SCOPE OF PROTECTION FOR WINE AND SPIRIT GEOGRAPHICAL INDICATIONS

There has long been a practice in Europe of identifying wines by the name of the region from which they originate. Chianti has been identified as

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738. See O’Connor, *The law of geographical indications*, 31.

739. *Ibid.*, 54.

possibly being the first legally defined geographical indication, its status having been declared by a Decree of Grand Duke Cosimo III dé Medici in 1716.<sup>740</sup> The name 'Champagne', the globally-recognized icon for the many issues and questions surrounding the recognition of rights in geographical indications at an international level, is said to have been formally recognized in 1887 by the Angers Court for use only in connection with wines produced and grown in the Champagne region of France.<sup>741</sup> This was not the first recognition of a geographical indication in France, but rather the start of a period of momentum in which courts 'confirmed that the name of a locality belonged to all the inhabitants that had interest to exploit it to make the situation of their establishment known, and the place of origin or of manufacturing of their products.'<sup>742</sup>

The concern in early cases recognizing geographical indications seems not to have been the identification of particular characteristics of products as a nexus to the territory of origin; rather, the names served purely to link geographical location of fabrication with product.<sup>743</sup> Today, Article 22(1) of the TRIPS Agreement requires that there be a deeper nexus between territory and product: it is not sufficient that a good simply originate from a defined geographical location. For all products, not just wines and spirits, it must be shown that 'a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.' In meeting this standard, 'any aspect or element of geographical origin, known or unknown, physical or human, may underpin a quality, reputation or other characteristic of a good identified as originating in a particular place.'<sup>744</sup>

A nod to their longstanding use in the 'Old World', Article 23 of the TRIPS Agreement accords a higher level of protection to wine and spirit geographical indications than it does to indications for other goods. Specifically, Article 23(1) sets a standard of absolute protection, meaning that it requires Member States to prevent all uses of a wine or spirit geographical indication on wines or spirits not originating in the identified geographical location, 'even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like.' Article 23(2) further prevents registration and requires invalidation of trademarks containing or consisting of a geographical name of a wine or spirit for wines or spirits.

To wines alone, the TRIPS Agreement directs further refinements in their current and future recognition. As to their current recognition, Article

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740. See Broude, 666.

741. See Alessandro Stanziani, *Wine Reputation and Quality Controls: The Origin of the AOCs in 19th Century France*, 18 Eur. J. L. Econ. 149, 157-8 (2004).

742. *Ibid.*, 157 (internal citations omitted).

743. *Ibid.*, 157-158.

744. O'Connor, *The law of geographical indications*, 54.

23(3) recognizes homonymous geographical indications, thus acknowledging the potential for a 'New World' wine region to have been named by its inhabitants after the 'Old World' wine region from which they emigrated. As to future recognition, Article 23(4) directs that negotiations be undertaken regarding the establishment of a 'multilateral system of notification and registration of geographical indications for wines eligible for protection' in their home country. This is the highest level of protection (and potential for future protection) offered to geographical indications under the TRIPS Agreement, and yet it still leaves many gaps into which unchallengeable uses may fall.

7.2.2 ISSUES FOR WINE AND SPIRIT GEOGRAPHICAL  
INDICATIONS AS GTLD STRINGS

7.2.2.1 Top-Level Domains Offer a Service, Not Goods

The WIPO II Report highlighted 'two fundamental problems in endeavoring to apply the existing international legal framework to prevent the bad faith misuse of geographical indications in the DNS.'<sup>745</sup> The first of these is the limitation of protection to geographical indications used to identify goods. In respect of second-level domain names, it was concluded:

The mere registration of a geographical indication as a domain name by someone with no connection whatsoever with the geographical locality in question, however cheap and tawdry a practice, does not appear to be, on its own, a violation of existing international legal rules with respect to false indications of source and geographical indications. Such a registration may violate existing standards if it is associated with conduct relating to goods. ... one can imagine various hypothetical uses of domain name registrations with respect to goods which might be considered to constitute violations of the provisions on the protection of geographical indications in the TRIPS Agreement. However, there are many circumstances in which a domain name registration, even though constituting a false or unauthorized use of a geographical indication, may not constitute a violation of existing international rules because there is no relationship between the domain name and goods.<sup>746</sup>

An obvious corollary to the limitation to goods is the exclusion of services, which has been subjected to scrutiny. The term 'good' notably replaces 'product', the term used in the Lisbon and Madrid (Indications of Source) Agreements and the Paris Convention, and this has been interpreted as evidence of the drafters' intention to exclude services from Articles 22 and

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745. WIPO, *WIPO II Report*, para. 239.

746. *Ibid.*, para. 240.

23: 'It seems that where negotiators wanted to indicate that a rule in respect of indications applied to services as well as goods, they said so.'<sup>747</sup> Others have also reached this conclusion.<sup>748</sup> Thus, for example, a registration of the domain name *www.champagne.com* must be prevented pursuant to Article 23(1) if the website operated under that name purported to sell or offer for sale sparkling wines not originating in Champagne, France or 'Champagne-type' sparkling wines. It could not be prevented if the website offered information about such products not in the context of advertising their sale or if it offered other services (such as hospitality and tourism services offered by a hoteliers' association in the Champagne region). The existing international legal framework thus offers, in the words of the WIPO II Report, 'only a partial solution to the problem of' registration of geographical indications as second-level domain names.<sup>749</sup>

By contrast, the existing international legal framework offers no solution at all at the top-level of the DNS. The explanation for this lies in the fundamental differences between the top and lower levels of the DNS, which have been comprehensively discussed in Chapter 2. To summarize that discussion, second and lower level domain names have come to be used to identify the content of the websites to which they point. Use of a geographical indication in connection with goods is possible (though not inevitable) in that environment, where the domain name serves to identify goods offered for sale by means of an associated website. Use of a geographical indication in connection with goods is not possible, however, where the domain name serves to identify a communications portal for use by others for a variety of purposes (offering goods or services, expressing an opinion, reporting news, etc.) as top-level domains do. Top-level domains are themselves a service: the registry's primary function is to maintain an up-to-date listing of all of the second-level domain name registrations within them. This facilitates access to and between the registrants of those domain names, the registrants of domain names in other top-level domains and internet users. In short, top-level domain registries have no inherent connection to goods. They provide an environment in which others can self-identify and make available information which may or may not be connected to goods. A .football top-level domain, for example, would have only an indirect connection, if even any, to footballs. Rather, .football identifies itself as a space in which web users are able to communicate with

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747. Gervais, 298. As an example of an explicit application to services, Gervais points to Art. 24(6) of the TRIPS Agreement.

748. See for example, O'Connor, *The law of geographical indications*, 53. It is also interesting to note the reference to Art. 22 in the Jamaican delegation's proposal regarding the scope of Art. 6ter of the Paris Convention, in which concern is expressed at that provision's failure to cover services. See WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *Report Adopted by the Standing Committee*, para. 311, SCT/21/8.

749. WIPO, *WIPO II Report*, para. 240.



others, most likely about things having to do with ‘football’, which term has multiple interpretations (an item of sports equipment as well as various forms worldwide of a sport called ‘football’). The same can be said of a .champagne or a .parmigiano-reggiano top-level domain.

This means that Article 23 of the TRIPS Agreement offers no protection against uses of geographical indications for wines and spirits at the top-level of the DNS. Even to the extent that the second ‘fundamental problem’ identified in the WIPO II Report – the lack of harmonization as to the recognition of geographical indications<sup>750</sup> – was somehow resolved, this would not change the outcome as regards geographical indications’ use as a top-level domain. To impute a connection with goods to a top-level domain is to deny the very structure of the DNS. For this reason, expansion at the top-level cannot simply mirror the geographical indications community’s attempts at managing growth at the second-level; the issues are similar, but clearly not the same.

#### 7.2.2.2 Homonymous Wine Geographical Indications Possible, TLDs Impossible

Another issue that can be managed at the second-level of the DNS but proves insurmountable at its top-level is that of homonyms. Article 23(3) of the TRIPS Agreement recognizes homonymous geographical indications for wines by requiring that they be protected and also that the States involved resolve conflicts by establishing means of differentiation. In so doing, States are to ensure not only that consumers are not misled, but also that the producers involved are treated equitably. This recognition is made ‘subject to the provisions of paragraph 4 of Article 22’, which prevent the use of geographical indications that are ‘literally true as to the territory’ but nevertheless ‘falsely represent to the public that the goods originate in another territory’. Recognition of homonyms enables, for example, the co-existence of Rioja as a geographical indication identifying wines from the Rioja region of Spain as well as a geographical indication identifying wines from the Rioja region of Argentina.<sup>751</sup>

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750. *Ibid.*, para. 241.

751. Based on the example offered by Daniel Gervais of Rioja regions and wines in both Argentina and Spain in *The TRIPS Agreement: Drafting history and analysis*, 306 n. 419. This example is also used in Irene Calboli, *Expanding the Protection of Geographical Indications of Origin under TRIPS: ‘Old’ Debate or ‘New’ Opportunity?*, 10(2) *Marq. Intell. Prop. L. Rev.* 182, 192 (2006) (citing Felix Addor & Alexandra Grazioli, *Geographical Indications beyond Wines and Spirits: A Roadmap for a Better Protection for Geographical Indications in the WTO/TRIPS Agreement*, 5 *J. World. Intell. Prop.* 865, 879 (2002)). See also Iris V. Quadrio & Martin Chajchir, *Nineteenth Yearly Review of International Trademark Jurisprudence*, 102 *Trademark Rep.* 455, 468-469 at ‘Argentina: I.I.C.3. Geographical Indications/Appellations of Origin’ (2012).

The sorts of ‘creative solutions’<sup>752</sup> that might be employed to distinguish wines identified by homonymous names to achieve their co-existence as ‘offline’ geographical indications are of some assistance at the second-level of the DNS, but of no effect at the system’s top-level. Domain names require only absolute uniqueness, so variation at the second-level, even minor, can serve to distinguish a *www.riojaspain.com* from a *www.riojaargentina.com*. Even easier, and indeed in direct acknowledgement of the territorial nexus of geographical indications, would be to distinguish homonym wines through the use of country code top-level domains: *www.rioja.es* and *www.rioja.ar*. Yet this sort of variation is not possible at the top-level of the DNS, where concerns about user confusion are captured in the *gTLD Applicant Guidebook* via rejection and objection on grounds of confusing similarity.<sup>753</sup> In other words, the bar is set higher than absolute uniqueness for top-level domain strings, and there is simply no way to accommodate homonyms for wines or indeed for any other products even if these were at some point to receive a consistent level of protection under international law. Put simply, there cannot be more than one *.rioja* internet top-level domain.

Even the availability of IDNs (domain names in non-Latin language scripts) is unlikely to offer a satisfactory answer to this problem given the likelihood that in addition to retaining the name of their ‘Old World’ region, emigrants also retained the language of their country of origin or at least a version of it insufficiently distinguishable from the original to survive objection on grounds of confusing similarity. Whether the States involved in a conflict over homonymous geographical indication new gTLDs could reach the sort of compromise called for by Article 23(3) is questionable. Also questionable is two States reaching agreement to share a gTLD, with the result that resolution of conflicting applications will be left to community priority evaluation and/or auction.<sup>754</sup> The result under either all-or-nothing approach is a losing party’s exclusion from the top-level of the DNS. Even if a sufficiently different (and agreeable) alternative string exists, the gTLD applicant must wait until a subsequent DNS expansion round to apply for it.

Member States likely to find themselves in this position should consider that ‘if the solution adopted by a Member prejudiced the producers of another Member or could objectively mislead consumers, it could be argued that that Member had failed to comply with’<sup>755</sup> Article 23(3). Applying this logic to the New gTLD Program, a State’s authorization of a geographical indication new gTLD application would violate Article 23(3) of the TRIPS Agreement if it ‘prejudiced the producers’ of products in another State identified by an identical geographical indication. It is not difficult to come

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752. Gervais, 307.

753. ICANN, *gTLD Applicant Guidebook*, section 3.2.2.1.

754. *Ibid.*, section 4.1.

755. Gervais, 307.

to the conclusion that exclusion from the DNS root would indeed prejudice the holders of a competing geographical indication. Although likely to be few in number, conflict between homonymous geographical indications has the potential to be extremely problematic. It is imperative that the States likely to be embroiled in such conflicts (which should be easy to identify given that they would already presumably have taken action in the offline context pursuant to Article 23(3)) give consideration to this issue and develop strategies for addressing it.

In conclusion, it appears impossible to extend the protection offered by Article 23 of the TRIPS Agreement to geographical indications for wines and spirits at the top-level of the DNS. Geographical indications for other products receive an even lower level of protection, and in the next section it will be shown that these are also unable to be protected against unauthorized use as gTLDs.

### 7.2.3 SCOPE OF PROTECTION OF OTHER PRODUCT GEOGRAPHICAL INDICATIONS

While geographical indications for wine and spirits receive what is characterized as ‘absolute’ protection under the TRIPS Agreement, indications for all other products are said to receive only ‘relative’ protection.<sup>756</sup> Specifically, Article 22(2) requires that Members prevent any use of a geographical indication that is misleading as to the true geographic origin of the goods. It does so by requiring Member States to take steps to prevent any communication ‘that indicates or suggests that the good in question originates in a geographical area other than the true place of origin’. Acts of competition or confusion with goods of a competitor are notably not limited, but this provision ‘would seem to require at least trying to benefit from or denigrate the reputation of an industrial sector.’<sup>757</sup> Article 22 also brings geographical indications meeting the TRIPS definition of that term within the scope of Article 10*bis* of the Paris Convention, effectively expanding the scope of

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756. See Stephen A. Bowers, *Location, Location, Location: The case against extending geographical indication protection under the TRIPS Agreement*, 31(2) A.I.P.L.A. Q. J. 129, 131 (2003); Thomas Cottier & Marion Panizzon, *Traditional Knowledge and Geographical Indications: Foundations, Interests and Negotiating Positions*, in *Trade and Intellectual Property Protection in WTO Law: Collected Essays* (Cameron May 2005); Lynne Beresford, *Geographical Indications: The Current Landscape. But see Dwijen Rangnekar, Demanding Stronger Protection for Geographical Indications: The Relationship between Local Knowledge, Information and Reputation*, #2004-11 United Nations University-INTECH Discussion Paper Series (2004) (arguing that it is inappropriate to consider Art. 23 as ‘absolute’ protection).

757. Gervais, 301.

Article 10bis since it does not otherwise apply to origin statements.<sup>758</sup> The effect of this is explored in detail in Chapter 8.

As noted in the preceding section of this chapter, the TRIPS Agreement preserves the origin-connoting nature of geographical indications: specifically, Article 22 permits the nexus between good and territory to be not only particular physical characteristics but the intangible attribute of reputation. This is a significant point of departure from the Lisbon Agreement, which limits protectable appellations of origin to those whose quality and characteristics are attributable to geographical location. The TRIPS Agreement broadens the scope of protectable indications, but this does not impact upon the level of protection offered. Unlike the protection offered by Article 23 to geographical indications for wines and spirits, Article 22 does not require the prevention of 'kind', 'type', 'style', 'imitation' or similar uses of geographical indications for other products. This is subject only to the limitation in Article 22(4) prohibiting indications that are 'literally true as to the territory' but nevertheless 'falsely represent to the public that the goods originate in another territory'.

Like unauthorized wine and spirit geographical indication TLD strings, unauthorized use of geographical indications for other products is not preventable. This is not simply because they receive a lower level of protection under the TRIPS Agreement relative to wine and spirit geographical indications, but because the protection they do receive is limited, as with wine and spirit geographical indications, to names identifying goods. As recognized in the WIPO II Report more than a decade ago, the use of geographical indications as second-level domain names to lure prospective consumers to a website offering products other than those true to geographical origin could fall within the scope of Article 22(2)(a).<sup>759</sup> Top-level domains' lack of connection to goods renders TLD strings comprised of non-wine or spirit geographical indications in all cases unpreventable.

This conclusion can be reached without consideration of another key impediment to the recognition of rights at the international level in geographical indications, which is the lack of harmonization of protection at the international level. This was characterized as one of the 'fundamental problems' in the WIPO II Report.<sup>760</sup> In practical terms, the lack of harmonization means that a name protected in one jurisdiction may not be protected in others. This is the heart of the divide between countries that support recognition and those that do not, a division that has only become further entrenched in the negotiations called for by Article 23(4) of the

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758. See Conrad, 35-36 (further arguing at 36 that the TRIPS Agreement 'extends the purview of Article 10bis for the members of GATT/TRIPs without revealing that it is not simply the incorporation of a parallel treaty, but an extension of its scope' (internal citations omitted)).

759. See WIPO, *WIPO II Report*, para. 240.

760. *Ibid.*, para. 241.

TRIPS Agreement. In the remaining section of this chapter, the status of those negotiations is explored as a foundation for considering the possible effect that the New gTLD Program will have on the future recognition of rights in geographical indications. Two other issues are additionally taken up given their relevance to new gTLD applications: the impact of an international register on the recognition of rights in the DNS and issues of priority between trademarks and geographical indications.

### 7.3 OTHER ISSUES FACING GEOGRAPHICAL INDICATIONS IN THE DNS

#### 7.3.1 INTERNATIONAL NOTIFICATION AND REGISTRATION SYSTEM

A primary reason offered in the WIPO II Report for not including geographical indications within the scope of the Uniform Domain Name Dispute Resolution Policy (UDRP) was the lack of harmonization at the international level on the recognition of rights and, therefore, the inability to point to one clear international owner of any given geographical indication.<sup>761</sup> In the TRIPS-plus environment, side agreements might, if sufficient in number of signatories and patched together, offer geographical indications the subject of those agreements a level of recognition that comes closer to being equivalent to a universal convention,<sup>762</sup> but this would require a significant amount of research to discern which indications these might be, if any. An international register would remove this problem, putting all on clear notice of the existence and owner of recognized geographical indications. This is the solution proposed by Article 23(4) of the TRIPS Agreement for geographical indications for wines.

The Lisbon Agreement's establishment of an international notification and registration system has far broader application in that it incorporates geographical indications for all products, not only wines. That agreement has already established an International Register which is maintained by WIPO on behalf of the twenty-seven signatories. Despite that relatively low number, the involvement of 'Old World' countries such as France, the Czech

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761. *Ibid.*, at Executive summary para. (iv) and paras 241-243.

762. See Peter Drahos, *BITS and BIPS: Bilateralism in Intellectual Property*, 4 J. World Intell. Prop. 791, 802 (2001) ('The key point is that the MFN principle in TRIPS, when combined with bilateralism on intellectual property, will have the effect of spreading and setting new minimum standards of intellectual property faster than would have happened otherwise.'). See also Lucas S. Michels, *A Blueprint for International TRIPS-plus Geographical Indications Protections? An analysis of geographical indication protection proposals in the European Union – India Bilateral Trade and Investment Agreement*, 15 Gonzaga J. Int'l L. 2 (2011-2012).

Republic, Italy, Portugal and Spain makes the total number of registrations significant; France alone has more than five hundred.<sup>763</sup> Appellations of origin registered under the Lisbon Agreement stand to benefit from their higher level of recognition in the New gTLD Program by reason of their being 'protected by a statute or treaty' and thus eligible for inclusion in the Trademark Clearinghouse,<sup>764</sup> the database of authenticated legal rights that underpins several rights protection mechanisms available in new gTLDs.

While the International Register is the Lisbon Agreement's most significant contribution to the cause of protecting geographical indications at the international level, it is equally a deterrent for those who oppose recognition. This explains the absence of 'New World' wine producing countries such as the United States, Australia, Chile and Argentina from the ranks of Lisbon Agreement signatories. This dichotomy continues to manifest itself in the negotiations called for by Article 23(4). Those negotiations, considered part of the TRIPS Agreement's 'built-in agenda',<sup>765</sup> commenced in 1998. The intervening years have seen little progress beyond a volley of proposals authored on the one side by the European Community<sup>766</sup> and on the other by Japan and the United States, later joined by Canada and Chile.<sup>767</sup> Since the year 2000, these proposals have focused on two issues: first, the international notification system for wines and second, the extension of the additional degree of protection offered to wines and spirits to other products. For a time, the latter issue seemed to dominate discussions, with a surprising number of 'New World' countries joining in support<sup>768</sup> of extension amidst confusion as to whether the Doha Ministerial Declaration mandated this debate.<sup>769</sup> The Doha Ministerial Declaration set a deadline for decisions regarding the establishment of an international notification and registration system for the Fifth Session of the Ministerial Conference held in Cancun,

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763. See WIPO, *Appellations of Origin*, <http://www.wipo.int/ipdl/en/lisbon/lisbon-map.jsp> (accessed 15 Oct. 2012).

764. ICANN, *New gTLD Applicant Guidebook*, Trademark Clearinghouse, section 3.2.5.

765. WTO Council for Trade-Related Aspects of Intellectual Property Rights, *Report (1996) of the Council for TRIPS*, Part III, (1996) IP/C/8 96-4704.

766. WTO Council for Trade-Related Aspects of Intellectual Property Rights, *Implementation of Article 23.4 of the TRIPS Agreement relating to the establishment of a multilateral system of notification and registration of geographical indications*, (2000) IP/C/W/107 Communication from the European Communities and their Member States, Rev. 1 00-2521.

767. WTO Council for Trade-Related Aspects of Intellectual Property Rights, *Proposal for a multilateral system for notification and registration of geographical indications based on Article 23.4 of the TRIPS Agreement*, (1999) IP/C/W/133/Rev.1 Communication from Canada, Chile, Japan and the United States, Rev. 1 99-3125.

768. WTO Council for Trade-Related Aspects of Intellectual Property Rights, *Proposal from Bulgaria, Cuba, Czech Republic, Egypt, Iceland, India, Jamaica, Kenya, Liechtenstein, Mauritius, Nigeria, Pakistan, Slovenia, Sri Lanka, Switzerland, Turkey and Venezuela (Revision)*, (2001) IP/C/W/247/Rev.1 01-2491.

769. See Gervais, 46-47. To clarify, 'the Doha Declarations do not add to or diminish legal obligations. The question to be considered is whether there is flexibility within the WTO

in late 2003.<sup>770</sup> That deadline has come and gone, and although progress was reportedly made in early 2011 in drafting a 'composite text' that sets out all of the views thus far expressed,<sup>771</sup> no agreement has been reached. Nor has agreement been reached on the issue of extension of protection.<sup>772</sup>

Were it not the case that geographical indications' connection to goods otherwise barred the applicability in the DNS of the protection afforded them under the TRIPS Agreement, an international notification and registration system would greatly facilitate the allocation of geographical indication new gTLDs. Such a system already exists to a certain extent at a domestic level even in countries that do not protect geographic indications as such.<sup>773</sup> This occurs through trademark law in cases where geographical indications are able, most commonly as a collective mark, to satisfy registration criteria.<sup>774</sup> The availability of collective mark registration is but one of the many ways that TRIPS members have fulfilled their obligations to prevent misuse of geographical indications.<sup>775</sup>

One can envisage a notification system for rights in geographical indications functioning in a manner similar to the Trademark Claims service developed through ICANN's New gTLD Program. This service is intended to put would be domain name applicants on notice of existing rights and offer them the choice of either terminating or continuing with a domain name application.<sup>776</sup> Owners of marks in the Trademark Clearinghouse are to be notified of completed registrations, thus putting them in a better position to challenge such registrations. The term 'owners' is not entirely appropriate in

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legal regime for binding legislative decisions that do not change obligations.' Steve Chamovitz, *The Legal Status of the Doha Declarations*, 5 J. Int'l Econ. L. 207, 210 (2002).

770. *Doha WTO Ministerial Declaration*, Art. 18, WT/MIN(01)/DEC1, 20 Nov. 2001 (available at [http://www.wto.org/english/thewto\\_e/minist\\_e/min01\\_e/mindecl\\_e.htm](http://www.wto.org/english/thewto_e/minist_e/min01_e/mindecl_e.htm)).

771. WTO, *Multilateral system of notification and registration of geographical indications for wines and spirits: Report by the Chairman, Ambassador Darlington Mwape (Zambia) to the Trade Negotiations Committee*, TN/IP/21, (21 Apr. 2011) (available at [http://www.wto.org/english/tratop\\_e/dda\\_e/chair\\_texts11\\_e/trips\\_e.doc](http://www.wto.org/english/tratop_e/dda_e/chair_texts11_e/trips_e.doc)).

772. See WTO, *Issues related to the extension of the protection of geographical indications provided for in Article 23 of the TRIPS Agreement to products other than wines and spirits and those related to the relationship between the TRIPS Agreement and the Convention on Biological Diversity: Report by the Director-General*, WT/GC/W/633 and TN/C/W/61 (21 Apr. 2011) (available at <http://docsonline.wto.org/imrd/directdoc.asp?DDFDocuments/t/WT/GC/W633.doc>).

773. See Justin Hughes, *Champagne, Feta, and Bourbon: The Spirited Debate about Geographical Indications*, 58 Hastings L.J. 299, 331 (2006) (discussing the level of regulatory intervention in France's protection of appellations and the United States' use of trademark law).

774. Collective marks are discussed in Part III, Chapter 5, section 5.3 above.

775. See n. 720 above and accompanying text. On the protection of geographical indications as collective marks under US law, see Beresford, 984.

776. The Trademark Clearinghouse is discussed in detail in Part II, Chapter 3, section 3.2.2 above.

the context of geographical indications given their communal rather than individual nature,<sup>777</sup> but this fact does not impede the development of a register. The entrenched position of a number of States against more specific international protection of geographical indications makes the establishment of such a system unlikely, however, without a broader consideration of where they fit within the WTO Agreement framework and other issues arising under the Doha trade negotiations mandate.<sup>778</sup>

### 7.3.2 CONFLICT BETWEEN TRADEMARKS AND GEOGRAPHICAL INDICATIONS

While it is certainly the case that registration as a standard, collective or certification mark has advantages for geographical indications, the availability of multiple forms of protection raises the potential for conflict between them. Despite having been considered conceptual 'equivalents' in the context of a comparison of European Union and domestic legislation,<sup>779</sup> geographical indications and trademarks (all forms) are distinctly separate subject matter under international law, and the legal rights in them do not in all circumstances align.

The first problem lies in the issue of priority as between trademarks and geographical indications. In other words, where one rights holder claims rights in a trademark and another in the same name as a geographical indication, which one prevails? While the Paris Convention operates from a 'first in time, first in right' principle, it has been considered that this is limited to trademarks as against other trademarks.<sup>780</sup> This does not resolve the conflict but rather re-characterizes the issue to be resolved in terms of "who has the better right to use a geographical name?", and not "who used a geographical name first?"<sup>781</sup>

The Lisbon Agreement, perhaps unsurprisingly given that it offers the highest level of protection of the existing international conventions, gives a measure of priority to protected appellations of origin. Article 5(3) of that agreement requires that States protect an internationally registered appellation unless it is declared within a year that the State is unable to ensure protection. Grounds for such a declaration are not specifically provided in the agreement, but it is presumed that an appellation's treatment as generic or the

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777. See Conrad, 12; Calboli, 185.

778. See Cottier & Panizzon, *Traditional Knowledge and Geographical Indications*.

779. Lionel Bently & Brad Sherman, *The Impact of European Geographical Indications on National Rights in Member States*, 96 *Trademark Rep.* 850, 877-878 (2006). Bently and Sherman further note that the authors of *Kerly's Law of Trade Marks and Trade Names*, Britain's leading treatise on trademark law, support this view.

780. See O'Connor, *The law of geographical indications*, 115.

781. *Ibid.*



existence of prior rights would fall within this ambit.<sup>782</sup> Where a declaration is not made, conflicting prior rights must be phased out within two years pursuant to Article 5(6).

The presumed prevailing position on priority under the TRIPS Agreement is that Article 16 confers priority on a first registered trademark,<sup>783</sup> but this is not a universally held view.<sup>784</sup> Under the heading 'Rights Conferred', Article 16(1) gives trademark owners the exclusive right to prevent the use of 'identical or similar signs'. The loose definition of 'signs' in Article 15 (headed 'Protectable Subject Matter') suggests that this priority is conferred only as against other trademarks. Article 24(5), on the other hand, provides:

Where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith either:

- a. before the date of application of these provision in that Member as defined in Part VI; or
- b. before the geographical indication is protected in its country of origin;

measures adopted to implement this Section shall not prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.

On its face, Article 24(5) suggests a reprise of the 'first in time, first in right' principle, whereby one party is able to use and the other not. Advocates of this interpretation call upon Article 16(1) for support, positing:

[A] right to use must include the minimum rights in respect of trademarks under the Agreement. As such, this right to use would not simply mean a right to register and continue to use in spite of the presence of an identical or similar geographical indication, but in fact a right to exclude the geographical indication concerned.<sup>785</sup>

The important question is not only one of priority, but of whether the TRIPS Agreement permits co-existence between trademarks and geographical indications. It is very clearly the case that the TRIPS Agreement permits some co-existence of conflicting geographical indications due to its allowance for homonymous indications for wines in Article 23(3). The effect of Article 24(5) is greatly reduced if, read in conjunction with the reference to

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782. *Ibid.*, 115-116.

783. See Burkhardt Goebel, Presentation, *Geographical Indications and Trademarks: The Road from Doha 8* (WIPO & USPTO Worldwide Symposium on Geographical Indications 9-11 Jul. 2003) WIPO/GEO/SFO/03/11.

784. See for example, O'Connor, *The law of geographical indications*, 118 (concluding that trademarks and geographical indications receive equal protection under TRIPS).

785. Gervais, 315-316.

it in Article 24(1), it is interpreted as establishing a ‘first-in-time, first-in-right’ principle in respect of wine and spirit geographical indications only. The use in Article 24(5) of the term ‘Section’, however, suggests that it refers to the entire section 3 of the TRIPS Agreement, comprised of Articles 22, 23 and 24, ‘and not to a “section” in the sense of an “article” as that term is used in the national laws of several countries.’<sup>786</sup> An alternate interpretation of Article 24(5) permits co-existence of conflicting geographical indications and trademarks as the natural consequence of Article 24(5) not obliging TRIPS members to:

provide the protection of geographical indications if an identical or similar trademark has been registered in good faith. However, if this protection is provided (and there is clear possibility to provide this protection), it should not ‘prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark.’ (emphasis in original)<sup>787</sup>

Neither interpretation can be supported by evidence of a relevant intention on the part of the TRIPS Agreement drafters, but both sides assert compatibility with the text of the Agreement itself.<sup>788</sup> While there are ways of avoiding or resolving conflict using the legal frameworks in place,<sup>789</sup> in the specific context of the DNS it has been shown earlier in this chapter that co-existence at the top-level is extremely difficult – if not impossible – due to the technical requirement of absolute uniqueness braced by ICANN’s disallowance of confusingly similar TLD strings. Conflicts can potentially be managed in second and lower level domain names through differentiation (unless a TLD registry operator implements policy to disallow confusingly similar domain name registrations by registrants, a policy that would be burdensome to police), but just as there cannot be two .rioja TLDs to represent both of the regions referred to by that name, there cannot be two .rioja TLDs to represent each of a geographical indication and a trademark.

The need to decide on priority as between applicants for new gTLDs will inevitably arise in top-level expansion. Where conflicts arise within a country, national laws can be relied upon. Where conflicts arise between applicants in different countries that treat geographical indications differently, some means of resolution is patently needed. Drawing from existing means of conflict resolution, the two clearest options that take into consideration the legal interest involved rather than simply resolving a

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786. *Ibid.*, 315.

787. O’Connor, *The law of geographical indications*, 63.

788. *Ibid.* See also Gervais, 315-316.

789. See *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs – Complaint by Australia, Report of the Panel*, 150 para. 7.686, WT/DS290/R 05-0936 (W.T.O. D.S.B. Panel 15 Mar. 2005) (finding that co-existence is a limited exception under TRIPS Art. 17); O’Connor, *The law of geographical indications*, 119-121.

dispute in favour of the party able to pay the most as in an auction are (i) to adopt a 'first in time, first in right' rule; or (ii) to apply unfair competition principles. The latter are discussed in detail in the next chapter, though it can be said as an initial point that this is administratively the more complex approach. From the perspective of ease and efficiency of domain name registration, it is likely preferable to base priority on timing, although this creates inequities between countries with protection of geographical indications and countries without such protection.<sup>790</sup> ICANN's having undertaken to ensure that new gTLDs do not conflict with existing legal rights recognized under international law means that unfair competition issues must be considered.

### 7.3.3 IMPLICATIONS FOR LISBON AGREEMENT SIGNATORIES

A further issue arises with respect to new gTLDs for strings meeting the definition of 'appellation of origin'. Members of the Lisbon Union are required pursuant to Article 1 to protect appellations of origin 'as such'. Article 3 demands absolute protection 'against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as "kind," "type," "make," "imitation," or "the like".' This level of protection contrasts sharply with that offered to geographical indications under Article 22 of the TRIPS Agreement, which requires that Member States prevent only uses in connection with goods and constituting an act of unfair competition pursuant to Article 10*bis* of the Paris Convention.

The greater level of protection offered by the Lisbon Agreement operates to prevent the making of a new gTLD application for a string comprised of an appellation of origin notified under that agreement by an unauthorized party because the signatories are, as WIPO explains, 'under the obligation to provide a means of defence against any usurpation or imitation of an appellation of origin in their territory.'<sup>791</sup> It is plausible that the registration of a new gTLD comprised of a notified appellation by a party not associated with the notification would be deemed to constitute a 'usurpation or imitation'. In order to comply with the Lisbon Agreement, signatories' domestic law must therefore prevent the registration of new gTLDs by those not otherwise entitled to do so.

This creates an uneven playing field in ICANN's New gTLD Program. A new gTLD applicant in France must be prevented from applying for a

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790. See Conrad, 42-43. See also Rimmer, 12 (highlighting problems of free riding).

791. WIPO, *The Lisbon Agreement for the Protection of Appellations of Origin and their International Registration: Objective and Main Features, Protection to be Accorded*, <http://www.wipo.int/lisbon/en/general/> (accessed 15 Oct. 2012).

.tequila new gTLD,<sup>792</sup> for example, but an applicant in China, not a signatory of the Lisbon Agreement, need not be so prevented. Similarly, a new gTLD applicant in Slovakia must be prevented from applying for a .pilsner<sup>793</sup> new gTLD, but an applicant in the United States, a country with a recognized beer industry but not a signatory of the Lisbon Agreement, need not be so prevented, and so on for all of the notified applications currently in the International Register of Appellations of Origin. ICANN's *gTLD Applicant Guidebook* does not itself give rise to a violation of the Lisbon Agreement, but Lisbon Union members must be aware of their obligations under that agreement in order to ensure that actions taken in the context of ICANN's New gTLD Program are not in breach.

#### 7.4 CONCLUSIONS ON RIGHTS IN GEOGRAPHICAL INDICATIONS

All top-level domain strings constituted of geographical indications, regardless of the type of goods they identify, fall outside of the limited scope of protection offered to geographical indications under the TRIPS Agreement. This is a different conclusion than the one reached in the WIPO II Report, which found that the TRIPS Agreement was insufficient to prevent registrations of second-level domain names lacking a connection to goods. Critically, top-level domains represent a service. They facilitate interaction between second-level domain name registrants and therefore do not have a direct connection to goods. While the establishment of an international register could facilitate the registration of domain names constituted of geographical indications, this would benefit only second- and lower level domain names the use of which is directly connected to goods. The much-disputed international register, regardless of what form it could ultimately take, is of no consequence to geographical indications' use at the top-level of the DNS. This conclusion does not have any bearing on the presumed exclusive right of governments to geographic names in ICANN's *gTLD Applicant Guidebook*.

The holders of 'offline' legal rights in geographical indications are not, however, entirely foreclosed from exercising their rights in the New gTLD Program. Geographical indications 'protected by a statute or treaty',<sup>794</sup> are eligible for inclusion in the Trademark Clearinghouse, making them eligible

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792. This is due to the existence of the registration TEQUILA: Notification No. 699 by the Government of Mexico, accessible through WIPO Lisbon Express searchable database at <http://www.wipo.int/ipdl/en/search/lisbon/search-struct.jsp> (accessed 15 Oct. 2012).

793. This is due to the existence of the registration PLZEN/PILSEN PILS/PILSENER/PILSNER: Notification No. 1 by organizations in the Czech Republic, accessible through WIPO Lisbon Express searchable database at <http://www.wipo.int/ipdl/en/search/lisbon/search-struct.jsp> (accessed 15 Oct. 2012).

794. ICANN, *New gTLD Applicant Guidebook*, Trademark Clearinghouse, section 3.2.5.

to participate in sunrise and the Trademark Claims service in new gTLDs. Further, the *gTLD Applicant Guidebook*, UDRP and Uniform Rapid Suspension procedure do not differentiate standard trademarks from other forms of trademark. Registration of a geographical indication as a standard, collective or certification mark in countries in which registration criteria can be satisfied has the effect of elevating an indication to a higher level of recognition in DNS policy.

Finally, special care must be taken by Lisbon Union members to take steps to prevent the ‘usurpation or imitation’ of notified indications through their registration as a new gTLD by someone other than a notifying party. At a minimum, this is an issue that GAC members should consider within the purview of the ‘early warning’ review process available to them under ICANN’s *gTLD Applicant Guidebook*.

## Chapter 8

# Unfair Competition and Related Commercial Rights in Geographic Names

What is honest is not dishonest.<sup>795</sup>

### 8.1 UNFAIR COMPETITION LAW PRINCIPLES APPLIED TO GEOGRAPHIC NAMES

#### 8.1.1 THE POTENTIAL OF UNFAIR COMPETITION LAW

Unfair competition law has high potential as a source of rights in geographic names given its traditional role as ‘gap filler’ where rights are not recognized in subject matter as such under intellectual property law or related *sui generis* regimes.<sup>796</sup> Even where intellectual property rights are recognized, in many jurisdictions it is common practice to raise claims in the nature of unfair competition in addition to intellectual property infringement claims. That said, one must be careful to recognize the different natures of protection offered by these distinct sources of rights: in the specific context of the protection of names, trademark law protects a private property interest in a name as such, while unfair competition law regulates commercial behaviour

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<sup>795</sup> Bowen, LJ in *Angus v. Clifford*, 60 L.J. Rep. (N.S.) C.D. 456 (1891).

<sup>796</sup> On the traditional role of unfair competition law, see Gustavo Ghidini, *Intellectual Property and Competition Law: the innovation nexus* 112 (Edward Elgar 2006).

affecting competitors or consumers.<sup>797</sup> In other words, unfair competition law does not confer an exclusive proprietary right on an individual party, but rather aims to benefit the market as a whole. Whether this difference has any effect in actual practice is, however, questionable; it is said that 'there are overlaps for which a convincing theory has yet to be found.'<sup>798</sup>

Unfair competition law is based on a fundamentally simple understanding 'that dealings based on deceit are legally wrong.'<sup>799</sup> It is primarily addressed at the international level by the Paris Convention for the Protection of Industrial Property, Article 1(2) of which identifies 'the repression of unfair competition' as one of that convention's express objects.<sup>800</sup> Accordingly, Article 10*bis* (1) requires that members of the Paris Union provide 'effective protection against unfair competition', which Article 10*bis* (2) defines broadly as '[a]ny act of competition contrary to honest practices in industrial or commercial matters'. Relatedly, Article 10 requires members to prevent the 'direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer, or merchant.'

This definition of 'unfair competition' in the Paris Convention uses fairly broad, general terms, leaving Paris Union members to determine how best to meet their obligations in domestic law. The analysis undertaken in this chapter shows this nevertheless to be the most inclusive attempt to target unfair competition in an international convention to date. The TRIPS Agreement is notably silent on unfair competition save for limited references to Article 10*bis* of the Paris Convention: Article 22(2)(b) in the context of prohibited uses of geographical indications and Article 39 in the context of protecting undisclosed confidential information. Article IX:6 of the GATT Agreement, which is discussed below in this chapter, merely requires members to 'co-operate' to prevent false representations of product origins.

Problematic from the perspective of protecting rights in geographic names is the fact that – as with the law of trademarks – the law of unfair competition has at its heart commercial activity. Indeed, it is said that 'the first prerequisite [of unfair competition] is that the conduct must not be private, social or political, but must be commercial.'<sup>801</sup> This and other core principles of unfair competition law place considerable strain on its ability to offer all geographic names (not simply sub-sets such as geographical

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797. See WIPO, *Protection against unfair competition: analysis of the present world situation*, WIPO Publication No. 725, 10 (1994).

798. Frauke Henning-Bodewig, *Unfair competition law: European Union and Member States 5* (Kluwer Law International 2006).

799. *Black's Law Dictionary* 1667 (Bryan A. Garner & Henry Campbell Black eds., West 2009) (definition of 'unfair competition').

800. Alternatively it has been posited that 'the aim of the PC was the international protection of industrial property rights and not the protection against unfair competition.' *Law against unfair competition: towards a new paradigm in Europe?* 54 (Reto M. Hilty & Frauke Henning-Bodewig eds., Springer 2007).

801. Henning-Bodewig, 1.

indications or geographically-named certification marks) blanket protection against unfair use. Gap filler it may be, but unfair competition law is not the solution to every problem. This is true even if the problem is a squarely commercial one (which for geographic names is frequently not the case) because '[n]ot everything that is regarded as "unfair" in the commercial sector falls under unfair competition law.'<sup>802</sup>

The aim of this chapter is to determine whether governments or others have rights under unfair competition law that justify preventing the registration of geographic names as new gTLDs. It begins with an examination of the purposes and general principles of unfair competition law and their application to geographic names, then turns to an evaluation of four specific categories of commercial behaviour in order to identify situations in which registration of geographic new gTLDs could potentially be prevented. It is also pointedly considered whether the lodging of an application for a new gTLD without the authorization of an 'offline' rights holder constitutes an act of unfair competition such that limitations should be implemented in top-level domain policy in respect of geographical indications.

### 8.1.2 PURPOSES OF UNFAIR COMPETITION LAW

Unfair competition law has long played a key role in the resolution of domain name disputes, albeit in a somewhat disguised form: the Uniform Domain Name Dispute Resolution Policy (UDRP) draws heavily from the unfair competition provisions of the Paris Convention.<sup>803</sup> The applicability of that policy to domain names constituted of trademarks (the only type of name actionable under the policy) should not, however, be automatically imputed to other subject matter, particularly when proposals to widen the scope of the UDRP have previously been rejected due to lack of support in international law.<sup>804</sup> Rather, it should be questioned as a starting point whether limiting the use of geographic names in the DNS on the basis of unfair competition – whether through the UDRP or otherwise – is consistent with the principles and purposes of unfair competition law.

There is no universally agreed singular purpose of unfair competition law, nor an all-inclusive enumeration of acts that constitute unfair competition.<sup>805</sup> Rather, this is an area of law that is 'deeply rooted' in domestic law and, as a result, has developed in different ways to prevent different forms of

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802. *Ibid.*, 1.

803. See WIPO, *WIPO I Report*, paras 172-174.

804. See n. 362 above and accompanying discussion on the scope of the UDRP.

805. See Henning-Bodewig, 19 (observing that 'relatively scant attention has been paid ... to the international competition law anchored in Article 10bis and 10ter of the Paris Convention').



commercial behaviour in different jurisdictions.<sup>806</sup> The Paris Convention preserves these differences by leaving to its members the decision of how to identify and remedy unfair competition. In some countries, this means protecting competitors from each other's unscrupulous practices. Unfair competition law in the United States and England, for example, has as its general focus the defendant who 'poaches upon the commercial magnetism of [a] symbol'.<sup>807</sup> Other countries, such as Spain and Germany, take a broader view of unfair competition law and use it to control not only acts that harm competitors but those that harm consumers.<sup>808</sup> This dual-headed protection is recognizable in Article 22 of the TRIPS Agreement, which sets out the protection available to geographical indications: while Article 22(2)(a) 'is aimed at representations misleading the public, i.e., consumers', Article 22(2)(b) 'protects the interests of producers and merchants' through the application of Article 10*bis* of the Paris Convention.<sup>809</sup>

An understanding of the types of behaviour captured by unfair competition law first requires an understanding of the purposes of unfair competition law. Identifying behaviour that is 'unfair' requires 'taking into account particularly the interests of those "concerned" by it, namely the parties involved in the operation of the marketplace.'<sup>810</sup> When one considers these interests, four central purposes of unfair competition law emerge. When geographic names are tested against these, there is reason to question the appropriateness of relying on unfair competition law to protect them.

### 8.1.2.1 Promote Honesty in Commercial Dealing

At the heart of unfair competition law is the notion of fairness and, by corollary, the prevention of unfairness, which Article 10*bis* (2) of the Paris Convention characterizes as acts 'contrary to honest trade practices'. Honesty in this context is less a moral concept than a normative concept derived from the marketplace in question. As such, it is measured according to 'what is actually usual in business life ("trade practices"),' and then 'corrected by the ethical aspect of "honest".'<sup>811</sup>

The focus on commercial dealings in unfair competition law is problematic for geographic names because many of their uses are non-commercial in nature (e.g., maps, signs, official documents and news reports). For these sorts of uses there is not a relevant trade or marketplace

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806. *Introduction to Intellectual Property: Theory and Practice* 246-248 (WIPO ed., Kluwer Law International 1997).

807. *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (Sup. Ct. 1942).

808. See Henning-Bodewig, 2-3. See also WIPO, *Protection against unfair competition*, 15-17.

809. Conrad, 36.

810. WIPO, *Protection against unfair competition*, 24-25.

811. Henning-Bodewig, 9.

from which to draw the requisite standard of honesty in business. There can be no commercial unfairness in the activity of providing information outside of trade in goods or services. This is not to suggest that honesty and fairness have no place in non-commercial contexts, but rather to highlight the fact that unfair competition laws cannot be relied upon to control that sort of behaviour.

Where unfair competition law has traditionally been applied in the context of geographic names is in the regulation of origin statements. Across trades and industries it has long been the expectation that where information is provided to convey the origin of a product, that information must be truthful. To behave otherwise cuts against the basic notion of honest trade practices; this is equally the case online as it is offline. Some statements are easily identifiable as connotative of origin, such as 'Made in the USA' and 'Swiss chocolate'. Geographic domain names at any level of the DNS are less easily discernible as per se connotative of origin, however. There are several reasons for this. The DNS is a global communications system the structure of which is not organized along territorial lines. Some ccTLDs are operated outside of the country represented by the country code and are targeted at domain name registrants with no connection to that country.<sup>812</sup> There is no general rule in generic or country-code TLDs that applicants of geographic second-level domain names must be physically present in the geographic territory named. Whether geographic domain names constitute a dishonest statement of origin is therefore one of the core questions to be explored in detail in the next section of this chapter.

### 8.1.2.2 Promote and Protect Investment by Business

Consistent with justifications of intellectual property law on the basis of reward theory,<sup>813</sup> unfair competition laws are grounded in the belief that offering protection to intangible business assets such as goodwill and confidential information against unfair usurpation is a necessary incentive to

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812. Tuvalu's .tv ccTLD is an example. Recognizing the unique online opportunities inherent in its ISO 3166-1 country code, the Tuvaluan government commenced a tender process for the marketing of .tv ccTLDs in the mid-1990s. See Stephen Boland & Brian Dollery, *The Value and Viability of Sovereignty-Conferred Rights in MIRAB Economies: The Case of Tuvalu*, University of New England Working Paper Series in Economics 2005-2009, 17 (available at <http://www.une.edu.au/business-school/working-papers/economics/1999-2007/econ-2005-9.pdf>). Verisign has operated the .tv domain since its acquisition of The .tv Corporation at the end of 2001. *Verisign Acquires The .tv Corporation*, PR Newswire (7 Jan. 2002) (available at <http://www.prnewswire.com/news-releases/verisign-acquires-the-tv-corporation-75291122.html>). See also IANA, *Delegation Record for .TV*, <http://www.iana.org/domains/root/db/tv.html> (accessed 15 Oct. 2012).

813. See for example, Justin Hughes, *The Philosophy of Intellectual Property*, 77 Geo. L.J. 287, 305-310 (1988-1989).

ensure their creation.<sup>814</sup> Protection by means of unfair competition law is all the more important to businesses when their assets are not able to be characterized (and therefore protected) as intellectual property. Justifying protection for geographic names on this basis is not, however, an easy fit.

Outside of their use as brands, it is difficult to conceptualize the creation of geographic names as occurring through some sort of planned, strategic, commercial process of asset generation. It is likewise difficult to characterize the creation of new geographic names as an activity that requires regulatory intervention to ensure its continuation. What immediately distinguishes the name 'France' from the name 'Polaroid' is that the latter has been created in a commercial environment for use in a commercial environment, and logically therefore derives its value from commercial attractiveness. The name 'Polaroid' must be distinctive – in other words, able to distinguish the goods or services on which it is used as originating from a particular trader – if it is to succeed in the marketplace. That distinctiveness can arise because the name is coined and has no other connotation or because it develops a reputation through use; either way, a certain degree of 'investment, labor, and strategic dissemination' is required in order to 'create[] a set of unique meanings in the minds of consumers'.<sup>815</sup> This is the primary function of a brand, the legal protection of which takes the form of a trademark.

Geographic names, by contrast, are not products of a commercially-oriented development process and their primary function is not to create a link in consumers' minds between particular goods or services and a particular trader. Their primary function is to identify a particular geographic location. Even if no other connotation is generated in a person's mind by a geographic name, if the name serves to identify the correct place on the map to which it is attributed, it is a success. Achieving this sole purpose has not traditionally involved focus groups or market surveys; the choice of a geographic name is not tested for its ability to attract consumers. These observations are not made with the intention of suggesting that strategy has no role to play in the choice of geographic names; the dispute between Greece and the former Yugoslav Republic of Macedonia over the name 'Macedonia'<sup>816</sup> offers ample room for speculation about motives in countries' naming decisions. Rather, the intention here is to highlight the fact that businesses and countries take different things into consideration and do so for different reasons when making naming decisions. These differences call into question the appropriateness of justifying the protection of geographic names under unfair competition law on the basis of ensuring geographic names' continued use and creation.

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814. See *Restatement of the Law (Third): Unfair Competition* §1 Comment f (1995).

815. Coombe, 61 (internal citations omitted).

816. The 'Macedonia' name dispute is discussed in detail in Part III, Chapter 6, section 6.3.2 above.

Where investment in a corporate sense is being made in the context of geographic names is in goodwill. Countries are increasingly seen as brands,<sup>817</sup> with reputations that can be managed with a view to creating 'a desirable identity which consumers can relate to and want to build a repeat purchase relationship with'.<sup>818</sup> This is not a new phenomenon; governments and tourist bureaus have long been using reputation to entice the tourist consumer. What is new, however, is that more attention is being paid to geographic brands, whose effectiveness and value are now measured on an annual basis similar to the way in which the world's most valuable trademarks are ranked each year.<sup>819</sup>

In many countries, unfair competition law steps in to protect investment in goodwill, but protecting goodwill is not the same as protecting a name. This is because names and goodwill are two distinct (though related) concepts: goodwill is comprised, according to an oft-cited Australian judicial opinion, of 'elements',<sup>820</sup> of which the name is but one:

As the differential profit advantage of a firm, goodwill may arise from superior efficiency, from convenience, from confidence, from nepotistic connections, from persuasive advertising, from successful infringement of a persuasive symbol, from threats of violence, and so on into a range of conduct entirely beyond the pale of the law.<sup>821</sup>

Correspondingly, the goodwill of a country or other geographic location (and thus its attractiveness to consumers) is likely to be influenced not only by its name but by its exports, the stability and form of its government, its culture and heritage, the friendliness of its people, its tourism, its topography, its propensity to experience natural disasters, etc.<sup>822</sup> The name is a powerful symbol which encapsulates these qualities and brings them to the public mind similar to the way in which the 'Polaroid' brand 'through much effort and the expenditure of large amounts of money had acquired a widespread reputation and much goodwill'.<sup>823</sup>

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817. See FutureBrand, *Country Brand Index 2011-2012*, <http://www.futurebrand.com/think/reports-studies/cbi/2011/overview/> (accessed 15 Oct. 2012). See generally, Forrest, *The new frontier*, 133-134.

818. Allan Bonsall & John Harrison, *Brand Aid: The Secrets of Consumer Speak* 26 n. 21 (Esstee Media 2006).

819. See for example, FutureBrand, *Country Brand Index 2011-2012*; GfK Custom Research North America, *The Anholt-GfK Roper Nation Brands Index 2012*, [http://www.gfkamerica.com/practice\\_areas/roper\\_pam/nbi\\_index/index.en.html](http://www.gfkamerica.com/practice_areas/roper_pam/nbi_index/index.en.html) (accessed 15 Oct. 2012).

820. *Commissioners of Inland Revenue v. Muller & Co's Margarine, Ltd.*, A.C. 217, 223 (H.L. 1901).

821. Ralph S. Brown Jr., *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 Yale L.J. 1165, 1199 (1948) (internal citations omitted).

822. See GfK Custom Research North America, *The Anholt-GfK Roper Nation Brands Index 2012*.

823. *Polaroid Corp. v. Polaroid, Inc.*, 319 F.2d 830, 837 (7th Cir. 1963).

Geographic names are and have for ages been created and used despite a lack of clear protection for them under international law. While there may be need of unfair competition law to protect governments' investments in goodwill, there is little need of unfair competition law to ensure the continued creation and use of geographic names. For this reason, protection of geographic names under unfair competition law can be more transparently characterized as fuelled by a desire to preserve a monopoly in a name than a desire to encourage more names' creation and use.

### **8.1.2.3 Promote Competition and Efficiency in the Market**

There is a great paradox inherent in unfair competition law, which is that the exercise of a right to demand that others not engage in anti-competitive conduct in the name of promoting competition has inherently and unavoidably anti-competitive consequences. Unfair competition law must strike a balance between 'protect[ing] the competitive position of the enterprise' and preventing 'business practices that hinder rather than promote the efficient operation of the market.'<sup>824</sup> It is not controversial to propose that a certain degree of competitive behaviour is needed to promote a healthy marketplace. It would not be appropriate, therefore, for unfair competition law to be overzealous in quashing acts aimed at gaining a competitive advantage. A seminal American text on unfair competition law succinctly explains the situation in this way:

Every competitor seeks to win trade that would otherwise go to someone else. The ultimate end point of that process could conceivably be the complete elimination of one or more rivals as effective competitors. Yet there is no violation of the law so long as the rules of the 'game' are observed. Thus it is not the injury suffered by the complainant which makes competition unfair, it is the competitor's violation of a duty to keep his competition within certain bounds.<sup>825</sup>

The striking of those bounds is made all the more difficult when the behaviour at issue is potentially non-commercial in nature, as in the case of geographic names. Although they can be used commercially, geographic names' primary function as informational identifiers makes it difficult to distinguish competitive uses from anti-competitive uses. It is inappropriate to simply presume that all uses of geographic names are anti-competitive unless proven otherwise: such a drastic measure would have the benefit of preventing free riders, but could also seriously impinge upon the rights of the public to use geographic names in non-competitive, non-commercial ways.

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824. *Restatement (Third) of the Foreign Relations Law of the United States* §1 Comment g.

825. Rudolf Callmann & Louis Altman, *Callmann on unfair competition, trademarks and monopolies* §1:9 (4th ed., Thomson-West 1997).

## Chapter 8: Unfair Competition and Related Commercial Rights

The intention of unfair competition law is said first and foremost to be to protect the market as a whole, while ‘the protection of monopolies in names is but a secondary and limiting policy.’<sup>826</sup> When potentially non-commercial subject matter such as a geographic name is involved, special consideration must be given to the balance between protecting the interests a government may have in a name and protecting the public’s right to use that name in a non-commercial context. If the use at issue is non-commercial, then unfair competition law is not the appropriate means of regulating that behaviour.

Commercial use is not in question for geographical indications due to their origin-connoting role and direct link to products, making unfair competition law particularly relevant to this specific type of geographic names. Accurate origin information can help consumers identify, distinguish and select goods and services, and it has been suggested that these things have a significant impact on the operation of a market.<sup>827</sup> Geographical indications are a specifically defined type of geographic name, however, and the assumption that all uses of all geographic names – commercial and non-commercial, online and offline, origin-connotative and otherwise – by someone other than relevant governments are unfair places unjustified impediments on many uses of names not falling within the scope of unfair competition law.

If the balance in unfair competition law is tipped in entirely favour of a government asserting rights in a geographic name to the exclusion of others’ use of the name, it is difficult to fulfil any of the other purposes of unfair competition law. At greatest risk are consumers, who suffer the effects of a legally-supported monopoly.<sup>828</sup> The result of the great paradox of unfair competition law is that in the name of encouraging a competitive marketplace, consumers end up with fewer choices. That said, the law has long questioned consumers’ ability to make choices, and in some countries, ensuring their protection is itself considered a purpose of unfair competition law.

### 8.1.2.4 Protect Consumers

Not all jurisdictions view unfair competition law as an appropriate means of protecting consumers from the unscrupulous behaviour of merchants. The aim of consumer protection law from an economic point of view is to reduce

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826. *Eastern Wine Corp. v. Winslow-Warren Ltd.*, 137 F.2d 955, 959 (C.C.A. 2d. 1943) (opinion of Frank, J).

827. See Bowers, 135. *Compare* Broude, 662-678.

828. See Coombe, 65-66. Coombe highlights the anti-democratic effect of control over names in the context of trademarks, but her remarks could also logically apply to geographic names.

the knowledge and experience gap between buyer and seller.<sup>829</sup> This aim must be balanced with, *inter alia*, the right of freedom of expression, albeit with the recognition that commercial speech may be deemed to warrant less protection than non-commercial speech.<sup>830</sup> There is no universal standard as to what constitutes commercial speech, and the particular challenges of distinguishing commercial and non-commercial use in relation to domain names have been discussed in detail in Part III Chapter 5.2.2, above.

The long-held assumption that the consumer 'always aspires to follow the lead of the advertiser, and to have his hand guided in the supermarket'<sup>831</sup> has morphed almost seamlessly from the offline environment to the online environment. In fact, early cases of online confusion deemed it even more likely that consumers would suffer confusion on the internet than in the bricks-and-mortar environment because of the difficulties of determining the identity and legitimacy of a website's owner.<sup>832</sup> The comical aphorism, 'On the internet, nobody knows you're a dog',<sup>833</sup> precisely identifies this problem as well as the public's consciousness of it. It is this concern that motivated ICANN's Governmental Advisory Committee to limit registration of country names as second-level domain names in the newly delegated .info gTLD.<sup>834</sup> As to whether consumers actually require this sort of protection is, however, debatable.

Not all courts or scholars have assumed the gullibility of the (offline or online) consumer. In 1925 it was argued that there were many consumers for whom 'complete indifference reigns. The buyer cannot be deceptively confused if he does not care whether he gets Thinsies or Thins.'<sup>835</sup> Yet the way in which modern consumers use the internet to find information makes it unlikely that 'complete indifference reigns'. To the average contemporary online shopper may even be attributed more savvy than ignorance; the vast numbers of results yielded by existing internet search methods and tools suggest that users may reasonably be presumed to have even lower expectations of immediately finding what they seek online than offline. In the California case of *The Network Network v. CBS, Inc.*<sup>836</sup> it was provocatively suggested more than a decade ago:

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829. See John Vickers, Lecture, *Economics for consumer policy* 8-9 (British Academy Keynes Lecture, 29 Oct. 2003) (available at [http://www.oft.gov.uk/shared\\_ofst/speeches/spe0403.pdf](http://www.oft.gov.uk/shared_ofst/speeches/spe0403.pdf)).

830. See for example, *Hertel v. Switzerland* (59/1997/843/1049) Eur. Ct. H.R. (1998).

831. Brown Jr, 1197 (internal citations omitted).

832. See for example, *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 50 U.S.P.Q.2d (B.N.A.) 1545, 1559-1560 (9th Cir. 1999).

833. Peter Steiner, 69(20) *New Yorker* 61 (5 Jul. 1993).

834. The reservation of country names in the .info TLD is discussed in detail in Part II, Chapter 3, section 3.2.1.1 above.

835. Brown Jr, 1197 (internal citations omitted).

836. *The Network Network v. CBS, Inc.*, 54 U.S.P.Q.2d (B.N.A.) 1150, 1155 (C.D. Cal. 2000). See also *Bruce Springsteen v. Jeff Burgar and Bruce Springsteen Club*, Case No. D2000-1532 (WIPO Arbitration and Mediation Center 25 Jan. 2001) (available at <http://>

## Chapter 8: Unfair Competition and Related Commercial Rights

There is a difference between inadvertently landing on a website and being confused. Thousands of Internet users every day take a stab at what they think is the most likely domain name for a particular website. Given the limited number of letters in the alphabet, and the tendency toward the use of abbreviations in commerce generally and in domain names in particular, it is inevitable that consumers will often guess wrong.

Similar views have been expressed outside of the United States,<sup>837</sup> but they have not taken hold in domain name policy. That the WIPO II Report was aimed specifically at 'misleading'<sup>838</sup> uses of names in the DNS suggests that those who call for a measure of common-sense and *caveat emptor* to be applied in the wilderness that is the internet are outnumbered by those who believe the average web user to be at a disadvantage. If such a disadvantage truly exists, then unfair competition law may indeed be a useful tool to address this problem in those countries that ascribe to unfair competition the purpose of protecting consumers. As the internet and our dependence upon it as an everyday means of communication grow, it is difficult to say whether users have become savvier and adjusted their expectations accordingly, or whether the potential for confusion has increased along with the volume of information available. The future applicability of unfair competition law to online commercial behaviour will depend heavily upon the way in which the DNS develops and is used following the addition of hundreds of new top-level domains into the root through ICANN's New gTLD Program.

In conclusion, it can be said that the protection of geographic names is not a natural fit within unfair competition law. It is difficult to draw analogies between countries and businesses, and geographic names' primary function as non-commercial identifiers means that to the extent that their protection under unfair competition law can be justified, that protection must necessarily be limited to preventing only those unfair uses that are distinctly commercial in nature and falling within the sorts of activities deemed 'unfair'. Unfair competition law has proven not to be needed to ensure the continued creation and use of geographic names, but it may have a role to play in protecting online consumers against being misled in countries that

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[www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1532.html](http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1532.html)) (remarking that 'it is relatively unlikely that any user would seek to go straight to the internet and open the site <bruce.springsteen.com> in the optimistic hope of reaching the official Bruce Springsteen website. If anyone sufficiently sophisticated in the use of the internet were to do that, they would very soon realise that the site they reached was not the official site, and consequently would move on, probably to conduct a fuller search').

837. See for example, Ueli Buri, Doctoral Dissertation in Law, Bern, *Die Verwechselbarkeit von Internet Domain Names nach schweizerischem Firmen-, Marken-, Namens- und Lauterkeitsrecht* (2000).

838. WIPO, *WIPO II Report*, v (Executive Summary).



attribute to it that aim and where likelihood of being misled actually does exist.

Governments' interests in geographic names are not primarily commercial, though they may include certain commercial aspects as a result of the increased attention to country branding. Ultimately, the multiple purposes of unfair competition law lend support for the view that the protection of governments' interests in geographic names should not automatically prevail over all other interests. Further, where government interests are protected through unfair competition law, this must be strictly limited to commercial uses of geographic names that fall within accepted understandings of what is 'unfair'.

### 8.1.3 ACTS OF UNFAIR COMPETITION

It is next relevant to consider whether the act of registering a geographic domain name falls within the definition of an 'act of unfair competition' provided by the Paris Convention. Article 10*bis* (2) sets up a two-part test to determine whether an act of unfair competition has occurred, seeking first to determine whether there is an 'act of competition' and then if so, whether that act is generally 'contrary to honest practices'.

#### 8.1.3.1 Geographic TLDs: An 'Act of Competition'?

Unfair competition law seeks to control the unfair behaviour of commercial competitors for the benefit of the various parties identified in the preceding section of this chapter. As a starting point, there must be competition, because '[w]herever there is competition, there is unfair competition.'<sup>839</sup> The 'act of competition' sought to be prevented by Article 10*bis* (2) is conduct of a commercial nature which is likely to affect the players within a market. Most often such conduct is directed at a competitor, though it has been shown above that the harm occasioned by unfair conduct may have a wider impact. The question thus arises: are there competitors and competition of the sort envisioned by Article 10*bis* (2) at the top-level of the DNS?

It is certainly the case that applicants for domain names at all levels of the system compete against other applicants for the ability to identify themselves by a particular name in the DNS. Since the system's earliest days, it has been possible at the second and lower levels for competing applications for a single name to be made. This led to the early adoption of a 'first come, first served' registration policy.<sup>840</sup> Competing applications at the top-level of the DNS have likewise been made, though the instances of such conflicts are far fewer than at lower levels of the system due to the tightly controlled path

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839. Callmann & Altman, §1:1.

840. See n. 301 above.

of development at the top-level.<sup>841</sup> Open and uncapped top-level expansion rounds are certain to generate an increase in the number of conflicting top-level domain applications. This is borne out by the applications received by ICANN in the New gTLD Program: of the 1,930 new gTLD applications filed during the application period of January to May, 2012, ICANN's analysis identified 751, nearly 40%, in direct contention.<sup>842</sup>

Even so, competition in the context of gTLD applications is not quite competition for market share in the traditional sense. Domain name applicants are competitors in that they vie for control of a unique resource. Allocation of the unique resource has the effect of granting the right of entry into the market, similar to the effect of the granting of a business license or permit in a regulated market. To the extent that an applicant engages in unfair acts in the course of preparing or submitting its application for a new gTLD string, this could have the effect of harming other applicants, web users, and even the functionality and perceived legitimacy of the system as a whole.

It is less easy to characterize the situation as competitive once new gTLDs are created, however, because it is not quite clear that the registries of delegated new gTLD strings are actually in competition with other TLD registries. On the one hand, it could be said that the availability of far greater numbers of top-level domains in which to register domain names will increase competition among top-level domain registries. This was precisely the aim of the two 'proof of concept' top-level expansion rounds, but it has yet to fully bear out in practice.<sup>843</sup> On the other hand it must be questioned whether new gTLDs do in fact compete with each other, particularly in the case of 'sponsored' or 'community based' gTLDs that are targeted at or are even restricted to a defined segment of the internet community. Will a new .paris top-level domain compete, for example, with a new .eco top-level domain – or even any of the existing top-level domains save the universal generic .com, .net and .org – for domain name registrants?

Article 10*bis* of Paris Convention notably requires action only when there are competitors, and it is not clear that competitors exist in this context. Member States have the freedom to 'grant protection against certain acts even if the parties involved are not competing against each other',<sup>844</sup> but this is not required under the Paris Convention or other international law.

### 8.1.3.2 Geographic TLDs: 'Contrary to Honest Practices'?

The most fundamental question in the application of unfair competition law to geographic domain names is whether the simple act of registering a

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841. Top-level DNS development is discussed in Part I, Chapter 2, section 2.4 above.

842. ICANN, *Program Statistics*, <http://newgtlds.icann.org/en/program-status/statistics> (accessed 15 Oct. 2012).

843. See n. 188 above.

844. WIPO, *Protection against unfair competition*, 18.

geographic domain name or applying for a TLD string is inherently 'contrary to honest practices' when that act is carried out by anyone other than the relevant government or public authority (in the case of a geographic name) or the geographical indication holder (in the case of a geographical indication). Governments in particular have been quick to assume that the only legitimate interests in geographic domain names are their own. This point has been made not only in international law fora but in domestic courts and UDRP disputes. A group of such cases involve a United States-based company called Virtual Countries, which registered during 1999 and 2000 various country names as second-level domain names and operated thirty-one websites under those names.<sup>845</sup> The complaint made by the government of New Zealand against Virtual Countries' registration of *www.newzealand.com* is illustrative of governments' general sentiment in this situation: 'Virtual Countries has no rights or legitimate interests in respect of the domain name [*newzealand.com*] because only the Complainant as Head of the Sovereign State of New Zealand, or its agencies, can have those rights or interests.'<sup>846</sup>

If the government is the only party with 'rights or legitimate interests' in geographic domain names, it must logically follow that the registration of geographic domain names without government authorization is inherently 'contrary to honest practices'. Yet as a universal rule this is problematic, because what are deemed honest practices in one country may not be so deemed in another. To the extent that 'honest practices' can be identified from international trade norms, then these should be considered,<sup>847</sup> but agreed standards of honesty in commercial behaviour have proven elusive even at a regional level.<sup>848</sup>

It is difficult to prove the existence of agreed standards of honesty at a global level given their wide use in a variety of contexts. The use of geographic names in non-commercial contexts in the offline environment is ordinarily not subject to a requirement of government approval. There are, of course, bound to be variations in domestic approaches, but teachers, schoolchildren, journalists, researchers and politicians in free speech-promoting societies usually need not seek government clearance before speaking or writing geographic names. Further, as the recent survey conducted by the WIPO Special Committee on the Law of Trademarks, Industrial Designs and Geographical Indications evidences, many countries

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845. See for example, *Virtual Countries, Inc. v. Republic of South Africa and South African Tourism Board*, No. 00 Civ. 84888 U.S. Dist. LEXIS (S.D.N.Y. 2001); *New Zealand v. Virtual Countries*, WIPO Case No. D2002-0754; *Puerto Rico Tourism Company v. Virtual Countries*, WIPO Case No. D2002-1129. See also discussion in Rimmer, *Virtual Countries*, 126.

846. *New Zealand v. Virtual Countries*, WIPO Case No. D2002-0754.

847. See Bodenhausen, 144.

848. See Henning-Bodewig, 20.

have taken steps to limit proprietary rights in geographic names as trademarks.<sup>849</sup> This has the practical effect of ensuring that geographic names remain accessible for public commercial use.

In the online environment, responses to third party use of geographic names are inconsistent. In some cases governments have been unable to convince UDRP panelists that unauthorized geographic domain name registrants have no legitimate interest in the names in question. The earlier-mentioned dispute between the government of New Zealand and Virtual Countries over the domain name [www.newzealand.com](http://www.newzealand.com) is a notable example. The panel in that dispute considered it unnecessary to specifically address the question of Virtual Countries' legitimate interest in the domain name, but it was nevertheless pointed out that the use of the name on an operative, 'genuine' website 'although sketchy and badly in need of being updated' weighed in the registrant's favour.<sup>850</sup>

Further insight is provided by a subsequent dispute involving the domain name [www.andalucia.com](http://www.andalucia.com), in which the panel relied upon consensus views that had by that point emerged from UDRP decisions. In response to the question, 'Does a respondent automatically have a legitimate interest in a domain name comprised of a generic (dictionary) word(s)?'<sup>851</sup> the panel found:

While the general rule is not necessarily, there is an exception, that is stated thusly: 'However: If a respondent is using a generic word to describe his product/business or to profit from the generic value of the word without intending to take advantage of complainant's rights in that word, then it has a legitimate interest.'

...

The Panel finds that where, as here, a respondent is using a geographic indication to describe his product/business or to profit from the geographic sense of the word without intending to take advantage of complainant's rights in that word, then the respondent has a legitimate interest in respect of the domain name.<sup>852</sup>

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849. This survey is discussed in detail in Part III, Chapter 6, section 6.2.1.2 above.

850. *New Zealand v. Virtual Countries*, WIPO Case No. D2002-0754.

851. WIPO, *WIPO Overview of WIPO Panel Views on Selected UDRP Questions: 2.2 Does a respondent automatically have a legitimate interest in a domain name comprised of a generic word(s)?*, <http://www.wipo.int/amc/en/domains/search/overview/index.html#15> (accessed 15 Oct. 2012).

852. *Junta de Andalucia Consejeria de Turismo, Comercio y Deporte, Turismo Andaluz, S.A. v. Andalucia.com Limited*, Case No. D2006-0749 (WIPO Arbitration and Mediation Center 13 Oct. 2006) (available at <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0749.html>). See also *Asphalt Research Technology, Inc. v. National Press & Publishing, Inc.*, Case No. D2000-1005 (WIPO Arbitration and Mediation Center 13 Nov. 2000) (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1005.html>); *Porto Chico Stores, Inc. v. Otavio Zambon*, Case No. D2000-1270 (WIPO Arbitration and Mediation Center 15 Nov. 2000) (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1270.html>).

Similar questions have arisen in respect of domain names comprised of geographical indications. The registrant of the domain name [www.parmaham.com](http://www.parmaham.com), for example, was not found to have a legitimate interest in the name 'parma ham',<sup>853</sup> but the result may have been different had the domain name at issue resolved to an active website. Taking a slightly different approach, the sole panelist in that dispute found that possession of the domain name by the respondent, who was not otherwise affiliated with the holder of the geographical indication, nevertheless did not constitute bad faith. It was noted that this finding would not necessarily preclude a finding of unfair competition under domestic law. An issue is potentially also raised in relation to Article 22 of the TRIPS Agreement, but only, as concluded in the previous chapter, if the website was related to goods (in the immediate example, Prosciutto di Parma).

As to whether the global online public perceives the registration of a geographic domain name by a registrant other than the relevant government as 'contrary to honest practices', this would be difficult to determine in a global marketplace. Despite concerns about globalization and a resultant homogenization of consumer tastes and preferences, there remain significant cultural and other differences that prevent the formulation of a single perception or interpretation of most names. It has already been argued in the previous chapter that this divergence of consumer interpretation remains one of the greatest challenges to recognizing rights in geographical indications at the international level. The same problem hinders their protection under unfair competition law at the international level: terms which are in some countries protected as identifying a particular product originating from a particular geographical location are in other countries considered generic. As such, their use in the latter countries by someone other than producers of the product in the named location could not be considered dishonest.

Accordingly, if protection of geographic names is to be based on Article 10*bis* of the Paris Convention, this must result from a name-by-name, country-by-country determination of whether or not use of the name by a particular party without government authorization is 'honest practice'. This would be a resource-intensive undertaking, since not just the substance of the standard of honesty but even how it is determined that something is an 'honest practice' differs from country to country. Even *ex post* analysis of disputes involving similar names arising in multiple territories would present challenges, given the differing standards of 'unfairness' that may have been applied. Further, if it is the case that '[t]he most important factor for

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[www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1270.html](http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1270.html)); *Gorstew Limited v. Worldwidewebsales.com*, Case No. D2002-0744 (WIPO Arbitration and Mediation Center 23 Oct. 2002) (available at <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0744.html>).

853. *Consorzio del Prosciutto di Parma v. Domain Name Clearing Company, LLC*, Case No. D2000-0629 (WIPO Arbitration and Mediation Center 18 Sep. 2000) (available at <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0629.html>).

determining “unfairness” in the marketplace ... is derived from the *purpose* of unfair competition law’,<sup>854</sup> there is little hope of arriving at any universal standard because the differing purposes of unfair competition law in various jurisdictions will lead to differing standards. In particular, what is considered fair in countries that carve consumer protection out from unfair competition law will differ from those countries that do not.<sup>855</sup>

It should thus not simply be assumed that the registration of a geographic domain name by a non-government registrant or the registration of a geographical indication domain name by a non-local producer falls squarely within the broadly worded definition of ‘unfair competition’ provided by Article 10*bis* (2) of the Paris Convention. Deeper consideration is needed to determine whether unauthorized registrations of geographic domain names fall within any of the specifically enumerated acts of unfair competition provided for under the Paris Convention. This will now be explored.

## 8.2 SPECIFIC ACTS OF UNFAIR COMMERCIAL BEHAVIOUR

Paragraph (1) of Article 10*bis* of the Paris Convention is of a general nature, not obliging States to create new law ‘if their existing general legislation – for example, provisions of civil law directed against torts, or principles of common law – suffices to assure effective protection against unfair competition.’<sup>856</sup> Paragraphs (2) and (3) are less general in nature; while neither provides a comprehensive, authoritative list of impermissible acts of unfair competition, paragraph (2) offers the broad definition just discussed and paragraph (3) identifies three specific acts which, at a minimum, must be prohibited by members’ domestic law. These acts seek to prevent unfair competition, on the one hand by stopping an enterprise from disparaging its competitors, and on the other hand by attempting to narrow the knowledge and experience gap between enterprise and consumer. Of these three acts that the convention specifically identifies as unfairly competitive, it is said that they share one aspect in particular:

The *common aspect* of these most important, but by no means exhaustive, examples of unfair market behavior is the attempt (by an entrepreneur) to succeed in competition without relying on his own achievements in terms of quality and price of his products and services, but rather by taking undue advantage of the work of another or by influencing consumer demand with false or misleading statements.

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854. WIPO, *Protection against unfair competition*, 24-25.

855. See Henning-Bodewig, 21.

856. Bodenhausen, 143.

Practices that involve such methods are therefore doubtful at the outset as to their fairness in competition.<sup>857</sup>

It must be borne in mind that although Article 10*bis* (3) specifically identifies three behaviours as unfairly competitive, this list is not exhaustive; members are required to target all acts which would fall within the broad definition of unfair competition set out in Article 10*bis* (2), the relationship of which to geographic names generally and geographic domain names particularly has been discussed in the immediately preceding section of this chapter. Further, although geographic domain name registration is not expressly addressed by Article 10*bis* (3) and even to the extent that this provision is interpreted as not covering geographic domain name registration, there is nothing to prevent members from creating domestic law to that effect.

In addition to Article 10*bis*, which is specifically headed 'Unfair competition', Article 10 of the Paris Convention also addresses commercial behaviour that has the effect of harming competitors, consumers, or both. It makes actionable the use of false indications of source and thus is particularly relevant to the use of geographical indications. It is likewise applicable to other geographic names the use of which could be interpreted as connoting origin. The remainder of this chapter is devoted to an examination of these provisions in order to determine whether any of them offers grounds for restricting the registrability of geographic names as new gTLD strings.

### 8.2.1 FALSE INDICATIONS OF SOURCE

The first attempt to control unfairly competitive acts at the international level took the form of preventions against false indications of source. At the 1880 conference that would result in the drafting of the Paris Convention, it was declared a priority that:

Tout produit portant illicitement soit la marque d'un fabricant ou d'un commerçant établi dans l'un des pays de l'Union, soit une indication de provenance dudit pays, sera prohibé à l'entrée dans tous les autres États contractants, exclu du transit et de l'entrepôt, et pourra être l'objet d'une saisie suivie, s'il y a lieu, d'une action en justice.<sup>858</sup>

The prohibition against false indications of origin took shape as Article 10, in which indications were actionable only to the extent that they were used in conjunction with a false, fictitious, or deceptive trade name.<sup>859</sup> Since revision at the 1958 Lisbon Conference, Article 10 applies to all direct or

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857. WIPO, *Protection against unfair competition*, 24.

858. Ministère des Affaires Étrangères de la France, *Conférence Internationale pour la Protection de la Propriété Industrielle*, 14.

859. See Conrad, 23.

indirect uses of a false indication of the source of goods. It is not expressly limited to geographical source, but that is identified as its most common application.<sup>860</sup>

Two things seriously hinder the applicability of Article 10 to geographic domain names. First, the indications of source covered by Article 10 are confined to those relating to goods, with the result that this provision is relevant only to second-level domain names corresponding to a website dealing in goods. Article 10 has no application to top-level domains because they bear no direct connection to goods. Rather, top-level domains represent the service of providing an online communications portal that others may, if they so choose, use to engage in commercial activity involving goods.

Second, even for those second-level domain names having a direct nexus to goods, or if a nexus between top-level domains and goods were thought to exist, Article 10 has no practical effect because the remedy for its breach is seizure of the falsely identified goods upon importation. This would have no effect on a domain name at any level of the DNS. Article 10 targets the cross-border movement of falsely identified goods; geographic domain names do not fall within this ambit.

Similar limitations arise in the application of Article IX:6 of the GATT Agreement, which deals with 'marks of origin'. It provides:

The contracting parties shall co-operate with each other with a view to preventing the use of trade names in such a manner as to misrepresent the true origin of a product, to the detriment of such distinctive regional or geographical names of products of the territory of a contracting party as are protected by its legislation. Each contracting party shall accord full and sympathetic consideration to such requests or representations as may be made by any other contracting party regarding the application of the undertaking set forth in the preceding sentence to names of products which have been communicated to it by the other contracting party.

As an initial matter, the obligations imposed by this provision are significantly weaker than those imposed by Article 10 of the Paris Convention, requiring only 'co-operation with a view to' preventing false representations of origin. As with Article 10, the application of GATT Article IX:6 is not applicable to services. This likewise renders it only partially applicable to second-level domain names and entirely inapplicable to top-level domain strings. In addition, the capability of this provision to protect geographic names is hindered by its having been given a very narrow interpretation in the case of *Japan – Customs Duties, Taxes and Labelling Practices on Imported Wines and Alcoholic Beverages*.<sup>861</sup> The Panel in that case found

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860. See Bodenhausen, 139.

861. *Japan – Customs Duties, Taxes and Labelling Practices on Imported Wines and Alcoholic Beverages*, L6216 adopted 10 Nov. 1987, BISD 34S/83 (GATT Panel Report).



that the use of terms such as ‘Riesling’ or ‘chateau’ by Japanese manufacturers was not detrimental to the names of products produced by the European Communities.

Like the Paris Convention, the GATT Agreement does not expressly prevent members from offering greater protection to origin statements under domestic law than is required by their treaty obligations. On the contrary, GATT Article XX(d) allows contracting parties to adopt or enforce measures ‘necessary to secure compliance with laws or regulations which are not inconsistent with the provisions of this Agreement, including those relating to [ ... ] the protection of patents, trade marks, copyrights and the prevention of deceptive practices’. The term ‘deceptive practices’ has notably been interpreted to include ‘false marking of geographical origin.’<sup>862</sup> There is, however, no scope for protection of non-commercial names under the GATT.

Neither Article 10 of the Paris Convention or Article IX:6 of the GATT specifically offers rights that enable one party to prevent another’s registration and use of a geographic top-level domain string. Some scope exists under these provisions for restricting registration of second and lower level domain names, but this is limited to the use of specifically origin-connoting geographic names used to identify websites offering goods. Member States are not prevented from enacting specific legislation preventing unauthorized registration of domain names as a false statement of origin, but any such rights would be enforceable only in the jurisdiction in which they are granted.

### 8.2.2 ACTS CREATING CONFUSION WITH A COMPETITOR

Turning now to the first of the three acts that are specifically identified as unfairly competitive by the Paris Convention, Article 10*bis* (3)(i) prohibits ‘all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor’. The term ‘all acts’ is sufficiently broad to be interpreted as including the registration and use of a name at any level of the DNS. The following two elements must additionally be satisfied for Article 10*bis* (3)(i) to justify a general rule of preventing their delegation to applicants without government authorization:

- The acts of applying for and operating a geographic gTLD, irrespective of the registrant’s intent,<sup>863</sup> are likely to create confusion with the government.

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862. Gervais, 7, citing *WTO Guide to GATT Law and Practice* 583 (6th ed., 1995).

863. See WIPO (ed.), *Introduction to Intellectual Property*, 254 (nothing that while irrelevant to the determination of whether an act of unfair competition has taken place, intent may be deemed relevant to the determination of sanctions.)

- Unauthorized geographic gTLD applicants and relevant governments are competitors.

These steps are analysed in the sub-sections that follow.

### 8.2.2.1 Likelihood of Creating Confusion

It has been argued that society has become conditioned to ‘assume that all the iconic indicia of consumer culture must be owned, and thus that *any* appearance of them must be approved by their official owners.’<sup>864</sup> If this is so, confusion is likely to result from the use of geographic names in the DNS, fuelled by the authoritative or official status of their presumptive owners. There are various means of determining confusion in domestic law, but most commonly it is established using a ‘likelihood of confusion’ test derived from trademark law.<sup>865</sup> This test has played a major role in trademark owners’ efforts to extend their offline rights into the online environment. The standard applied is ordinarily that of ‘an average (reasonable) consumer, having normal attentiveness with regard to the nature of the product or service or the place where it is offered’.<sup>866</sup> In the context of this study the following question arises: would the average, reasonable, normally attentive internet user be likely to be confused by geographic domain names registered by or delegated to parties other than governments? The following two fabricated examples are illustrative of this issue:

- When the average internet user in Country A sees the top-level domain .uruguay, do they understand it to be delegated to or affiliated with the country of Uruguay?
- When the average internet user in Country A sees the domain name ‘mombasa.visit’, do they understand this second-level domain in the .visit top-level domain to be registered by or affiliated with the city of Mombasa?

The answers to these questions depend on a range of factors, of which several can be borrowed from trademark law:<sup>867</sup>

- The similarity between the geographic name and geographic domain name/string.
- The reputation or degree of distinctiveness of the geographic name/string and the location it names.
- The reputation of the government/s relevant to the name/string.

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864. Coombe, 65 (internal citations omitted).

865. See AIPPI, *Effective protection against unfair competition under Article 10bis Paris Convention of 1883*, AIPPI Y.B. 1994/II, 398, 6.3. (1994)

866. *Ibid.*, 6.5.

867. See WIPO (ed.), *Introduction to Intellectual Property*, 255.

- Internet user sophistication regarding the DNS (e.g., some users will know that not all country code TLDs are operated by or formally affiliated with the government of the territory represented).<sup>868</sup>
- The relationship of the reasonable internet user to the name (local familiar names may be interpreted differently than non-local unfamiliar names).
- The existence of other, non-geographic meanings of the name (the names ‘Turkey’ and ‘Orange’, for example).
- The existence of multiple geographic locations having the same name (Oxford, Ohio, USA and Oxford, England, for example).
- The relationship, if any, between a second-level domain name and the top-level domain in which it is registered (e.g., tokyo.japan may be assumed by the reasonable person to be associated with the government while cooking.japan may be understood differently).

Reliance upon the ‘reasonable person’ standard in the global context presents significant challenges because of the widely varied experience and knowledge of internet users across the globe. The reasonable internet user in one jurisdiction may be affected by the factors noted above in a different way than the reasonable internet user in another jurisdiction. Identifying a global standard would require capturing the many domestic standards and finding among them sufficient consistencies, to the extent that any exist. There is thus scant support for a general rule that any registration of a geographic domain name by a non-government registrant is likely to confuse.

There is greater scope for consistency in findings of likelihood of confusion when the domain name or string in question is a distinctive geographical indication.<sup>869</sup> The identification of a global ‘reasonable person’ standard is influenced by the fact that the ordinary use of a geographical indication is as an identifier of source. Consistent use of wine and spirit geographical indications resulting from the higher level of protection afforded them under Article 23 of the TRIPS Agreement increases the capacity for likelihood of confusion. The international register as proposed by Article 23<sup>870</sup> could, if it were to be established, have the effect of strengthening the public’s awareness of the indications recorded by it. Certain geographical indications may also benefit from widespread recognition through a patchwork of bi- and multilateral agreements between the origin country and trade partners. The European Union in particular has

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868. Country-code TLD administration is discussed at Part I, Chapter 2, section 2.4.2 above. The example of Tuvalu’s .tv ccTLD, which has no territorial restrictions and operates as if it were an open gTLD, is provided in n. 812 above.

869. See WIPO (ed.), *Introduction to Intellectual Property*, 256-257.

870. The proposed international register is discussed in Part III, Chapter 7, section 7.3.1 above.

made the recognition of geographical indications a key issue in recent agreements with its trade partners.<sup>871</sup>

In countries in which a geographical indication is interpreted as identifying a type of (rather than a particular) product, there is no connotation of origin and thus no likelihood of confusion. Courts tend to rely on the meaning of a term to the relevant public, as ascertained from such things as dictionary definitions, telephone directories, media sources and other publications, along with the use of the term made by the party claiming ownership, its competitors and others.<sup>872</sup> It would be interesting to consider whether the convention of using lower-case letters in domain names has any effect on public perception, given that geographical indications are often identified in written expression with capital letters following the convention of proper (i.e., non-generic) names.

These issues lead to the conclusion that name-by-name, jurisdiction-by-jurisdiction analysis is needed to determine whether registration as a domain name or delegation as a gTLD of geographical indications or other geographic names falls within the scope of Article 10*bis* (3)(i). It is overreaching for States to prevent registration of geographic domain names on the basis of the existence of a general rule among all Paris Union members that this activity is inherently likely to confuse.

### 8.2.2.2 Confusion with a Competitor

In cases in which likelihood of confusion is found, unauthorized registration/delegation of a geographic domain name will not fall within the scope of Article 10*bis* (3)(i) if the registrant/registry operator and government or geographical indication holder are not competitors. To clarify, the likelihood of confusion must exist between two parties in a market, with advantages accruing to one competitor because consumers believe that competitor to be another competitor. General confusion about a market is not sufficient.

As noted earlier in this chapter, competition exists in the DNS but not in a clear, conventional sense. All new gTLD applicants compete against each other for monopoly control of a uniquely named domain. In the

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871. A summary of key EU bilateral agreements on geographical indications made in the ten years following the implementation of the TRIPS Agreement is provided in O'Connor and Company & Insight Consulting, *Geographical indications and TRIPS: 10 Years Later... A roadmap for EU GI holders to get protection in other WTO Members*, [http://trade.ec.europa.eu/doclib/docs/2007/june/tradoc\\_135088.pdf](http://trade.ec.europa.eu/doclib/docs/2007/june/tradoc_135088.pdf). Recently-signed agreements addressing geographical indication protection include the Trade Agreement between the European Union and Colombia and Peru (Annex XIII) and the EU-South Korea FTA (Chapter 10, sub-s. B). See Trade Agreement between the European Union and Colombia and Peru (26 Jun. 2012) (available at <http://trade.ec.europa.eu/doclib/press/index.cfm?id=691>); EU-South Korea Free Trade Agreement (6 Oct. 2010) (available at <http://eur-lex.europa.eu/JOHtml.do?uri=OJ:L:2011:127:SOM:EN:HTML>).

872. See Xuan-Thao N. Nguyen, *Nationalizing Trademarks: A new international trademark jurisprudence?*, 39 Wake Forest L. Rev. 729, 744-745 (2004).

application process, a non-State geographic gTLD applicant is in competition with a government applicant. Once the string is delegated to a successful applicant, the focus turns to operation of the TLD registry and the relevant question becomes whether the non-State geographic gTLD registry operator is in competition with the government of that geographic location. This depends upon the gTLD and its operator, in particular what the mission and purpose of the gTLD are and whether these are likely to cause confusion with the 'establishment, the goods, or the industrial or commercial activities' of the government.

Outright rejection of gTLD applications lacking government authorization is unsupportable under Article 10*bis* (3)(i) because this fails to take into account the mission and purpose of the proposed domain and whether this gives rise to a competitive relationship. Further, it is certainly the case that not all geographic gTLD operators will be in competition with relevant governments. Domain names comprising a proprietary name and the derogatory word 'sucks' (so-called 'sucks sites') provide clear examples of potentially non-competing, non-commercial domains. This issue had not yet presented at the top-level of the DNS prior to the New gTLD Program, but two applications were made in the program for the top-level string '.sucks'.<sup>873</sup> Even if these applications are not successful,<sup>874</sup> they serve as an example of what is often non-commercial speech that cannot be considered confusion with a competitor.

The absence of a likelihood of confusion in all cases and the potential for confusion outside of a competitive relationship support a conclusion that Article 10*bis* (3)(i) does not oblige Paris Union Member States to prevent the unauthorized registration of geographical indications and other geographic names as domain names. Neither does Article 10*bis* (3)(i) prevent States from adopting and enforcing such a universal rule through domestic law.

### 8.2.3 FALSE ALLEGATIONS DISCREDITING A COMPETITOR

As the second specifically identified act of prohibited unfair competition, Article 10*bis* (3)(ii) of the Paris Convention targets 'false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor'. It is essentially a provision that protects a commercial enterprise from harm to its commercial

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873. See ICANN, *Reveal Day 13 June 2012: New gTLD Applied-For Strings*, <http://newgtlds.icann.org/en/program-status/application-results> (13 Jun. 2012, accessed 15 Oct. 2012).

874. Kevin Murphy, *Governments probe domain land-snatch: many.gTLDs.suck*, The Register (29 Jun. 2012) (available at [http://www.theregister.co.uk/2012/06/29/domain\\_land\\_grab\\_under\\_the\\_microscope/](http://www.theregister.co.uk/2012/06/29/domain_land_grab_under_the_microscope/)). Murphy comments that the 'companies that have applied for .sucks ... face an uphill battle selling their proposed benefits to the GAC and to ICANN's influential intellectual property lobby.'

reputation. With that in mind, it may be of even greater use to online businesses than offline businesses, because online reputation is potentially more difficult to build and therefore more valuable to the enterprise.<sup>875</sup> Yet while this may be the case for businesses and their brand-oriented domain names, it should not automatically be assumed to be so for those interested in geographic domain names.

It is helpful to begin by distinguishing Article 10*bis* (3)(i) from Article 10*bis* (3)(ii): misleading the public into confusion involves communicating something (usually positive) about one's own identity or products, while making a false allegation involves communicating something negative about another market player. In order for Article 10*bis* (3)(ii) to be called upon to prevent the unauthorized registration of geographic domain names or application for a geographic gTLD, the act of registration/application must be interpreted as the making of a false allegation. Additionally, that false allegation must be of a discrediting nature. It is difficult to see how the simple act of registering a geographic domain or applying for a TLD string could satisfy either of these elements.

### 8.2.3.1 False Allegations

Making an application for a geographic gTLD such as .london or for a geographic second-level domain such as champagne.com cannot on its own be characterized as the making of a false allegation. That these actions should even be characterized as an 'allegation' is not at all obvious given the ordinary meaning of that term as 'a claim that someone has done something wrong, typically an unfounded one.'<sup>876</sup> There may be some scope for interpreting a geographic gTLD string as a claim the applicant makes about itself, but it is not logical to characterize a geographic gTLD as a claim about another party.

Even if domain names generally or geographic domain names specifically are understood in this manner, it is inappropriate to assume that the claim they make is false. Geographic names can be interpreted in a variety of ways, including most obviously as the identifier of a particular geographic location. Only false allegations are expressly prohibited by this provision, and it is indubitably not the case that all of the possible interpretations of a geographic name are inherently false. The same can be said of domain names more generally. Here it helps to return to the discussion of what a domain name is, first and foremost the identifier of a particular location in the DNS. It is true that domain names have taken on initially unintended semantic

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875. See Dan Jerker B. Svantesson, *The right of reputation in the Internet era*, 23(3) Int'l Rev. L. Comp. & Tech. 169, 170 (2009) (positing that reputation has a much greater role to play online than off because 'online you simply do not have the same possibilities of building trust through means such as location, shop structure, etc.').

876. *The Concise Oxford English Dictionary* 34 (Catherine Soanes & Angus Stevenson eds., 11th ed. revised, Oxford University Press 2008).

significance, but to consider the act of applying for a top-level domain name the making of a false allegation is to push that significance to illogical limits. It should, however, be acknowledged that Paris Union members remain free to prohibit through domestic law true but nevertheless disparaging statements.<sup>877</sup>

### 8.2.3.2 Discrediting a Competitor

Even if it is found that a geographic domain name or string constitutes a false allegation, that allegation must be ‘of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor’, what WIPO characterizes as an ‘attack’ on one’s competitor.<sup>878</sup> The ordinary meaning of the verb form of the word ‘discredit’ as ‘harm the good reputation of, cause (an idea or account) to seem false or unreliable’<sup>879</sup> serves to emphasize that the allegations at issue in Article 10*bis* (3)(ii), unlike the misleading activity targeted by Article 10*bis* (3)(i), are specifically directed at others in the market.

The act of filing an application for a geographic domain name cannot, on its own, be said to constitute an attack on others. Such a finding could only be reached by considering the context in the geographic domain name is used, for example in conjunction with pejorative words. It could be said that a top-level domain such as .australiasucks or the domain name ‘australia’ registered in a new .sucks TLD (‘australia.sucks’) discredits everything about Australia, including its ‘establishment’, ‘goods’, and ‘industrial or commercial activities’. Opinions are not actionable,<sup>880</sup> however, and it can be argued that registrants of such domain names are using the domain name system to express an opinion rather than an objective fact.

Furthermore, discrediting though it may be, the use of a name in a ‘sucks site’ may be non-commercial in nature and made by a party not constituting a ‘competitor’. Like Article 10*bis* (3)(i), Article 10*bis* (3)(ii) does not require that States prevent acts, however undesirable, against those who are not competitors. Accordingly, most countries limit disparagement to ‘cases where there is at least some sort of competitive relationship between the plaintiff and the defendant.’<sup>881</sup> Countries that do extend the scope of this provision are not required by Article 10*bis* (3)(ii) to do so, but neither are they prevented from doing so.

Restrictions on the registration of geographic domain names on the basis of their constituting a false allegation that discredits a competitor thus lack support from Article 10*bis* (3)(ii). Paris Union members are not obliged

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877. See AIPPI, 7.1.

878. WIPO (ed.), *Introduction to Intellectual Property*, 266.

879. Soanes & Stevenson (eds.), *The Concise Oxford English Dictionary*, 409-410.

880. See Lisa P. Ramsey, *Free Speech and International Obligations to Protect Trademarks*, 35 *Yale J. Int’l L.* 405, 421 (2010).

881. WIPO (ed.), *Introduction to Intellectual Property*, 266.

to prevent the registration of geographic names as domain names or strings, and it is difficult to see how Member States can rely on Article 10*bis* (3)(ii) as a basis for domestic law to that effect. A State's claim to rights on this basis appears less motivated by a desire to prevent unfair competition than a desire to foreclose all competition in order to prevent any slights against or encroachments upon the State's reputation. If that is the true intention, a more appropriate source of rights to consider is the trademark theory of dilution, the potential application of which to geographic names is discussed in the final section of this chapter.

#### 8.2.4 INDICATIONS OR ALLEGATIONS LIABLE TO MISLEAD THE PUBLIC

Article 10*bis* (3)(iii) of the Paris Convention sets out the last of the three specifically prohibited acts of unfair competition, 'indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.' The Austrian proposal from which this provision originated included the word 'origin', but its removal was motivated by objections raised by the United States.<sup>882</sup> Origin statements or indications going to 'the *identity of the producer*, his *establishment* or his *industrial or commercial activities*' (emphasis in original) were thus beyond the reach of Article 10*bis*, and to the extent not covered by Article 10, relegated to domestic law.<sup>883</sup> The International Association for the Protection of Intellectual Property (AIPPI) has observed, however, that 'in general, all kinds of allegations, not restricted to those listed in Article 10*bis*, are covered by such protection, including allegations referring to the geographical origin of the products'.<sup>884</sup> Furthermore, despite the inapplicability on its face to geographical indications, this provision nevertheless 'became a launching point for'<sup>885</sup> the drafting of Articles 22, 23 and 24 of the TRIPS Agreement respecting geographical indications. The end result is a curious one, in that section 22(2) of the TRIPS Agreement effectively extends the scope of protection under Article 10*bis* of the Paris Convention by bringing geographical indications, which are by definition origin statements, within its scope.<sup>886</sup>

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882. See J. Thomas McCarthy & Veronica Colby Devitt, *Protection of Geographical Denominations: Domestic and International*, 69 Trademark Rep. 199, 201-203 (1979).

883. See Bodenhausen, 146 (internal citations omitted).

884. AIPPI, 8.1.

885. Hughes, *Spirited Debate*, 312.

886. See Conrad, 35-36.



#### 8.2.4.1 Misleading

As with standards of truthfulness and fairness, the question of whether an indication or allegation is misleading inevitably varies from jurisdiction to jurisdiction.<sup>887</sup> Some countries tolerate exaggeration up to a point, but there is no universal agreement as to where that point lies.<sup>888</sup> This makes it difficult to enumerate specifically misleading acts at the international level. It is generally the case that in order to fall within the scope of Article 10*bis* (3)(iii), the indication or allegation in question need not be inherently false or actually result in a false impression in the consumer's mind. Rather, its misleading character is determined by the consumer's reaction, which 'may differ from country to country and may also depend on the kind of addressee (consumers or traders) and the type of goods or services. The Paris Convention leaves this question to member States'.<sup>889</sup>

The question in the context of geographic names' use in the DNS is whether their delegation to (top-level) or registration by (second or lower level) an applicant other than a government or geographical indication holder is inherently misleading to the average, reasonable internet user. As discussed in the context of the prohibition through Article 10*bis* (3)(i) of 'all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor', global reasonableness standards are difficult if not impossible to identify. It is extremely difficult to gauge public perception on a global scale, and attempts to do are very likely to reveal that the savvy and experience attributed to the average internet user differs from country to country and perhaps even within a country.

#### 8.2.4.2 Limited to Goods

Even if geographic top-level domains are considered inherently misleading, there is an insurmountable obstacle to the application of Article 10*bis* (3)(iii), which is the limitation of that provision to 'indications or allegations' made about goods. As has been argued in the context of geographical indications in the previous chapter, unlike second-level domains (which may, although need not, have a direct connection to goods), top-level domains and their operators have no such connection. Rather, they provide a service by making available a communications portal. A .champagne gTLD, for example, could be a space in the DNS for domain name registrants to communicate commercial and non-commercial information about Champagne the region, Champagne the product originating from that region, or other things.

While Article 10*bis* (3)(iii) may offer protection against the registration of geographic second- and lower level domain names to the extent that these

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887. See AIPPI, 8.2.

888. See WIPO (ed.), *Introduction to Intellectual Property*, 261-262 and 264.

889. *Ibid.*, 262.

are a) used in connection with goods and b) deemed misleading under domestic law as regards those goods, no such protection is afforded in the context of top-level domain strings. For the same reasons for which it was concluded the previous chapter that there are no preventable uses of geographical indications at the top-level of the DNS, it can be concluded that Article 10*bis* (3)(iii) does not oblige Paris Union Member States to prevent geographic gTLD applications by non-State applicants. It is open to members to deem the registration of a geographic domain name at any level of the DNS by a party other than the relevant government or geographical indication holder inherently misleading, but this is not required by the Paris Convention. Nor is there any evident consistency amongst States adopting this broader approach.

### 8.3 PROTECTION OF REPUTATION

Although it seems logical to link a desire to prevent reputational harm with unfair commercial behaviour, the preceding analysis of Paris Convention Articles 10 and 10*bis* illustrates the very limited protection available to reputation through international unfair competition law. The concerns of governments and geographical indication holders about misappropriation of identity by others' use of geographic names are not limited to actions of competitors, nor does the term 'competitor' have much traction in this context. Even to the very limited extent that Articles 10 and 10*bis* protect these interests, they are clearly not sufficient bases for broader claims to exclusive rights in geographic names. Two further, related doctrines of rights protection will now be considered to determine their potential for filling the gaps left by unfair competition law: dilution and personality rights.

#### 8.3.1 DILUTION

Dilution sits uneasily alongside unfair competition principles because its prevention of the use of a trademark in connection with even unrelated goods or services effectively makes competition in that sector impossible. Put simply: 'How could there be unfair competition when there was no competition?'<sup>890</sup> Dilution is therefore logically addressed in the Paris Convention not in Article 10*bis*, but rather separately in Article 6*bis*, which applies only to 'well-known' trademarks.

The function of the doctrine of dilution is to prevent the erosion by anyone – direct competitors or otherwise – of the reputation of famous

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890. Brown Jr, 1192.

trademarks.<sup>891</sup> The broader range of preventable acts fills in some of the gaps identified in the previous section of this chapter in terms of the applicability of unfair competition law to geographic names' use in the DNS. It has already been suggested that dilution may be usefully applied at the second-level of the DNS 'if a customer became confused about the owner of the domain name, purchased goods from a cybersquatter thinking they were made by the brand and lost confidence in the brand, thereby harming its reputation and value.'<sup>892</sup>

There is precedent for protecting geographic names under Article 6*bis* even where they are not registered as trademarks: Article 6*bis* has successfully been relied upon to support a claim to rights in the name of the government of the Spanish region of Catalunya, 'Generalitat de Catalunya'. In a UDRP dispute brought by the local government, the name in question was found to be protected on the basis of its well-known status and Spanish law's recognition of unregistered well-known marks.<sup>893</sup> The key in this and similar cases is domestic law's recognition of a geographic name as a trademark, which has the automatic effect of bringing the name within the scope of the UDRP. If domestic law does not consider the name a trademark, then the UDRP is inapplicable and the party asserting rights in the name can rely only on whatever other rights might be available under domestic law.

Setting aside the possibility of bringing a UDRP claim, the domestic applicability of dilution theory may extend beyond trademarks. This has significant potential for the protection of geographic names as a possible future development in international law. The protection of geographical indications in some European jurisdictions, for example, has been compared to the protection against dilution afforded to famous trademarks in the United States,<sup>894</sup> which is where trademark dilution theory originated. Not coincidentally, then, have the European Commission's proposals for increased protection of geographical indications under the TRIPS Agreement been said to resemble a dilution or 'dilution plus' type of protection.<sup>895</sup>

In its 1996 Model Provisions on Protection against Unfair Competition, the World Intellectual Property Organization proposed amending Article 10*bis* (3) to include acts that damage goodwill or reputation.<sup>896</sup> Such an amendment would increase support for the protection of geographic names, in particular by eliminating the need for a competitive relationship between

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891. See Callmann & Altman, 22:15. On well-known marks and their potential reservation from domain name registrability, see Part II, Chapter 3, section 3.2.1.3 above.

892. Elizabeth C. Woodard, *The UDRP, ADR, and Arbitration: Using proven solutions to address perceived problems with the UDRP*, 19 Fordham Intell. Prop. Media & Ent. L. J. 1169, 1176 n. 31 (2009).

893. *Catalunya v. Wolf*, WIPO Case No. D2002-1124.

894. See Hughes, *Spirited Debate*, 347-349.

895. *Ibid.*, 319.

896. See WIPO, *Model Provisions on Protection Against Unfair Competition*, WIPO Pub. No. 832 (1996).

the parties, with the operative situation being 'any act or practice in the course of industrial or commercial activities'.<sup>897</sup> Interpreted broadly, as instructed by the accompanying Notes, this would include 'activities of professionals and non-profit making activities.'<sup>898</sup>

In summary, the proposed amendment to Article 10*bis* (3) has as-yet not been agreed upon and the 'model' provisions, which are directed at countries that are as an initial matter introducing unfair competition laws into national legislation in order to comply with their obligations under the TRIPS Agreement, are not binding. Nevertheless, these things are indicative of a desire at the international level to broaden the protection offered by dilution and to bring geographic names within the scope of unfair competition law.<sup>899</sup> Currently, the protection against dilution offered by Article 6*bis* of the Paris Convention is available only to geographic names recognized under domestic trademark law. Nor is Article 10*bis* (3), in its present wording, able to prevent damage to reputation except by competitors and in the very limited constellations identified in its sub-sections (i), (ii) and (iii).

### 8.3.2 GEOGRAPHIC NAMES AND PERSONALITY RIGHTS

There are strong conceptual links between unfair competition and the protection of personality or identity. Like individuals, governments are concerned about identity theft in the online environment. The recognition of personality rights in geographic names could address States' concerns by preventing unauthorized parties from holding themselves out as the government or its authorized representative on the internet. This sort of protection ordinarily has as its focus the reputation of persons; it must therefore be questioned whether international law recognizes personality rights of States such that these rights might be called upon by governments to prevent unauthorized applications for geographic gTLDs.

WIPO has considered this question in the context of protecting personal names from unauthorized registration as second-level domain names, and concluded that the domestic nature of personality protection and the diversity of domestic approaches are obstacles to the existence of an international norm of protection of personal names.<sup>900</sup> In jurisdictions where protection exists for personal names, this generally takes the form of personality law, which derives from individuality and personhood.<sup>901</sup> Such a theory could recognize that a State's identification with a symbolic name gives rise to a 'personality stake'<sup>902</sup> in that name; the use of that name by another could

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897. *Ibid.*, 62 Art. 1(1).

898. Henning-Bodewig, 24.

899. See Gervais, 298-299.

900. See WIPO, *WIPO II Report*, para. 178.

901. See Melville B. Nimmer, *The Right of Publicity*, 19 Law & Contemp. Probs. 203 (1954).

902. Hughes, *The Philosophy of Intellectual Property*, 340-341.

plausibly be interpreted as analogous to appropriation of an individual's interest in his or her personality.<sup>903</sup> Yet the characteristics of individuality and personhood underpinning protection are unique to human beings and lacking in other forms of legal person. On this basis, personality theory has been deemed to be of limited application to protecting corporations' trademarks.<sup>904</sup> The same logic refutes governments' claims to geographic names on the basis of personality.

Even where human personality rights are recognized in domestic law,<sup>905</sup> they cannot be characterized as rights in a name as such.<sup>906</sup> First, they are limited to protecting commercial value in a name,<sup>907</sup> and ordinarily this stands to benefit only famous persons. Even then, not all uses of the famous person's name can be prevented; in particular, non-commercial, informational uses are not preventable where the right to free speech is protected.<sup>908</sup> In the context of domain names, it is certainly not the case that any person can object to a registration of his or her name as a domain name on the basis of personality theory, and in any event the multiplicity of names will make it virtually impossible for every person with a common name to have his or her own domain name.

If a personality theory of statehood exists, to the extent that it is based upon existing personality doctrines respecting persons, the protection it offers is likewise limited. Though their relatively low numbers and global notoriety create commercial value in States' names, the benefit to States of a personality theory would be limited to preventing commercial uses of a country name. Most sub-national geographic names will have more difficulty in demonstrating requisite fame than country names. Non-commercial use of geographic names in diplomatic, official, descriptive or informative contexts – realistically a large proportion of the possible uses of geographic names – cannot be prevented. A complete prohibition on the unauthorized registration of geographic domain names on this basis would require as a conceptual first step deeming the act of registration, irrespective of the nature of the proposed use of the domain, an inherently commercial activity.<sup>909</sup>

The internet has undeniably given rise to concerns about misappropriated identity and corresponding harm to reputation. There is nevertheless no

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903. See Leon Green, *The Right to Privacy*, 27 Ill. L. Rev. 237 (1932).

904. See Anupam Chander, *The New, New Property*, 81 Texas L. Rev. 715, 748 (2003), citing Margaret Jane Radin, *Reinterpreting Property* 12-13 and 112 (University of Chicago Press 1993).

905. See Madow, 132 n. 23 and n. 24.

906. See WIPO, *WIPO II Report*, para. 172.

907. See Madow, 130.

908. See WIPO, *WIPO II Report*, para. 196 (contemplating the 'chilling effect on free speech' if personal names were to be protected under the UDRP).

909. On the inherently commercial nature of internet transactions and the effect that such a determination would have on DNS law and policy, see Part III, Chapter 5, section 5.2.2 above.

international legal framework currently in place to prevent the harm that could potentially result from the registration of a geographic domain name by a party not authorized to do so by a relevant government. There are conceptual obstacles to applying human personality rights to non-human interests, and even if this were not the case, human personality rights are not recognized as an international norm. A theory of State personality is not yet extant, and its future development would likely require significant departure from existing notions underpinning personality protection available to persons.

#### 8.4 CONCLUSIONS ON COMMERCIAL RIGHTS IN GEOGRAPHIC NAMES

This chapter has challenged justifications of restrictions on geographic names in the DNS on the basis of international unfair competition law. Governments' claims to rights in geographic names on this basis appear to be grounded more in a desire to exercise control than to promote honesty in commercial dealing, promote and protect commercial investment, promote competition or protect consumers. One is ultimately inclined to agree with the comments made in a 1945 decision of the United States Second Circuit Court of Appeals that 'the doctrine of so-called "unfair competition" is really a doctrine of "unfair intrusion on a monopoly".'<sup>910</sup>

As a starting point, the notion of 'competitors' in the context of the top-level of the DNS is strained. It is prudent to question whether an applicant for a new geographic gTLD is a competitor, in the ordinary sense of that term, with existing TLD registries, other applicants for new gTLDs, or governments relevant to a geographic name. If not, unfair competition law as provided for in Article 10*bis* of the Paris Convention is inapplicable to geographic gTLDs. Yet even if this challenge is overcome, there remain other considerable obstacles to applying international unfair competition law at the top-level of the DNS.

Preventing the registration of geographic gTLDs cannot be justified on the basis of all registrations being a false indication of the source of goods or an indication or allegation liable to mislead the public about goods, because top-level domains and the registries that operate them lack the requisite connection to goods. The then-Director General of WIPO pursued the inclusion of services in Article 10*bis* (3) in 1977,<sup>911</sup> but the attempt was unsuccessful. This provision remains applicable only to goods and therefore cannot be applied to the top-level of the DNS.

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910. *Standard Brands v. Smidler*, 151 F.2d 34, 40 (C.C.A. 2d 1945) (concurring opinion of Frank, J.).

911. See McCarthy & Devitt, 204. Services were included in the first TRIPS negotiation draft, but later removed. See Conrad, 34 n. 101.

Whether a TLD string can on its own constitute an allegation discrediting a competitor is doubtful. Dilution theory, which is conceptually at odds with unfair competition law but relatedly targets commercial behaviour that causes harm, is recognized in international law, but at this stage applies only to trademarks. It remains to be seen whether this form of protection will ultimately be extended to geographical indications through the TRIPS Agreement or some other instrument. Nor is there a norm in international law recognizing personality rights in respect of states.

There is scope for protecting the rights of geographical indication holders (which unlike government interests do have a clearly and directly commercial application) by preventing their registration as top-level domain strings, but this protection depends in large part on the distinctiveness of the indication. Until awareness is achieved more broadly, whether through an international register or otherwise, few names will benefit from this protection. Like geographic names generally, geographical indications are subject to a name-by-name, jurisdiction-by-jurisdiction analysis as to their distinctiveness and likelihood of creating confusion.

These considerations lead to the conclusion that neither Article 10 nor Article 10*bis* of the Paris Convention obliges Paris Union members to prohibit as acts of unfair competition the unauthorized registration of geographic names or geographical indications as top-level domain strings. The same conclusion is reached with respect to Article 6*bis* of the Paris Convention and GATT Article IX:6. It is important to emphasize, however, that Article 10*bis* (3) is not exhaustive; the broader definition of 'unfair competition' provided in Article 10*bis* (2) makes this clear. While the three specifically enumerated acts of unfair competition 'are important examples of unfair competition and may even cover the majority of acts committed in practice ... there exist manifold other ways and means to commit unfair competition which do not fall into any of these three categories.'<sup>912</sup> WIPO's Model Laws are evidence of a view that the unfair competition provisions of the Paris Convention require clarification and strengthening.

It is also important to emphasize that although the Paris Convention does not specifically oblige States to prevent the registration of geographic domain names as false indications of origin or as acts of unfair competition, it does not prevent members from enacting domestic law to that effect. Unfair competition law remains a domestic source of rights with the subject matter protected as well as the means of protection left open for States to decide. Greater protection for geographic names generally and geographical indications specifically, through unfair competition or anti-dilution law, may motivate the marketplace to provide better, more accurate information or perhaps even better quality products. In the context of the DNS, this may upset the delicate balance between laws protecting commercial signs, competition law and free speech. Although there was found in 1925 'no

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912. AIPPI, para. 1.

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substantial precedent to indicate the degree of control of an industry through trade symbols which would be held a restraint of trade or an attempt to monopolize any part of trade or commerce', the process of evaluating new gTLD applications and delegating new gTLDs could just bring about the sort of 'scheme of industrial dominion'<sup>913</sup> that was then speculated of.

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913. Brown Jr, 1202.



## Chapter 9

# Human Rights in Geographic Names

What are we? A nation? A region? In the Internet we are a community of interest.<sup>914</sup>

### 9.1 LINKING GEOGRAPHIC DOMAIN NAMES WITH HUMAN RIGHTS

#### 9.1.1 HUMAN RIGHTS, INTERNET ACCESS, AND IDENTITY

In the relatively short time since its being made accessible to the public, the internet has come to play an integral role in peoples' daily lives. This is so much the case that it can now be plausibly argued that obstacles impeding a person's ability to access and use the internet have the effect of impinging upon that person's ability to survive and thrive in the modern world. Much has been written about the potential benefits of technology to humankind and the continuation and development of cultures, languages and communities;<sup>915</sup> indeed, this has been a prime reason for expanding the top-level of the DNS since the privatization of the internet with the formation of ICANN, a corporate body specifically charged by the United States government with reflecting in its decision-making processes 'the functional, geographic and

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914. Gerrand, *Cultural diversity in cyberspace*, quoting Amadeu Abril i Abril.

915. See for example, Celia Lury, *Cultural rights: technology, legality, and personality* (Routledge 1993); Kyra Landzelius ed., *Native on the net* (Routledge 2006); *Intellectual Property and Traditional Cultural Expressions in a Digital Environment* (Christoph Beat Graber & Mira Burri-Nenova eds., Edward Elgar 2008).

cultural diversity of the Internet'.<sup>916</sup> As ICANN proceeds with expansion of the top-level of the DNS, an argument can be made that rejecting an application for a new gTLD can have the practical effect of denying the applicant (and, to the extent that the application is made on behalf of a community, that community) from expressing itself online and having an online identity. Given the fundamental nature of the internet to contemporary humanity, it is therefore imperative that any restrictions placed by ICANN on the creation of new generic top-level domains is closely examined with the rights of the persons and communities affected by them in mind.

The implications of the technology underpinning the DNS, in particular the requirement of absolute name uniqueness, have been discussed in earlier chapters of this book in the context of internet governance issues, but there are also major societal implications embedded in the decision-making processes that will result in a greater number of gTLDs. Conceptual links can be drawn between the societal implications of these decisions and the fundamental attributes of humanity that are acknowledged and protected through human rights law. The aim of this final chapter is to explore those implications and the potential of human rights as a basis for challenging States' assumptions of exclusive rights in geographic names and control over their use in the DNS.

The relevance of human rights to new gTLD policy has been recognized within ICANN from the start of the policy development process: in its 2007 recommendations to the Board of Directors the Generic Names Supporting Organization (GNSO) expressly identified the Universal Declaration of Human Rights and the International Covenant on Civil and Political Rights as potential sources of existing legal rights, conflict with which it advised avoiding.<sup>917</sup> These instruments and others are considered in this chapter as possible sources of human rights in geographic names which may conflict with a policy that gives States exclusive control over their use in the DNS.

Some human rights lack a precise definition, making it difficult to determine whether particular actions fall within their scope. This can be seen as an advantage or a disadvantage to those who seek to challenge States' rights in geographic names. It is on the one hand an advantage that human rights treaties and customs are in a state of development; if a claim can plausibly be based on any of the universal aspects of humanity protected by human rights law, it may be more favourably received than a claim to rights based on capitalistic attitudes to property ownership.<sup>918</sup> It is nonetheless a disadvantage that no specific human right to possess, control or use a geographic name has been codified or crystallized in international law. Standing in the way of such a precisely articulated right coming into

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916. ICANN, *Bylaws*, Article 1 section 2(4).

917. GNSO, *Final Report on the Introduction of New Generic Top-Level Domains*, Recommendation 3.

918. See Michael F. Brown, *Who Owns Native Culture?* 40 (Harvard University Press 2003).

existence is a reluctance to interpret the term 'human rights' too liberally for fear of diluting the effectiveness of human rights law in redressing major wrongs.<sup>919</sup> Yet even without such specificity, certain internationally recognized human rights of a broader nature, such as the rights to national identity, self-determination, freedom of expression, culture, language and property, as well as the doctrine of common heritage of mankind, may potentially be called upon in support of a right of persons to use geographic names.

Precisely because of the lack of specificity in articulating the bounds of human rights, the intention here is not to catalogue all of the rights that could potentially be interpreted as encompassing a right to geographic names. Rather, the intention is to focus on key rights for which there is a compelling connection to geographic names and explore the strengths and weaknesses of those connections. Before commencing this analysis, it is important first to identify the core concepts of the international human rights law framework into which this discussion fits. This chapter thus begins with a discussion of the subjects and sources international human rights law, explaining their particular relevance to geographic names and their use in the DNS. This foundation is then built upon by examining five specific human rights: the right to self-determination, the right to national identity, the right to freedom of expression, the right to culture and the right to language. The substance of each of these rights is discussed in order to evaluate their potential for encompassing a right of persons or peoples make use of a geographic name in the DNS.

Recalling earlier chapters' consideration of the links between geographic names and property rights, the third section of this chapter explores the potential for geographic names' recognition as the property or non-property of mankind. It begins with a discussion of the recognition in international law of a right to property, then progresses to consideration of the intellectual property-based concept of the public domain. This chapter ends by turning to natural resources law to consider the applicability the concept of the common heritage of mankind. Conclusions on human rights relating to geographic names are then summarized.

### 9.1.2 DISTINGUISHING HUMAN RIGHTS AND INTELLECTUAL PROPERTY RIGHTS

There 'is little doubt' as to the intention of human rights law as 'endow[ing] individuals directly with basic rights'<sup>920</sup> under international law. These rights

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919. See Richard B. Bilder, *An Overview of International Human Rights Law*, in *Guide to International Human Rights Practice* 15 (Hurst Hannum ed., Transnational Publishers 2004).

920. Rene Provost, *International Human Rights and Humanitarian Law* 18 (Cambridge University Press 2002).

'apply always and everywhere',<sup>921</sup> but an individual's being acknowledged as having the capacity to possess rights 'does not necessarily imply the capacity to exercise those rights oneself'.<sup>922</sup> Rather, human rights law imposes obligations on (in some cases, all) States to respect and promote human rights on the individual's behalf. In addition to the obligation upon them not to infringe human rights, States are obliged to protect these rights against interference by private parties.<sup>923</sup> Increasingly, international law recognizes not just individual but collective or community rights, as it comes to be acknowledged that modern State theory and the fundamental precepts of international law derived from it inadequately capture 'the multiple, overlapping spheres of community, authority, and interdependency that actually exist in the human experience.'<sup>924</sup> Identity (whether online or offline) is not purely individualistic: rights affecting identity must take into account individual and collective interests, and these must be balanced not just between individuals as against other individuals and communities, but between the individual and his or her own community.<sup>925</sup>

This tension is also inherent in intellectual property law, with its traditional aim of protecting the creative efforts and outputs of identifiable individual creators. The almost-complete ignorance in the TRIPS Agreement of community-generated creative works has provoked debate about the need for *sui generis* protection regimes based on or beyond the existing intellectual property law framework.<sup>926</sup> In the meanwhile, human rights law offers

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921. *Ibid.*, 19, quoting Report on Human Rights in Armed Conflict, U.N. Doc. A/8052 (1970) 13, para. 25.

922. *Peter Pázmány University v. Czechoslovakia*, P.C.I.J. Reports Ser. A/B No. 61, 231 (P.C.I.J. 1933).

923. If ICANN's New gTLD Program policy of recognizing exclusive rights of States to geographic names is deemed inconsistent with international law under any of the bases explored in this study, this gives rise to an interesting possibility that the United States has an obligation under human rights law to compel ICANN, an American corporation, to revise its policy of requiring government consent or non-objection to applications for geographic new gTLDs. This issue lies beyond the scope of this study but is identified here for later consideration. On the obligation to protect, see generally, Manfred Nowak, *U.N. Covenant on Civil and Political Rights: CCPR Commentary* 448 (2d ed. revised, N.P. Engel 2005).

924. S. James Anaya, *Indigenous Peoples in International Law* 101 (2d ed., Oxford University Press 2004).

925. As an example of a situation requiring balancing of the rights of individuals vis-à-vis their community, Anaya points (at 136) to the Human Rights Committee's decision in the case of *Kitok v. Sweden*, Communication No. 197/1985, *Report of the Human Rights Committee*, U.N. GOAR, 43rd Sess., Supp. No. 40, at 207, U.N. Doc. A/43/40, Annex 7(G) (1988) (views adopted 27 Jul. 1988).

926. See for example, Thomas Cottier & Marion Panizzon, *Legal Perspectives on Traditional Knowledge: The case for intellectual property protection*, 7 J. Int'l Econ. L. 371 (2004); Jeannette Mwangi, *TRIPS and Agricultural Biotechnology: Implications for the Right to Food in Africa*, in *Human Rights and Intellectual Property Rights: Tensions and Convergences* 241-288 (Mpazi Sinjela ed., Martinus Nijhoff 2007).

an alternative means of protecting and preserving communities' culture, language and ways of life.<sup>927</sup>

Despite this apparent overlap, it must be borne in mind that the aims of intellectual property law and the rights it protects are not equivalent to the aims and protections afforded by human rights law. The United Nations' Committee on Economic, Social and Cultural Rights makes this clear in its General Comment No. 17,<sup>928</sup> which explains the rationale of Article 15(1)(c) of the International Covenant on Economic, Social and Cultural Rights (ICESCR). That provision sets out the 'right of everyone to benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he or she is the author'. In distinguishing this right from the rights that accrue to authors and inventors under intellectual property laws, the Committee explained:<sup>929</sup>

The right of everyone to benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he or she is the author is a human right, which derives from the inherent dignity and worth of all persons. This fact distinguishes Article 15, paragraph 1 (c), and other human rights from most legal entitlements recognized in intellectual property systems. Human rights are fundamental, inalienable and universal entitlements belonging to individuals and, under certain circumstances, groups of individuals and communities. Human rights are fundamental as they are inherent to the human person as such, whereas intellectual property rights are first and foremost means by which States seek to provide incentives for inventiveness and creativity, encourage the dissemination of creative and innovative productions, as well as the development of cultural identities, and preserve the integrity of scientific, literary and artistic productions for the benefit of society as a whole.

Human rights are further distinguished from intellectual property rights by their indefinite duration and the essentially personal, rather than financial, interests they protect.

These fundamental differences offer unique perspectives when human rights are considered in the interpretation of laws recognizing intellectual property rights. These differences also give rise to a clear potential for conflict in the exercise of human rights with the exercise of intellectual

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927. See Dominic McGoldrick, *Culture, Cultures, and Cultural Rights*, in *Economic, Social and Cultural Rights in Action 454* (Mashood A. Baderin & Robert McCorquodale eds., Oxford University Press 2007).

928. *The right of everyone to benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he or she is the author (Article 15, paragraph 1(c), of the Covenant)* U.N. Doc. E/C.12/GC/17 (available at <http://www.unhcr.ch/tbs/doc.nsf/%28Symbol%29/E.C.12.GC.17.En?OpenDocument>).

929. *Ibid.*, para. 1.

property rights; protection afforded to one party in respect of a particular aspect of culture or identity or product of intellectual effort (a geographic name, for example) under one system could be afforded to a different party under the other, or a right recognized under one may not be recognized at all under the other. Prominent scholars have found evidence of this in case law, yet this issue is not effectively addressed by either the TRIPS Agreement or human rights instruments.<sup>930</sup>

### 9.1.3 SOURCES OF HUMAN RIGHTS LAW

The sources of international human rights law are the same as those relied upon in other areas of international law and are identified in Article 38(1) of the Statute of the International Court of Justice. Of the three principal sources set out in Article 38(1) it bears noting that treaties possess a special relevance in the human rights context; there are now a significant number of treaties in force between States regarding matters of human rights, and leading scholars characterize treaties as being of ‘paramount importance’<sup>931</sup> to international human rights law. Particularly significant among these is the United Nations Charter, to which nearly all States throughout the world are bound and by which they are united to the common general purpose of ‘promoting and encouraging respect for human rights and for fundamental freedoms for all without distinction as to race, sex, language, or religion’.<sup>932</sup> In addition to this broadly worded obligation there are a number of ‘core’<sup>933</sup> treaties of global effect that deal with specific aspects of human rights.<sup>934</sup> Beyond these,

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930. On the lack of a general cultural exception in WTO agreements, see Mary E. Footer & Christoph Beat Graber, *Trade Liberalization and Cultural Policy*, 3(1) J. Int’l Econ. L. 115 (2000); Deborah Z. Cass, *The constitutionalization of the World Trade Organization: legitimacy, democracy, and community in the international trading system* (Oxford University Press 2005). On the balance between free speech and free trade, see *Human Rights and International Trade* (Thomas Cottier, Joost Pauwelyn & Elisabeth Bürgi Bonanomi eds., Oxford University Press 2006).

931. Bruno Simma & Philip Alston, *The Sources of Human Rights Law: Custom, Jus Cogens, and General Principles*, Aust’l Y.B. Int’l L. 82, 85 (1988-1989).

932. Charter of the United Nations, Art. 1(3) (26 Jun. 1945, entered into force 24 Oct. 1945) 59 Stat. 1031; TS 993; 3 Bevans 1153.

933. United Nations, *Office of the United Nations High Commissioner for Human Rights: International Law*, <http://www2.ohchr.org/english/law/index.htm#core> (accessed 15 Oct. 2012).

934. These include the International Covenant on Civil and Political Rights (16 Dec. 1966, entered into force 23 Mar. 1976) 999 U.N.T.S. 171; International Covenant on Economic, Social and Cultural Rights (16 Dec. 1966, entered into force 3 Jan. 1976) 993 U.N.T.S. 3; International Convention on the Elimination of All Forms of Racial Discrimination, (21 Dec. 1965, entered into force 4 Jan. 1969) 660 U.N.T.S. 195; Convention on the Elimination of All Forms of Discrimination against Women (18 Dec. 1979, entered into force 3 Sep. 1981) U.N. GAOR Supp. (No. 46) at 193, U.N. Doc. A/34/46; Convention against Torture and Other Cruel, Inhuman or Degrading Treatment or Punishment, (10 Dec. 1984, entered into force 26 Jun. 1987) 39 U.N. GAOR Supp. (No. 51) at 197, U.N.

numerous bi- and multilateral treaties contribute to the significant and growing framework of international human rights conventions.

Given the fundamental nature of human rights to all mankind, customary human rights law is also important in that its universal applicability allows for the exercise of rights even in the absence of a State's membership in treaties recognizing human rights.<sup>935</sup> That said, proving the existence of a customary rule is not without difficulty, as has already been shown in previous chapters of this book in the contexts of other bases of rights, because it requires broad empirical analysis of State practice and *opinio juris*. In the human rights context, the imprecision of the definition and scope of particular rights creates additional challenges in proving the existence of customary rules. In spite of this, there is broad agreement that certain basic human rights have assumed the status of customary international law,<sup>936</sup> though exactly which rights have done so is debated. Commonly on such a list are freedoms from genocide, slavery, torture and racial discrimination.<sup>937</sup> There is also support for recognizing certain rights of indigenous peoples as having crystallized into customary norms.<sup>938</sup>

Exposition of customary human rights law is further complicated by a degree of overlap between custom and general principles of international law. This is exemplified by the treatment of the right of self-determination, which is relevant to the use of geographic names by peoples in their full and free participation in representative government. The right of self-determination, which is discussed in detail in the next section of this chapter, has been characterized as having its origins in general principle,<sup>939</sup> in custom,<sup>940</sup> and arguably either principle or custom.<sup>941</sup> If a general practice becomes established State practice, the question becomes the origin of the norm. It is not necessary for the purposes of this study, however, to pinpoint

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Doc. A/39/51 (1984); Convention on the Rights of the Child (20 Nov. 1989, entered into force 2 Sep. 1990) 44 U.N. GAOR Supp. (No. 49) at 167, U.N. Doc. A/44/49 (1989); International Convention on the Protection of the Rights of All Migrant Workers and Members of their Families (18 Dec. 1990, entered into force 1 Jul. 2003) 47 U.N. GAOR Supp. (No. 49A) at 262, U.N. Doc. A/47/49 (1990); Convention on the Rights of Persons with Disabilities (13 Dec. 2006, entered into force 3 May 2008) U.N. Doc. A/61/611; International Convention for the Protection of All Persons from Enforced Disappearance (20 Dec. 2006, entered into force 23 Dec. 2010) U.N. Doc. A/61/488.

935. See Provost, 55.

936. See Bilder, 10, citing Hurst Hannum, *The Status of the Universal Declaration of Human Rights in National and International Law*, 25 Ga. J. Int'l & Comp. L. 287 (1995-1996).

937. See for example, Gillian D. Triggs, *International Law: Contemporary principles and practices* 951-952 (2d ed., LexisNexis Butterworths 2011); *Restatement (Third) of the Foreign Relations Law of the United States* §702.

938. See Anaya, *Indigenous Peoples in International Law*, 64.

939. See for example, Hurst Hannum, *The Right of Self-Determination in the Twenty-First Century*, 55 Wash. & Lee L. Rev. 773, 775 (1998).

940. See for example, Triggs, 952.

941. See for example, Theodor Meron, *Human rights and humanitarian norms as customary law* 97 (Clarendon Press 1989).

the origin of a particular norm; the critical concern here is whether a norm exists, not how it originated.

Finally, in identifying the sources of international human rights law, mention must be made of the significance of so-called 'soft law' because, as with the development of norms respecting the internet, much of the dialogue respecting human rights occurs outside the formal rubric of Article 38(1) of the Statute of the ICJ.<sup>942</sup> United Nations General Assembly resolutions, for example, are recommendations only and not legally binding on members. They are nevertheless of high significance because of their capacity to influence State practice. Likewise, the Universal Declaration of Human Rights is not a legally binding instrument; as stated in its Preamble, it is 'a common standard of achievement for all peoples and all nations.'<sup>943</sup> It too 'has force as a morally, though not legally, binding document, as a yardstick by which to measure the development of the rule of law, and its authority is enhanced by the universality of its acceptance by Members of the United Nations.'<sup>944</sup> These and other non-binding instruments establish standards that can result in changes to State behaviour and ultimately lead to the formal, voluntary, observable assertions of consensus by States needed to generate a rule of customary international law.<sup>945</sup> With this in mind, such standards are considered in this chapter as a fundamental aspect of the potential future recognition of (if not a formal source of existing) rights in geographic names under international human rights law.

## 9.2 PARTICULAR HUMAN RIGHTS RELEVANT TO GEOGRAPHIC NAMES

National identity, expression, culture and language are all interconnected, symbiotic elements of human existence: nations and national identity are frequently formed out of linguistic communities and culture is the product of the ways in which and languages with which humans express themselves. It is difficult, therefore, to partition these rights into discrete analytical sections and evaluate their relevance to geographic names without a certain degree of overlap. Further, the precise parameters of the rights to national identity and self-determination, expression, culture and language are not settled. Notwithstanding these challenges, compelling arguments can be made linking geographic names with each.

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942. So-called 'soft law' and its broader relevance to this study is discussed in Part II, Chapter 4, section 4.2.3 above.

943. An alternative view is asserted in M.G. Kaladharan Nayar, *Human Rights: The United Nations and United States Foreign Policy*, 19(3) Harv. Int'l L.J. 813, 816-817 (1978) (arguing that the Universal Declaration in its entirety is customary international law).

944. Ruth Donner, *The Regulation of Nationality in International Law* 191 (2d ed., Transnational Publishers 1994).

945. See Simma & Alston, 90.



The analysis in this chapter is structured to first identify the theoretical connections between a particular human right and geographic names. Where appropriate because of a deviation with an ordinary understanding of rights holders under international law, beneficiaries of the right in question are identified. The legal basis, substance and limitations of each right are then discussed in order to evaluate potential conflicts with ICANN's policy of requiring government authorization of applications for geographic new gTLDs. Conclusions are made at the end of the analysis of each right, and then summarized together at the end of the chapter.

9.2.1                   RIGHT TO NATIONAL IDENTITY AND RIGHT OF  
                              SELF-DETERMINATION

9.2.1.1                **Connections between National Identity and Geographic  
                              Names**

Human beings have long identified themselves by reference to nationality. It has been said that this is 'not inevitable ... [but] is extremely important for how people define themselves.'<sup>946</sup> In the day-to-day human experience, national identity is not only a complex legal concept deriving from State sovereignty but also a social concept deriving from the innate human processes of self- and group-identification. The oft-quoted English philosopher John Stuart Mill aptly described this social aspect, what he termed the 'feeling of nationality', as potentially 'generated by various causes':

Sometimes it is the effect of identity of race and descent. Community of language, community of religion, greatly contribute to it. Geographical limits are one of its causes. But the strongest of all is identity of political precedents; the possession of national history and consequent community of recollections; collective pride and humiliation, pleasure and regret, connected with the same incidents in the past. None of these circumstances however are either indispensable, or necessarily sufficient by themselves.<sup>947</sup>

The tendency to relate as individuals and groups with nations (though acknowledging the difficulty inherent in defining the term 'nation'<sup>948</sup>) is, in this view, a fundamental aspect of the human experience. This helps to explain the multi-purpose role of geographic names in human lives and

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946. James Summers, *Peoples and International Law: How Nationalism and Self-Determination Shape a Contemporary Law of Nations* 20 (Martinus Nijhoff 2007) (internal citations omitted).

947. John Stuart Mill, *Considerations on Representative Government* 294 (Parker, Son & Bourn 1861).

948. See James Mayall, *Nationalism and international society* 2 (Cambridge University Press 1990).

specifically why a geographic name such as 'France' can serve not only the practical function of identifying a particular geographic location on a map but also the symbolic function of, to use Mill's term, the 'feeling of nationality' that is shared by the people of that location.

Effective articulation of one's 'feeling of nationality' is dependent upon having the freedom to make use of names and symbols representative of nationality. By corollary, governments' constraints on the use of national names and symbols impede the dynamic and ongoing processes of individual and group self-identification, ultimately impinging upon democratic freedom.<sup>949</sup> These tensions have crept into the online world, where they are likely amplified by three additional factors: the global reach of the internet as a communications medium, governments' limited ability to exert control due to their narrow role in internet governance, and the 'tremendous potential [of the internet] as a staging ground for identity-claims'.<sup>950</sup> The integral role that domain names play in online identification is unmistakably clear and has been so since the commercial launch of the DNS. Indeed, the primary reason for increasing the number of available gTLDs is to offer greater opportunity for under-represented communities to stake identity-claims in the internet.<sup>951</sup>

Even a cursory review of efforts at DNS policy-making in the ICANN environment reveals that most have had as their aim relieving what was identified early on as the 'considerable amount of tension [that] has unwittingly been created between, on the one hand, addresses on the Internet in a human-friendly form which carry the power of connotation and identification and, on the other hand, the recognized rights of identification in the real world ...'.<sup>952</sup> Particular attention has been paid to trademark rights; the efforts of that community to transpose its rights in the 'real' (in other words, 'offline') world to the 'online' world have been explored in detail in Chapter 3.

The trademark community's experience is illustrative of the trend of relying on offline identity to justify claims to online identity, but the ubiquity of the internet in contemporary human experience could just as easily give rise to the reverse situation, where online identity is used to justify claims to offline identity. Illustrative of this situation is the Occupied Territory of Palestine's experience in seeking the creation of its own ccTLD. Creation of a .ps domain was initially refused because of the absence of the two-letter country code 'PS' from the International Standardization Organization's ISO 3166-1 list, inclusion in which requires United Nations recognition.<sup>953</sup> Interim measures involving the creation of a Palestinian second-level domain

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949. See Coombe, 143.

950. Kyra Landzelius, *Introduction: Native on the net*, in *Native on the Net* 14 (Kyra Landzelius ed., Routledge 2006).

951. ICANN, *gTLD Applicant Guidebook*, Preamble.

952. WIPO, *WIPO I Report*, para. 22.

953. The process of ccTLD creation and delegation is discussed in Part I, Chapter 2, section 2.4.2 above.

within the .int gTLD, which would have resulted in domain names taking the form [www.examplername.palestine.int](http://www.examplername.palestine.int), were justified on the basis of Palestine's status as a Permanent Observer to the United Nations.<sup>954</sup> Palestinians were otherwise forced to choose between global gTLDs like .com and Israel's .is ccTLD.<sup>955</sup>

This example shows that in the modern world, offline and online identity are inextricably intertwined, and that achieving recognition of identity in the online world may for some be a milestone in an ongoing struggle for recognition of identity in the offline world.<sup>956</sup> It further shows that despite the trend of globalization, the world order is still heavily reliant upon States and state theory for legitimization. Palestine's status remains an issue of debate, but as a first step a .ps ccTLD required, and as a second step became part of, Palestine's claims to sovereignty. This helps to explain the significance attributed to .ps in its Domain Registration Policy, which states: 'Domain names under the .ps domain and the contents they point to, are considered virtual extensions of the Palestinian sovereignty with applicability of Palestinian law to the said extensions'.<sup>957</sup> The significance of the .ps domain has not been lost on the Palestinian internet community. In an early 2001 article, Ghassan Qadah, then-administrator of .ps and senior technology advisor to the Palestinian National Authority, characterized the ccTLD as an 'important symbol for the Palestinian state',<sup>958</sup> the creation of which represented a breakthrough in legitimacy in the eyes of the global community.

The process of creating and delegating ccTLDs remains tied to the ISO-3166-1 list, and those seeking their creation today will face the same challenges faced by the proponents of the .ps ccTLD more than a decade ago. Prior to the launch of the New gTLD Program, comparable difficulties were faced by applicants of new gTLDs, whose chance of success was severely hampered by ICANN's discretion and the tight quantitative limits placed in the two 'proof of concept' gTLD expansion rounds. The New gTLD Program is so significant because it is without quantitative limits: any application for a new gTLD meeting the criteria set out in the *gTLD Applicant Guidebook* will result in the creation of the applied-for string. This is a real opportunity

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954. See IANA, *Report on Request for Delegation of the .ps Top-Level Domain*, <http://www.iana.org/reports/ps-report-22mar00.htm> (22 Mar. 2000, accessed 15 Oct. 2012).

955. See Oscar S. Cisneros, *Dot-PS: Domain Without a Country*, *Wired.com* (12 Jan. 2001) (available at <http://wired.com/print/politics/law/news/2001/01/41135>).

956. 'The Palestinians' main objective was to achieve recognition for themselves not merely as refugees deserving of help on humanitarian grounds, but as a people with political aspirations.' David Hirst, *The Gun and the Olive Branch: The Roots of Violence in the Middle East* 461-462 (Thunder's Mouth Press/Nation Books 2003).

957. Palestinian National Internet Naming Authority, *PNINA Registration Policies and Procedures for Registering Domains under the .ps ccTLD*, section 2.2, <http://www.pnina.ps/domains/registration-policy/> (accessed 15 Oct. 2012).

958. Cisneros.

for previously unsuccessful as well as first time applicants to stake identity claims in the DNS.

Geographic new gTLDs may be desired by those who identify in the offline world with existing, recognized nations or territories and wish to transpose their offline identity onto the online environment just as trademark owners have done with their offline trademark rights. The human rights to expression, culture and language which are discussed in the subsequent sections of this chapter are most relevant to that situation. Others may, like the proponents of the .ps ccTLD, hope to facilitate the realization of their offline political aspirations through recognition of their online identity in the form of a top-level domain. For those applicants, ICANN's New gTLD Program represents an opportunity to establish an online national identity as a platform to acquiring offline national identity. The right of self-determination, also inherently linked to identity,<sup>959</sup> is also potentially relevant in that context. Before delving into the substance, scope and limitations of the rights of national identity and self-determination, however, a distinction should be made between their respective beneficiaries.

### 9.2.1.2 Beneficiaries of the Right to National Identity and Right of Self-determination

An initial distinction can be made between the right to national identity and the right of self-determination: in the case of the former, international law recognizes the rights of individuals while in the latter, international law recognizes the rights of peoples.<sup>960</sup> In other words, while the right to national identity follows the pattern of individual human rights, self-determination is collective in nature. This is not to suggest that individual rights may not also have the effect of protecting collective interests, but rather to emphasize that international law singles out certain groups for additional protection through the right of self-determination.<sup>961</sup>

The term 'peoples' is not clearly defined in the international conventions in which it is used, nor has a generally accepted definition emerged from the interpretation of those conventions.<sup>962</sup> This raises particular

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959. See Karen Knop, *Interpretation and Identity*, in *Diversity and Self-Determination in International Law* (Cambridge University Press 2002).

960. Common Articles 1(1) of the International Covenant on Civil and Political Rights and the International Covenant on Economic, Social and Cultural Rights provide: 'All peoples have the right of self-determination.' Further, the United Nations Charter provides in Article 1(2) that one of the purposes of the United Nations is to '[t]o develop friendly relations among nations based on respect for the principle of equal rights and self-determination of peoples, and to take other appropriate measures to strengthen universal peace' (emphasis added). By contrast, Article 15(1) of the Universal Declaration of Human Rights recognizes the right of 'everyone ... to a nationality'.

961. See Brownlie, 579-580.

962. See Martti Koskenniemi, *National Self-Determination Today: Problems of Legal Theory and Practice*, 43(2) *Int'l & Comp. L.Q.* 241 (1994).

challenges, although it has been suggested that the very fact of its being undefined is what makes the term 'peoples' so significant: 'If it is claimed that a group is a people there is no agreed standard against which that claim can be measured. It is purely a matter of perception. ... [This] may be a problem for lawyers, but it lubricates the politics of nationalism.'<sup>963</sup> Distinctions have been made between the terms 'peoples' and 'populations', with the former being 'generally regarded as implying a greater and more positive recognition of group identity and corresponding attributes of community.'<sup>964</sup> For reasons that are discussed in detail in the next section of this chapter, having the status of a 'people' has been equated with claims to independent statehood. The term 'populations', on the other hand, has traditionally been used to signify a lower level of recognition in international law, and it is this term that States prefer when a claim to rights is seen as a threat to sovereignty. This is a distinction that relies on a narrow positivist view,<sup>965</sup> and it has proven to be an obstacle to communities that do not fit within, and in some cases do not even aspire to fit within, the State-centric model.

A clear illustration of this problem is found in the efforts of indigenous peoples to achieve recognition under international law. It is in this context that much of the discussion of the beneficiaries of human rights takes place. The world's population has been said to include roughly 300 million indigenous people,<sup>966</sup> yet despite their numbers and the fact that they inhabit almost every part of the world, it is difficult to assess with precision their status under international law because of this problem of terminology. Some States are reluctant to use the phrase 'indigenous peoples' in the international law context because 'it is too close to the concept of "people"'<sup>967</sup> and thus the right of self-determination. In spite of this it has been argued that it is 'in any case proper to conclude that, as a matter of already existing international law, the principle or right of self-determination applies in one way or another to indigenous peoples.'<sup>968</sup> Why some States might continue to find this problematic turns on certain outdated conceptions of the substance of the contemporary right of self-determination.

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963. Summers, xlii (internal citations omitted).

964. Anaya, *Indigenous Peoples in International Law*, 60.

965. *Ibid.*, 101. See also Knop, 53-54.

966. See Alessandro Fodella, *International Law and the Diversity of Indigenous Peoples*, 30 *Vt. L. Rev.* 565, 566 (2006).

967. Summers, xliii. See also Anaya, *Indigenous Peoples in International Law*, 61-72.

968. Anaya, *Indigenous Peoples in International Law*, 112. See also Glenn T. Morris, *In Support of the Right of Self-Determination for Indigenous Peoples under International Law*, 29 *German Y.B. Int'l L.* 277 (1986).

### 9.2.1.3 Legal Basis, Status, and Substance of the Right of Self-determination

The right of self-determination is expressed in the UN Charter, which provides in Article 1(2) that one of the purposes of the United Nations is to 'develop friendly relations among nations based on respect for the principle of equal rights and self-determination of peoples, and to take other appropriate measures to strengthen universal peace'. This is supported by obligations under Article 55 to promote economic and social cooperation. The right of self-determination is codified as common Article 1(1) in the International Covenant on Civil and Political Rights (ICCPR) and the International Covenant on Economic, Social and Cultural Rights (ICESCR), by virtue of which peoples 'freely determine their political status and freely pursue their economic, social and cultural development.'

Because of its acknowledged<sup>969</sup> *jus cogens*<sup>970</sup> status, the right of self-determination 'informs and complements other general principles of international law, viz., of State sovereignty, the equality of states, and the equality of peoples within a State.'<sup>971</sup> Historically, the substance of the right of self-determination has been conjoined with its remedial aspects, the 'most controversial'<sup>972</sup> and prominent of which is secession. With the demise of colonialism and the inclusion of the right of self-determination in the ICCPR, however, it has been observed that a shift occurred from an externally-focused right to an internally-focused<sup>973</sup> right which:

ceased to be a rule applicable only to specific territories (at first, the defeated European powers; later, the overseas trust territories and colonies) and became a right of everyone. It also, at least for now, stopped being a principle of exclusion (secession) and also became one of inclusion: the right to participate. The right now entitles peoples in all

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969. See Crawford, 101; Brownlie, 580-581; Triggs, 995.

970. Art. 53 of the Vienna Convention on the Law of Treaties identifies *jus cogens* as 'a norm accepted and recognized by the international community of States as a whole as a norm from which no derogation is permitted and which can be modified only by a subsequent norm of general international law having the same character.'

971. See Brownlie, 582. See also Francisco Forrest Martin, *Delineating a Hierarchical Outline of International Law Sources and Norms*, 65(2) Saskatchewan L. Rev. 341, 343 (2002).

972. Sarah Joseph et al., *The International Covenant on Civil and Political Rights: Cases, Materials, and Commentary* 101 (Oxford University Press 2000). See also Anaya, *Indigenous Peoples in International Law*, 99 ('In its most prominent modern manifestation within the international system, self-determination has promoted the demise of colonial institutions of government and the emergence of a new political order for subject peoples.'). On the historical connection between self-determination and colonialization with specific examples, see Nathaniel Berman, *Sovereignty in Abeyance: Self-Determination and International Law*, 7 Wis. Int'l L.J. 51, 84-103 (1988).

973. See Rupert Emerson, *Self-Determination*, 465-466; Joseph et al., 101-104; Triggs, 996.

states to free, fair and open participation in the democratic process of governance freely chosen by each state.<sup>974</sup>

Accordingly, contemporary articulations of the right of self-determination recognize the right of peoples 'to be full and equal participants in the creation of the institutions of government under which they live and, further, to live within a governing institutional order in which they are perpetually in control of their own destinies.'<sup>975</sup> The right is thus called upon to help peoples 'assert their identities, to preserve their languages, cultures, and traditions and to achieve greater self-management and autonomy, free from undue interference from central governments.'<sup>976</sup> This broad understanding of self-determination acknowledges the human need to associate in and self-identify as members of groups<sup>977</sup> and not be unduly restricted in doing so. The right to self-determination so understood can be seen to prevent States from exercising control over identity symbols (such as geographic names) without the input of the peoples who identify with those symbols.

The right of self-determination does not, however, shed light on the existence of an exclusive right of States in geographic names. Rather, what the right of self-determination does is prevent States from taking unilateral, unconsulted decisions respecting the name by which a 'people' identifies. Unilateral, unconsulted decisions regarding the control of geographic names in the DNS could in this way be deemed analogous to State practices in the offline world that have the effect of forcibly incorporating indigenous peoples into a majority society to the detriment of their group identity, which in turn affects their ability to exercise their economic, social and cultural rights.<sup>978</sup> Arguably, a decision by a central government to deny a 'people' the ability to identify online by a particular name could prevent the group's preservation and expression of its identity, which could logically be seen to impinge upon the group's ability to exercise its economic, social and cultural rights.

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974. Thomas M. Franck, *The Emerging Right to Democratic Governance*, 86 Am. J. Int'l L. 46, 58-59 (1992).

975. Anaya, *Indigenous Peoples in International Law*, 113 (internal citations omitted).

976. Australian Government Delegation, Speaking Notes on Self-Determination, 2 (24 Jul. 1991), quoted in Anaya, *Indigenous Peoples in International Law*, 111.

977. See Thomas M. Franck, *Clan and Superclan: Loyalty, Identity and Community in Law and Practice*, 90 Am. J. Int'l L. 359, 376-382 (1996) (discussing 'identity as a personal act of self-determination').

978. As an example of such a case, see Inter-American Commission on Human Rights, *Report on the Situation of Human Rights of a Segment of the Nicaraguan Population of Miskito Origin and Resolution on the Friendly Settlement Procedure Regarding the Human Rights Situation of a Segment of the Nicaraguan Population of Miskito Origin*, O.A.S. Doc. OEA/Ser.L/V/II.62, doc. 10, rev. 3 (1983) OEA/Ser.L/V/II.62, doc. 26 (1984) (*Case No. 7964 (Nicaragua)*). On the links between participation and economic, social and cultural rights, see Richard Burchill, *Democracy and the Promotion and Protection of Socio-Economic Rights*, in *Economic, Social and Cultural Rights in Action* 375-379 (Mashood A. Baderin & Robert McCorquodale eds., Oxford University Press 2007).

Finally but importantly, the right of self-determination prevents particular actions taken by States. It does not prevent actions by non-State actors, amongst which notable in the context of this study is ICANN. A challenge could not be raised by a 'people' against ICANN asserting that its policies regarding geographic new gTLDs violate their right to self-determination. It would need to be considered whether such a challenge could be raised against the United States in order to compel ICANN, a corporation registered in that jurisdiction, to change its policy.<sup>979</sup>

#### 9.2.1.4 Legal Basis, Substance, and Limitations of the Right to National Identity

There is 'a growing consciousness [of the existence of a] personal right to compose one's identity',<sup>980</sup> and much has been written about national identity in particular national contexts.<sup>981</sup> International law recognizes a right to national identity,<sup>982</sup> but that right is of only limited application to geographic names.

The most direct articulation of a right to national identity can be found in Article 8 of the Convention on the Rights of the Child, which requires that 'States Parties undertake to respect the right of the child to preserve his or her identity, including nationality, name and family relations as recognized by law without unlawful interference.' Commentary indicates that 'the purpose of this provision is to prevent a child from being afforded less protection by the society and the State because he is stateless', not to 'make it an obligation for States to give their nationality to every child born in their territory.'<sup>983</sup> In other words, the concern is that children have *a* nationality rather than that they have *a particular* nationality.

Article 24(3) of the ICCPR recognizes the 'special'<sup>984</sup> right of all children to 'acquire a nationality'. Article 15(1) of the Universal Declaration

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979. See n. 923 above.

980. Franck, *Clan and Superclan*, 359.

981. See for example, Ahmet İçduygu & Özlem Kaygusuz, *The Politics of Citizenship by Drawing Borders: Foreign Policy and the Construction of National Citizenship Identity in Turkey*, 40(6) *Middle Eastern Studies* 26 (2004); Aneta Mihaylova, *National versus Regional Identity: the 'Other' Romanians in Greater Romania*, 1(2006) *Balkan Studies* 9 (2006); Nan Seuffert, *Jurisprudence of National Identity: Kaleidoscopes of imperialism and globalisation from Aotearoa New Zealand* (Ashgate 2006); Lauren Gilbert, *National Identity and Immigration Policy in the U.S. and the European Union*, 14(1) *Colum. J. Eur. L.* 99 (2007-2008); Jo Eric Khushal Murkens, 'We want our identity back': the revival of national sovereignty in the German Federal Constitutional Court's decision on the Lisbon Treaty, 2 *Bundesverfassungsgericht* 530 (2010).

982. See generally, Donner.

983. United Nations Office of the United Nations High Commissioner for Human Rights, *CCPR General Comment No. 17: Rights of the child (Art. 24)* para. 8 (1989) (available at <http://www.unhchr.ch/tbs/doc.nsf/0/cc0f1f8c391478b7c12563ed004b35e3?Opendocument>).

984. Nowak, 560.



of Human Rights, by contrast, recognizes the right of ‘everyone ... to a nationality’, while Articles 6 and 33 of the Declaration on the Rights of Indigenous Peoples similarly do so in respect of indigenous persons. These provisions support the conclusion that a person’s possession of some national identity is protected, but this has no bearing on a person’s right to possess a particular nationality.

The latter issue is one left to domestic law, as provided for in the 1930 Convention on Certain Questions in Relation to the Conflict of Nationality Laws<sup>985</sup> and confirmed in the seminal *Nottebohm* case, in which it was said that it ‘is for every sovereign State ... to settle by its own legislation the rules relating to the acquisition of its nationality, and to confer that nationality by naturalization granted by its own organs in accordance with that legislation.’<sup>986</sup> International law thus only imposes upon States an obligation to ensure that each person has an identity.

It is difficult to see how this right could be infringed by a policy of exclusive state control of geographic names, unless a decision to deny a person the right to identify him/herself online using a particular name puts that person’s possession of having any nationality at risk. At the same time, neither does the right to national identity offer specific support to States’ claims of exclusivity in geographic names. A person’s right to use a particular name in order to identify him or herself is more logically characterized in terms of a right of self-expression, so it is to this particular human right that focus now turns.

## 9.2.2 RIGHT TO FREEDOM OF EXPRESSION

### 9.2.2.1 Connections between Free Expression and Geographic Names

The tendency with which human beings identify themselves according to their nationality has been highlighted in the previous section of this chapter in order to draw a connection between geographic names and the human rights of national identity and self-determination. The same tendency can be relied upon in connecting geographic names and the human right to freedom of expression. Geographic names are integral to human vocabulary. Beyond their obvious roles as identifiers of a particular geographical location and their necessity in articulations of national identity, geographic names also help individuals to describe and articulate opinions and ideas about the world, its people, politics, culture, environment and products. Their broad

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985. Convention on Certain Questions in Relation to the Conflict of Nationality Laws, Art. 1. (12 Apr. 1930, entered into force 1 Jul. 1937) 179 L.N.T.S. 89.

986. *Nottebohm Case (second phase)*, Judgment of April 6th, 19 JJ, I.C.J. Reports 1955, p.4, 20-21. For an identification of rules commonly adopted by States to determine nationality, see Brownlie, 388-394.

range of uses, non-commercial and commercial, is evidenced by the multiplicity of potential sources of rights in them as identified and discussed in this and earlier chapters.

While being mindful of the sorts of restrictions against false or misleading use that have been examined in the previous chapter, it is difficult to discuss the world without being able to use the names that identify the subject of discussion. It has been remarked that '[a] news reporter cannot very well be expected to refer to "the football club based in Manchester, England" every time he or she wishes to report on the exploits of Manchester United.'<sup>987</sup> Taking this example one step further and focusing on geographic names rather than on trademarks, neither can a reporter (or indeed a school pupil, a journalist, a researcher or a person at the dinner table) be rationally expected to refer to 'the football club based in the second most populous urban district in the country that occupies two-thirds of the island nation located between roughly 54.5 and 52.2 degrees latitude and through which the prime meridian runs'.

Requiring that we communicate in this way when referring to geographic names would almost surely chill communication; this is not an end to which a society that favours intellectual and social development aspires.<sup>988</sup> This helps to explain why the right to free expression is considered one of the most fundamental of all human rights, and it opens the door to a correlative human right to express one's self using geographic names. Placing the articulation of geographic names in the DNS exclusively in the control of States arguably impinges upon this right, bearing in mind the potentially commercial as well as non-commercial nature of expression involving geographic names.<sup>989</sup>

### **9.2.2.2 Legal Basis, Substance, and Limitations of the Right to Freedom of Expression**

The right to free expression is 'not infrequently termed the core of the [International] Covenant [on Civil and Political Rights] and the touchstone for all other rights guaranteed therein.'<sup>990</sup> Article 19 of the ICCPR sets out the scope of the right as well as its limitations:

1. Everyone shall have the right to hold opinions without interference.
2. Everyone shall have the right to freedom of expression; this right shall include freedom to seek, receive and impart information and ideas of all

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987. Frederick M. Abbott et al., *International Intellectual Property in an Integrated World Economy* 271 (Aspen 2007).

988. See Joseph et al., 386.

989. See n. 830 above and accompanying discussion on the need to balance consumer protection with freedom of expression.

990. Nowak, 438 (internal citations omitted).

kinds, regardless of frontiers, either orally, in writing or in print, in the form of art, or through any other media of his choice.

3. The exercise of the rights provided for in paragraph 2 of this article carries with it special duties and responsibilities. It may therefore be subject to certain restrictions, but these shall only be such as are provided by law and are necessary:

- (a) For respect of the rights or reputations of others;
- (b) For the protection of national security or of public order (ordre public), or of public health or morals.

Paragraph 1 acknowledges the ‘right to hold opinions’. This right is interpreted as absolute in its passive form (possession), but pursuant to paragraphs 2 and 3, not absolute in its active form (expression).<sup>991</sup> This means that a person may hold whatever opinions he/she wishes in his/her mind, but the communication of those opinions to others may be restricted in certain situations.<sup>992</sup> The use of the term ‘opinions’ here is perhaps misleadingly limiting; it has been noted that the use of the phrase ‘information and ideas of all kinds’ in paragraph 2 was intended to signal that ‘every communicable type of subjective idea and opinion, of value-neutral news and information, of commercial advertising, art works, political commentary regardless of how critical, pornography, etc., is protected’,<sup>993</sup> including information and ideas expressed in commercial contexts or of a commercial nature.<sup>994</sup>

The broadly worded range of protected types and means of expression make it clear that the right to free expression applies to all types of expression, including expression made on the internet and irrespective of whether online activity is considered inherently commercial. This is a particularly significant point to the question of whether international law recognizes rights in geographic names, because many of the other bases of rights explored in the previous chapters of this book (trademarks, geographical indications, prevention of unfair competition, dilution, personality rights) rely on commercial activity. The right to free expression notably also applies irrespective of whether the act in question is considered political—even politically critical—expression.<sup>995</sup> It could thus potentially be called upon to

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991. See Joseph et al., 387.

992. See for example, *Faurisson v. France*, 4 I.H.R.R. 444 (Hum. Rts. Comm. 1996).

993. Nowak, 444.

994. See for example, *Ballantyne, Davidson, McIntyre v. Canada*, U.N. Doc. CCPR/C/47/D/359/1989 and 385/1989/Rev.1 (1993).

995. The individual’s right to engage in politically critical expression has been deemed paramount even where States have based this on national security and public order. See for example, *Mukong v. Cameroon*, 2 I.H.R.R. 131 (Hum. Rts. Comm. 1995).

defend the registration of a geographic domain name with a connotation that is considered undesirable by a relevant government.<sup>996</sup>

The right to freedom of expression may only be restricted in furtherance of the aims specified in ICCPR Article 19(3), about which it is recorded that 'more than 30 concrete proposals for restrictions'<sup>997</sup> were made in the drafting process. Of these 'most related to expression that instigates or incites to criminal actions or violent overthrow of the government, reveals State or trade secrets, undermines friendly relations with other States, impairs the independence of the judiciary, infringes rights of personality (honour, good reputation) or is pornographic or blasphemous.'<sup>998</sup> The final text takes a different approach, identifying not specific instances in which expression can be restricted, but rather permissible purposes justifying restriction. Of these, the purposes of protecting national security and public order ('ordre public') and ensuring respect for the rights of others have greater relevance to geographic names than the purposes of protecting public health or morals.

Protection of national security focuses on activities that pose 'serious cases of political or military threat to the entire nation',<sup>999</sup> Commonly falling within this ambit are disclosures of State secrets.<sup>1000</sup> This is clearly not relevant to the use of geographic names, save in the rare constellation in which revelation of a particular name in State secrets has the effect of identifying the State in question. The primary issue in such a case is, in any event, the revelation of the secret rather than the use of the State's name. Such a constellation would also implicate the right to freedom of information recognized in Article 2(1) of the UNESCO Convention on the Protection and Promotion of the Diversity of Cultural Expressions, which is qualified by Article 19(3) allowing for restrictions on the basis of '[r]espect of the rights or reputations of others' and 'protection of national security or of public order (ordre public), or of public health or morals'. Yet in practice, national security has been treated more broadly, merging with 'public order', which is directed at activities that affect the 'peaceful and effective functioning of society'.<sup>1001</sup> Accordingly, restrictions are commonly aimed at the sorts of expressions 'which may incite crime, violence or mass panic'<sup>1002</sup> but would also apply to expressions advocating the overthrow or de-stabilization of a government.

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996. An example is the [www.tamilnet.com](http://www.tamilnet.com) website, discussed in Mark Whitaker, *Internet counter counter-insurgency: TamilNet.com and ethnic conflict in Sri Lanka*, in *Native on the Net* 255-271 (Kyra Landzelius ed., Routledge 2006).

997. Nowak, *U.N. Covenant on Civil and Political Rights: CCPR Commentary*, 457.

998. *Ibid.*

999. *Ibid.*, 463-464.

1000. See Joseph et al., 400.

1001. *Ibid.*, 396.

1002. *Ibid.*, 396 and 401, citing *Kim v. Republic of Korea* (574/94) and *Park v. Republic of Korea* (628/95).

While geographic names could be (and indeed have been, as the Catalonian linguistic community's experience with the .cat gTLD application demonstrates<sup>1003</sup>) interpreted as an expression of destabilizing sentiments, this is countered by the fact that geographic names are not inherently politically threatening. They are not inherently fighting words, nor are they inherently directed at inciting the sorts of grave situations to which national security and public order are directed. They could plausibly be seen to indirectly play a role in inciting 'crime, violence, or mass panic', but such a determination is entirely dependent on the context in which they are used, bearing in mind the need to 'specify the precise nature of the threat allegedly posed by the author's exercise of freedom of expression.'<sup>1004</sup>

A stronger case can be made that a second- or lower level domain name has the potential to incite 'crime, violence or mass panic' than a gTLD string because of the connection between lower level domain names and content. The function of a top-level domain, by contrast, is not to identify content but to provide a service, a channel of communication. An indirect link to content could be made by targeting a top-level domain at particular domain name registrants (e.g., a policy of restricting domain name registration to members of an anti-government group), but this is clearly an exception and not the rule. Restricting all uses of geographic names on this basis would surely prove excessive and unnecessary. Rather, the determination that a name disrupts national security or public order can be made on a case-by-case basis only.

This conclusion has special significance to applications for new gTLDs because of the provision within the *gTLD Applicant Guidebook* of a 'limited public interest objection' (what in earlier drafts was termed the 'morality and public order exception').<sup>1005</sup> Each objection made on this ground must likewise be considered on a case-by-case basis. In relying on this objection, governments should take care to specify the precise nature of the threat to national security or public order. A statement of discomfort with an applied-for name, as is made possible by the *gTLD Applicant Guidebook* in its provision for 'early warning' by the Governmental Advisory Committee (GAC),<sup>1006</sup> will not suffice to satisfy States' obligations under Article 19(3)(b) of the ICCPR.

Lastly, restrictions of expression are permitted for the purpose of ensuring 'respect of the rights or reputations of others'. This study could hopefully be of use in this regard. The existence of multiple sources of

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1003. The .cat gTLD application is discussed in Part I, Chapter 1, section 1.2.2.3 above.

1004. *Keun-Tae Kim v. Republic of Korea*, para. 12.5, U.N. Doc. CCPR/C/64/D/574/1994 (U.N. Hum. Rts. Comm. 1999).

1005. ICANN, *gTLD Applicant Guidebook*, section 3.2.1. On the potential applicability of the so-called 'limited public interest objection' to geographic new gTLD applications, see Part I, Chapter 1, section 1.2.2.3 above.

1006. ICANN, *gTLD Applicant Guidebook*, section 1.1.2.4. See also ICANN, *New gTLD Program Explanatory Memorandum: Early Warning*.

potentially conflicting rights in geographic names revealed in this study requires that States consider and prioritize in the application of Article 19(3)(a) of the ICCPR these multiple interests proportionately in domestic law. It is not at all clear how this can be achieved in the context of the DNS, however, given that the delegation of a new gTLD to one applicant has the practical effect of denying all others across the globe the use of that name as a top-level domain string. This problem is exacerbated by a policy of rejecting strings on the basis of confusing similarity.<sup>1007</sup>

Recent experience suggests that the winner in a contest between self-expression rights and property rights is increasingly likely to be a property rights holder.<sup>1008</sup> This raises interesting implications that go beyond mere domain name disputes into the realm of freedom and liberty, and the formation of DNS policy offers an opportunity to explore these. The challenge that arises not only in the exercise of the right to freedom of expression but all of the human rights considered in this chapter is that to the extent that persons or 'peoples' have a right to use a geographic name, that right can only practically be exercised in the context of top-level domains by one registry operator (or, in respect of a community based application, by one operator on behalf of a community). These issues lie beyond the scope of this study, but are raised here for future discussion.

A more general question is whether the right to freedom of expression encompasses a right to express oneself using a geographic name. This is a right the exercise of which depends entirely on context. It would be difficult to specify beyond the general limitations articulated in Article 19(3) of the ICCPR situations in which a person's expression of a geographic name must categorically be prohibited. ICANN should for that reason avoid imposing such a blanket prohibition in new gTLD policy. It is further the case that Article 19 of the ICCPR does not require the prohibition of expression in any form or for any purpose; rather, it gives States the possibility of imposing restrictions where these can be duly justified. This neither specifically proves nor denies the existence of an exclusive right of States to geographic names, though it does at least suggest that multiple interests may exist in names, which in turn suggests non-exclusivity. It also indicates that where restrictions imposed by States have the effect of impinging upon free expression, those restrictions must be for one of the purposes identified in Articles 19(3)(a) or (b). The likelihood of those circumstances being present in the context of an application to ICANN for a new gTLD is remote. In summary, arguments justifying restrictions on geographic gTLDs for the purposes of national security or public order must be individually scrutinized rather than assumed.

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1007. See ICANN, *gTLD Applicant Guidebook*, section 2.2.1.1.2.

1008. See Wendy Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 Yale L.J. 1533, 1537 (1993) (positing that '[t]he incantation "property" seems sufficient to render free speech issues invisible').

9.2.3 RIGHT TO CULTURE

9.2.3.1 Connections between Culture and Geographic Names

Although certainly not confined by geographical boundaries, culture is inherently linked to geography. Many aspects of culture are drawn from the land, with climate, topography, presence of natural resources, proximity to neighbours and sea access, among other things, having an impact on how people interpret their surroundings.<sup>1009</sup> These interpretations and the ways in which people express them through such things as music, arts, literature, lifestyle, religious beliefs and traditions meld together to form culture, which the United Nations Educational, Scientific and Cultural Organization (UNESCO) defines as the 'set of distinctive spiritual, material, intellectual, and emotional features of a society or a social group'.<sup>1010</sup> The people that share these features often, though not always, also share geographical location. Sometimes the link between geography and culture is not recent, relying instead on historic places. An example of this is Indonesia's attempt to develop a national culture following independence through initiatives that included the creation of a new national motto expressed in an ancient language no longer in use but 'connected to the past of ancient feudal kingdoms on Java and Bali, with few remaining links to the rest of Indonesia'.<sup>1011</sup> One can also point to geographic name changes motivated by decolonization and inspired by names of places of historical significance, including Bombay/Mumbai<sup>1012</sup> and Burma/Myanmar.<sup>1013</sup>

Geographic names can be considered representative or symbolic of a nation and its culture, though the appropriateness of the term 'national culture' is debatable. Few, if any, modern States are mono-cultural.<sup>1014</sup> To the extent that there is a recognized 'national culture', this is likely to be the culture of a dominant majority, the promotion of which at one extreme risks eliminating minority cultures. At the other extreme lies the appropriation of minorities' cultural symbols into national culture without the support or

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1009. See Johanna Gibson, *The lay of the land: the geography of traditional cultural expression*, in *Intellectual Property and Traditional Cultural Expressions in a Digital Environment* 182-204 (Christoph Beat Graber & Mira Burri-Nenova eds., Edward Elgar 2008); Triggs, 319-323.

1010. Universal Declaration on Cultural Diversity, Preamble, adopted by the UNESCO General Conference on 2 Nov. 2001, 31C/Resolution 25.

1011. Christoph Antons, *Traditional cultural expressions and their significance for development in a digital environment: examples from Australia and Southeast Asia*, in *Intellectual Property and Traditional Cultural Expressions in a Digital Environment* 289 (Christoph Beat Graber & Mira Burri-Nenova eds., Edward Elgar 2008).

1012. See generally, Thomas Blom Hansen, *Wages of violence: naming and identity in postcolonial Bombay* (Princeton University Press 2001).

1013. See generally, Gustaaf Houtman, *Mental culture in Burmese crisis politics: Aung San Suu Kyi and the National League for Democracy* 43-47 (Institute for the Study of Languages & Cultures of Asia & Africa 1999).

1014. See McGoldrick, 450.

permission of the affected minorities.<sup>1015</sup> The focus in discussions of protecting and promoting cultural rights is therefore less on nations and more on minority and particularly indigenous groups within nations, based on the assumption 'that majorities can take care of, and protect, their own dominant culture.'<sup>1016</sup>

Indigenous peoples' culture is particularly linked to geography because the characterization of a people as 'indigenous' generally points to the inhabitation of a particular geographic territory.<sup>1017</sup> Western thinking on indigeness tends to go one step further by identifying the group as the first inhabitants of a territory, meaning that they lived in the geographic location prior to the arrival of colonizing outsiders.<sup>1018</sup> The cultural rights of indigenous peoples so-defined are therefore called upon to 'preserve, develop and transmit to future generations their ancestral territories, and their ethnic identity, as the basis of their continued existence as peoples, in accordance with their own cultural patterns, social institutions and legal systems'.<sup>1019</sup> In other parts of the world, indigeness is not seen as dependent on colonization or minority status; in some countries 'the majority or even the whole population'<sup>1020</sup> is characterized as indigenous. In practice, the lack of an agreed definition of 'indigenous people' makes it difficult to apply these understandings to real-life disputes. Further, as recognized at the beginning of this chapter, some States are reluctant to formally recognize the link between 'indigenous peoples' and territory out of concerns that this could lead to claims of independent statehood.<sup>1021</sup>

Even without an agreed legal definition of 'indigenous peoples', it is clear that indigeness involves a connection to geographic territory. For many indigenous groups, the relationship with land and their environment has great significance to their culture.<sup>1022</sup> For these groups in particular, the names used to identify the land may have a cultural meaning beyond mere identification; members may wish to call upon the human right to culture to

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1015. See for example, *Harold Joseph Thomas v. David George Brown & James Morrison Vallely Tennant*, 215 F.C.A. (Fed. Ct. Aust'l 1997).

1016. McGoldrick, 452.

1017. See Anaya, *Indigenous Peoples in International Law*, 3; Landzelius, *Introduction: Native on the net*, 34 n. 5 (offering the following definition of 'indigenous' as 'conventional': 'disadvantaged descendants of those peoples that inhabited a territory prior to formation of a state').

1018. See Jeremy Waldron, *Indigeneity? First Peoples and Last Occupancy*, 1 N.Z. J. Pub. & Int'l L. 55 (2002).

1019. Landzelius, *Introduction: Native on the net*, 34 n. 5, quoting International Work Group for Indigenous Affairs ([www.iwgia.org](http://www.iwgia.org)).

1020. Antons, 291.

1021. See Anaya, *Indigenous Peoples in International Law*, 65. See also discussion earlier in this chapter, at Part III, Chapter 9, section 9.2.1.3, on the right of self-determination.

1022. See Fodella, 565-566.



protect this from misuse or misappropriation by others who do not comprehend its significance.<sup>1023</sup> Further, to deprive such a group of the free use of its name may impinge upon its ability to interact materially and intellectually, to preserve and create its culture.

### 9.2.3.2 Legal Basis and Substance of the Right to Culture

The human right to culture is widely recognized in human rights law instruments, both binding and non-binding: it is provided for in varying terms in the Universal Declaration of Human Rights (Articles 22 and 27), the ICESCR (Article 15(1)(a)), the ICCPR (Article 27), the Convention on the Rights of the Child (Article 30) and the Declaration on the Rights of Indigenous Peoples (Articles 8, 11 and 31), and it is the focus of UNESCO's Convention on the Protection and Promotion of Cultural Diversity of Cultural Expressions<sup>1024</sup> and the Convention for the Safeguarding of Intangible Cultural Heritage.<sup>1025</sup> Each of these instruments refers in some way to a right to participate in or practice a culture, but none expressly acknowledges a right to possess a culture. Article 15(1)(a) of the ICESCR is illustrative of this point: it specifically recognizes 'the right of everyone (a) To take part in cultural life', and 'the participatory element has been interpreted as including a right to express one's own cultural life.'<sup>1026</sup> Yet it must logically be said that a 'right to participate in a culture can only exist if there is a culture'.<sup>1027</sup> This argument is supported by the specific obligation imposed upon States by Article 15(2) to 'conserve, develop and diffuse culture.'

Beyond this right of all persons to 'take part' in culture, members of minorities are specifically afforded rights to 'enjoy' their cultures. Article 27 of the ICCPR relevantly provides:

In those States in which ethnic, religious or linguistic minorities exist, persons belonging to such minorities shall not be denied the right, in community with the other members of their group, to enjoy their own culture, to profess and practice their religion, or to use their own language.

The cultural rights of children of minority groups are recognized in similar terms in Article 30 of the Convention on the Rights of the Child.<sup>1028</sup> Articles

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1023. See Antons, 296.

1024. Convention on the Protection and Promotion of the Diversity of Cultural Expressions (18 Dec. 1990, entered into force 18 Mar. 2007) 33C/Res. 42.

1025. Convention for the Safeguarding of the Intangible Cultural Heritage (17 Oct. 2003, entered into force 20 Apr. 2006) 32C/Res. 32.

1026. McGoldrick, 453.

1027. *Ibid.*, 454.

1028. Convention on the Rights of the Child, Art. 30 (20 Nov. 1989, entered into force 2 Sep. 1990), 44 U.N. GAOR Supp. (No. 49) at 167, U.N. Doc. A/44/49 (1989): 'In those

8, 11 and 31 of the Declaration on the Rights of Indigenous Peoples<sup>1029</sup> relatedly call for the recognition of cultural rights of indigenous peoples.

Certain difficulties arise in the application of cultural rights to counter States' claims of exclusive rights in geographic names and their use in the DNS. First, the substance of the right to culture is very much in debate because of the fact that culture 'is not a static concept: cultures change all the time'.<sup>1030</sup> Nor is culture a universal concept such that it could be definitively said that a right to control or use geographic names is an essential aspect of all cultures. Jurisprudence in this area reveals that a determination that the right to culture encompasses a right to control or use a geographic name depends upon the importance of the name in question to the existence of the particular culture in question.

A further issue arises in that even if it is determined that the use of a geographic name is integral to a particular culture, it is not axiomatic that a policy of exclusive State control over geographic names impinges upon the right of persons, children or minorities to take part in or enjoy their culture. That Article 15 of the ICESCR specifically provides for the 'right *freely* to participate' (emphasis added) is significant, however, in that restrictions on the right to use a geographic name are patently inhibitive of *free* participation. In the context of the DNS and given the integral role played by the internet in creating, preserving and communicating culture,<sup>1031</sup> a policy of requiring government authorization of applications for geographic new

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States in which ethnic, religious or linguistic minorities or persons of indigenous origin exist, a child belonging to such a minority or who is indigenous shall not be denied the right, in community with other members of his or her group, to enjoy his or her own culture, to profess and practise his or her own religion, or to use his or her own language.'

1029. United Nations Declaration on the Rights of Indigenous Peoples, adopted by the General Assembly 2 Oct. 2007, G.A. Res. A/RES/61/295:

Art. 8(1): Indigenous peoples and individuals have the right not to be subjected to forced assimilation or destruction of their culture.

Art. 11(1): Indigenous peoples have the right to practise and revitalize their cultural traditions and customs. This includes the right to maintain, protect and develop the past, present and future manifestations of their cultures, such as archaeological and historical sites, artefacts, designs, ceremonies, technologies and visual and performing arts and literature.

Art. 31(1): Indigenous peoples have the right to maintain, control, protect and develop their cultural heritage, traditional knowledge and traditional cultural expressions, as well as the manifestations of their sciences, technologies and cultures, including human and genetic resources, seeds, medicines, knowledge of the properties of fauna and flora, oral traditions, literatures, designs, sports and traditional games and visual and performing arts. They also have the right to maintain, control, protect and develop their intellectual property over such cultural heritage, traditional knowledge, and traditional cultural expressions.

1030. Lyndel V. Prott, *Cultural Rights as Peoples' Rights in International Law*, in *The Rights of Peoples* 95 (James Crawford ed., Oxford University Press 1992).

1031. See Kathryn Bowrey, *Law & Internet Cultures* (Cambridge University Press 2005); Mira Burri-Nenova, *The long tail of the rainbow serpent: new technologies and the protection*

gTLDs would arguably require involvement of the State to a degree that impinges upon *free* participation in online cultural life. While there are no cases on these specific facts, an analogy can be drawn from other ‘offline’ constellations. In the case of *Ominayak v. Canada*,<sup>1032</sup> for example, it was argued that the survival of the Lubicon Lake Band people depended upon their connection to the land, which was integrally connected to their culture. Because of this integral connection between land and culture, Article 27 of the ICCPR was deemed infringed by the Canadian government having allowed the provincial government of Alberta to grant leases for oil and gas exploration on lands belonging to the Lubicon Lake Band. A similar argument could be made in a situation where a State denies members of a cultural group the ability to identify themselves in the online environment using a geographic domain name or string.

In summary, there is no general right to culture that universally and in all cases supports a corresponding right of members of cultural groups to control or make use of a geographic name. Such a right does exist, but is limited to members of a cultural group in which a geographic name is integral. Nevertheless, the existence of this right serves to refute the exclusivity of rights claimed by States in geographic names. It also places restrictions on State decision-making respecting the use of geographic names by others.

### 9.2.3.3 Promoting Cultural Diversity

Beyond the individual’s right to participate in culture, there is also increasing emphasis in international legal discourse on humanity’s interest in cultural diversity.<sup>1033</sup> These interests have not yet developed into norms that recognize rights to culture, however. UNESCO’s Convention on the Protection and Promotion of Cultural Diversity of Cultural Expressions (the ‘UNESCO Convention’) is the most prominent example: it does not create rights respecting culture or cultural diversity. The obligations set out in that convention are not absolute, being articulated in the following terms: in Article 6, ‘each Party *may* adopt measures aimed at protecting and promoting the diversity of cultural expressions within its territory’ (emphasis added) and

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*and promotion of traditional cultural expressions, in Intellectual Property and Traditional Cultural Expressions in a Digital Environment* 205-236 (Christoph Beat Graber & Mira Burri-Nenova eds., Edward Elgar 2008).

1032. *Ominayak, Chief of the Lubicon Lake Band v. Canada*, Communication No. 267/1984, Report of the Human Rights Committee U.N. GOAR, 45th Sess., Supp. No. 40, Vol. 2, at 1, U.N. Doc. A/45/40, Annex 9(A) (1990).

1033. See for example, Cottier, *The Agreement on Trade-Related Aspects of Intellectual Property Rights*, 170; Fodella, *International Law and the Diversity of Indigenous Peoples; Accommodating cultural diversity* (Stephen Tierney ed., Ashgate 2007); *Cultural Diversity, Heritage and Human Rights: Intersections in theory and practice* (Michele Langfield et al. eds., Routledge 2010).

in Article 7, ‘shall endeavour to create in their territory an environment which encourages individuals and social groups’ (emphasis added). This has no bearing on the existence or exclusivity of State rights in geographic names, but the UNESCO Convention is nevertheless indirectly relevant to DNS policy on geographic names.

Geographic names per se are not inherently an element of cultural diversity,<sup>1034</sup> but their use in the context of the DNS has tremendous potential in terms of facilitating cultural diversity by providing a channel for the creation and dissemination of cultural expression. States party to the UNESCO Convention are not specifically obliged to enact measures respecting domain names in order to promote or preserve cultural diversity. The UNESCO Convention does recognize that in making decisions to promote or protect cultural diversity, States may have to prioritize conflicting interests. This is critical in the context of competing claims arising from the exercise of cultural rights, the possibility of which is not sufficiently acknowledged or addressed by other multilateral treaties respecting the right to culture, including the ICCPR and the ICESCR.

Prioritization of conflicting cultural interests is, understandably, entirely avoided by ICANN in the *gTLD Applicant Guidebook*. The rough guidance offered by the Convention on the Protection and Promotion of Cultural Diversity of Cultural Expressions as to how such competing claims might be addressed could nevertheless be useful to identifying the considerations that should be borne in mind in the resolution of disputes involving culturally significant gTLD strings.

#### 9.2.3.4 Cultural Property

Another growing area of discourse in the area of cultural rights relates to cultural property.<sup>1035</sup> The notion of culture as property is largely based upon

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1034. The term ‘cultural diversity’ is defined in Art. 4(1) of the UNESCO Convention as ‘the manifold ways in which the cultures of groups and societies find expression. These expressions are passed on within and among groups and societies. ... [It] is made manifest not only through the varied ways in which the cultural heritage of humanity is expressed, augmented and transmitted through the variety of cultural expressions, but also through diverse modes of artistic creation, production, dissemination, distribution and enjoyment, whatever the means and technologies used’.

1035. See generally, John Henry Merryman, *Two Ways of Thinking About Cultural Property*, 80(4) *Am. J. Int’l L.* 831 (1986); Lyndel V. Prott, *Problems of Private International Law for the Protection of the Cultural Heritage*, 217 *Recueil des Cours de l’Academie de la Haye* 301 (1989); Fiona Macmillan, *Human rights, cultural property and intellectual property: three concepts in search of a relationship*, in *Intellectual Property and Traditional Cultural Expressions in a Digital Environment* (Christoph Beat Graber & Mira Burri-Nenova eds., Edward Elgar 2008); Jürgen Bröhmer & Jennifer Greaney, *Der Schutz der Kulturgüter der australischen Ureinwohner*, in *Verfassung – Völkerrecht – Kulturgüterschutz* (Michaela Wittinger, Rudolf Wendt & Georg Röss eds., Duncker & Humblot 2011).

Western intellectual property doctrines, but at the same time also awkwardly depends on the application of those doctrines to 'cross-cultural claims that cannot be addressed solely by reference to values that have traditionally been embedded within the legal commentaries on property.'<sup>1036</sup> While the use of the term 'property' in this discourse unmistakably 'implies control in the form of an ability to alienate, exploit and exclude others'<sup>1037</sup> as possessed by a single individual, the added cultural element implies a different rationale for this protection than pure commercial interest. Thus cultural property differs from other forms of property in significant ways:

first, that it is 'owned' in common or, at least, publicly; secondly, that the ownership rights focus on preservation, access and the sharing of benefits associated with it; and thirdly, that the role of cultural property rights is to prevent or limit the privatization of cultural property.<sup>1038</sup>

Discussion of legal protection for cultural property diverges into two broad themes: protection of 'cultural expressions' and protection of 'traditional knowledge'. For neither of these terms is there an agreed definition and likewise for neither is there yet an agreed legal protection framework. These concepts are nevertheless arguably the principal focus of today's international intellectual property law development efforts. The volume of scholarship on cultural expressions and traditional knowledge means that an examination of whether either of these encompasses a particular subject matter such as geographic names constitutes a study unto itself. Such a detailed enquiry lies outside of the scope of this work, but the considerable recent effort expended at the international level in the contexts of human rights, international trade law<sup>1039</sup> and intellectual property law<sup>1040</sup> demands that the potential of cultural expressions and traditional knowledge as

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1036. Tatiana Flessas, *Cultural Property Defined, and Redefined as Nietzschean Aphorism*, 24 *Cardozo L. Rev.* 1067, 1068 n. 3 (2003), quoted in *The Resolution of Cultural Property Disputes: Some Issues of Definition* 55 (Kathryn Last ed., Kluwer Law International 2004).

1037. *The Resolution of Cultural Property Disputes* 55 (Kathryn Last ed.).

1038. Macmillan, *Human rights, cultural property and intellectual property*, 91.

1039. The scope for protecting cultural property in international trade law beyond the narrow issue of geographical indications (which is discussed later in this chapter in the context of traditional knowledge) is being considered, but as the UN Sub-Commission for the Protection and Promotion of Human Rights resolution on 'Intellectual Property and Human Rights' warns, it is necessary to be aware of 'actual or potential conflicts that exist between the implementation of TRIPS and the realization of economic, social and cultural rights.' United Nations Sub-Commission on Human Rights, *Resolution 2000/7: Intellectual Property Rights and Human Rights*, U.N. Doc. E/CN.4/SUB.2/RES/2000/7 (2000). For detailed discussion on this issue, see for example, Pamela Samuelson, *Implications of the Agreement on Trade Related Aspects of Intellectual Property Rights for Cultural Dimensions of National Copyright Laws*, 23(1-2) *J. Cult. Econ.* 95 (1999); John Henry Merryman, *Cultural Property, International Trade and Human Rights*, 19 *Cardozo Arts & Ent. L.J.* 51 (2001); Cottier, *The Agreement on Trade-Related Aspects of*

existing or future sources of rights in geographic names be raised here for later, thorough consideration.

#### 9.2.3.4.1 *Geographic Names as Cultural Expressions*

The term ‘cultural expression’ has been encountered in earlier sections of this chapter in the context of the human right to culture and the promotion of cultural diversity. There, it was noted that the UNESCO Convention creates no binding obligations on State parties with respect to cultural expressions, which are defined in Article 4(3) as ‘those expressions that result from the creativity of individuals, groups and societies, and that have cultural content.’ What the UNESCO Convention does is acknowledge the role that cultural expressions play in society and, controversially, the ‘complementarity of economic and cultural aspects of development’.<sup>1041</sup> With these things in mind, the UNESCO Convention offers States guidance on the implementation of measures aimed at promoting and protecting the diversity of cultural expressions.

The World Intellectual Property Organization takes a different approach, focusing instead on intellectual property law frameworks. In June 2011, its Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (the ‘Intergovernmental Committee’) released draft articles on the protection of ‘traditional cultural expressions’ (or ‘TCEs’, as they are also known).<sup>1042</sup> In draft alternative forms,<sup>1043</sup> the articles propose to define the subject matter of protection using key intellectual property (of which in particular copyright) terminology.

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*Intellectual Property Rights*; Fiona Macmillan, *Copyright, the World Trade Organization and Cultural Self-Determination*, in *New Directions in Copyright Law* (Fiona Macmillan ed., Edward Elgar 2007).

1040. See for example, Cottier & Panizzon, *Legal Perspectives on Traditional Knowledge*; Peter K. Yu, *Intellectual Property and Human Rights in the Nonmultilateral Era*, 64 Fla. L. Rev. 1045, 1072 (2012).

1041. Convention on the Protection and Promotion of the Diversity of Cultural Expressions, Art. 2(5).

1042. WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, *Initial Draft Report*, WIPO Doc. WIPO/GRTKF/IC/18/11 Prov. (2011) (available at [http://www.wipo.int/edocs/mdocs/tk/en/wipo\\_grtkf\\_ic\\_19/wipo\\_grtkf\\_ic\\_19\\_ref\\_grtkf\\_18\\_11\\_prov.pdf](http://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_19/wipo_grtkf_ic_19_ref_grtkf_18_11_prov.pdf)).

1043. WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, *The Protection of Traditional Cultural Expressions: Draft Articles*, WIPO Doc. WIPO/GRTKF/IC/22/4 (2012) (available at [http://www.wipo.int/edocs/mdocs/tk/en/wipo\\_grtkf\\_ic\\_22/wipo\\_grtkf\\_ic\\_22\\_4.pdf](http://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_22/wipo_grtkf_ic_22_4.pdf)). See also WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, *Like-Minded Countries Contribution to the Draft Articles on the Protection of Traditional Cultural Expressions*, WIPO Doc. WIPO/GRTKF/IC/22/5 (2012) (available at [http://www.wipo.int/edocs/mdocs/tk/en/wipo\\_grtkf\\_ic\\_22/wipo\\_grtkf\\_ic\\_22\\_5.pdf](http://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_22/wipo_grtkf_ic_22_5.pdf)).

The protection envisaged by draft Article 3 is, in both proposed options, likewise broadly reliant upon intellectual property terminology. On the other hand, the 'Glossary of Key Terms Related to Intellectual Property and Genetic Resources, Traditional Knowledge and Traditional Cultural Expressions' updated and published by the Secretariat in early 2012<sup>1044</sup> evidences the need to extend beyond intellectual property in understanding these culture-based concepts. A more significant difference between the UNESCO Convention and the WIPO Draft Articles than terminology is the fact that the latter creates rights and clear obligations respecting cultural expressions, whilst the former does not.

Both instruments attribute a relatively wide scope of subject matter as falling within 'cultural expressions', but they do so using different approaches, with UNESCO focusing on cultural content and WIPO focusing on the form of expression. This is a direct result of differing motivations of human rights law and intellectual property law. Despite these differences, an argument can be made that geographic names fall within the scope of the protected subject matters of both of these instruments. WIPO's Draft Articles are the most clearly applicable given their express inclusion in sub-paragraph (a) of 'names' as covered subject matter. Falling within the UNESCO Convention's definition of 'cultural expression', on the other hand, depends on a name's having such a strong link to a culture that it can be considered 'cultural content'. The requirement that protected subject matter 'result from the creativity of individuals, groups and societies' may prove an obstacle to geographic names' protection given that they are often inspired by historic, geographic or other features rather than being the product of human creativity. In this geographic names differ from things that would typically be characterized as creative cultural expressions, such as music, dance, stories and artworks.

Even if geographic names fall within either of these definitions of cultural expressions, no binding obligations have as-yet been created for their protection. Surveys conducted as part of WIPO's Cultural Heritage Project<sup>1045</sup> evidence the fact that protection of TCEs is at this stage still a work in progress even at the domestic level. Work within WIPO's Intergovernmental Committee to finalize the Draft Articles is ongoing and appears to be making progress. This is an area of high potential for the recognition of rights in geographic names in the (perhaps even near) future, but not currently a source of legal rights in geographic names under international law.

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1044. WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, *Glossary of Key Terms Related to Intellectual Property and Genetic Resources, Traditional Knowledge and Traditional Cultural Expressions*, WIPO Doc. WIPO/GRTKF/IC/22/INF/8 (2012) (available at [http://www.wipo.int/edocs/mdocs/tk/en/wipo\\_grtkf\\_ic\\_22/wipo\\_grtkf\\_ic\\_22\\_4.pdf](http://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_22/wipo_grtkf_ic_22_4.pdf)).

1045. WIPO, *Creative Heritage Project: Surveys of Existing Practices, Protocols and Policies*, <http://www.wipo.int/tk/en/culturalheritage/surveys.html> (accessed 15 Oct. 2012).

9.2.3.4.2 *Geographic Names as Traditional Knowledge*

While the term 'cultural expression' tends to focus upon the results of creativity (the *what* of culture), the term 'traditional knowledge' tends to focus upon creative energies themselves (the *how* of culture). Though it too lacks an agreed definition, 'traditional knowledge' is broadly understood as something of value to a community because of its production and use by that community often (though not necessarily) over a lengthy period of time.<sup>1046</sup> It is also frequently associated with the relationship between people and the environment in which they live. Accordingly, traditional knowledge may include knowledge of 'plants and animals and their properties; minerals and soils and their properties; combinations of organic and inorganic matters; processes and technologies; means of enhancing individual health and welfare; means of enhancing collective health and welfare; [and] artistic expressions.'<sup>1047</sup> The medicines, healing practices, religious ceremonies, handicrafts and other ways of life that are derived from this knowledge are valuable to the communities that develop and use them in terms of the community's continued ability to survive and thrive, but they may also have commercial value to outsiders. The incidence of outsiders appropriating and using traditional knowledge, particularly when this occurs without compensation, has given rise to interest in its protection.

The potential subject matter of traditional knowledge covers a broad range of activities. This is reflected in the variety of participants involved in efforts to protect it at the international level, including the World Intellectual Property Organization, the World Trade Organization, the United Nations' Food and Agriculture Organization, the United Nations Conference on Trade and Development, the United Nations Educational, Scientific and Cultural Organization, and the World Health Organization.<sup>1048</sup> There are not yet any multilateral conventions of global force that specifically protect 'traditional knowledge' as a discrete subject matter, though the Convention on Biological Diversity<sup>1049</sup> represents a significant step forward for the protection of the biological resources upon which many forms of traditional knowledge are based.

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1046. See Antony Taubman & Matthias Leistner, *Analysis of Different Areas of Indigenous Resources: Traditional Knowledge*, in *Indigenous Heritage and Intellectual Property, Genetic Resources, Traditional Knowledge and Folklore* 59-60 (Silke von Lewinski ed., Kluwer Law International 2008).

1047. Bernard O'Connor, *Protecting Traditional Knowledge. An Overview of a Developing Area of Intellectual Property Law*, 6(5) *J. World Intell. Prop.* 677, 677-678 (2005). See also Thomas Cottier, *The Protection of Genetic Resources and Traditional Knowledge: Toward More Specific Rights and Obligations in World Trade Law*, 1 *J. Int'l Econ. L.* 555 (1998).

1048. See Cottier & Panizzon, *Legal Perspectives on Traditional Knowledge*.

1049. Convention on Biological Diversity (5 Jun. 1992, entered into force 29 Dec. 1993) 1760 U.N.T.S. 79; 31 I.L.M. 818.



In conjunction with its work on protecting traditional cultural expressions, WIPO's Intergovernmental Committee is also currently engaged in efforts to protect traditional knowledge, though it has been said that international protection of TCEs is more 'mature'.<sup>1050</sup> Draft articles on the protection of traditional knowledge<sup>1051</sup> are under development, and similar to the draft articles on traditional cultural expressions, the definition of 'traditional knowledge',<sup>1052</sup> eligibility criteria (draft Article 1) and the scope of protection (draft Article 3) are at this stage drafted in optional forms.

Meanwhile, regional frameworks for the protection of traditional knowledge are also gaining ground, the most notable of which being the African Regional Intellectual Property Organization (ARIPO) Swakopmund Protocol on the Protection of Traditional Knowledge and Expressions of Folklore (the 'Swakopmund Protocol').<sup>1053</sup> Although not yet in force,<sup>1054</sup> the Swakopmund Protocol is instructive in terms of its broad but relatively concise definition of 'traditional knowledge',<sup>1055</sup> and detailed criteria<sup>1056</sup> of

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1050. WIPO, *A new dawn for custodians of TK in Africa*, WIPO Magazine (December 2010) (available at [http://www.wipo.int/wipo\\_magazine/en/2010/06/article\\_0008.html](http://www.wipo.int/wipo_magazine/en/2010/06/article_0008.html)).

1051. WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, *The Protection of Traditional Knowledge: Draft Articles*, WIPO Doc. WIPO/GRTKF/IC/21/4 (2012) (available at [http://www.wipo.int/edocs/mdocs/tk/en/wipo\\_grtkf\\_ic\\_21/wipo\\_grtkf\\_ic\\_21\\_4.pdf](http://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_21/wipo_grtkf_ic_21_4.pdf)); WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, *Like-Minded Countries Contribution to the Draft Articles on the Protection of Traditional Knowledge*, WIPO Doc. WIPO/GRTKF/IC/21/5 (2012) (available at [http://www.wipo.int/edocs/mdocs/tk/en/wipo\\_grtkf\\_ic\\_21/wipo\\_grtkf\\_ic\\_21\\_5.pdf](http://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_21/wipo_grtkf_ic_21_5.pdf)).

1052. Option 1: For the purposes of this instrument, the term 'traditional knowledge' refers to the know-how, skills, innovations, practices, teachings and learning, resulting from intellectual activity and developed within a traditional context.

Option 2: Traditional knowledge is knowledge that is dynamic and evolving, resulting from intellectual activities which is passed on from generation to generation and includes but is not limited to know-how, skills, innovations, practices, processes and learning and teaching, that subsist in codified, oral or other forms of knowledge systems. Traditional knowledge also includes knowledge that is associated with biodiversity, traditional lifestyles and natural resources.

WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, *The Protection of Traditional Knowledge: Draft Articles*, Art. 1.

1053. Swakopmund Protocol on the Protection of Traditional Knowledge and Expressions of Folklore (9 Aug. 2010, not in force).

1054. The Swakopmund Protocol was signed by nine ARIPO Member States: Botswana, Ghana, Kenya, Lesotho, Liberia, Mozambique, Namibia, Zambia and Zimbabwe. Pursuant to section 27, the Protocol will enter into force three months after six Member States have deposited instruments of ratification or accession.

1055. Swakopmund Protocol, Art. 2.1: "traditional knowledge" shall refer to any knowledge originating from a local or traditional community that is the result of intellectual activity and insight in a traditional context, including know-how, skills, innovations, practices and learning, where the knowledge is embodied in the traditional lifestyle of a community, or contained in the codified knowledge systems passed on from one

protectability which directly link knowledge to a particular community and its cultural identity.

Names are notably not expressly included in the definition of 'traditional knowledge' in the Swakopmund Protocol or in either of the definitional options in WIPO's Draft Articles on the Protection of Traditional Knowledge. It is questionable whether a geographic name could be interpreted to implicitly fall within the sorts of knowledge protected under either, given that they focus on how knowledge is generated rather than the form of its expression.

Even if a connection cannot be drawn between traditional knowledge and geographic names as a general matter, such a connection can potentially be drawn between traditional knowledge and products identified by geographical indications.<sup>1057</sup> This is because geographical indications implicitly represent the *how* element that geographic names more broadly do not. Those who support the recognition and protection of geographical indications recognize that the aim of their protection goes beyond the mere name to 'protection of a certain quality and reputation that is attributable to a product that is made in a defined place.'<sup>1058</sup> This quality and reputation is frequently derived not only from particular characteristics of the geographical territory from which a product originates, but from the human interaction with that territory and the knowledge employed to transform elements in their natural state into distinctive products.<sup>1059</sup>

It has been shown in Chapter 7 that the international intellectual property law framework offers only limited protection to geographical indications against unauthorized use. Geographical indications as presently recognized thus have little capacity to protect the cultural aspects that inhere in them. Specifically, geographical indications are considered not to possess:

the independent capacity to protect local cultures of production, consumption or identity, or to prevent the erosion of cultural diversity. Market forces inevitably induce changes in local production methods and consumption preferences, in spite of the GIs that should, in theory, play a role in preserving them, and the proliferation of GIs has itself

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generation to another. The term shall not be limited to a specific technical field, and may include agricultural, environmental or medical knowledge, and knowledge associated with genetic resources.'

1056. Swakopmund Protocol, Art. 4.

1057. See Cottier & Panizzon, *Legal Perspectives on Traditional Knowledge*.

1058. O'Connor, *The law of geographical indications*, 18. See also Conrad, 13.

1059. See Dev Gangjee, *Melton Mowbray and the GI Pie in the Sky: Exploring cartographies of protection*, 2006(3) *Intell. Prop. Q.* 291, 300-308 (2006) (discussing 'the link between product and place'). See also Stephen R. Munzer & Phyllis Chen Simon, *Territory, Plants, and Land-Use Rights among the San of Southern Africa: A Case Study in Regional Biodiversity, Traditional Knowledge, and Intellectual Property*, 17 *Wm. & Mary Bill Rts J.* 831 (2009).

diluted the claims of special reputation, typicity, and cultural identity of GI-endowed locales.<sup>1060</sup>

Traditional knowledge protection has been proposed as a means of addressing these inadequacies and facilitating the protection of both a geographical indication as such and the cultural knowledge it represents.<sup>1061</sup> This is an interesting future possibility, but the scope that traditional knowledge protection currently offers for recognizing rights in geographic names (of which geographical indications in particular) is only speculative. Taking guidance from the Swakopmund Protocol, geographic names are not expressly provided for and a plain reading of the definition and eligibility criteria of ‘traditional knowledge’ renders it unlikely that these will be interpreted to implicitly geographic names.

#### 9.2.4 Right to Language

Closely linked to the right to culture is the right to language. Culture and language are symbiotic aspects of life; many forms of cultural expression use language, and the words that comprise languages are constantly evolving and being drawn from speakers’ cultural interactions and experiences. This is not unique to modern civilization; the German writer Johann Wolfgang von Goethe observed the following of late eighteenth century life: ‘So unübersetzlich sind die Eigenheiten jeder Sprache; denn vom höchsten bis zum tiefsten Wort bezieht sich alles auf Eigentümlichkeiten der Nation, es sei nun in Charakter, Gesinnungen oder Zuständen.’ [‘It is impossible to translate the idiosyncrasies of each language; every word, from the most arcane down to the simplest, is permeated by the particular nature of the nation, be it in character, outlook or circumstances.’]<sup>1062</sup>

Modern technologies seem to be moving human societies away from such culturally and nationally distinct languages, however. The ease and affordability of global cultural dissemination via the internet contributes to the growing trend of linguistic homogenization, and it has been estimated that as much as ‘95 per cent of the languages today will have no long-term prospects of survival’.<sup>1063</sup> The death of languages is linked to the death of

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1060. Broude, 678. See also Rhonda Chesmond, *Protection or Privatisation of Culture? The cultural dimension of the international intellectual property debate on geographical indications of origin*, 29(9) Eur. Intell. Prop. Rev. 379 (2007).

1061. See Cottier & Panizzon, *Traditional Knowledge and Geographical Indications*; Olufunmilayo B. Arewa, *TRIPS and Traditional Knowledge: Local Communities, Local Knowledge, and Global Intellectual Property Frameworks*, 10 Marquette Intell. Prop. L. Rev. 155 (2006); Gervais, 130-140.

1062. Johann Wolfgang von Goethe, *Italienische Reise 1786-1788 Teil 1* (Den 5. Oktober, nachts), 80 (Hirmer Verlag 1961) (trans. Dinah Cannell in Konrad Schröder, *Languages, in What is Europe? Aspects of European Cultural Diversity* 13 (Monica Shelley & Margaret Winck eds., Routledge 1995).

1063. Schröder, *Languages*, 14.

cultures, and this is generally viewed as undesirable.<sup>1064</sup> Paradoxically, the internet may have just as much of a role to play in reversing this trend as it has had in its creation by helping waning linguistic communities to overcome challenges to communication such as geographical isolation, unsupportive government language policies and political conflict. One step in this direction is ICANN's introduction in 2010 of 'Internationalized Domain Names' (IDNs), enabling domain names to be represented in non-Latin scripts.<sup>1065</sup> The introduction of IDN new gTLDs promises even greater possibilities for linguistic communities to promote, preserve and develop their language in the online world.<sup>1066</sup>

It is not surprising that much of the discussion surrounding human rights and language takes place within the context of minority rights. As is the case with cultural rights, it can be argued that the majority is sufficiently well equipped to protect its linguistic interests, but that its doing so puts the continued existence of minority languages at risk. Article 27 of the ICCPR is clearly relevant given its recognition of the right of persons of 'ethnic, religious or linguistic' minority groups to, *inter alia*, 'use their own language'. Article 30 of the International Convention on the Rights of the Child additionally recognizes the right of a child belonging to a minority or indigenous group to 'use his or her own language'. These are, however, the only instruments of global effect to specifically recognize a right to language.

To clarify, the Charter of the United Nations recognizes at Article 1(3) a right of non-discrimination on the basis of language, as do Articles 2(1) of the ICCPR and 2(2) of the ICESCR, but this is not axiomatically subject to interpretation as a right *to* language. The Committee on the Elimination of Discrimination has recommended that States' obligations to prevent discrimination be interpreted as ensuring 'that indigenous communities can exercise their rights to practise and revitalize their cultural traditions and customs and to preserve and to practise their languages',<sup>1067</sup> but even this is not expressly a right to language. Nor does the additional protection offered to indigenous people and minorities by Articles 27 and 30 of the ICCPR and International Convention on the Rights of the Child, respectively, expressly recognize a right to language. Rather, protection in both of these instruments is articulated in terms of a right to *use* or *practice* a language, similar to the way in which the right *to participate in* culture is recognized in the ICESCR

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1064. See for example, Gerrand, *Cultural diversity in cyberspace*.

1065. On Internationalized Domain Names (IDNs), see Part I, Chapter 1, section 1.2.2.3 above.

1066. IDN strings comprised 6%, or 116 of 1,930, of applied-for strings in the first round of the New gTLD Program. ICANN, *New Generic Top-Level Domains: Quick Facts about applied-for new gTLD strings*, <http://newglds.icann.org/en/program-status/statistics/applications-quick-facts-13jun12-en.pdf> (13 Jun. 2012, accessed 15 Oct. 2012).

1067. United Nations Committee on the Elimination of Racial Discrimination, General Recommendation No. 23: Indigenous Peoples (1997) (available at [http://www.unhchr.ch/tbs/doc.nsf/%28Symbol%29/73984290dfea022b802565160056fe1c?Opendocument#\\*%2](http://www.unhchr.ch/tbs/doc.nsf/%28Symbol%29/73984290dfea022b802565160056fe1c?Opendocument#*%2)).

rather than a right *to* culture. The analysis of the right under Article 15 of the ICESCR ‘to take part in the cultural life of the community’ cited earlier in this chapter is aptly recalled here; borrowing those words, the right to use a language logically ‘can only exist if there is a’<sup>1068</sup> language. This statement seems sensible in the context of the right to language, but nevertheless lacks support in international law in the way that the right to culture is supported through Article 15(2) of the ICESCR, which requires States to take steps necessary for culture’s conservation and development. In spite of this, it is posited that:

normative expectations converge at least to the extent that states feel an obligation to provide *some* affirmative support for the use of indigenous languages and to ensure that indigenous people do not suffer discrimination for failure to speak the dominant language of the state in which they live.<sup>1069</sup>

The scope for a broader right of indigenous peoples to language is supported by the Declaration on the Rights of Indigenous Peoples, Article 13(1) of which is of particular relevance here. It provides: ‘Indigenous peoples have the right to revitalize, use, develop and transmit to future generations their histories, languages, oral traditions, philosophies, writing systems and literatures, **and to designate and retain their own names for communities, places and persons**’ (emphasis added). The Declaration on the Rights of Indigenous Peoples is not binding and thus not a formal source of rights in geographic names, but the language just emphasized suggests at a minimum that there is some recognition at the international level of the importance of geographic names to indigenous peoples. Otherwise, nothing in the ongoing discourse on legal rights in geographic names suggests that there is currently a custom or general principle of recognizing this right of indigenous peoples to ‘retain their own names for communities [and] places’.

Recognition of the human right to language in international law thus appears to be limited to particular segments of the human population and the particular context of preventing discrimination. While there are regional agreements that provide for rights respecting language,<sup>1070</sup> these are also limited to the non-discrimination context and do not create specific rights to language that might support a correlative right to use or control a geographic name. Nor has support for a right to language been found outside of human rights law in the area of international trade law.<sup>1071</sup>

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1068. McGoldrick, 454. See discussion above at section 9.2.3.2.

1069. Anaya, *Indigenous Peoples in International Law*, 139 (internal citations omitted).

1070. For example, the European Convention on Human Rights recognizes at Art. 14 a right to non-discrimination on the basis of language. Convention for the Protection of Human Rights and Fundamental Freedoms (4 Nov. 1950, entered into force 3 Sep. 1953) E.T.S. 5; 213 U.N.T.S. 221.

1071. See Broude, 682 (concluding that the potential for using trade-restrictive measures to preserve language, ‘a national treasure of sorts,’ under GATT Art. XX(f) is very low).

Against this backdrop it must be considered whether actions of the State that have the effect of preventing a particular linguistic community from having an online identity in the form of a geographic internet top-level domain could be interpreted as discrimination on the basis of language. In cases in which language and geographic territory share a name, a restriction on the linguistic community's application for that domain name or string could plausibly constitute discrimination by preventing that community from expressing itself on the internet. On the other hand, a policy of State control of geographic names would not be discriminatory if, for example, domain name registration within gTLDs were open to members of the linguistic community. Further, the policy underpinning the operation of the domain and use of domain names registered within it could not discriminate against in-language content and users. A hypothetical example would be a decision by the government of the United Kingdom to apply for a .cymru gTLD in which domain name registrants are prohibited from registering Welsh-language names or displaying Welsh-language content.<sup>1072</sup>

The human right to language thus appears at present to offer scant support for a right of persons to make use of or exercise control over geographic names. Application of the right to language is limited to preventing State actions that discriminate on the basis of language. Preventing a linguistic community's access to the internet could in certain circumstances constitute a breach of this right. It does not automatically follow, however, that the recognition of exclusive State rights in a geographic domain name is discriminatory. That said, neither does the human right to language prove the existence of an exclusive right of States to geographic names; what it does is obligate States using geographic names not to do so in ways that discriminate against linguistic communities.

### 9.2.5 RIGHT TO PROPERTY

Several forms of property have been explored in this and earlier chapters as potential bases of rights under international law in geographic names: in the context of human rights, cultural property (including cultural expressions and traditional knowledge), and in the context of intellectual property, trademarks and geographical indications. These regimes protect exclusive individual – and to a lesser extent collective – rights to property in a particular form or satisfying particular criteria. What remains as a final area of enquiry is to consider whether geographic names can be considered as either the

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1072. This example did not eventuate in the actual application process; the .cymru application made by Nominet UK, the registry operator of the United Kingdom's .uk ccTLD, specifically supports 'the registration of internationalized domain names (IDNs) to support the Welsh language'. See ICANN, *Application Details, String: CYMRU*, Question 23, <http://gldresult.icann.org/application-result/applicationstatus/applicationdetails/1420> (accessed 15 Oct. 2012).

property of individuals or, alternatively, belonging to all humankind. The starting point in answering these questions is the recognition in international law of an individual's right to property and its potential applicability to geographic names. This then leads to a discussion of the notion of public property, what was termed '*res publicae*' in Roman law. Lastly, it is shown that these historic notions of property remain a feature of contemporary legal frameworks, appearing in the intellectual property context in the concept of the public domain.

### 9.2.5.1 The Human Right to Property and Individuals' Rights in Geographic Names

A human right to property remains elusive and indefinite in international law. It is recognized most clearly in the non-binding United Nations Declaration on Human Rights, Article 17 of which provides:

- (1) Everyone has the right to own property alone as well as in association with others.
- (2) No one shall be arbitrarily deprived of his property.

A right to property is not provided for in either the ICCPR or the ICESCR, though both address property in the context of non-discrimination.<sup>1073</sup> 'There is reason to believe, however, that it was the precise formulation of the contours of the right to property, rather than disagreement over its existence in some form, that proved the stumbling block (and even then, only narrowly so).'<sup>1074</sup> This is supported by the express recognition of a right to property in regional agreements, amongst which the European Convention on Human Rights,<sup>1075</sup> the African Charter on Human and Peoples Rights<sup>1076</sup> and the

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1073. See International Covenant on Civil and Political Rights, Arts. 2(1), 24(1) and 26(1); International Covenant on Economic, Social and Cultural Rights, Art. 2(2).

1074. Francisco Forrest Martin et al., *International Human Rights Law and Practice: Cases, Treaties and Materials* 868-869 (Kluwer Law International 1997) citing William A. Schabas, *The Omission of the Right to Property in the International Covenants*, 4 Hague Y.B. Int'l L. 135 (1991).

1075. Art. 1 of the Optional Protocol to the Convention provides: Every natural or legal person is entitled to the peaceful enjoyment of his possessions. No one shall be deprived of his possessions except in the public interest and subject to the conditions provided for by law and by the general principles of international law. The preceding provisions shall not, however, in any way impair the right of a State to enforce such laws as it deems necessary to control the use of property in accordance with the general interest or to secure the payment of taxes or other contributions or penalties.

1076. African Charter on Human and Peoples' Rights, Art. 14 (27 Jun. 1981, entered into force 21 Oct. 1986) O.A.U. Doc. CAB/LEG/67/3 Rev 5, discussed in Mashood A. Baderin, *The African Commission on Human and Peoples' Rights and the Implementation of Economic, Social and Cultural Rights in Africa*, in *Economic, Social and Cultural Rights in Action* 151-153 (Mashood A. Baderin & Robert McCorquodale eds., Oxford University Press 2007).

American Convention on Human Rights.<sup>1077</sup> Further support for the existence of a right to property can be derived from the non-binding United Nations General Assembly Resolution on Respect for the Right of Everyone to Own Property Alone as Well as in Association with Others and Its Contribution to the Economic and Social Development of Member States.<sup>1078</sup>

Although it may broadly (even if not universally) be agreed that a human right to property exists in some form in international law, there is disagreement as to the precise substance of the right and limitations to it.<sup>1079</sup> This is less problematic in the regional instruments just noted. Article 17(2) of the European Charter on the Fundamental Rights of the European Union,<sup>1080</sup> for example, specifically states: 'Intellectual property shall be protected.' The European Convention on Human Rights is another example; although a right to property is not expressly provided for, analysis shows that protection of intellectual property, including trademarks, bears out in cases.<sup>1081</sup>

The most common and general aspect of the right to property at the international level is its protection of individuals 'against wrongful state action'.<sup>1082</sup> Whether protection against arbitrary and uncompensated taking of property is the only protection offered by an international law-based right to property is unclear but possible. Related arguments may be made to the effect that a taking constitutes a violation of the TRIPS Agreement's guarantees of protection to trademarks and geographical indications.<sup>1083</sup> Another broader possibility that is philosophically supported by the belief that property rights are directly linked to economic prosperity<sup>1084</sup> is its encompassing a positive right to acquire and possess at least *some* property. Even this broader view does not extend so far as to justifying claims to

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1077. American Convention on Human Rights, Art. 21 (22 Nov. 1969, entered into force 17 Jul. 1978) 1144 U.N.T.S. 123.

1078. *Respect for the right of everyone to own property alone as well as in association with others and its contribution to the economic and social development of Member States*, 14 Dec. 1990, United Nations General Assembly Doc. A/RES/45/98.

1079. See *Restatement (Third) of the Foreign Relations Law of the United States* §711 comment d.

1080. Charter of Fundamental Rights of the European Union, OJ 2000/C 364/01.

1081. See Goebel, 7.

1082. Forrest Martin et al., *International Human Rights Law and Practice*, 866.

1083. See for example, *Australia – Certain Measures Concerning Trademarks and Other Plain Packaging Requirements Applicable to Tobacco Products and Packaging*, WT/DS434/1; *Australia – Certain Measures Concerning Trademarks, Geographical Indications and Other Plain Packaging Requirements Applicable to Tobacco Products and Packaging*, WT/DS435/1; *Australia – Certain Measures Concerning Trademarks and Other Plain Packaging Requirements Applicable to Tobacco Products and Packaging*, WT/DS441/1.

1084. *Ibid.*



acquire or own *particular* property, however. Nor have claims based solely on a right to property been accepted in international courts.<sup>1085</sup>

While there are regional laws that support a right to property as protecting particular property,<sup>1086</sup> international law does not go so far. International law does, however, offer support for the claim that a property right recognized in a geographic name (e.g., as a trademark, geographical indication or as cultural property) cannot arbitrarily be taken away. In the specific context of the New gTLD Program, this should motivate governments to provide clear reasons for denying support of a geographic new gTLD application made by an applicant possessing a geographic trademark or geographical indication.

## 9.2.5.2 Collective Property Rights in Geographic Names

### 9.2.5.2.1 Geographic Names as Public Property: 'Res Publicae'

Various societies and political ideologies have held to varying degrees the belief that some things in life are the property of the public at large. In law, this has roots in the Roman concept of '*res publicae*', in which public access was ensured by operation of law.<sup>1087</sup> Classic examples of *res publicae* include highways, railways, harbours, ports and bridges. These things 'are overwhelmingly the physical spaces required for mobility—lanes for travel, transportation, navigation, and communication among distant locations.'<sup>1088</sup> Their desirability to the public and use by all, in addition to their susceptibility to a certain degree of control to ensure their orderly use,<sup>1089</sup> justifies ownership by all.

Taking the view that geographic names are public property starts with a determination that they are property, something that the law has been notably reticent to do at least in the context of their registrability as trademarks.<sup>1090</sup> Article 6*ter* of the Paris Convention is argued to have been

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1085. See for example, *L.E.S.K. v. the Netherlands*, U.N. Human Rights Committee, Communication No. 381/1989 U.N. Doc. CCPR/C/45/D381/1989 (1992); *K.J.L. v. Finland*, U.N. Human Rights Committee, Communication No. 544/193 U.N. Doc. CCPR/C/49/D/544/1993 (views adopted by the Human Rights Committee 3 Nov. 1993); *Koné v. Senegal*, U.N. Human Rights Committee, Communication No. 386/1989 U.N. Doc. CCPR/C/52/D/386/1989 (views adopted by the Human Rights Committee 21 Oct. 1994), as cited in Forrest Martin et al., *International Human Rights Law and Practice*, 875.

1086. See Goebel, 7.

1087. See Carol M. Rose, *Romans, Roads, and Romantic Creators: Traditions of public property in the information age*, 66 L. & Contemp. Probs. 89 (2003).

1088. *Ibid.*, 97.

1089. *Ibid.*, 99.

1090. See discussion of geographical names' protectability as a trademark in Part III, Chapter 5, section 5.1.1 above.

motivated by national emblems' incapability of propretization.<sup>1091</sup> Debates surrounding the protection of cultural expressions, traditional knowledge and biological resources centre on the appropriateness of propretization.<sup>1092</sup> It is also said that '[f]rom an indigenous perspective, a song or story is not a commodity or a form of property but "one of the manifestations of an ancient and continuing relationship between people and their territory".'<sup>1093</sup> Nor are plants and animals, healing methods, or ways of life easily characterized as property.

Characterizations of the internet and its DNS as *res publicae*<sup>1094</sup> should be scrutinized. It would be difficult if not impossible to maintain a *res publicae* space in the current environment of natural monopoly that results from the technical rule of absolute name uniqueness. The proviso that the public must be willing to 'behave in an orderly fashion'<sup>1095</sup> in a *res publicae* space requires an absolute willingness on the part of unsuccessful gTLD applicants to relinquish aspirations of extending offline rights into the online environment.

Even if the communications network underpinning the internet is deemed public property, this does not mean that all of the traffic and content upon it is also public property. Reference can be made back to physical *res publicae* spaces: the use of a public highway or port by privately owned vehicles and ships does not transform those vehicles and ships into public property. Likewise, if the internet is considered public property, its use to communicate information does not transform that information into public property. The information may be public property, but if so, this is irrespective of its transmission via the internet. That said, the line between 'lanes and means of communication... [and] the content of communication'<sup>1096</sup> is difficult to draw. This is certainly an issue for domain names because they have a tendency to connote content while also identifying the source of information and its location in the internet.

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1091. See Antony Taubman, *The public domain and international intellectual property law treaties*, in *Intellectual Property: The Many Faces of the Public Domain* 82 (Hector MacQueen & Charlotte Waelde eds., Edward Elgar 2007).

1092. Anupam Chander & Madhavi Sunder, *The Romance of the Public Domain*, 92 Cal. L. Rev. 1331, 1368 (2004).

1093. Wend B. Wendland, 'It's a small world (after all)': some reflections on intellectual property and traditional cultural expressions, in *Intellectual Property and Traditional Cultural Expressions in a Digital Environment* 150 (Christoph Beat Graber & Mira Burri-Nenova eds., Edward Elgar 2008), quoting Erica-Irene Daes, Special Rapporteur of the (then) Sub-Commission on Prevention of Discrimination and Protection of Minorities and Chair of the Working Group on Indigenous Populations, *Study on the Protection of the Cultural and Intellectual Property of Indigenous Peoples*, E/CN.4/Sub.2/1993/28, 28 Jul. 1993, para. 22.

1094. Rose, 100 (identifying the internet as 'the most obvious example of *res publicae* in Intellectual Space').

1095. *Ibid.*, 99.

1096. *Ibid.*, 104.

Just as '[p]ublic roads and open systems of transportation make private property more valuable'<sup>1097</sup> (emphasis in original), the internet and other modern communications mediums make privately owned names and symbols more valuable, encouraging their commoditization despite the incongruity in some cases of that approach with the beliefs of their creators. As has been shown in earlier sections of this chapter, recent trends in the propertization of cultural expressions and traditional knowledge tend to follow existing property regimes. In the DNS context, this is consistent with the broad understanding of domain names as property or something conceptually comparable. The existence of these other potential sources of legal rights in geographic names renders it even more remote that they might be considered generally, or in the specific context of the DNS, public property.

#### 9.2.5.2.2 *Geographic Names as Part of the Public Domain*

It is a widely accepted premise of intellectual property law that new creation depends upon the existence of a stock of ideas and expressions that is open and available to all; in some legal systems, this philosophy justifies the very existence of intellectual property laws as temporary means of private propertization.<sup>1098</sup> The things falling outside of private property rights, whether at the expiry of protection or not protectable in the first place, are considered to be in the 'public domain'. There are three ways of characterizing the public domain: as property belonging to all – the notion of public property just discussed,<sup>1099</sup> as 'res nullius' – the 'property of no one',<sup>1100</sup> or as the 'opposite of property' – something not falling within the characterization of property.<sup>1101</sup>

There is no agreed definition of 'public domain', but there is consistency in terms of its focus on access rather than ownership, as this definition illustrates: 'Resources for which legal rights to access and use for free (or for nominal sums) are held broadly.'<sup>1102</sup> Articulated in this way in terms of access and use, the notion of the public domain is inconsistent with property rights, which confer 'control in the form of an ability to alienate, exploit and exclude others'.<sup>1103</sup> Nevertheless, even access and use can give rise to

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1097. Chander & Sunder, 1345.

1098. Hughes, *The Philosophy of Intellectual Property*, 323-325.

1099. See for example, Rose, 100.

1100. See for example, Indigenous World Association and Indigenous Media Network, Joint Statement, *Commission on Human Rights, Sub-Commission on the Promotion and Protection of Human Rights, Working Group on Indigenous Populations* (18–22 Jul. 2005).

1101. See for example, James Boyle, *Foreword: The Opposite of Property?*, 66 L. & Contemp. Probs. 1 (2003).

1102. Chander & Sunder, 1338.

1103. Last (ed.), *The Resolution of Cultural Property Disputes*, 55.

feelings that might be mistaken for property, particularly property owned by the State as:

a form of domain defined not merely by the absence of exclusive private rights but by a positive sense of public ownership or collective sovereignty. This is domain as *dominion*: the sense of 'domain' recalled in the concept of 'eminent domain', the sovereign's residual entitlement to assume use of private property for public use, based on a superior form of sovereign dominion over property.<sup>1104</sup>

Intellectual property laws traditionally make a distinction between property and the public domain, subject matter falling into the former category being protected and subject matter falling into the latter category not protected.<sup>1105</sup> This is helpful to achieving a foundational understanding of what the public domain comprises, but it has been argued that it is not appropriate to conclude from this simplified explanation that intellectual property and the public domain are somehow opposed, as if 'the public domain is a bulwark against propertization and an alternative to intellectual property.'<sup>1106</sup> Rather, there is a cyclic symbiosis between property rights and the public domain, an idea which has as its roots in Lockean 'labour theory': energies are exerted upon ideas and information in the public domain and thus take on the status of private property, which status they relinquish when the term of protection ends.<sup>1107</sup> Falling into the public domain, they become available to others for use in creating new intellectual property. In this way, the public domain is a driver of propertization 'because it offers a sphere of free works upon which capitalists can draw without either seeking consent or drawing liability.'<sup>1108</sup>

The subject matter in the public domain is not itself appropriable, but can be used to create appropriable subject matter that ultimately joins the stock of non-appropriable subject matter. This is precisely what concerns indigenous communities if cultural heritage is to be considered public domain:

Placing our knowledge into the public domain turns it into a freely available resource for commercial utilization. Thus, it also creates the pre-condition for using non-indigenous Intellectual Property Rights (IPR) regimes to patent 'inventions' based upon our knowledge. ... We therefore strongly reject the application of the public domain concept to

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1104. Taubman, *The public domain and international intellectual property law treaties*, 60-61, citing Grotius, *In Hugonis Grotii Jus Belli Et Pacis Commentatio*. De Jure Belli, Book I, iii. §6.

1105. See generally, Jessica Litman, *The Public Domain*, 39 Emory L.J. 965 (1990).

1106. Chander & Sunder, 1343.

1107. On Locke's labour theory and its application in justifying intellectual property rights, see Hughes, *The Philosophy of Intellectual Property*, 296-329.

1108. Chander & Sunder, 1343.

any aspect that relates to our cultures and identities, including human and other genetic information originating from our lands and waters.<sup>1109</sup>

On the other hand, the non-appropriable nature of the public domain aligns it with the Roman law concept of *res communes*, which ‘encapsulates what might be called the Impossibility Argument against private property: The character of some resources makes them incapable of “capture” or any other act of exclusive appropriation.’<sup>1110</sup> Classic examples of *res communes* are oceans and water; they are needed and used by all, but it is physically impossible to exert exclusive control over them.<sup>1111</sup>

In the non-physical world, languages, alphabets, facts and laws of nature all fit the description of being needed by all and incapable of possession or propertization by individuals.<sup>1112</sup> The symbols protected by Article 6ter have also been considered to fit this description.<sup>1113</sup> These examples highlight the distinction made in Roman law between *res publicae* and *res communes*: *res publicae* are contained spaces over which some degree of control is possible. This distinction has since blurred, and intellectual property law appears to have played a role in that process.<sup>1114</sup>

A characterization of geographic names as falling in the public domain<sup>1115</sup> does not necessarily equate to a ‘right’ of the public to them, however. On the contrary, claims to rights in the public domain lack support because of the very notion of the commons as a non-proprietary environment:

Rather, we all have the *privilege* or *liberty* to do what we like with these works (for example, stage a Shakespeare play); the only corollary is that other persons have *no right* to prevent us from so doing (for example, the direct descendant of William Shakespeare has no right to prevent me staging *Macbeth*).<sup>1116</sup>

Applying this thinking to geographic names, the public may not so much have a right to use a geographic name (suggesting a corresponding duty on the part of others, including the State, not to interfere in that interest) but rather a ‘privilege or liberty’ to use them – as domain names or otherwise –

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1109. Indigenous World Association and Indigenous Media Network, *Joint Statement*.

1110. Rose, 93.

1111. *Ibid.*, citing William A. Hunter, *Introduction to Roman Law* 59-60 (9th ed. revised, Oxford University Press 1934).

1112. On traditional knowledge and the public domain, see Cottier & Panizzon, *Legal Perspectives on Traditional Knowledge*, 374-376.

1113. See Taubman, *The public domain and international intellectual property law treaties*, 82.

1114. See Rose, 94-95.

1115. See Rimmer, 131.

1116. Cahir, 39-40.

within the bounds of other norms surrounding their use such as those established by unfair competition law.<sup>1117</sup>

If they do form part of the public domain, geographic names should be made available for domain name registration by any member of the public. This is not because each member of the public has a legal right to have such a space delegated to their control by ICANN: no one member of the public has a greater claim than another. The ‘first come, first served’ approach to domain name registration reflects this view perfectly, but the perfect application of the public domain to the DNS ends there. In the offline world, things in the public domain are available to all, and their transformative use by one does not prevent transformative use by another. In the online world, multiple simultaneous users of a domain name cannot exist: the technical requirement of absolute name uniqueness means that domain names start out as available to all, but they lose that status once they are delegated (top-level) or registered (second- and lower levels). The plot (e.g., boy meets girl, they fall in love, their love is forbidden by family relations) remains in the public domain for others to use even after *Romeo and Juliet* is written, but a geographic name is effectively removed from the pool of available names when it is delegated to a registry operator or registered by a domain name registrant. There can only be one .africa, one .switzerland, one .paris, and only one kenya.africa, berne.switzerland and one montmartre.paris

In conclusion, although the law does not recognize a right of the public to subject matter in the public domain, when the use at issue takes the form of a domain name, the practical outcome is difficult to distinguish from a legal right. While there is no right to prevent another person from making an application for a geographic gTLD string or domain name comprised of a term falling within the public domain, there is a technological impediment to doing so that gives rise to an exclusive, property-type right once the name has been captured in that way.

### 9.3 GEOGRAPHIC NAMES AS THE COMMON HERITAGE OF MANKIND

The final basis of rights considered in this study is a concept that has its roots in natural resources law, but also has clear links to cultural rights.<sup>1118</sup> It is

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1117. See Taubman, *The public domain and international intellectual property law treaties*, 58-59.

1118. See for example, Liu Lina, *Ownership of Underwater Cultural Heritage in the Area*, 1 Creighton Int'l & Comp. L.J. 60 (2011); Derek Fincham, *The Distinctiveness of Property and Heritage*, 115 Penn St. L. Rev. 641 (2011); Joseph P. Fishman, *Locating the International Interest in Intranational Cultural Property Disputes*, 35 Yale J. Int'l L. 3347 (2010); Siegfried Wiessner, *Re-enchanting the world: Indigenous peoples' rights as essential parts of a holistic human rights regime*, 15 UCLA J. Int'l L. & Foreign Aff. 239 (2010).

acknowledged from the outset that this discussion could sit apart from human rights in this book, but it has been purposefully placed here in order to highlight the conceptual connections between cultural rights, the public domain and common heritage. This is broadly consistent with the doctrine of common heritage of mankind coming to be embraced within human rights law, for example, as a tenet recognized in the preamble of the United Nations Declaration on the Rights of Indigenous Peoples.<sup>1119</sup>

The principle of common heritage of mankind has as its starting point a concept similar to that of the public domain, but to this is added a social responsibility framework. Common heritage of mankind proposes that 'all people would be expected to share in the management of a common space area' and economic benefits from the exploitation of that space 'would be shared internationally.'<sup>1120</sup> Its traditional application in the context of natural resources also gives rise to two further aspects, namely that the use of the area 'must be limited exclusively to peaceful purposes' and that scientific research conducted therein 'would be freely and openly permissible, so long as the environment of the common space area was in no way physically threatened or ecologically impaired.'<sup>1121</sup> The deep sea bed is the most commonly identified common heritage of mankind space.<sup>1122</sup>

There are not obvious reasons for treating geographic names, like the deep sea bed, as a common resource managed and accessible by all, with the profits of any economic exploitation to be divided globally and equally. On the contrary, several compelling bases of private legal rights in geographic names have been identified in this study and the existence of these rights weighs against treating geographic names as a communal resource. Private rights also underpin domain names, the fundamental building blocks of the DNS. Some argue that this is not the most appropriate model, that the internet should 'be exploited for the benefit of the people of the world'<sup>1123</sup> and that its governance by a corporation is inappropriate to achieve that aim.

For the internet to be managed as a common resource, its fundamental components must all be shared internationally and decisions respecting its development must be geared to achieving total equality of access. These notions are not *prima facie* inconsistent with the object of ICANN, the California non-profit public benefit corporation established to oversee

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1119. United Nations Declaration on the Rights of Indigenous Peoples (2 Oct. 2007) G.A. Res. A/RES/61/295.

1120. Christopher C. Joyner, *Legal Implications of the Concept of the Common Heritage of Mankind*, 35(1) Int'l & Comp. L. Q. 190, 191-192 (1986) (internal citations omitted).

1121. *Ibid.*, 192.

1122. See Dolliver M. Nelson, *Reflections on the 1982 Convention on the Law of the Sea*, in *The Law of the Sea: Progress and Prospects* 33-34 (Richard Barnes & David Ong eds., Oxford University Press 2006). Antarctica is also put forward as a potential common heritage space. See J.M. Spectar, *Saving the Ice Princess: NGOs, Antarctica & International Law in the New Millennium*, 23 Suffolk Transnational L. Rev. 57 (1999).

1123. Chander, *The New, New Property*, 750.

domain name system policy, as articulated in the 'Core Values' in section 2 of its Bylaws. Yet as ICANN continues its struggle for legitimacy in the eyes of the global internet community, a struggle which has been reinvigorated by recent decisions respecting the addition of new top-level domains to the root, calls for shifting operational and policy control over the DNS to an international intergovernmental organization have intensified.<sup>1124</sup>

Shifting the internet and its DNS out of the private environment championed by ICANN and into shared global management (e.g., to the International Telecommunications Union) would have the effect of quashing any claims to their 'ownership' by any sovereign or even by all mankind. This would turn the focus unambiguously towards access and the motivation in policy decision-making conclusively towards the long-term greater good.<sup>1125</sup>

This is in many ways a desirable path for the internet to take, but would unquestionably be fraught with practical and legal difficulties too numerous to list here. These difficulties do not make treating the internet as the common heritage of mankind impossible, but this is not an outcome to be taken lightly or assumed to be inevitable. Additionally, while it is conceptually not difficult to apply such thinking to the governance model, the same is not true for the domain names that are the primary components of the system being governed. These have (if unintentionally) come to be viewed if not as property, then something analogous – a sort of 'third generation' or 'virtual property'.<sup>1126</sup> If treating the internet as we treat the deep sea bed requires treating domain names as belonging to all mankind, any property or related proprietary rights in domain names, the most fundamental components of the DNS, should arguably be extinguished. Such an outcome is entirely antithetical to the way the DNS currently operates and also raises issues of takings of property as discussed earlier in this chapter in the context of the human right to property. At this point in time it is difficult to imagine the occurrence of such a massive shift in thinking.

Sharing the proceeds of exploiting common heritage resources internationally – this is, after all, the social conscience component upon which the principle of common heritage of mankind is based – is also antithetical to the way we presently view and use the privatized internet. In the face of ICANN's non-profit status, questions have notably been raised about its use of the 'approximately USD 350 million'<sup>1127</sup> generated by new gTLD

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1124. See Patrick S. Ryan, *The ITU and the Internet's Titanic Moment*, Stanford Tech. L. Rev. 8 (2012); Brito, *ICANN vs. the World*.

1125. See Joyner, 194.

1126. David Nelmark, *Virtual Property: The Challenges of Regulating Intangible, Exclusionary Property Interests Such as Domain Names*, 3(1) Northwestern J. Tech. & Intell. Prop. 1 (2004). See also Chik, *Lord of Your Domain, But Master of None*.

1127. ICANN, *TAS Interruption: Update (4 May 2012)*, <http://newgtlds.icann.org/en/announcements-and-media/latest> (accessed 15 Oct. 2012).



applications.<sup>1128</sup> ICANN's response, that 'the community will be consulted as to how that excess should be used',<sup>1129</sup> while supportive of the multi-stakeholder governance model, does not equate to sharing the proceeds of exploiting common heritage resources internationally.

In summary, the current model of internet governance leverages the spirit of the doctrine of the common heritage of mankind without embracing it fully. To do so would require fundamental changes, not just to the governance model itself but to the now firmly established and jealously defended private rights in the domain names so fundamental to the domain name system. Treating the internet, the DNS, and names used in that context as the common heritage of mankind thus reveals itself to be an interesting theory but implausible in practice at this point in time.

#### 9.4 CONCLUSIONS ON HUMAN RIGHTS ENCOMPASSING RIGHTS TO GEOGRAPHIC NAMES

It is human nature to identify with the communities in which one lives. Modern multi-layered societies give rise to the likelihood that each person makes multiple associations, linking him or herself to a family, a local community, a professional community, a linguistic community, a sub-national region, a nation, a supra-national region. One association is no less important than the other to generating a complete picture of who a person is as a human being and how the person perceives his or her place in this world and wishes others to perceive him or her. To limit a person's ability to articulate this sense of belonging is arguably to limit his or her freedom and therefore violate the most fundamental aspects of his or her humanity. There are thus clear links between human rights and human beings' innate habit of self-identification.

This chapter has considered the most prominent links between human rights and geographic self-identification by analysing the rights to national identity and self-determination, freedom of expression, culture, language and property, as well as the doctrines of the public domain, public property, and common heritage of mankind. Of these, the right to freedom of expression and cultural rights have in particular been shown to offer clear bases for a

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1128. See for example R. Shawn Gunnarson, *Modest Proposals for gTLD Profits*, CircleID (27 Oct. 2011) (available at [http://www.circleid.com/posts/modest\\_proposals\\_for\\_gtld\\_profits](http://www.circleid.com/posts/modest_proposals_for_gtld_profits)) (accessed 15 Oct. 2012); Michael Berkens, *Beckstrom: 'I Took ICANN From \$57 Million Under Management To \$444 Million'*, The Domains (25 Jun. 2012) (available at <http://www.thedomains.com/2012/06/25/beckstrom-i-took-icann-from-57-million-under-management-to-444-million/>).

1129. ICANN, *Frequently Asked Questions: 1.7 Is ICANN initiating the New gTLD Program to make money?*, <http://newgtlds.icann.org/en/applicants/customer-service/faqs/faqs-en> (accessed 15 Oct. 2012).

person's right to use a geographic name. These rights are not absolute, but they do require consideration by States in reacting and responding to applications for geographic new gTLDs. New gTLD registries should also consider the issues noted in this chapter when developing supplemental policies that restrict the registration of geographic names as domain names in the newly created gTLDs.

The human right to freedom of expression as protected under international law recognizes a person's right not to have access to a geographic name prevented unless this poses a rationally articulated threat to national security or public order. Geographic names are not inherently threatening to national security or public order. Although the contexts in which they are used could give rise to such an interpretation, the existence of threats can only be determined on a case-by-case basis, so a universal rule restricting the use of geographic names on this basis is inappropriate. States' objections to geographic domain names or strings should be scrutinized to ensure that they 'specify the precise nature of the threat allegedly posed by'<sup>1130</sup> the applicant's registration of that name in the DNS.

The human right to culture has also been shown to recognize a person's right to use a geographic name; this right is limited in terms of who may claim it (members of an identifiable cultural group) and when it may be claimed (where the name is integral and there is a risk of direct harm to the culture as a result of the State's action). Analogous arguments have been successfully made linking non-interference with land to the existence, practice and preservation of culture. In the context of the DNS and given the integral role played by the internet in creating, preserving and communicating culture, preventing a cultural group from possessing an online identity and a space in which to freely express and practice its culture could be seen to impinge upon free participation in online cultural life.

It is therefore a principal conclusion of this study that the human right to freedom of expression and the human right to culture stand in the way of a policy of recognizing exclusive rights of States in geographic names' use in the DNS. It is inappropriate to assume that only States have rights in geographic names, or that these rights necessarily always trump the rights of non-State others. Going forward, changes to new gTLD policy respecting geographic names are warranted to acknowledge the existence of these rights. In the interim, States should consider the impact of these rights upon their decision-making as respects new gTLDs.

Although the other rights examined in this chapter offer only scant support for the existence of rights in geographic names, some nevertheless serve to limit State action and should therefore also be borne in mind going forward in DNS policy-making. The human right of self-determination gives to 'peoples' a right to be involved in decision-making respecting geographic names and their use in the DNS. The human right of nationality ensures that

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1130. *Keun-Tae Kim v. Republic of Korea*, para. 12.5.

State decisions regarding geographic names do not put a person's possession of a (though not a *specific*) nationality at risk. The human right to language prevents State actions respecting geographic names and their use in the DNS that discriminate on the basis of language.

This is the current and most visible protection available under international human rights law to geographic names, bearing in mind that this area is involved in an ongoing state of development and additional rights may be recognized even in the not-too-distant future. An agreement on the protection of cultural expressions is in progress, as is an agreement on the protection of traditional knowledge. Custom may also develop out of the provision in the Declaration of the Rights of Indigenous Peoples for indigenous peoples to 'retain their own names for communities, [and] places'.

Notwithstanding the existence of human rights encompassing a right to geographic names, there remains the practical problem in the context of the DNS of exclusivity; even if persons or peoples have these rights, it is practically impossible for more than one claimant or group of claimants to exercise such rights by registering them as domain names given the technological requirement of absolute name uniqueness. The law has not yet provided a means of prioritizing these interests. ICANN's approach in new gTLD allocation is to resolve by auction conflicts that are unable otherwise to be resolved.<sup>1131</sup> While this avoids ICANN having to make overt value judgments on specific gTLD applications, it embeds in the New gTLD Program as a whole a value judgment of prioritizing exceptionally funded applicants.

As ICANN gTLD policy matures, due consideration to cultural diversity may require ICANN to make different, overt value judgments. Having taken on the responsibility of ensuring that new gTLD policy is consistent with rights recognized in international law, ICANN has at its disposal the full complement of laws and soft law instruments to assist it in this process. Of particular value is the guidance offered by the UNESCO Convention on the Protection and Promotion of the Diversity of Cultural Expressions.

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1131. ICANN, *gTLD Applicant Guidebook*, section 4.2.2.

## **APPENDIX B**

# AMAZON DOMAIN NAME AND TRADEMARK PORTFOLIO IN SOUTH AMERICA

**PRIVATE & CONFIDENTIAL**

27th March 2013

This summary only includes Domain Names and Trademarks with the "Amazon" name in the eight countries listed. It is not an exhaustive list. Amazon has many more Domains and Trademarks registered in South America (including, for example, the "KINDLE" Trademark). Amazon also owns Domain names in Guyana (AMAZON.GF) and Surinam (AMAZON.SR) but the data is not currently available at the registry level. Some of the Domain Names listed in this report have been acquired from Third Parties and Infringers.

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## OVERALL SUMMARY

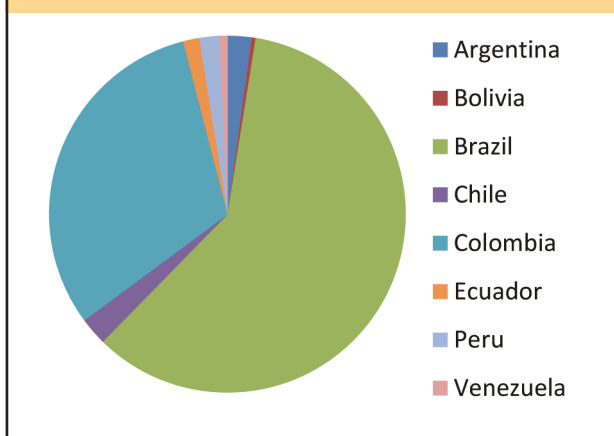
### Domain Registrations

Country	Total
Argentina	6
Bolivia	1
Brazil	165
Chile	7
Colombia	86
Ecuador	4
Peru	5
Venezuela	2
<b>Grand Total</b>	<b>276</b>

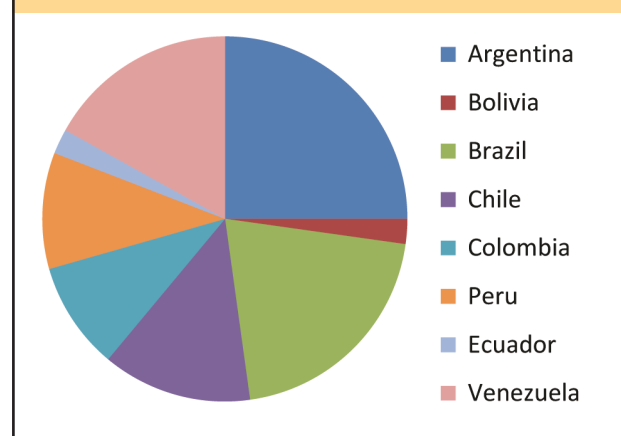
### Trademark Filings

Country	Total
Argentina	34
Bolivia	3
Brazil	28
Chile	18
Colombia	13
Ecuador	3
Peru	14
Venezuela	23
<b>Grand Total</b>	<b>136</b>

### Total Domain registrations per country



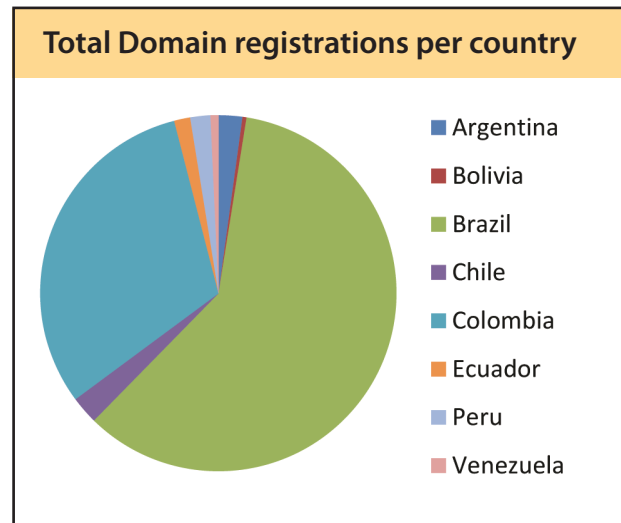
### Total Trademark filings per country



## Summary

- Second-level domains are not available to anyone in Argentina, Brazil and Venezuela
- Argentina only allows registrations under .com.ar
- Brazil only allows registrations under restricted hierarchies (e.g., .com.br, .org.br)
- Aside from local presence requirements, there is no formal review process for most of these hierarchies
  - The exceptions are .org.br, .srv.br and .tv.br, which are completely “closed”

Domain Registrations	
Country	Total
Argentina	6
Bolivia	1
Brazil	165
Chile	7
Colombia	86
Ecuador	4
Peru	5
Venezuela	2
<b>Grand Total</b>	<b>276</b>



## ARGENTINA

### i. .AR Domain Registrations

Domain Name	Acquisition Date
AMAZON.COM.AR	9/18/1998
AMAZONKINDLEFIRE.COM.AR	9/29/2011
AMAZONCLOUD.COM.AR	9/29/2011
AMAZONSILK.COM.AR	9/29/2011
AMAZONFREETIME.COM.AR	9/6/2012
AMAZONKINDLE.COM.AR	11/30/2007

### ii. Domain registrations with the country name "Argentina"

Domain Name	Acquisition Date
AMAZONARGENTINA.COM	6/25/2004

## BOLIVIA

### i. .BO Domain Registrations

Domain Name	Acquisition Date
AMAZON.COM.BO	12/23/1999

### ii. Domain registrations with the country name "Bolivia"

Domain Name	Acquisition Date
AMAZONBOLIVIA.COM	5/11/2007

## BRAZIL

### i. .BR Domain Registrations

Domain Name	Acquisition Date
AMAZON.COM.BR	7/20/2012
AMAZONKINDLEKDK.COM.BR	1/21/2010
AMAZONKINDLEDEVELOPMENTKIT.COM.BR	1/21/2010
AMAZONKINDLEACTIVECONTENT.COM.BR	1/21/2010
AMAZONGAMESERVICES.COM.BR	1/10/2013
AMAZONSQS.COM.BR	12/16/2011
AMAZONCLOUDWATCH.COM.BR	12/16/2011



Domain Name	Acquisition Date
AMAZONELASTICCOMPUTECLLOUD.COM.BR	12/16/2011
AMAZONSIMPLEDB.COM.BR	12/16/2011
AMAZONSNS.COM.BR	12/16/2011
AMAZONCLOUDFRONT.COM.BR	12/16/2011
AMAZONRDS.COM.BR	12/16/2011
AMAZONS3.COM.BR	12/16/2011
AMAZONCLOUDFORMATION.COM.BR	12/16/2011
AMAZONLOJAVIRTUAL.COM.BR	12/12/2012
AMAZONLOCKER.COM.BR	12/10/2012
WAMAZON.COM.BR	12/7/2012
AMAZONM.COM.BR	12/7/2012
AMAZONL.COM.BR	12/7/2012
EVERYTHINGINAMAZONBRAZIL.COM.BR	12/5/2012
AMAZONFREETIMEUNLIMITED.COM.BR	12/5/2012
SUAMAZONBRASIL.NET.BR	12/5/2012
TUDONAMAZONBRASIL.NET.BR	12/5/2012
SUAMAZONBRASIL.COM.BR	12/5/2012
TUDONAMAZONBRASIL.COM.BR	12/5/2012
YOURAMAZONBRAZIL.COM.BR	12/5/2012
AMAZONBRASILAQUI.NET.BR	12/3/2012
AMAZONSHOPPINGBRASIL.COM.BR	12/3/2012
AMAZONCLICKBUY.COM.BR	12/3/2012
KINDLEBOOKSAMAZON.COM.BR	12/3/2012
YOURAMAZON.COM.BR	12/3/2012
AMAZONMOVIES.COM.BR	12/3/2012
COMPRASNAMAZON.NET.BR	12/3/2012
AMAZONCOMPRASNOBRASIL.COM.BR	12/3/2012
AMAZONAGORANOBRAZIL.COM.BR	12/3/2012
AMAZONBRASILAQUI.COM.BR	12/3/2012
AMAZONCOMPRASNOBRASIL.NET.BR	12/3/2012
SEUAMAZON.COM.BR	12/3/2012
AMAZONCINEMA.COM.BR	12/3/2012
AMAZONFILME.COM.BR	12/3/2012
COMPRASNAMAZON.COM.BR	12/3/2012
AMAZONAGORANOBRAZIL.NET.BR	12/3/2012
AMAZONMUSICA.COM.BR	12/3/2012
KINDLEBOOKSAMAZON.NET.BR	12/3/2012
AMAZONSHOPPINGBRASIL.NET.BR	12/3/2012
AMAZONBRAZILHERE.COM.BR	12/3/2012
AMAZONTELEVISION.COM.BR	12/3/2012

Domain Name	Acquisition Date
AMAZONTELEVISION.COM.BR	12/3/2012
AMAZONAUDIO.COM.BR	12/3/2012
AMAZONTELEVISAO.COM.BR	12/3/2012
AMAZONBUYSINBRAZIL.COM.BR	12/3/2012
AMAZONCLICKBUY.NET.BR	12/3/2012
AMAZONINSTANTVIDEO.COM.BR	11/17/2011
AMAZONDEVPAY.COM.BR	11/5/2012
AMAZONMONEY.COM.BR	11/13/2012
AMAZONMONEYACCOUNT.COM.BR	11/13/2012
AMAZONCLOUDDRIVEPHOTOS.COM.BR	11/1/2012
AMAZONDATA.COM.BR	10/23/2011
AMAZONTABLET.COM.BR	10/23/2011
AMAZONBUSCA.COM.BR	10/23/2011
AMAZONTECNOLOGIA.COM.BR	10/23/2011
AMAZONPRESS.COM.BR	10/23/2011
AMAZONIA TECH.COM.BR	10/23/2011
AMAZONSHOPPING.COM.BR	10/23/2011
AMAZONTRAINING.COM.BR	10/23/2011
AMAZONOFERTA.COM.BR	10/23/2011
THEAMAZONS.COM.BR	10/23/2011
AMAZONPLAYER.COM.BR	10/23/2011
AMAZONTABLETS.COM.BR	10/23/2011
FASHIONAMAZON.COM.BR	10/23/2011
SUPERAMAZON.COM.BR	10/23/2011
AMAZONOFERTAS.COM.BR	10/23/2011
AMAZONSITES.COM.BR	10/23/2011
AMAZONKINDLE.COM.BR	10/23/2011
AMAZONCASA.COM.BR	10/23/2011
GREENAMAZON.COM.BR	10/23/2011
AMAZONVOIP.COM.BR	10/23/2011
STUDIOAMAZON.COM.BR	10/23/2011
AMAZONSEXSHOP.COM.BR	10/23/2011
CLOUDAMAZON.COM.BR	10/21/2012
AMAZONKIDS.COM.BR	10/21/2012
AMAZONLIFE.COM.BR	10/21/2012
AMAZONGAME.COM.BR	10/21/2012
AMAZONMEGASTORE.COM.BR	10/21/2012
AMAZONMOBILE.ECO.BR	10/21/2012
AMAZONN.COM.BR	10/21/2012
AMAZONPRIME.COM.BR	10/21/2012

Domain Name	Acquisition Date
AMAZONMOBILE.COM.BR	10/21/2012
AMAZONDUO.COM.BR	10/8/2012
AMAZONCLOUDPLAYER.COM.BR	9/28/2011
AMAZONCLOUDSTORAGE.COM.BR	9/28/2011
AMAZONKINDLETOUCH.COM.BR	9/28/2011
AMAZONSILKBROWSER.COM.BR	9/28/2011
AMAZONCLOUDDRIVE.COM.BR	9/28/2011
AMAZONKINDLEFIRE.COM.BR	9/28/2011
AMAZONSILK.COM.BR	9/21/2011
AMAZON-FAMILY.COM.BR	9/20/2012
AMAZONFAMILY.COM.BR	9/20/2012
AMAZONUSA.COM.BR	9/16/2011
AAMAZON.COM.BR	9/16/2011
AMAZONPREMIUM.COM.BR	9/11/2012
AMAZONBASICS.COM.BR	9/9/2009
AMAZONPOWERFAST.COM.BR	9/6/2012
AMAZONTIMETOREAD.COM.BR	9/6/2012
AMAZONFREETIME.COM.BR	9/6/2012
AMAZONPAPERWHITE.COM.BR	9/6/2012
AMAZONVPC.COM.BR	8/26/2009
AMAZONCLOUDREADER.COM.BR	8/17/2011
AWSAMAZON.COM.BR	8/17/2011
AMAZONEC2.COM.BR	8/17/2011
AMAZONKINDLECLOUDREADER.COM.BR	8/17/2011
AMAZONROUTE53.COM.BR	8/17/2011
AMAZONVIDEOSHORTS.COM.BR	7/24/2012
AMAZONE.COM.BR	7/20/2000
AMAZONVIDEOSHORT.COM.BR	7/20/2012
AMAZONWEB.COM.BR	6/20/2010
AMAZONVIP.COM.BR	6/20/2010
AMAZONSTUDIOS.COM.BR	6/17/2012
AMAZONCOMPRAS.COM.BR	6/17/2012
AMAZONSTORE.NET.BR	6/17/2012
AMAZONKINDLEBOOKS.COM.BR	6/17/2012
AMAZONDOWNPLAYER.COM.BR	6/1/2012
AMAZONMP3PLAYER.COM.BR	6/1/2012
AMAZONDOWNLOADS.COM.BR	6/1/2012
AMAZONMUSICDOWNLOAD.COM.BR	6/1/2012
AMAZONDOWN.COM.BR	6/1/2012

Domain Name	Acquisition Date
AMAZONMUSICDOWNLOADS.COM.BR	6/1/2012
AMAZONGAMECIRCLE.COM.BR	5/25/2012
AMAZONB2B.COM.BR	3/29/2012
AMAZON.EMP.BR	3/26/2012
AMAZONCURSOS.COM.BR	2/26/2012
AMAZONMUSIC.COM.BR	2/26/2012
AMAZONBOOKS.COM.BR	2/26/2012
AMAZONCOZINHA.COM.BR	2/26/2012
AMAZONIAINFORMATICA.COM.BR	2/26/2012
LOJAAMAZON.COM.BR	2/26/2012
AMAZONGLOBAL.COM.BR	2/26/2012
AMAZONMEDIAGROUP.COM.BR	2/26/2012
AMAZONFRESH.COM.BR	2/26/2012
AMAZONNETWORKBRASIL.COM.BR	2/26/2012
AMAZONSEX.COM.BR	2/26/2012
AMAZONLAND.COM.BR	2/26/2012
AMAZONASPRODUCOES.COM.BR	2/26/2012
AMAZONASAUTOS.COM.BR	2/26/2012
AMAZONEXPRESS.COM.BR	2/26/2012
SHOPAMAZON.COM.BR	2/26/2012
AMAZONNETWORK.COM.BR	7/20/2012
AMAZONPRODUCOES.COM.BR	2/17/2012
AMAZON1.COM.BR	2/17/2012
AMAZON.ATO.BR	2/16/2012
AMAZON.SRV.BR	2/16/2012
AMAZON.FLOG.BR	2/16/2012
AMAZON.PPG.BR	2/16/2012
AMAZON.TMP.BR	2/16/2012
AMAZON.RADIO.BR	2/16/2012
AMAZON.VLOG.BR	2/16/2012
AMAZON.IND.BR	2/16/2012
AMAZON.CNG.BR	2/16/2012
AMAZON.REC.BR	2/16/2012
AMAZON.ETI.BR	2/16/2012
AMAZON.INF.BR	2/16/2012
AMAZON.ETC.BR	2/16/2012
AMAZON.WIKI.BR	2/16/2012
AMAZONAPPS.COM.BR	1/9/2012
EAMAZON.COM.BR	2/25/2000

**ii. Subset of the above list plus gTLD registrations with the name “Brazil”**

Domain Name	Acquisition Date
AMAZONBRAZIL.ORG	7/28/2009
AMAZONFASHIONBRAZIL.COM	12/5/2012
YOURAMAZONBRAZIL.COM.BR	12/5/2012
AMAZONBRAZILHERE.COM.BR	12/3/2012
AMAZONBUYSINBRAZIL.COM.BR	12/3/2012
AMAZONBRAZILCOMPANY.COM	9/27/2012
EVERYTHINGINAMAZONBRAZIL.COM.BR	12/5/2012
AMAZONBRAZIL.MOBI	7/28/2009
AMAZONBRAZIL.COM	7/20/2007
BRAZILAMAZON.COM	4/12/2005
AMAZONBRAZIL.BIZ	7/4/2012
AMAZONBRAZIL.INFO	7/2/2009
AMAZONBRAZIL.NET	6/4/2007
BRAZIL-AMAZON.COM	1/15/2008

**ii. Subset of the above list plus gTLD registrations with the name “Brasil”**

Domain Name	Acquisition Date
AMAZONBRASIL.COM	5/29/2012
AMAZONBRASILSHOPPING.COM	3/25/2012
AMAZONFASHIONBRASIL.COM	12/5/2012
SUAMAZONBRASIL.NET.BR	12/5/2012
TUDONAMAZONBRASIL.NET.BR	12/5/2012
SUAMAZONBRASIL.COM.BR	12/5/2012
TUDONAMAZONBRASIL.COM.BR	12/5/2012
AMAZONBRASILAQUI.NET.BR	12/3/2012
AMAZONSHOPPINGBRASIL.COM.BR	12/3/2012
AMAZONCOMPRASNOBRASIL.COM.BR	12/3/2012
AMAZONAGORANBRASIL.COM.BR	12/3/2012
AMAZONBRASILAQUI.COM.BR	12/3/2012
AMAZONCOMPRASNOBRASIL.NET.BR	12/3/2012
AMAZONAGORANBRASIL.NET.BR	12/3/2012
AMAZONSHOPPINGBRASIL.NET.BR	12/3/2012
BRASILAMAZON.COM	5/26/2012
AMAZONBRASIL.ORG	5/9/2012
AMAZONBRASIL.NET	3/26/2012
AMAZONNETWORKBRASIL.COM.BR	2/26/2012

**iii. Domain registrations under .br.com**

Domain Name	Acquisition Date
AMAZON.BR.COM	6/21/2000

## CHILE

### i. .CL Domain Registrations

Domain Name	Acquisition Date
AMAZON.CL	8/25/1999
AMAZONKINDLE.CL	8/26/2010
AMAZONKINDLEFIRE.CL	9/28/2011
AMAZONSILK.CL	9/28/2011
AMAZONCLOUD.CL	9/28/2011
AMAZONFREETIME.CL	9/6/2012
AMAZONITA.CL	3/21/2011

### ii. Domain registrations with the country name "Chile"

Domain Name	Acquisition Date
AMAZONCHILE.COM	6/25/2003

## COLOMBIA

### i. .CO Domain Registrations

Domain Name	Acquisition Date
AMAZON.CO	2/24/2010
AMAZON.COM.CO	1/21/2000
AAMAZON.CO	7/21/2010
AMAZON.NET.CO	2/8/2010
AMAZON.NOM.CO	2/8/2010
AMAZONADMASH.CO	4/11/2011
AMAZONAPP.CO	10/15/2010
AMAZONAPPS.CO	10/15/2010
AMAZONAPPSTORE.CO	10/23/2012
AMAZONAUTORIP.CO	1/7/2013
AMAZONAWS.CO	7/21/2010
AMAZONAWSGLACIER.CO	8/20/2012
AMAZONBASICS.CO	7/21/2010
AMAZONBOOKS.CO	7/21/2010
AMAZONCLOUDDRIVE.CO	3/28/2011
AMAZONCLOUDFRONT.CO	3/5/2013
AMAZONCLOUDPLAYER.CO	3/28/2011
AMAZONCLOUDREADER.CO	8/9/2011
AMAZONCLOUDSTORAGE.CO	9/28/2011
AMAZONCO.CO	4/20/2011
AMAZONEC2.CO	7/21/2010

Domain Name	Acquisition Date
AMAZONELASTICTRASCODER.CO	1/28/2013
AMAZONFREETIME.CO	9/6/2012
AMAZONFREETIMEUNLIMITED.CO	12/5/2012
AMAZONFRESH.CO	6/29/2010
AMAZONGAMESERVICES.CO	1/9/2013
AMAZONGLACIER.CO	8/20/2012
AMAZONINSTANTVIDEO.CO	2/22/2011
AMAZONINSTANTVIDEOS.CO	2/22/2011
AMAZONKINDLE.CO	6/29/2010
AMAZONKINDLE.COM.CO	2/8/2010
AMAZONKINDLE.NET.CO	2/8/2010
AMAZONKINDLECLOUDREADER.CO	8/9/2011
AMAZONKINDLEDX.COM.CO	2/8/2010
AMAZONKINDLEFIRE.CO	9/28/2011
AMAZON-KINDLE-FIRE.CO	9/28/2011
AMAZONKINDLETOUCH.CO	9/28/2011
AMAZONL.CO	1/26/2011
AMAZONLOCAL.CO	3/23/2011
AMAZONLOCKER.CO	12/10/2012
AMAZONM.CO	1/26/2011
AMAZONMOBILE.CO	4/29/2011
AMAZONMP3.CO	6/29/2010
AMAZONN.CO	4/20/2011
AMAZONPAYMENTS.CO	7/21/2010
AMAZONPOWERFAST.CO	9/6/2012
AMAZONPRIME.CO	6/29/2010
AMAZONREDSHIFT.CO	11/26/2012
AMAZONS.CO	4/20/2011
AMAZONS3.CO	7/21/2010
AMAZONSELLERCENTRAL.CO	4/5/2011
AMAZON-SELLERCENTRAL.CO	4/5/2011
AMAZONSERVICES.CO	7/21/2010
AMAZONSES.CO	1/25/2011
AMAZONSILK.CO	9/28/2011
AMAZON-SILK.CO	9/28/2011
AMAZONSILKBROWSER.CO	9/28/2011
AMAZON-SILK-BROWSER.CO	9/28/2011
AMAZONSIMPLEEMAILSERVICE.CO	1/25/2011
AMAZONSTUDIOS.CO	11/15/2010
AMAZONSUPPLIES.CO	3/29/2012

Domain Name	Acquisition Date
AMAZONSUPPLY.CO	3/29/2012
AMAZONTICKETS.CO	1/23/2012
AMAZONTIMETOREAD.CO	9/6/2012
AMAZONWEBSERVICES.CO	6/29/2010
AMAZONWEBSTORE.CO	7/21/2010
AMAZONWHISPERCAST.CO	6/20/2012
AMAZONWHISPERNET.CO	7/21/2010
AMAZONWHISPERSYNC.CO	7/21/2010
AMAZONWINE.CO	9/27/2012
AMAZONWORLD.CO	7/21/2010
AWSAMAZON.CO	7/21/2010
EAMAZON.CO	1/26/2011
FULFILLMENTBYAMAZON.CO	7/21/2010
PAYWITHAMAZON.CO	4/11/2012
PAY-WITH-AMAZON.CO	4/11/2012
QAMAZON.CO	4/20/2011
SELLERCENTRALAMAZON.CO	4/5/2011
SELLERCENTRAL-AMAZON.CO	4/5/2011
SSL-IMAGES-AMAZON.CO	7/21/2010
WAMAZON.CO	1/26/2011
WWAMAZON.CO	7/21/2010
WWWAMAZON.CO	7/21/2010
WWW-AMAZON.CO	1/26/2011
WWWAMAZONCO.CO	4/20/2011
WWWLAMAZON.CO	7/21/2010

**ii. Domain registrations with the country name “Colombia”**

Domain Name	Acquisition Date
AMAZONCOLOMBIA.COM	6/25/2003

**ECUADOR**

**i. .EC Domain Registrations**

Domain Name	Acquisition Date
AMAZON.EC	10/22/2003
AMAZON.COM.EC	1/28/1998
EAMAZON.EC	10/22/2003
EAMAZON.COM.EC	6/16/2000



**ii. Domain registrations with the country name “Ecuador”**

Domain Name	Acquisition Date
AMAZONECUADOR.COM	11/7/2012
AMAZONENECUADOR.COM	9/12/2012
ECUADORAMAZON.COM	10/8/2007

**PERU**

**i. .PE Domain Registrations**

Domain Name	Acquisition Date
AMAZON.PE	12/8/2007
AMAZON.COM.PE	3/16/1998
AMAZONKINDLE.PE	2/21/2008
AMAZONKINDLE.COM.PE	2/21/2008
EAMAZON.COM.PE	5/8/2000

**ii. Domain registrations with the country name “Peru”**

Domain Name	Acquisition Date
AMAZON-PERU.COM	7/3/2005

**VENEZUELA**

**i. .VE Domain Registrations**

Domain Name	Acquisition Date
AMAZON.COM.VE	4/5/2000
AMAZON.CO.VE	4/5/2000

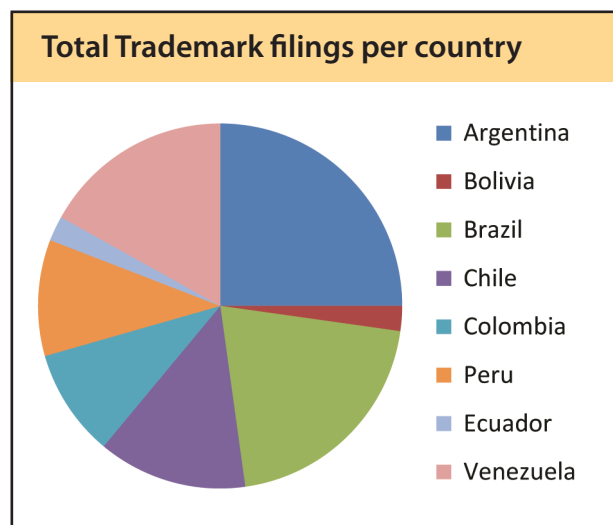
**ii. Domain registrations with the country name “Venezuela”**

Domain Name	Acquisition Date
AMAZONVENEZUELA.COM	6/25/2003
AMAZONVENEZUELA.NET	5/21/2011

# EXTRACT FROM AMAZON TRADEMARK PORTFOLIO IN SOUTH AMERICA

## Summary

Trademark Filings	
Country	Total
Argentina	34
Bolivia	3
Brazil	28
Chile	18
Colombia	13
Ecuador	3
Peru	14
Venezuela	23
<b>Grand Total</b>	<b>136</b>



## ARGENTINA

Title	Status	Application #	Application Date	Registration #	Registration Date
AMAZON.COM (42)	Registered	12186	9/16/1999	89500-C	3/20/2003
AMAZON.COM (38)	Registered	12187	9/16/1999	89501-C	3/20/2003
AMAZON.COM (35)	Registered	12188	9/16/1999	89499-C	3/20/2003
AMAZON (28)	Registered	2.278.422	4/3/2000	1.841.859	8/28/2001
AMAZON (45)	Registered		4/3/2000	1.841.855	8/28/2001
AMAZON.COM (38)	Registered	2.241.592	9/16/1999	1.816.575	1/19/2001
AMAZON.COM (43)	Registered	1816578	9/16/1999	3063134	1/19/2001
AMAZON (22)	Registered	2.278.419	4/3/2000	1.841.856	8/28/2001
AMAZON (35)	Registered	2.278.423	4/3/2000	1.841.860	8/28/2001
AMAZON.COM (44)	Registered	1816578	9/16/1999	3063136	1/19/2001
AMAZON (20)	Registered	2.278.417	4/3/2000	1.841.865	8/28/2001
AMAZON.COM (39)	Registered	2.241.593	9/16/1999	1.816.576	1/19/2001
AMAZON (15)	Registered	2.278.413	4/3/2000	1.843.616	9/14/2001
AMAZON (38)	Registered	2.278.425	4/3/2000	1.841.852	8/28/2011
AMAZON (24)	Registered	2.278.420	4/3/2000	1.841.857	8/28/2001
AMAZON (25)	Registered	2.278.421	4/3/2000	1.841.858	8/28/2001
AMAZON (39)	Registered	2.278.426	4/3/2000	1.841.853	8/28/2001
AMAZON.COM (42)	Registered	2.241.595	9/16/1999	1.816.578	1/19/2001
AMAZON.COM (41)	Registered	2.241.594	9/16/1999	1.816.577	1/19/2001
AMAZON.COM (Design) (41)	Registered	2.295.175	7/4/2000	1.853.698	11/29/2001
AMAZON (07)	Registered	2679845	6/22/2006	2.235.755	6/24/2008
AMAZON (11)	Registered	2.278.410	4/3/2000	1.916.903	3/6/2003

Title	Status	Application #	Application Date	Registration #	Registration Date
AMAZON (19)	Registered	2.278.416	4/3/2000	1.841.864	8/28/2001
AMAZON.COM (Design) (45)	Registered	2.295.175	7/4/2000	1.853.698	11/29/2001
AMAZON (09)	Registered	2.278.409	4/3/2000	1.843.614	9/14/2001
AMAZON (06)	Registered	2.278.406	4/3/2000	1.852.192	11/19/2001
AMAZON (41)	Registered	2.278.427	4/3/2000	1.841.854	8/28/2001
AMAZON.COM (Design) (42)	Registered	2.295.175	7/4/2000	1.853.698	11/29/2001
AMAZON.COM (45)	Registered	1816578	9/16/1999	3063138	1/19/2001
AMAZON.COM (35)	Registered	2145224	4/22/1998	1779480	3/17/2000
AMAZON.COM (Design) (35)	Registered	2.679.846	6/22/2006	2.371.391	5/28/2010
AMAZON (12)	Registered	2.278.411	4/3/2000	1.843.615	9/14/2001
AMAZON.COM (35)	Registered	2977762	2/9/2010	2418099	
AMAZON (08)	Registered	2679844	6/22/2006	2.235.754	6/24/2008
AMAZON (21)	Registered	2.492.843	2/3/2004	2049762	10/31/2005
AMAZON (42)	Registered	2278428	03/04/2000	1841855	28/08/2001
AMAZON (11)	Registered	2278410	03/04/2000	1916903	06/03/2003

## BOLIVIA

Title	Status	Application #	Application Date	Registration #	Registration Date
AMAZON.COM (42)	Registered	12186	9/16/1999	89500-C	3/20/2003
AMAZON.COM (38)	Registered	12187	9/16/1999	89501-C	3/20/2003
AMAZON.COM (35)	Registered	12188	9/16/1999	89499-C	3/20/2003

## BRAZIL

Title	Status	Application #	Application Date	Registration #	Registration Date
AMAZON.COM (42)	Registered	12186	9/16/1999	89500-C	3/20/2003
AMAZON.COM (38)	Registered	12187	9/16/1999	89501-C	3/20/2003
AMAZON.COM (35)	Registered	12188	9/16/1999	89499-C	3/20/2003
AMAZON.COM (35)	Registered	819841978	3/11/1997	819841978	06/08/2002
EAMAZON (35)	Registered	823149196	9/14/2000	823149196	29/01/2008
EAMAZON (41)	Published	823149170	9/14/2000		
AMAZON.COM (40, 35, 34, 15, 40, 40)	Opposed	822027178	9/17/1999		
AMAZON BASICS (Design) (9)	Opposed	902.170.791	12/4/2009		
AMAZON BASICS (Design) (2)	Opposed	902.170.759	12/4/2009		
AMAZON.COM (38)	Opposed	822027186	9/17/1999		
AMAZON BASICS (Design) (16)	Published	902.170.970	12/4/2009		
AMAZON WEB SERVICES (Design) (42)	Published	830958193	3/14/2011		
AMAZON BASICS (Design) (18)	Published	902.171.038	12/4/2009		
AMAZON BASICS (Design) (20)	Published	902.171.054	12/4/2009		
AMAZON BASICS (Design) (28)	Published	902.171.089	12/4/2009		

Title	Status	Application #	Application Date	Registration #	Registration Date
AMAZON ROUTE 53 (35)	Published	831237465	10/6/2011		
AMAZON ROUTE 53 (42)	Published	831237481	10/6/2011		
AMAZON 1-CLICK (35)	Published	831284420	12/19/2011		
AMAZON ROUTE 53 (45)	Published	831237490	10/6/2011		
AMAZON.COM (Design) (39)	Published	901764167	7/3/2009		
AMAZON PRIME (35)	Filed	901.961.566	9/17/2009		
AMAZON BASICS (Design) (11)	Filed	902.171.160	12/4/2009		
AMAZON FLOW (41)	Filed	840101309	4/24/2012		
AMAZON FLOW (38)	Filed	840101295	4/24/2012		
AMAZON FLOW (9)	Filed	840101279	4/24/2012		
AMAZON FLOW (42)	Filed	840101260	4/24/2012		
AMAZON FLOW (35)	Filed	840101287	4/24/2012		
EAMAZON (42)	Filed	823149188	9/14/2000		
AMAZON.COM (Design) (35)	Filed	822962683	7/12/2000		
AMAZON SILK	Filed	840278829	9/26/2012		
AMAZON SILK	Filed	840278802	9/26/2012		

## CHILE

Title	Status	Application #	Application Date	Registration #	Registration Date
AMAZON.COM (Design) (35, 42)	Registered	493.083	7/13/2000	587.362	1/10/2001
AMAZON.COM (35, 42)	Registered	419.597	7/6/1998	532.142	1/14/1999
AMAZON (19)	Registered	482.675	4/14/2000	917.781	10/30/2000
AMAZON (09)	Registered	482.668	4/14/2000	917.795	10/30/2000
AMAZON (42)	Registered	482.687	4/14/2000	905.356	10/30/2000
AMAZON (11)	Registered	482.669	4/14/2000	917.794	10/30/2000
AMAZON (38)	Registered	482.684	4/14/2000	905.355	10/30/2000
AMAZON (24)	Registered	482.679	4/14/2000	917.778	10/30/2000
AMAZON (16)	Registered	482.673	4/14/2000	917.783	10/30/2000
AMAZON (35)	Registered	482.682	4/14/2000	916.919	3/15/2001
AMAZON (20)	Registered	482.676	4/14/2000	917.780	10/30/2000
AMAZON (18)	Registered	482.674	4/14/2000	917.782	10/30/2000
AMAZON (08)	Registered	482.667	4/14/2000	917.852	10/30/2000
AMAZON (21)	Registered	482.677	4/14/2000	917.779	10/30/2000
AMAZON (06)	Registered	482.665	4/14/2000	917.853	10/30/2000
AMAZON (15)	Registered	482.672	4/14/2000	917.784	10/30/2000
AMAZON (22)	Registered	482.678	4/14/2000	917.777	10/30/2000
AMAZON (41)	Registered	482.686	4/14/2000	905.357	11/23/2000

## COLOMBIA

Title	Status	Application #	Application Date	Registration #	Registration Date
AMAZON.COM (35 Exp.)	Registered	9/9/1999	99 057177	228783	8/24/2000
AMAZON.COM (39)	Registered	9/3/1999	99 055879	227347	5/19/2000
AMAZON.COM (35)	Registered	9/9/1999	99 057176	227353	5/19/2000
AMAZON.COM (35)	Registered	1/17/1998	98021304	214594	11/30/1998
AMAZON (42)	Registered	4/17/2000	28290	232563	1/18/2001
AMAZON (28)	Registered	4/14/2000	27869	232928	1/18/2001
AMAZON (36)	Registered	4/14/2000	27867	232929	1/18/2001
AMAZON (35)	Registered	4/17/2000	28289	232564	1/18/2001
AMAZON (16)	Registered	4/14/2000	27870	232927	1/18/2001
AMAZON (41)	Maintenance	4/14/2000	27863	233711	4/17/2001
AMAZON (09)	Registered	4/14/2000	27862	232931	1/18/2001
AMAZON (38)	Registered	4/14/2000	27865	232930	1/18/2001
AMAZON (39)	Registered	4/14/2000	27860	231398	12/5/2000

## ECUADOR

Title	Status	Application #	Application Date	Registration #	Registration Date
AMAZON.COM (42)	Registered	100673	12/7/1999	3939-01	2/15/2001
AMAZON.COM (38)	Registered	100672	12/7/1999	3938-01	2/15/2001
AMAZON.COM (35 Exp.)	Registered	100671	12/7/1999	3937-01	2/15/2001

## PERU

Title	Status	Application #	Application Date	Registration #	Registration Date
AMAZON.COM (09)	Registered	91641	9/17/1999	60814	1/31/2000
AMAZON (42)	Registered	104374	4/14/2000	27088	9/18/2001
AMAZON.COM (39)	Registered	91643	9/16/1999	20329	2/10/2000
AMAZON (09)	Registered	104382	4/14/2000	67013	10/19/2000
AMAZON (28)	Registered	104380	4/14/2000	64833	7/19/2000
AMAZON.COM (38)	Registered	91640	9/17/1999	20199	1/31/2000
AMAZON (16)	Registered	471193	4/14/2000	3649	11/30/2001
AMAZON (39)	Registered	104378	4/14/2000	26129	6/21/2001
AMAZON.COM (35)	Registered	91639	9/17/1999	22001	7/11/2000
AMAZON (38)	Registered	104379	4/14/2000	23429	10/27/2000
AMAZON (35)	Registered	104778	4/19/2000	26185	6/28/2001
AMAZON.COM (16)	Registered	405372	11/13/2009	164233	6/17/2010
AMAZON.COM (42)	Registered	91642	9/17/1999	20241	1/31/2000
AMAZON (41)	Registered	06/10/2185	14/04/2000	26648	08/08/2001

## VENEZUELA

Title	Status	Application #	Application Date	Registration #	Registration Date
AMAZON (01, 02, 29, 30, 33)	Registered	4/6/2000	2000-005735	P-228432	11/22/2000
AMAZON (21, 23, 24, 26)	Registered	4/6/2000	2000-005737	P-228434	11/22/2000
AMAZON (18, 21)	Registered	4/6/2000	2000-005731	P-228428	11/22/2000
AMAZON (08, 19)	Registered	4/6/2000	2000-005734	P-228431	11/22/2000
AMAZON (13, 14)	Registered	4/6/2000	2000-005729	P-228427	11/22/2000
AMAZON (21, 31)	Registered	4/6/2000	2000-005726	P-228424	11/22/2000
AMAZON (27, 28)	Registered	4/6/2000	2000-005733	P-228430	11/22/2000
AMAZON (03, 41)	Registered	4/6/2000	2000-005732	P-228429	11/22/2000
AMAZON (41)	Maintenance	4/11/2000	2000-006094	S-016674	6/1/2001
AMAZON.COM (38)	Maintenance	9/17/1999	16.203-99	S-017924	8/27/2001
AMAZON (36)	Registered	4/6/2000	2000-005725	P-228423	11/22/2000
AMAZON (23)	Registered	4/6/2000	2000-005728	P-228426	11/22/2000
AMAZON (39)	Maintenance	4/11/2000	2000-006090	S-016673	6/1/2001
AMAZON (32)	Registered	4/6/2000	2000-005738	P-228435	11/22/2000
AMAZON (28)	Maintenance	4/11/2000	2000-006093	P-233100	8/27/2001
AMAZON (42)	Registered	4/6/2000	2000-005724	P-228422	11/22/2000
AMAZON.COM (35)	Maintenance	9/17/1999	16.205-99	S-017926	8/27/2001
AMAZON (16)	Maintenance	4/11/2000	2000-006091	P-233099	8/27/2001
AMAZON (07)	Registered	4/6/2000	2000-005727	P-228425	11/22/2000
AMAZON (12)	Registered	4/6/2000	2000-005736	P-228433	11/22/2000
AMAZON.COM (42)	Maintenance	9/17/1999	16.204-99	S-017925	8/27/2001
AMAZON (50)	Registered	4/6/2000	2000-005739	S-015775	11/22/2000
AMAZON (05)	Opposed	4/6/2000	2000-005730		

## **APPENDIX C**

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DURBAN – GAC Plenary 2  
Saturday, July 13, 2013 – 16:00 to 17:00  
ICANN – Durban, South Africa

CHAIR DRYDEN: Good afternoon again, everyone. If we could begin to take our seats, please, we will begin.

Okay. Let's get started on our next session.

So we now have about 45 minutes to deal with our next agenda item regarding the GAC Beijing communique and where we stand regarding the responses from the Board or the New gTLD Program Committee on that communique.

And then at 5:00 we have, as you I think are aware, we have canceled the Board/GAC Recommendation Implementation Working Group session as we will talk about GAC early engagement in the policy development process when we meet with the GNSO. And I understand that Board colleagues from the Board/GAC working group will aim to be in attendance when we discuss that in the GNSO. So we will still have the benefit of their involvement in those discussions. And so in light of having this additional time and a late request from a group that wishes to establish a constituency for geo registries, that the vice chairs were very supportive of including in our agenda. They were able to agree to come and brief us at 5:00 on that. So we've allotted 30 minutes to receive a briefing from them. And I expect it will be along the same lines as the briefing we received in Beijing from the group wanting to set up the Brand Registry Group, which I understand has now been set up.

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*Note: The following is the output resulting from transcribing an audio file into a word/text document. Although the transcription is largely accurate, in some cases may be incomplete or inaccurate due to inaudible passages and grammatical corrections. It is posted as an aid to the original audio file, but should not be treated as an authoritative record.*



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So that will happen at 5:00. So in the meantime, here's what I would like us to accomplish.

We have a few documents that we can refer to for these next discussions, and I think probably the one that's most clear and summarizes everything nicely is the NGPC consideration of GAC Beijing advice dated 3rd July 2013, which is the full scorecard. So you will note that between Beijing and now, we have been getting scorecards coming from the New gTLD Program Committee, and based on their most recent meeting and resolutions and decisions coming out about the GAC's advice, they have now formulated a complete scorecard. So this is the state of play in terms of their responses on the entire Beijing communique including annex 1. And so this is a useful tool for us to see at a quick glance the state of play regarding the policy program committee's consideration of the GAC's advice. As well, recently circulated was a paper coming from the New gTLD Program Committee of the Board and that is titled "Questions and Concerns Regarding Portions of the GAC's Safeguard Advice." And this is focused on the category 1, which also relates to what is being called category 2.1 of the annex to the Beijing communique, where the committee has identified outstanding questions or concerns for the GAC.

And so this paper is meant to give us further information, further guidance for when we meet with them tomorrow morning, I think at 10:00, to look at these main outstanding issues that come from our Beijing communique.

The other issue is regarding the issue of implementation of acronyms of the intergovernmental organizations, and how to be responsive to the

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concerns that have been raised by the IGOs in light of the questions coming from the Board there as well. And we can find some guidance from the New gTLD Committee in the covering letter from the 3rd of July that was sent to us and signed by the chair of the Board, and in the first section there entitled "Initial Protections for IGO Protections," and that is to update the GAC on some of the decisions they have made and some of the questions or concerns that they are now raising with us and the IGO coalition on that.

So I think these are the key outstanding issues, but I do expect that colleagues here will identify others if they think there are other parts of the scorecard where they would like the GAC to comment further or provide further guidance.

So at this point, can we take any initial comments from colleagues about where we are and their thoughts about the agenda that we have identified for tomorrow morning for our exchange with the New gTLD Program Committee?

China, please.

I'm sorry, I can't see who is raising their hand. But, please, go ahead.

CHINA: I have no question.

PERU: This is Peru, Chair.

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CHAIR DRYDEN: Please, go ahead, Peru.

PERU: Okay. Thank you so much, Madam Chair. Peru is taking the floor on behalf of a sizable number of countries concerned about the application of geographic names and in general with the application of dot Amazon in particular, concerns that we would like to request the GAC members to endorse. However, personally, allow me just to salute our fellow colleagues here and to express our appreciation to the government of South Africa for hosting us.

This statement is submitted by Argentina, Brazil, Chile, Peru, and Uruguay with the full support of the Amazon region countries.

And it reads as follows: We acknowledge that the GAC principles regarding new gTLDs adopted in 2007 clearly establish that the principles shall not prejudice the application of the principle of national sovereignty. Besides, we understand that highlighting the importance of public interest is a relevant element that gives stability, sustaining the multistakeholder model, and ultimately the legitimacy of ICANN's administration.

In this sense, this model should contemplate adequate mechanisms before the GAC to guarantee a proper representation of the governments and their communities regarding the public policy issues within the ICANN framework. It is fundamental that governments have the adequate instance where their opinions can be effectively considered, particularly in a content of unprecedented wide-open call for application that has brought uncertainty for both governments and

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applicants and has created conflicts with system rules and will establish precedents and benchmarking for future operations.

In the context of the last applications for new gTLD process, various strings have generated concerns from different countries. This is the case of Brazil, Peru, and the Amazonic countries with the application for dot Amazon by the company Amazon, Inc. and, until very recently, was the case for Argentina and Chile with the application of dot Patagonia.

From the beginning of the process, our countries have expressed their concerns with the aforementioned applications presenting various documents to the GAC, referring to the context and basis of the national and regional concerns, including early warning and GAC advice requests.

Various facts recorded in several historiographical, literary and official documents throughout history, including the recent official regional declarations, have been submitted and explained by each country directly to the GAC and to the applicants through the established procedures and through an active engagement process with the interested parties that has allowed us to explain our position for requesting the withdrawal of the applications.

This is the position adopted, for example, by the fourth Latin American and Caribbean Ministerial Conference on Information Society, the Amazon Cooperation Treaty Organization, the Brazilian Internet Steering Committee, the Brazilian Congress, and the Brazilian civil society, the Peruvian Congress Commission on Indigenous Peoples, local governments of the Peruvian Amazon region, and several representatives of the Peruvian civil society.

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The 2007 principle states that ICANN's core values indicate that the organization, while remaining rooted in the private sector, recognizes that governments and public authorities are responsible for public policy and should take into account governments and public authorities' recommendations.

They also make reference to the provision of the Universal Declaration of Human Rights and the obligation that the new gTLDs should respect the sensitivities regarding terms with national, cultural, geographic, and religious significance.

They clearly add that ICANN should abide country, territory or place names and country, territory or regional language or people descriptions unless in agreement with the relevant governments or public authorities. Therefore, within the context of the approved principles, there is clear basis that supports our position as governments.

We understand that the introduction, delegation, and operation of new gTLDs is an ongoing process, and, therefore, it is subject to constant evaluation, evolution, and change in order to improve the program.

Being the first applications to be analyzed, the decision that will be taken are going to be relevant for future cases and will have effects in future applications which might potentially affect every country. In relation with this application, involved governments have expressed serious concerns related to the public interest. In particular, **dot Amazon is a geographic name that represents important territories of some of our countries which have relevant communities with their own**

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culture and identity directly connected with the name. Beyond the specifics, this should also be understood as a matter of principle.

During our last meeting in Beijing, the great majority of the governments represented in the GAC understood the legitimate concerns we have raised related to the use of geographic names in new gTLDs. We believe that this new GAC meeting is again an important opportunity for the GAC to give a clear mandate following the current principles for new gTLDs, approving the GAC advice proposals submitted by Brazil and Peru for dot Amazon address to the ICANN Board in order to reject this application.

We stand by the commitment to the GAC principles regarding new gTLDs adopted in 2007 which require countries' prior approval for the filing of geographic names and encourage ICANN to formulate clear criteria limiting the utilization of geographic names as top-level domain names in the next round of the program.

Thank you, chair.

CHAIR DRYDEN:

Thank you for those comments, Peru.

The GAC will discuss this agenda item on Tuesday at 10:30, I believe. So I consider your comments relevant to that particular agenda item.

All right. Peru, you have further comments.

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PERU: Yes, just very briefly. Just we will come back in the next opportunity on this, but just to let our colleagues know that this statement has already been provided by the secretariat and you must have it all in your -- in the Internet in your mail accounts.

Thank you.

CHAIR DRYDEN: Thank you for that clarification about the materials.

So for that agenda item regarding the strings for further consideration that we outlined in the Beijing communique, we do have materials that we have posted and circulated and that are available to GAC colleagues, and that includes statements and reports from GAC members.

So if we look at the state of play with the overall scorecard and views regarding the agenda specifically identified for exchange with the new gTLD policy committee tomorrow, are there thoughts on -- for example, do we have agreement that those are the key items that we have a need to exchange with the committee tomorrow on. Is there anything further that colleagues would like to flag that the GAC may need to look at this week in terms of the response?

As I say, most of the advice was accepted by the New gTLD Committee of the Board. And then as I say, there are these outstanding items that we will have a discussion about with the New gTLD Committee tomorrow.

So I see Switzerland and Australia.

Thank you.

SWITZERLAND:

Thank you, Madam Chair.

There's one other issue I would -- wanted to bring to the attention. In the GAC communique of Beijing, we had -- not in the safeguard part but in the general advice on new gTLDs, we had a text about community support for applications which basically says that in cases where a community has expressed a collective and clear opinion, positive or negative, on an application, that ICANN should take this into account. And ICANN basically just responded referring to the community evaluation and objection process.

And the idea of this text is that this should be done also in cases where there has been no community application or no community objection, but because some of the communities were not aware of these procedures or have been advised not to use them for reasons because they were too complicated or others things. There's lots of feedback that we have got in the past months that many communities, although they would -- they are clearly community, did not use these procedures and the idea of this text in the communique was to raise the awareness about this to ICANN and to the Board. And I think we should clarify this in the meeting with the gTLD committee; that we did not intend just to refer to the existing structures but that (indiscernible) is more fundamental than this.

Thank you.

CHAIR DRYDEN:

Thank you for that, Switzerland.



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My quick reaction is in terms of the understanding around what was intended by the GAC's advice, I remember there was some back and forth about that. And I think what we would need to do is, as a GAC, have a discussion about whether there's agreement that we would clarify along the lines you're proposing.

It's not clear to me at this point that we could do that, so let's create time for us to have that discussion, and then we can also raise it in the exchange with the Board on Tuesday, and then focus on the current agenda of the New gTLD Committee.

So we will take note of the need for a follow-up discussion in the GAC about what was intended in providing this advice, which was accepted by the Board gTLD committee, and identify what, if anything further, we would want to comment on or advise on. And we can also make use of the meeting that we have at the end of Tuesday with the Board.

So let's take careful note of that item and deal with it this way.

Okay. So next I have Australia, then United States, then Germany.

So Australia, please.

AUSTRALIA:

Thank you, Chair.

So I have a number of comments about the agenda. The first one is on the questions which the Board has sent through to the GAC to help structure our discussion, or the New gTLD Program Committee has sent through.

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For those who have had a chance to read them, as they only came through today, I think, they're quite detailed. And one thing which I think would be interesting to focus on in our discussion with the committee is if there are any areas of potential agreement. It seems where -- they've focused in great detail on the wording of a particular phrase and various questions, and they've gone into quite a lot of detail. The sense that I don't have from the feedback that we've got is areas where there may not be questions or where there is potentially some sort of provisional agreement. And it might be interesting to draw out areas where there aren't issues and see if we can build on those rather than diving into detailed areas where we may sort of get lost, so to speak.

The second one is I think we may -- although I don't think it's been flagged directly by the committee, we may be in a discussion with them about the closed generic issue. I also think the response from the Board indicates that they've accepted in part, there's a dialogue in the remainder. And in the dialogue it's mentioned they will seek clarification on our advice with respect to exclusive registry access.

And from the way it's phrased, I'm not exactly sure which bits they're going to seek clarification on. So I think it might be something for us to be prepared for.

There's a number of component parts to that GAC advice in terms of generic strings, what the public interest may be and so on.

So I'm not sure where the Board will focus, but their scorecard response does flag that they will want to talk with us about that at some stage.

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And a potential third thing to consider is another one that the Board accepted the advice, but potentially where there may be still further questions is on the question of singles and plurals where we asked the Board to reconsider this. The Board did and considered that their initial response, reaction was okay.

I'm interested in whether any other GAC colleagues are as convinced as the Board is.

I think from my perspective, it still seems to raise questions from a very simple common-sense perspective.

I understand that there is an expert group that has provided advice here about confusability and so on. And -- But from a user perspective, I still find it very difficult to believe that this will not be confusing; that there will be a string and a plural of a string with an "S" at the end and that users will understand the difference.

There's a number of other aspects to this, potential gaming behaviors. In the second round, if it seemed to be okay to apply for plurals, what's to stop applicants from applying for plurals of very successful gTLDs in this round just to leverage off of that marketing and success and so on.

But I am concerned about consumer confusion with singles and plurals, and I'm interested to see whether anyone else shares that concern.

CHAIR DRYDEN:

Thank you very much for those comments, Australia.

So your first proposal to try and give some focus to our discussions and approach regarding the issues raised in the paper that we've just

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received I think is a practical one. So I'm happy for us to try to identify areas where we do agree with them as a way to help us move through consideration of these outstanding issues and touching upon closed generics and precisely how that will be handled. What the process is around that I think will be of interest to us to understand as well. So I have taken note of that.

Regarding singular and plurals, I will put them in the same pile, put that issue in the same pile as that raised by Switzerland regarding community support. So that allows us, again, to have GAC discussion following our exchange with the committee tomorrow morning. And then if we wish to raise that in the meeting with the Board, we can do so. And having done so, after hearing from colleagues in the GAC and having a more full discussion. And again, this allows us to focus on the outstanding category safeguard advice for tomorrow morning and the IGOs issue.

Okay. So we have a second agenda forming that we will find time to discuss as a GAC later on.

Okay. So next I have United States, please.

UNITED STATES OF AMERICA: Thank you, Madam Chair.

First, I did think it's useful to throw this out there, and I trust that colleagues will share our view, I hope. I think the Board, the New gTLD Committee has been amazingly responsive to the GAC, and I think this approach that is being followed of following the scorecard kind of

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methodology and coming back to the GAC after succeeding meetings is extremely helpful so that we know what their thinking is.

And I think I'd like to -- hopefully we will also say this to the Board when we meet in public with the whole community. I think we also owe a great deal of gratitude to the entire community for being so responsive to the GAC's Beijing advice. And I think all of the applicants clearly stepped up and responded to the Beijing communique in a very short window, and every other interested member of the community did as well.

So I think it's worthy of note that the community was incredibly responsive to the Beijing communique.

So I just wanted to put that out as sort of a threshold statement.

We have been tracking all of the Board messages back to the GAC. Unfortunately, and with apologies to them, but this latest communication just came to us today, and I had very similar questions as Peter did from Australia. In some cases it's not entirely clear to me what the Board is actually asking of the GAC. So -- And maybe they think turn about is fair play, perhaps. Maybe we weren't as clear, they thought, as we needed to be in our Beijing communique. But, for example, when they have that side-by-side list of some generic words and highly regulated sectors, I'm not entirely clear I understand what they're asking us to do. To verify whether a sector -- a string represents a regulated sector or not.

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So we might want to try to frame some questions -- I don't know whether colleagues share the hesitation I have or the questions I have. I'm just not entirely clear what they're asking us to do with them.

They also point out -- Apologies, colleagues. I have managed to attract germs from several airplane rides, so I hope it doesn't get worse.

They also talk about we didn't have a principled basis for distinguishing between certain categories and certain strings. So I'm not taking issue necessarily with what they're raising with us. I'm just not entirely sure I know what they're asking us to help them do as a next step.

So I would certainly welcome thoughts from colleagues as to how we tackle these questions, because I assume we have, all of us, a shared goal as to moving the ball further down the field. We'd like to take as many of these things off the list as we possibly can.

And I did want to make just a comment, since we haven't yet met with the New gTLD Committee. But on the IGO issue, just to sort of confirm that it might take away from the most recent conference call that we held with the board members, which I thought was extremely helpful. So appreciation to you, Chair, as well for setting that up and managing to that have held before we came.

I understand the Board's statement to be they have accepted our advice in theory, and they've accepted it concretely for IGO names, but where we remain sort of -- where more work remains to be done is vis-a-vis IGO acronyms.

So I did not hear them say that they would not protect acronyms, but that they need to engage with us further. So I took that as a good sign.

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And my understanding, and I hope that colleagues will share their impression, those of you who were on the call, that the primary question I think they want to work with us on is exactly what process we will be following to review those acronyms that actually have -- are in use and can be legitimately used by third parties.

So as we will all recall our IGO coalition, they worked very hard. They developed a proposed approach, and that was circulated around the GAC list and sent to the Board. And I'm going to put words in the Board's mouth, and I think I'm correct but the Board can obviously correct me if I'm wrong, and certainly colleagues can as well. My take-away from the July 3rd call was that the hesitation on the Board's part about the proposed process was that it put the IGOs themselves in a position of being judge and jury as to whether a third entity has a legitimate right to use that acronym. And I think that's the crux of the problem. Having said that, I think there should also be a solution; that we remove the IGOs from being judge and jury and rely on a more neutral approach, whether it's some variation of the trademark clearinghouse notification function. Something along those lines that would actually provide a different platforms so that -- and I'll use the World Health Organization, if I may -- the World Health Organization could get a notification if a legitimate third-party use of the word "who" in the English language for any TLD that had nothing to do with the health sector. And presumably the World Health Organization would consider that legitimate. I'm just throwing that out as an example. They're not here to speak but it strikes me that would be legitimate.

We need to find, I think, a more streamlined, cleaner way, more neutral approach where the IGOs are not somehow -- and I think they put

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themselves forward actually in an attempt to be helpful. So I'm looking at my IGO colleagues. I know that was probably their intention. But I think we have to appreciate there is some sensitivity on this issue.

So I just wanted to throw that out, and I trust that others have the same perspective. If you do not, then we should probably talk about this before we meet with the Board.

So thank you.

CHAIR DRYDEN:

Thank you for that, United States.

So I think you've helpfully identified a couple of issues for us from the paper that it would be useful for us to raise when we meet with the gTLD committee.

And regarding IGO acronyms, WIPO is ready to comment as well as part of our discussions this afternoon. So I will turn over to them shortly to provide some inputs to us.

But I'm thinking that the crux of the issue as you present it is my understanding as well of where we are.

So hopefully, then, we can turn to the gTLD committee and have them confirm that or clarify for us what is the precise nature of the issue.

So I have Germany next in the speaking order. And unless I have other requests from GAC members -- I have U.K. Okay. And then I will ask EU Commission, and then I will ask WIPO to comment on the IGO acronyms points.



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Germany, please, go ahead.

GERMANY:

Thank you. I just want to comment on some of the positions of my colleagues.

First of all, I would like to support U.S. position in respect of the questioning what expect the Board as answer for their questions in respect of our safeguard advice.

I have also some doubt. And maybe in general, the question is what expects ICANN to be the role of the GAC in this respect? And it would be interesting to hear more about this. And maybe we need to discuss it in depth.

Second issue is community support, which was raised by Switzerland. I would like to support this idea, and I think we had an advice in this respect.

I also have the feeling that it was not answered adequately, and I, therefore, see a need for maybe refining our questions or reiterating it, making sure that the answer we received wasn't exactly the one we expected, but this is fine for me to discuss further in the GAC.

The same issue is on string similarity, which is connection to plural and singular issues. I would like to ask the ICANN Board whether they used the same system for identifying string similarities for the ccTLDs, IDN ccTLDs, and for this new gTLD process. And if it was not the same system they used, I think it would be difficult because, frankly, from -- it's more an impression and not a concrete notion, but I have the

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impression that the rules in respect of IDN ccTLDs were rather strict, not allowing any changes without infringing string similarity tests. And for the gTLDs, it's the contrary. There seem to be quite a lot of possibilities, even if they seem to be similar. One example is singular plurals. And, for example, I would like to know whether they used the same algorithm. And if not, I think it would be some issue that the GAC could raise and ask questions.

Thank you.

CHAIR DRYDEN:

Thank you very much for that, Germany. That's helping confirm, I think, where we're headed and how to prepare our agendas and discussions for our meetings this week.

Okay. Great.

So next I have United Kingdom, please.

UNITED KINGDOM:

Thank you, Chair. Just two anxieties. Firstly, as maybe several colleagues here have done I did a consultation with our supervisory authorities and regulators last week. And it's a pity we didn't have these questions in time for that. And if there are issues that are in this document that require us to go back to our regulators and supervisory authorities, that's going to take some time. So I hope the Board will appreciate that. We've made this point on previous occasions, I'm sure.

My second anxiety is that I think there's a risk here that we are getting sucked into detailed implementation of safeguards, and I think we do,

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as Germany has indicated, need to be mindful of our role in terms of providing high level advice and saying to ICANN really it's your job to implement and you take, you know, advice as you see fit but don't come to the GAC to help you on implementation.

In addition, I just want to say, I support Switzerland on the community applications issue as we discussed in Beijing. This was not about community applicants. It's about those applications that have proved themselves to be representative of communities. And that was the point of the advice. And I -- I fear the GAC has -- sorry, the board has misunderstood the advice. So we can talk this through in our discussion as you suggested.

On IGO acronyms, I think the proposal from the U.S. is a good one. This is a very tricky issue. Over 200 IGOs, some of them have very, you know, popular acronyms -- I mean, popular in the sense they're acronyms used by other wide-ranging commercial and private interests and some are even words and names. So some kind of neutral approach to sorting this out, which I believe the IGO's would be sympathetic to, is -- sounds to me like the way forward. Thank you.

CHAIR DRYDEN:

Thank you for that, U.K. Next I have EU Commission.

EUROPEAN COMMISSION:

Thank you, Chair. The U.K. GAC representative has actually passed on part of the messages I wanted to communicate with this intervention. But we would like to reiterate that the fact that the board gave its reply only on the 2nd of July has given very little time for the European

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Commission to run internal consultation since are a big institution, as you know. And hence, for the time we have to engage in discussions with the board, there are some issues that might be still under discussion and we would like to defer big decisions for Buenos Aires. And we've also noticed that the response from the new gTLD community and the questions that are posed to the GAC actually force us to go beyond giving high-level response and force us to go down the road of implementation. Thank you.

CHAIR DRYDEN:

Thank you. Okay. So next we have WIPO to provide us with some comments on the issue of acronyms, I believe. So over to you, please.

WIPO:

Thank you, Madam Chair. Good afternoon, GAC members. My name is Gerry Tang from WIPO, and I am here with my colleague Sam Paltridge from the OECD to my left. We greatly appreciate being given the opportunity to be here speaking on behalf of the IGO coalition. This coalition consists of over 40 IGOs plus another 15 U.N. agencies such as UNICEF and all of us representing a wide range of essential public interests and who are created by and accountable to the states we represent.

The two GAC communiqués from Toronto and Beijing recognize and endorse a strong public interest in protecting both IGO names and acronyms at the top and second level of the Domain Name System. On this basis the GAC and IGO's actively work together to identify a contained list of IGO's whose names and acronyms are to be protected.

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Since then the ICANN board has recognized that the remaining issue is the implementation of this protection. In relation to this implementation the board identified three points. First, the languages in which IGO names and acronyms are to be protected. Second, the process for future review of the list. And third, how to handle acronyms for which there may be several claims. IGOs have now provided answers and proposals to each of these points. IGOs have agreed that the names and acronyms will only be protected in up to two languages, rather than the U.N. six languages. IGO's have agreed that the list of names and acronyms would be regularly reviewed, either prior to delegation of any domains in a new gTLD round or every three years, whichever is earlier.

Finally IGOs have agreed that whoever wishes to register a domain name that matches an IGO name or acronym that IGO cannot stand in the way of such registration where the registration is for a bona fide purpose, as opposed to something unlawful or dishonest that would harm the public by pretending some kind of connection with the IGO. Should an IGO and user come into dispute over a proposed domain name registration, that dispute would certainly be able to be reviewed.

The mechanism proposed by the IGOs is workable, efficient, and vitally -  
- considering that IGOs are publicly funded by your states -- cost effective. That being said, IGOs remain as always flexible and open to engage in good faith discussions with the GAC and the board on the operation of such mechanism. It should, however, be kept in mind that the purpose of these discussions is to implement a system that protects IGO names and acronyms, particularly acronyms which, given that IGO names are a bit of a mouthful, are the identifiers by which IGOs are far

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better known, from abuse in a vastly expanded domain name system. And I thank you very much for letting us speak here today.

CHAIR DRYDEN: Thank you very much for those comments. Okay. So I don't see further requests at this time. Okay. Netherlands.

NETHERLANDS: Thank you, Heather. As you -- you asked for topics which could be discussed also in the safeguards and the other sections we have, I want to make the statement on behalf of registry dot Amsterdam which basically says that they will not be able to sign a registry contract because it's in violation of data protection legislation. And there are remediation possibilities, and I think as the geo group will come back to this because it's not only a problem for dot Amsterdam. While they have -- let's say many registries have a problem with signing the current and agreed registry agreement, however, there are remediation and exemptions possible, but this procedure and registry agreement doesn't fit the -- is not, let's say, something which is fit for dot Amsterdam as a public authority. They will all -- they will even be in breach of national legislation, even signing the contract itself and then afterwards remediating it. So I would raise this -- would like to raise this point not now in content but I would raise it in -- also in -- during our talks tomorrow. Thank you.

CHAIR DRYDEN: Thank you for raising this further issue. We will have a briefing from the geo TLD group. I don't know whether they will raise this issue, I suppose

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they could. Okay. You seem to think they might. So this will give us some opportunity to hear from them and reflect on this issue further, and then in terms of whether we raise it tomorrow or whether we raise it as part of this other set of issues, list of issues that we are creating to come back to as a GAC, we can think about how to -- how to treat this. But I understand this as being an RAA issue, is that correct? Or am I -- could you clarify?

NETHERLANDS: It is a registry agreement problem.

CHAIR DRYDEN: Ah, registry agreement. Right. Okay. So that helps. Thank you. So I can put the right title to this, registry agreement.

All right. So next I have a request from Belgium, and then I will move to close the speaking list so that we can receive our briefing from the geo TLD group. So Belgium, please.

BELGIUM: Thank you, Madam Chair. I just wanted to take the floor to express our support to Germany's and Switzerland's positions regarding this community applications. We have the support of the communities in this regard, even when they have not been approved. We also support the U.K.'s position regarding the need to define more accurately what advice is expected from the GAC with regard to the fact that we are not in a position to control the implementation of safeguards.

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And finally, we would like to discuss the importance of having the support of the political authorities within the framework of geographical names applications, the importance of having the local authority's support when it comes to applications regarding geographical domain name. Thank you.

CHAIR DRYDEN:

A quick last look around.

Okay. So we will continue these exchanges tomorrow morning at 9:00. So what I'm hearing is confirmation that we have a discussion planned and an agenda agreed with the gTLD committee for our exchange tomorrow to talk about category 1 safeguards as well as it relates to closed generics and plans around that. And as well the issue of protecting IGO acronyms. And then in addition, we have additional issues identified where we might need further GAC discussion. If we can do that tomorrow morning, then let's make use of that time. If not, we will find time to further discuss the issue of the advice we gave on community applications and what we intended, in fact, with that advice. And as well, the issue of singular and plurals of the same string, and again, our advice was accepted there where we asked the board to look at this issue and they did, and just to be clear, they -- they made a decision. There was a resolution saying that they would not do anything particular or make changes to the guidebook to deal particularly with this issue. So now it's being proposed that the GAC may want to look at this again and provide further comments and advice, so I also have that on the list. And as well the issue of registry agreements, and particularly a circumstance where an applicant would have a conflict or



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potential conflict with national laws and how that would be treated based on how the -- the registry agreements are currently formulated. So that's where we are today.

We will continue in this manner when we continue at 9:00 tomorrow and before we meet with the gTLD committee. So I'll just check that our presenters are here from the geo TLD group. Perfect. Okay. So we'll move to have that briefing now. And just take one moment. Okay. All right. So we have a deck, and to my right is Dirk who will be giving us the briefing today. So please, go ahead.

DIRK KRISCHENOWSKI:

Yeah, my name is Dirk Krischenowski. I'm managing director and founder of dot Berlin, the initiative for the Berlin top-level domain name, and I'm speaking here now on behalf of our geo TLD interest group. We have so far, and I would like to thank Heather and the GAC members to invite us to speak to you and talk to you. And we much appreciate this opportunity to discuss some points with you. Some have been already addressed in the afternoon, and we would give some more briefing and input on the points in the following slides. Next slide, please.

The slides are who we are, the concerns with the registry agreement, our PM requirements and the formation of our geo top-level domain name constituency. Next slide, please. Who we are. Next slide. Yeah, this is quite small, but it gives an overview over all the top-level domain applications we have seen in this round. And you see where are many from, but I think we're from all ICANN regions. We have geo top-level domain applications there. And I would go next slide in more details.

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So as the group of geo top-level domain names we thought we should define geo top-level domain names a little bit closer so that everybody knows who we are. And we said geo top-level domain names are those who are geographic names like dot London, dot Paris, or dot Berlin, some geographic identifiers or abbreviations like dot Rio or dot NYC, or geographic indications like dot (indiscernible) or dot Irish or dot Catalonia and some others. And geo top-level domain names absolutely need to have documented support of their local or relevant government and authorities. This is essential as well. And a third point which would make up a geo TLD is -- the purpose of the geo TLD is to indicate and identify domain names with a geographic origin. This is somehow important because there are some geo TLDs which recently became geo TLDs by the geo TLD panel. And we -- our group consists at the moment of 50 applicants for geo TLDs out of 76 total geo top-level domain names. That's our group. Next slide, please.

The concerns with the registry agreement. Next slide, please. A short slide, but I think this reflects the discussion in the afternoon. We think potentially most of us as geo top-level domain names think that the registry agreement really overrides the national legislation, especially in the privacy and data retention policies, like the EU Article 29, and we see some potential problems facing us with the consistency of the UDRP and local dispute resolution policies which several geo top-level domain names have. And I mean with local dispute resolution policies are not only those implemented by the national legislation but implemented by the geo top-level domain itself. We have this already in some ccTLDs, these local dispute resolution systems, and we would be happy to discuss this with you and we would like to -- like you to address this

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topic, especially at the GAC board -- at the ICANN board and the ICANN staff so that we have a solution when we go into the contract negotiation phase and sign the contracts with ICANN. There's one slide, please.

The RPM discussion. It's a little built complicated. Please next slide. ICANN has said oh, this is not -- not very good to see, but ICANN has said there should be no registration phase prior to the trademark house clearing -- clearinghouse phase and these are the most models ICANN has. On the top you have the trademark clearinghouse phase and then trademark clearing -- trademark claim service. Afterwards general availability comes, and if a geo top-level domain name, a city or a local government wants to have its local face, ICANN says you can have this limited registration phase in number 2 and 3 before it comes to general availability. And what does this mean for cities? We like to have an example on that. Please next slide. Let's say -- a hypothetical example but could fit, we have the city of Paris having -- want to have a local governmental face where the city of Paris registers Metro dot Paris and police dot Paris. These names would then go in this phase to the city of Paris. Then there would be the TMCH phase and the general availability. Everybody's happy. City has its names. And the other phases can run properly. But this is a proposal of Paris, and if we have on the next slide, please.

>> [ Speaker is off microphone ]

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DIRK KRISCHENOWSKI:

Ah, yeah. On the next slide, the proposal of ICANN says the TMCH phase should be first and that would mean that Metro dot Paris would go to a big company like Metro AG, a very big GAC concern and let's say the police dot Paris would go to the very well-known Police band which you probably all know. And both names would be gone even before the local government phase would start. And there's probably no chance to avoid this. This is an example where our problems raised from. On the next slide we have summarized these topics. It's first prioritization phase and we would like to have -- or ask for that governmental reserved names should trump the TMCH phase. So the government should have -- the local government and probably national governments should have the ability to reserve their names or register them actually in -- before the trademark clearinghouse sunrise phase starts. And priority should be given to those registrants that have a nexus with a geo top-level domain name, let's say to Paris, to Berlin, to Barcelona or to other cities. That's what we are asking for. And second is, at the moment the RPM requirements say there can't be any names online before the trademark clearinghouse phase has been finished. And we think it's essential for the cities and regions, that key partners in these geo top-level domain names and by this I mean the city marketing or the zoo or some other public institutions as well as well-known organizations in the city should have the ability to launch their name before the trademark clearinghouse phase. This is essential for marketing the TLD. Imagine you want to launch a TLD with a trademark clearinghouse phase and you can't even do proper marketing with some good key partners projects which are already there and show the public what you can do with the TLD. And secondly, the launch phases could be different or should be different to illegible registrants. Next slide,

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please. Yeah. Then we have the geo top-level domain constituency which is the third point we would like to address. Next slide, please. We are -- at the moment here's the picture from the GNSO and we are going to ask for a constituency within the registry stakeholder group. Next slide, please. And this group consists today of 22 gTLDs like dot com, info, org, info, travel, jobs, Asia, cat and others, and the new gTLD applicants interest group. And what we ask for -- next slide, please -- is to have, along with the brand constituency which has been proposed by many brands, gTLD applicants in Beijing along with those guys who want to ask for geo top-level domain constituency which represents our view and the intake group should still exist as a group of interested parties. And on the last slide, we have a brief mission statement of the geo top-level domain constituency, should as other constituencies represent interests of the geographic top-level domain names, promote cooperation, networking, and other sharing among its members, stakeholders, and within ICANN, ensure that policies are consistent with geographic and local communities, vital interests, and should give guidance to future applicants for geographical top-level domain names. These were the topics I'd like to address with you, and I would be happy if we, as I have two -- two other members of our group with me from Paris and from Africa and Cape Town, Joburg, and Durban, to discuss these points with you.

CHAIR DRYDEN:

Many thanks for that presentation. So are there any questions that GAC members have about the concerns identified by the geo applicants? So I see Paraguay and Portugal, please.

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PARAGUAY: Thank you, Madam Chair. I just want to know if we can have a copy of this presentation sometime? Thank you.

DIRK KRISCHENOWSKI: Yes, for sure.

CHAIR DRYDEN: Okay. Portugal, please.

PORTUGAL: Thank you. Well, I shall talk in Portuguese because we have translation but I don't know -- (audio problem). Or not. Or I can wait. Or I can speak in English because it's late.

[ Laughter ]

Well, I'd like to thank you for this -- this presentation. That for me was the most important part of this afternoon. So thank you very much. I'd like to better understand why you set up this constituency, what was the reason behind? So what did you make to see that you -- you would need to be together? And if you -- it has this -- something to do with the fact that ICANN is not really supporting your interests. Thank you.

DIRK KRISCHENOWSKI: Okay. The reasons why we are doing this, I think we are -- we are quite different from the rest of all new gTLD applicants due to our nature. We all have support from the relevant local and presumably also the

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national government in this case. And if you have seen, we have local topics which are really just not affecting the rest of the world but this local community that has applied for its name and with the local community there's -- there's always local government. And this local government has certain interests to use its name and to have its name as good in the root as the ccTLDs. Let's say they have their particular interests as well. And I think the geo TLDs are much closer to the ccTLDs like to the geo TLDs in a certain way, but potentially fits still in the registry stakeholder group because they have a contract with ICANN. Yep.

CHAIR DRYDEN:

Thank you. Netherlands, please.

NETHERLANDS:

Yes, thank you, Heather. And thank you, Dirk. I think it's very, let's say, we cannot plot this new constituency because I think many of you geo TLD applicants went -- applicants in the geo group were one of the first movers, let's say, in the gTLD process. I think you also from Berlin, I recall that you had many years of moving things around, trying to push things in the good direction in ICANN and I think it certainly helps the process.

One thing I would like to expand maybe more on your side is this, let's say, registry agreement problems which I have heard from two of my applicants from our country which is dot police and dot Amsterdam. I'm a little searching about what -- what's this problem means for you in

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practice. You mentioned (indiscernible) and privacy as being a potential problem in the RA agreement. Thank you.

DIRK KRISCHENOWSKI:

Yeah, I think as absolutely a practical compound, when it comes to WHOIS, the ICANN contract asks us to publish all the WHOIS data including fax, telephone, and e-mail address, and this is not in line or in conflict with legislation in the European Union or in Germany or in Netherlands or the member states. There they have all different systems, but no one has, I think, the full ICANN -- all the details published for the registrant. I think some -- some ccTLDs might even have near too close a WHOIS system and that brings us to the first where we started to the first lawsuit immediately when we start by publishing all these data. That is I think not what we want to be dragged into lawsuits the day after we have signed or brought the first WHOIS entry online.

CHAIR DRYDEN:

Thank you.

Do you have in mind a particular solution to that issue in terms of the registry agreements?

We covered, I think, a similar issue when we talked about the Registrar Accreditation Agreement earlier because we have had to acknowledge that there are conflicts that can arise with national legislation, and it's not a new issue, as such. So if you could elaborate on that.



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DIRK KRISCHENOWSKI: Yeah, but it is an issue which is still very important and the first geo top-level domain names are going -- could go potentially online in the a couple of, let's say, two or three months from now onwards. And we would like you, as a GAC, to address this topic, and we'll also discuss this with ICANN, but we want to have a solution where we can live with in our particular situation and with national and -- yeah, national legislation or EU, or other legislation which is there.

CHAIR DRYDEN: Okay. Thank you.

So I don't see any further requests. Well, Switzerland, perhaps, and then Italy. Okay.

SWITZERLAND: Thank you, Chair. I'll be brief.

Just to support what the Netherlands and others have said. We think this is a useful thing, and I will not recall, like I did not recall in the brand registry meeting that we had the idea of categories some years ago. And it obviously makes sense because they are very different.

Just one point about the sunrise phase and the need for local constituencies or local specific needs that should reasonably come before the sunrise. I think this is a key point that is very important for many of the geo TLDs, and I want to support this issue that a solution should be found and that ICANN should be flexible in finding a solution that makes sense for geo TLDs.

Thank you.

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CHAIR DRYDEN: Thank you, Switzerland.

Italy, please.

ITALY: So you say that 50 of the 76 geo names are associated with the new constituency. And my question is, first of all, do you have any information about the withdrawal of some of them? I'm asking this because dot roma is one of these 76, and I can assure that they never, the top-level domain, limited, received the support from the City of Rome. And I'm surprised that the name is still there and they didn't renounce or withdraw the application.

So, but in any case, I would like to know if you contacted all the 76 just to share the problems with your organization.

DIRK KRISCHENOWSKI: Yes, we have contacted all geo top-level domain applicants to join our group, and we have, at the moment, 90 -- some 92 persons on our mailing list, which is running since I think the meeting in Toronto. So a pretty long time. And we have been organized and held meetings in between. The last meeting was hosted by the City of London in London two weeks ago, with over 40 participants from all over the world.

And so we have good contact, and informed them also about constituency formation request and all these things which come up with geo top-level domain names. So we try to have a very fair, transparent and open process in this matter.

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Regarding to some of the geo top-level domain names which might have no support letter, at the moment I'm not the right person to talk to. They are still in the list of applicants and they are not withdrawn, so I can't say anything else as reflecting on this list which is published by ICANN.

CHAIR DRYDEN:

Thank you. Okay. So at this point I would just note -- Germany, did you have comments? Please.

GERMANY:

Yes, thank you. It is a simple question in this respect. I just wanted to know how you make sure on this protection of city-specific names, you want to establish a list on this, how you want to make sure that you avoid some legal challenges maybe imposed by trademark infringements. Because, on the other hand, you have trademarks that you probably may infringe and that may be also have legal consequences. And in this respect, it will be the registry who now takes over the responsibility for this -- for developing a list that contains maybe also trademarks from other regions and jurisdictions.

DIRK KRISCHENOWSKI:

I think lawsuits in this matter can't be -- can't be avoided. And these examples here come from the real world. The metro company, the big German one, they sued the Paris metro on the metro.com -- or help me. Yeah, metro.com and metro.FR and other names, and such lawsuits or legal things can't be avoided.

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This will happen, but I think we have a very clear legislation in the countries how to work with these names. And I think when a city asks for metro.paris or police.paris, I don't see any company or other party getting into this name or getting this name.

Yeah.

CHAIR DRYDEN: Your colleague from the geo TLDs would like to speak.

NEIL DUNDAS: Thank you. I'm Neil Dundas from the dotAfrica applicant as well as three South African cities.

I think just to answer that specific question, the trademark holders have always got alternative dispute resolution. There are mechanisms designed to address trademark issues post delegation.

So if there is a domain that is allocated to a local government authority, such as metro, and the person that holds the trademark for metro believes that their marks -- their trademark rights have been infringed, they can always use the UDRP or some process like that where they would have to prove the name is abusive, essentially. And that would be very difficult to do against a legitimate use such as metro for the City of Paris.

So I think there are catch nets for the protection of trademark rights post the sunrise process.

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But from our perspective, if you are looking at a localized instance, the development of reserved name lists not only for our cities but for our continent is a very time-intensive and very lengthy process. We're going to have to approach many, many governments in Africa, we're going to have to coordinate those efforts, filter down, build up this list. It might be quite an extensive list ultimately. And I'm sure the same would apply for some of the city names.

But I think what we're asking for is that we sensitize ICANN to be flexible when we approach them on these issues because, at the moment, the issues are still in a gray area. We cannot go ahead and invest all our time and resources on developing these lists to only find out in the next few months that the sunrise process, the trademark clearinghouse process trumps them.

So we need to start sensitizing ICANN to the fact that geos are developing these lists and these lists have the support of local governments and authorities and that they should be given due respect and due regard when they are published, and certainly should have priority above trademark rights.

And of course there's an element of reasonableness there. The geo TL applicants will employ reasonable measures to ensure sure that the lists are within reasonable bounds.

From our perspective, just a last point is on the rights protection mechanisms. For a continent like Africa, which is a developing region of the world, concepts such as the trademark clearinghouse are exceptionally difficult processes to create awareness and educate the local businesses and trademark holders on.

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So we would like to see applicants have the flexibility to introduce their own localized systems to address trademark validations and verifications so that local participants can more effectively participate in the sunrise process.

This is an effective request. We want you to direct ICANN to say the trademark clearinghouse is fantastic for general protection across all gTLDs, but if we really want to promote and make our geo TLDs successful, allow the applicant some flexibility to implement their own processes, with the trademark clearinghouse as the fall-back position. But let us do something that we know can cater for the local communities we are trying to serve. And I think that's another issue we need to sensitize ICANN on, is when it comes time to negotiating these agreements, we're going to want them to see that flexibility is needed when they approach the geo TLDs.

We have local stakeholders such as governments involved, and there's a lot of thought and deliberation that has gone into this process, and ICANN must respect that and not simply push us to the back of the queue and then negotiate the agreements with us.

Thank you.

CHAIR DRYDEN:

Thank you.

So one final -- two final speakers, Netherlands and Norway, and then we need to conclude.

NETHERLANDS:

Yes, thank you, Heather. This last remark I think is very essential, what you made. And it proves for me that although there is -- let's say there is advantage of having a one size fits all, in this case I think one size fits all doesn't do justice to all the different kind of applications. And would also even make one extra example. I think your examples are very valid.

For example, we have national police applied for, polizei, dot polizei. It would be, to be honest, very ridiculous to them to have a clearinghouse mechanism to have commercial entities reserve names under polizei. So it completely doesn't make any sense.

So we have -- I think ICANN should really have, I should say, the flexibility to have certain applications, and I think the geo group is a very specific category to have an exemption to this rule, an adapted clearinghouse mechanism.

Thank you.

CHAIR DRYDEN:

Thank you. Norway, please.

NORWAY:

Thank you. This is just out of curiosity. Do you have any knowledge on relevant governments' involvement in the running of the geo TLDs? Like do you have like a new member list? Have you got many high demands from governments or are most of the members just got an approval, a letter of approval without any terms and conditions?

Thank you.

FABIAN:

Hi. My name is Fabian (saying name). I am working for the dot Paris project. As an example, the City of Paris is itself the applicant. So it has applied itself as the City of Paris, the city government for the TLD. And as far as running the TLD, it will be very closely involved in policy definition. So for instance, the TLD's launch policy has been designed with the City of Paris, and it's today put into question by those rules that ICANN has published.

But to answer your question more generally, I think there is a balance of the situation within the geo TLD community. There are those applications where the local government's involved. For instance, in France, out of the five geo TLDs, we have three of them that are the actual local government and two of them, two others, that are actually - sorry, it's one of the four that is not-for-profit which has support from the relevant authority.

So in our group we have a balance. We could get back to you with numbers, and to be precise. But we do have relevant government involved directly in applying and in running the TLDs.

And, for instance, to come back to the example of the City of Paris, it will be the one -- it's envisioning to be the one signing the contract with ICANN.

DIRK KRISCHENOWSKI:

And we have a roster of our group where it's -- where we can put on, if it's a local government who is applicant or private entity or association or something like this, we can provide you with this list, certainly.



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But it's like -- it's a colorful mix, like the ccTLDs are, with every kind of legal entity running a TLD. It's the same with geo top-level domain names.

CHAIR DRYDEN:

Okay. Thank you.

So I would note that we have the issue of registry agreements and geos on our discussion agenda in the GAC so we will be coming back to this issue. And I wonder whether it would be useful for us to ask for some sort of briefing about the registry agreements and, in particular, these issues from staff, if we can manage to schedule it to further inform the GAC returning to this topic.

So thank you for coming to present to us today. And as I say, we will be looking at this further at our meetings here.

So for the GAC, we will conclude here and reconvene at 9:00 a.m. tomorrow. So have a good evening, everyone.

Thank you.

[ END OF AUDIO ]

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DURBAN – GAC Open Plenary 4  
Tuesday, July 16, 2013 – 10:30 to 11:30  
ICANN – Durban, South Africa

CHAIR DRYDEN:

Okay, everyone. If you could take your seats, let's get started again. Okay. All right. So welcome back, everyone. Just a few organizational points to keep in mind. We're circulating an attendance sheet. So if you can please fill in the attendance sheet to help us track who is here. Usually Jeannie's very good at being on top of everyone that has joined the meeting a bit later than when we started on Saturday, but she's not here, so let's do the attendance sheet to make sure we can keep a good record of who is here in attendance and participating in our meetings.

Also, a reminder that at the end of today there is a cocktail with the board, so a Board-GAC cocktail that we're all invited to join. And this is a very good informal opportunity to talk to some of our board colleagues and have an exchange with them. So I would really encourage you to come as well. The ccNSO is having its tenth anniversary and we've really come to have good working relations with our colleagues in the Country Code Name Supporting Organization so I know they would really appreciate us joining them to celebrate this event on their tenth anniversary. And so that we are able to attend the cocktail with the board, there will be special buses arranged to take us to the ccNSO anniversary event so that this can be made as smooth a process as possible for us. So again, I encourage all of you to take advantage of these opportunities to socialize and join in the celebrations with our country code colleagues.

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So with that out of the way, just some notes on the agenda. As you know, we were planning to address the outstanding strings discussion in this session, but more time is needed for consultations with some GAC members, and so we have notified you via the GAC list that we have moved this to Wednesday, I think it's at 11:30 a.m. when we will have that meeting. But I do think that if we can continue this process of consultations, if I can talk to a few more colleagues and some that I have committed to come back to, then it will allow that session to go more smoothly and for us to understand how that will be conducted in advance, and I think that is in everyone's interest, given that there are some sensitivities associated, in particular with discussing those issues and those remaining strings, in that session.

So as an alternative -- Brazil, please.

BRAZIL:

Good morning, Chair. Thank you. Just related to the shift of the agenda that you just announced and sent us yesterday evening, or afternoon, sorry, I would like to ask the Chair to review this proposal because in our case we brought the vice minister today to the GAC meeting just because of this discussion. And he's leaving tomorrow early. So I would like to ask the Chair and our colleagues to review this proposal to bring the issue to the same agenda that we have received in the beginning of our work some weeks ago because we have planned our delegation and the trips based on that agenda. If you could review it and if we could have the support of our colleagues, the Brazilian delegation would appreciate it.

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CHAIR DRYDEN: Thank you, Brazil. So we did not receive any objections via the GAC list about this change, but I did consult with the vice chairs about this before making the change to the agenda and as I say, it's going to help us to have more time. Frankly, I just don't think we're all ready for the discussion today. However, if you are prepared to make a statement, then perhaps we can receive the statement now and then address these issues tomorrow as proposed. Brazil.

BRAZIL: Madam Chair, I made -- I'm making a statement. I would like to propose to the plenary to review this decision. If you could put today the decision of the plenary.

CHAIR DRYDEN: Thank you, Brazil. And ( audio problem ) I have proposed to move it to tomorrow. I do not believe we are ready for discussion of all the strings that are on the list. Consultations have been ongoing, my consultations have been ongoing, and we need more time for that. However, if you wish to make a statement about a string that is on that list, then we can hear that statement now. I think that would be a way to proceed. Okay. So I see Peru, Argentina, and the EU Commission.

PERU: Good morning, Chair, good morning, everybody. We would like to support the request from Brazil. Any GAC member has the right to ask for the review of a Chair decision, with all due respect. In our case we haven't been consulted, being main -- a country mainly interested in the discussion of dot Amazon, among other strings, and we are concerned

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about the fact that this shift in the agenda may not allow enough time to have a thorough discussion of what is the main business of the GAC. So we would like to endorse what Brazil has requested and, of course, join the plea for all GAC members to review this decision of the Chair. Thank you.

CHAIR DRYDEN:

Thank you, Peru. It's unfortunate that I was not aware of your views before we sat down to have this session. It would have been preferable to understand your concerns and to look at a way forward before we sat down in the plenary. So you may feel that you were not consulted, but neither have I been consulted in terms of your concerns. And of course, I -- I am happy to take note of them. Okay. So Argentina, you are next, please.

ARGENTINA:

Thank you, Madam Chair. Argentina shares the same concerns as Brazil has expressed and also Peru and would like to remind you that we did a statement in the name of several of our countries of the region that we were worried about specific strings in that list of strings that have to be reviewed. Also, I would like to remind you that in Beijing the agenda was changed and was shifted to Thursday, some work that has to be done, and some of us were already scheduled to leave that day. So we would like to have more time to discuss some issues that we think are substantive important for our region. Thank you.

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**CHAIR DRYDEN:** So as I understand it, the concern is that we won't have enough time. I believe we will. And I think the question that you are particularly interested in, the governments that have spoken so far, will be addressed very quickly. And if we can discuss it outside of this session, then I think that would be useful so that you know how it's going to be handled and what you can expect. And this is what I mean by wanting to make sure that all of the consultations in the corridors are complete so that that session can actually go very quickly and smoothly, in fact. So next I have EU Commission.

**EUROPEAN COMMISSION:** Thank you, Chair. I understand your concern of moving on quickly and I think it might not be the right moment to come to definitive conclusion, but I think one of the words that was also mentioned in the opening session is "empathy," far apart from efficiency and effectiveness. And I think if the delegates feel strongly about having some discussion at this stage, I would like to support the Brazilian proposal to have at least first discussion at this stage of the meeting. Thank you.

**CHAIR DRYDEN:** Thank you, EU Commission. Okay. Iran, you're next.

**IRAN:** Thank you, Madam Chairman. Yes, we understand that you have consulted some colleagues. May not be -- you may have not been able to consult others. However, we have the distinguished -- the deputy minister of Brazil here. He wants to follow the questions. We have full respect to all of our colleagues and we have to work together. I suggest

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that instead of discussing an hour what to do with the agenda, you continue your consultation this morning and the provision that this afternoon you provide opportunity, at least strings that Brazil and some other countries are interested to be discussed while the deputy minister is here. So we should, I think, work collectively and friendly and leave a little bit of time, maybe afternoon you can do that. Perhaps at least you consider the possibility that give priority to these strings while our distinguished colleague from Brazil is here. We don't want to disappoint anybody and we would like -- because he might have very heavy agenda, have to leave here, and that is all. So we also support the proposals of other colleagues that have made that. We need to continue that and take into account of the concern expressed our -- by our colleagues. That is point one.

Point number two, Madam Chairman, not ask for the floor again, we have sent you a letter and we would like that tomorrow when you discuss you provide us opportunity to briefly present the thrust of our letter. Thank you.

CHAIR DRYDEN: Thank you, Iran. Chile, please.

CHILE: Thank you, Chair. Well, we circulated a document, a few of the countries of our region, the first day of this meeting and we were ex -- what you expressed regarding that statement was that you -- that was going to be discussed today. So I think that we could -- if that's good for everyone, we could at some point talk about those topics because we --

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there are relevant countries here that have concerns, so I think it would be important to hear in this session what's going on and where we're standing at this point. Thank you.

CHAIR DRYDEN:

Thank you, Chile. Okay. So we have some time now before we break. So for those here present that would like to comment on the outstanding strings, let's do that now. I would like to keep the time in the agenda for Wednesday as well. But as has been proposed, this is an opportunity for at least some initial discussion, taking advantage of those that are present and giving them an opportunity to make their comments today. All right. Brazil, please.

BRAZIL:

Thank you, Madam Chair. I would like also to thank our colleagues that support our request. And I would like to emphasize the importance of having this discussion today as well as were planned a few months ago. So I would like to propose that we follow the suggestion of the Iran representative in having this discussion today after whom I believe at 2:30 today.

CHAIR DRYDEN:

Okay. We're looking at the schedule, and we have a session planned with the ccNSO at 2:00. So depending on whether we can make changes to that, we may or may not be able to have the discussion at 2:30, as you describe. But we do have the time now, if you did want to make comments, as I say, before we break for lunchtime. So India, please.



INDIA:

Thank you, Chair. Let me introduce myself. This is my first intervention at the GAC. I'm Ajay Kumar, representing government of India, and I would request the indulgence of the GAC plenary to consider a request which India has with respect to a couple of strings. These strings we had actually issued our early warning way back as per the time schedule and we had also engaged in the process of dialogue and interaction with the applicants with respect to these strings. And we were happy to work with them and to come out at an amicable solution. Unfortunately, however, while the discussions were going on and we were under the impression that we would be able to achieve a resolution, things have reached a situation where I don't think we have been able to reach a situation where we can agree to these gTLDs. I know this is beyond the deadline, but the request that I have for GAC's consideration is these two gTLDs, one is dot Indians which is very close to the ccTLD for India and the other one dot Ram which is the biggest Hindu deity in India for the biggest chunk of population in the country. Both of them have very serious concerns within the country. This matter has been considered in our government both with various stakeholders as well as with various ministries of the government and we realize that it is difficult for us to agree to these gTLDs. I understand that we are actually behind time and GAC has been proceeding and we greatly appreciate the great work which GAC has been doing, but the fact of the matter is that if we were to ignore the objections that we have today, we actually have a situation which will need to be addressed and, therefore, I think considering the large number of people who are expressing the concerns with respect to these

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application, the GAC may deliberate and find out a way to resolve these objections.

We cannot have a process really which would lead to a situation which creates -- leads to a problem. I mean the whole process through which the GAC has been going on over the last so many months has been to find out a way by which the gTLD process can proceed smoothly as well as we are able to find -- address the genuine concerns of the governments. And here we are in a situation, despite our best efforts, despite the interactions we have had at different times with the applicants, we have not been able to resolve.

So I think given the magnitude of the problem and the sensitivities conveyed at the highest levels from the government of India, we would request the GAC to kindly consider taking this matter and raising it along with the rest of 14 strings that have been included in the short list, the Beijing communique.

Thank you.

CHAIR DRYDEN: Thank you, India. Iran, please.

IRAN: Thank you, Madam Chairman.

I fully respect all distinguished colleagues in GAC to make every statement, but perhaps for the sake of time, perhaps possibly we just limit this period of time, one hour and so, to the Amazon discussions because our distinguished colleagues have difficulty for tomorrow.

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While we fully respect all colleagues to make every point, at a later time we will come to the discussion of the strings. So this is exceptional case of Brazil because they cannot stay here tomorrow. So if all distinguished colleagues agree, you limit the discussions to that.

Thank you.

CHAIR DRYDEN:

Thank you, Iran. I'm happy to hear initial comments and discussion from any of those governments that are interested in doing so in terms of the outstanding strings that we have identified, but certainly Brazil and others may wish to comment specifically on Amazon. But I like this proposal to have an initial discussion now to make use of the time we have.

Okay. Peru, please.

PERU:

Thank you, Chair.

So as we understand, and our thanks to our GAC member of Iran, we are to start the discussion on dot amazon at this moment.

In that sense, let us remind that we have already distributed a statement on what the position, not only of the countries but of the whole region is in this regard. And if you allow us, I would like to ask our colleagues from Brazil to make the first presentation, and then we come -- we'll come back to complement what they are going to say.

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CHAIR DRYDEN:

Thank you very much, Peru.

Brazil, are you requesting the floor? Please, Brazil.

BRAZIL:

Thank you, Madam Chair.

So we would like to, first of all, thank you, the GAC and the Chair, to accept our request to start this conversation today, to take advantage of the presence of our vice minister here, whose presence here expresses the wide and **deep concern** of the Brazilian society with the solicitation of the registration of dot amazon.

As you may know, we had a very deep, long and good discussion in the Brazilian Congress about this. Our Congressmen expressed their concern about the **risk to have the registration of a very important cultural, traditional, regional and geographical name related to the Brazilian culture.**

We share this opinion with all of the countries in the region, so Peru, Colombia, Venezuela, Ecuador, Suriname. All of them in a meeting in the Amazon Treaty Organization last April produced a document, a declaration related to the dot amazon, also expressing their concern to **the registration of this very important name to the Brazilian society.**

Afterwards, we had a meeting in the ALAC which comprised the Latin American and Caribbean countries in May. The same as well, all the countries supported the Brazilian, and the Amazon countries demand to the GAC, to our fellow countries to send an advice to the Board to reject the registration of dot amazon for the same reasons.

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As you may know, the Amazon region only in Brazil comprises 50% of our territory. More than 30 million people live in this region in Brazil.

We have one of the most important bio systems in the world with a very huge sort of fauna and flora. And this concern is also shared by all the Amazon countries.

Besides the Latin American, Caribbean countries, besides the Amazon countries, within the society we had a very meaningful reaction against the registration of dot amazon. We have a declaration issued by the Internet Steering Committee, the Brazilian Internet Steering Committee, which is a very democratic and multistakeholder platform which takes care of the Brazilian policy on Internet. We had a very huge reaction from the civil society which is organizing a document signed by thousands of people to be sent to the GAC board -- to the ICANN Board reacting against this solicitation.

So in a certain way, we fulfill the requirement, which was posed by the Beijing communique. I would like to read the exact text that we have approved -- or, sorry, because I was not here, you have approved in Beijing four months ago, which says, "The GAC advise the Board," so it's already a decision from the GAC, "that in those case where a community, which is clearly impacted by a set of new gTLD applications in contention has expressed a collective and clear opinion on those applications, such opinion should be duly taken into account together with all relevant information."

As you may remember, on Saturday or Sunday -- Sunday, Peru, Brazil, Argentina, Chile and Uruguay sent you a letter where we explained all this reaction from the society, from the Brazilian society, from the

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Peruvian society, from the Brazilian Congress, from the Brazilian Internet Steering Committee. And we would like to come here again to ask the GAC members to support a GAC advice to the Board in the same -- in the same terms as we have approved last meeting in Beijing about dotAfrica.

Besides that, we think that the principles approved in 2007 by the GAC as well comprise our demand on this issue.

I would like to inform all of you that we have very good conversations with the Amazon, Inc. We understand their business plan.

All of our conversations, we have met at least three times, were carried out with a very faithful willing from both sides. Nobody thinks that each of the other side has bad faith on this.

We understand their business plan. We understand they're willing to make a good job. But for a matter of principle, we cannot accept this registration. And we have expressed to them this position very clearly, very politely, and very frankly.

So I would like to ask my vice minister to complement these initial words. But I would just ask you again, reinforce the Brazilian demand to the GAC members to approve a rejection on the registration of dot amazon by a private company in name of the public interest.

If the chair allows me, I would like to ask my vice minister to talk.

BRAZIL:

Thank you all for this support to our request. I would like to add two points to the comments made by my colleague. The first one is that this

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domain string dot amazon, it affects a large number of communities in the Amazon, which is based on -- which covers eight different countries in South America.

I would like to recall what was said yesterday in the opening speech by the commissioner of the African Union where she said the importance of protecting geographical and cultural names in the Internet.

So I would like to ask the support of the members of GAC to reject this proposal of registering dot amazon.

CHAIR DRYDEN: Thank you, Brazil.

I see Peru.

PERU: Yes, Chair. Thank you. With your indulgence, just to highlight three or four points that we think are crucial for the understanding of our request.

And first, in terms of legal grounds for our request, we believe there is enough legal grounds in ICANN bylaws, in prior GAC advice, and also in the applicant's guide.

So our plea is very well grounded in the legal framework of the ICANN. That would be the first remark.

The second remark is that there is no doubt that this is a geographic name. Amazon is -- pertains to four departments of the Amazon countries. It is the department, for those that probably do not know

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our political division, is the second, the second division for our countries. It is larger than provinces in our political division. And so it pertains to Venezuela, to Colombia, to Peru, and to Brazil.

Amazon, in Spanish, also belongs to cities of our countries, and Amazon in English is also a city in Guyana.

It has been allotted the three-digit code number. So it is in that 3166-2 list. So there is no doubt whatsoever that this is a geographic name. This would be the second remark.

And the third remark is that, indeed, this is a public interest issue, and that is why we are discussing this in the GAC.

There are several populations that have been involved in this, and I want to stress the fact that, unanimously, all Amazon countries and all Amazon provinces, departments, and local governments have expressed, in writing, their rejection to dot amazon.

So there is a unanimous claim, a unanimous understanding of the community concern against this registration.

So for the time being, those are the three remarks I would like to make. And of course I will be keen to come back in the discussion of any concern or any question that the members of the GAC may have.

CHAIR DRYDEN:

Thank you, Peru.

Okay. Are there any other requests at this time?

At the end of the table. Is that South Africa?



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SOUTH AFRICA: South Africa, yes, chairperson.

CHAIR DRYDEN: Please.

SOUTH AFRICA: We would just like to state we support the contributions that have been made by the Brazilian delegation and the delegation from Peru.

We have similar strong concerns about the need to protect public interest and communities and cultural and geographic indicators.

Thank you, Chair.

CHAIR DRYDEN: Thank you, South Africa.

Next I have Gabon, then Sri Lanka.

Gabon? Do I have the right GAC member?

GABON: Yes.

Thank you, Madam Chair.

Gabon also needs to comment on this issue from -- it has received the comments from the Brazilian delegation on this issue, and we believe

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that if this zone was validated by ICANN, this could go against the new gTLD principles developed by the GAC council in 2007.

The new gTLDs should observe the sensitivities and those terms that have a national, cultural, geographical, regional or traditional meaning.

Therefore, ICANN should reject any application related to geographical, cultural strings that have these -- that pose these kind of problems.

SRI LANKA:

My intervention will be very short. This issue of dot amazon has reached our foreign ministry and has gone to the highest level of attention between discussions with Brazilian government on a lot of bilateral trade related issues. And in view of the comments made by the Brazilian as well as the Peruvian delegate, I wish to record a highest and the strongest support for what has been stated by our Brazilian, Peruvian delegates at this session.

Thank you.

CHAIR DRYDEN:

Thank you, Sri Lanka.

Next I have Trinidad and Tobago and then Russia.

TRINIDAD AND TOBAGO:

Yes, thank you, Madam Chair. Trinidad and Tobago supports the position of Brazil on the dot amazon issue.

Thank you very much.

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CHAIR DRYDEN: Thank you. Next I have Russia.

RUSSIA: Thank you, Madam Chairman. I will speak in Russian, so please use headphones.

The Russian delegation would like to express its support, its complete support to the claims that were given by our colleagues from Brazil and Peru. We also share their concerns in using geographical terms when registering -- when registering domains by special companies. And of course we consider that the point of view of governments has to be taken into account in these terms.

Thank you for your attention.

CHAIR DRYDEN: Spasibo, Russia.

Uruguay, you are next, please.

URUGUAY: Just a very short speech.

I want to speak as chair of the ministerial meeting of the Latin American, Caribbean countries. The support for Patagonia and Amazon claims were in the strong words we could make in this event. It was a ministerial one. And we find there's no more for us to say. That's our opinion on the item.

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Thank you very much.

CHAIR DRYDEN: Thank you. Next I have Uganda.

UGANDA: Thank you, Madam Chairperson. I want to thank you in supporting the statements made by the Brazil and other countries who are affected by Amazon like all of us. And I wanted also to ask you, Madam Chairperson, many of us are from developing countries. We're going through a process of generating similar strings which may be of concern to us.

So I'm wondering should we always have to come here and make statements like this, or there's going to be a general way of protecting those strings that we think are sensitive to us. Just a secondary request to hear from you. I'm not a regular participant in this meeting, but I follow. And I thought that the GAC advice there that was given would be enough to protect. But I just want to hear again whether this is going to be a procedure that, if we feel strongly that there's something that we need to protect, we have to come here and talk about it. Thank you.

CHAIR DRYDEN: Thank you, Uganda. I have Australia next.

AUSTRALIA: Thank you, Chair. And thank you to all colleagues who have spoken already on this very important and, obviously, very sensitive issue for

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the GAC to consider. And thank you. It's good to be followed by our colleague from Uganda. So thank you very much for raising the question about a broad process. Many of you will have seen that I've put some suggestions to the GAC list on this issue. So, first of all, I want to be very clear that the Australian government supports countries in advancing their national interest with regard to geographic names. This has obviously been an area of longstanding interest to the GAC, and there is a substantial amount of existing GAC advice on this issue.

The situation that we face today is that some governments consider geographic names that are not on ICANN's lists or picked up under ICANN's framework in the applicant guidebook.

And I think this is why we are here today discussing this, because there is an apparent gap in ICANN's processes and policy framework.

So, for me, my proposal and the Australian government's proposal has been to fix this gap. It appears that there are many applications in the current round that governments clearly consider to be geographic names and of considerable significance. And what we face is that there is no clear process. We have, in the GAC here, these conversations. But, in terms of ICANN's policy framework, we -- there is -- there is something missing. There is no process whereby governments and applicants can put their cases and have them heard and their criteria for resolution and so on.

So the Australian government, while not commenting on any of the applications that are before us today, broadly would like to advance the idea that the GAC suggests two ICANN that it establish a clear process to deal with this issue that would apply in this round and in future rounds

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as well. I expect that many applicants in this round and people who pay attention will be sensitized in future rounds to the GAC's interest in this. But this situation may come up again. And I think we'll do ourselves a great service if we were to recommend to ICANN to put in place a clear process to reconsider the issue of geographic names and deal with it so that we do have a very clear process going forward. Thank you.

CHAIR DRYDEN: Thank you, Australia. Argentina.

ARGENTINA: Thank you, Madam Chair. And thank you, Australia, for bringing this comment and your contribution. Our delegation and your country had a meeting that we think it was very constructive, and we replied to your proposal.

I would like to stress a part of the applicant guidebook which is a paragraph that should be considered by companies. And I think it has been taken kind of lightly from the applicant perspective. The applicant guidebook says, in the section that talks about geographic names, "In the event of any doubt, it's in the applicant's interest to consult with the relevant governments and public authorities and enlist their support or non-objection prior to the submission of the application in order to preclude possible objections and preaddress any ambiguities concerning the string and applicable requirements."

Argentina thinks that, if this paragraph would be more reinforced or mandated by the applicant guidebook, all these problems that we're having now wouldn't happen. Because, if we had some communication

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or contact from the company before, maybe we could have found a way out, which is something that could have been negotiated among countries and the company.

But that didn't happen. Just the companies went on with the application. So the applicant guidebook contemplates this event, but it has not been respected by the applicants. So we think that the GAC should stress this. And also we think that everything is written already in 2007 when the GAC, in the Lisbon meeting -- some of us were there that day -- we issued the new GAC principles for new gTLDs. And this is where all our ideas are expressed. Thank you.

CHAIR DRYDEN:

Thank you for that, Argentina. Next, I have Brazil and then Portugal. Thank you, Madam Chair. I'd like just to comment three things very quick. I would agree with Peter. I think we need to have an action in the GAC to try to cover this gap. But I don't think the gap is as serious as we think. First, because of some arguments that the representative from Argentina just raised. Because the, let's say, the obligation to search for a previous negotiations is from the applicant. The countries, they have the right to discuss in this fora, in this forum, the case is one thing. The second -- it doesn't mean that we don't need to cover the gap. I think it's useful to make an effort to cover this gap. But try to reach the question by Uganda I think, in our point of view, yes, sometimes you need to come here. Because the list, the previous list is not an exhaustive one. For example, now we have dot amazon. But in the future, maybe you can have dot sahara, dot sahel, dot nile, dot danube. I don't know if the names are there. I don't have the list by

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heart. But maybe the names are not there. But it doesn't mean they're not important for national culture and traditional concerns in your countries.

So it's true there's a gap. But also it's true that the procedure is a little bit different. But it's also true that the list is incomplete.

And, just to finish my argument, I'd like to say that it is possible that some geographical names solicitation can find a negotiated solution. Maybe -- and it's the case -- we know some case where the city name, the state name, the province name has been subject of solicitation of registration. And they are -- the government is negotiating with the company or the companies responsible for the solicitation. And it's okay. But in the dot amazon, it was not possible. And it's out of negotiation.

So it's still there, the possibility of some geographical names registrations can be negotiated. We don't -- we don't put it in -- at risk. But in this specific case -- and I'm quite sure that there will be some other case. Dot africa has been a case in the past. And, in this case, dot amazon was not possible to be negotiated.

Thank you.

CHAIR DRYDEN:

Thank you, Brazil. I have Portugal and then Peru, please.

PORTUGAL:

Thank you very much.



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I think it's too serious the issue we are dealing here with.

And I would like to make mine on behalf of the Portuguese government, the comments made five minutes ago by Australia and Argentina. Thank you.

CHAIR DRYDEN:

Thank you, Portugal. Peru, please.

PERU:

Thank you. I would like to go along with the proposal for working on any eventual gap that could be in the list or in criteria for geographic names that are not in the list of ICANN. In this case, however, I would like to stress the difference with dot amazon in particular and focus on this case in particular. There is no ambiguity in this case.

For the company that has submitted its application and it was very clear and they knew beforehand that it was there, a very vast region that was shared by several countries that the name was a geographic name as well. That was very well known by the company from the beginning. So, in this case, there was no doubt that they were dealing with a geographic name. There was also no doubt that it was a codified name because it got the three-digit code. So I would like to -- and we are ready to collaborate in this process of striking new criteria or clearer criteria, but it would work for other cases. We can -- I think that we can deal with separately. In the near future there is need to equate the situation of those names that are in the realm of the national patrimony of countries and that have cultural geographic significance. It is striking for us to see that there is a prior search on trademarks during the

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sunrise period. But there is no list or no searching mechanisms for geographic names. So we shall work on that. But, again, this is not the case for dot amazon. It was recognized by the company from the very beginning that they were dealing with governments and they were dealing with a region, a very vast one.

CHAIR DRYDEN: Thank you, Peru. Chile, please.

CHILE: Thank you, Chair. We supported -- a declaration was circulated at the beginning of this meeting. We reiterate what we expressed there. We had similar concerns recently with other applications. And this can be a case for any other country, too. So we recognize that there are procedures in place and provisions in the different -- the guidebook and bylaws. And, even though they could be clarified, we were also open to define new criteria for the other cases, definitely. But we see in this case that there is factual data that's been expressed. And, even though that, that's the same their position, they've engaged in conversations with the applicant. And no solution was achieved directly in those conversations. So we believe that we need to address the specific situation now and think seriously in what we have proposed regarding the GAC advice in spite of other conversations that we could put forward regarding the improvement or clarification for further cases. Thank you.

CHAIR DRYDEN: Thank you, Chile. I have South Africa and then Iran.

SOUTH AFRICA:

Thank you, Chair. During the Beijing meeting, I think there was only one dissenting voice regarding the GAC giving advice to the board to reject the dot amazon application. And, when you look at GAC principles with regard to geo names, it is a requirement that, if you apply for a geographic name, you have to have government support, which was not the case in this nature. Also taking into account that Amazon is a trademark. But, for me, the fundamental question is: What was there first? The region or the trademark? Because I think that's very important to consider. To say that you might find -- also find that what actually informed the company's name was the region Amazon. So from that premise, I think, really, as a GAC, our job is easy to say that we should actually give this advice to ICANN to say that they need to reject this dot amazon application. And also the other thing is that we need to actually make a decision in this meeting. We cannot defer the decision to when we go to Argentina. It might be too late. So I think that, you know, for us as a GAC, we really need to apply our minds and do the right thing. Because we are here representing governments and public policy. That's what we're here to do, advise ICANN on public policy that deals with the Internet. Thank you, Chair.

CHAIR DRYDEN:

Thank you, South Africa.

Iran, please?

IRAN:

Merci madam.

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[ Speaking foreign language ]

This is specific issue about dot amazon. The only reason is that our distinguished colleague -- we have addressed this issue of dot amazon because our colleague from Brazil was not able to attend this meeting tomorrow. What I'm asking is that we shouldn't make this issue too general, too comprehensive. It is not applicable to everyone. We need to discuss. We need to debate. But we shouldn't rush to get to something that might create difficulties for us in the future. That is why, Madam Chair, that I kindly asked you, with all due respect, to limit our discussion to dot amazon only. And for other more general cases there would be other times to discuss them. There are specific cases. And we have to resort to international conventions and act on a case-by-case basis so as not to be generalizing and create something that in the future will prevent us from discussing and making decisions. This is the request that we are specifically making to you, Madam Chair.

CHAIR DRYDEN: China and Nepal. China, please.

CHINA: I just want to say China supports the statement of Brazil and Peru, Argentina.

CHAIR DRYDEN: Thank you, China. NEPAL.

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NEPAL: Thank you, Chair. I just wanted to comment on the conjecture from South Africa that Amazon, the company, may have got its name from the region. I recall in Beijing that the Brazilian delegation did read to us statements from the Amazon Web site confirming that, indeed, they did get the name from the region.

CHAIR DRYDEN: Thank you. Next I have Thailand.

THAILAND: Yes, thank you, Madam Chair. And I'd like to join my previous delegation to support the statement made by Brazil. I also would like to add that in -- when we talk about geographical names, in fact, ICANN also has another process that conduct in IDN which refers to the extensive knowledge of United Nations geographic names, expert on geographic names, which also recognize a Romanized country on how they define the long-term country and territory process. It's there. But in the fast track IDN and IDN consideration which is not adopted in the application guidebooks. So there is some process already there, which is sufficient, if you could have a look on the details of how they defined geographical names. And I think most of the country also support this UNG, GN. Thank you.

CHAIR DRYDEN: Thank you very much, Thailand. Okay. So at this point, I think we can pause. Iran. Would you like to --

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IRAN: There is consensus on this issue. We do know that there are different viewpoints. However, we believe it is the right time to conclude. If you have the same impression I have on this situation.

CHAIR DRYDEN: At this point I think we can sum up for the moment. And this has been a very good exchange that we've had, I think, and we have successfully outlined, I think, what are some of the key issues in considering these names and there is, I think, a lot of clarity for us in terms of the concerns expressed about some of the strings that have been mentioned in this discussion. And it may be the case that we can acknowledge as well as the GAC at our meetings here -- in addition to addressing directly the question of those strings remaining on the list of outstanding strings -- that we acknowledge that in some cases there may be gaps or additional considerations, and we may want to point that out to the board when we put together our communique.

So I would, at this point, like to have us break for lunch, and we know that we have our session tomorrow where we will go through all the strings. And I do believe this has been, as I say, a useful exchange that we have had. I'm glad that we have had it. So I can see Brazil and Peru and Iran.

BRAZIL: Madam Chair, I think that we -- we have the opinions and the position of the countries here that clearly express their support to the Brazilian request to reject the dot Amazon registration, and I think that -- I don't see any reason to postpone this decision to tomorrow because we -- we

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have all the opinions here today. So I would like to ask you to consider that.

CHAIR DRYDEN: Thank you, Brazil. Okay. I can see from the requests we're getting I'm pretty sure I know what you're going to say. Peru and Argentina.

PERU: Risking being predictable at this point, Chair --

CHAIR DRYDEN: Perhaps I can continue. I think we can settle this. So what I propose to do is put the question regarding dot Amazon, and then we will conclude this session. So are there any objections to a GAC consensus objection to the application for dot Amazon? Recognizing that there are IDN equivalents, this would apply to those equivalents. So I am now asking you in the committee whether there are any objections to a GAC consensus objection on the applications for dot Amazon, which would include their IDN equivalents. I see none. Would anyone like to make any comments on the string dot Amazon. I see none. Okay. So it is decided, and now we will break for lunch. Please be back here at 2:00.

[ Applause ]

[ END OF AUDIO ]

## **APPENDIX D**



## APPENDIX D

The following quotes are extracted from the attached original documents, as found on the ICANN website.

### 2009:

The treatment of country and territory names, in version 2 of the Draft Applicant Guidebook, was developed in the context of the points raised by the GAC, the ccNSO, and the GNSO policy recommendations and trying to find a balance among the somewhat contrary views. [...]

The Board raised concerns that the criteria for country and territory names, as it appeared in version 2 of the Draft Applicant Guidebook was ambiguous and could cause uncertainty for applicants. Subsequently, on 6 March 2009, the ICANN Board directed staff to, among other things, "...revise the relevant portions of the draft Applicant Guidebook to provide greater specificity on the scope of protection at the top level for the names of countries and territories listed in the ISO 3166-1 standard".

The revised definition . . . continues to be based on the ISO 3166-1 standard and fulfills the Board's requirement of providing greater clarity about what is considered a country or territory name in the context of new gTLDs. It also removes the ambiguity that resulted from the previous criteria that the term 'meaningful representation' created.

The Board's intent is, to the extent possible, to provide a bright line rule for applicants. . . . It is felt that the sovereign rights of governments continue to be adequately protected as the definition [of geographic names] is based on a list developed and maintained by an international organization.

**Source: Letter from ICANN (Dengate-Thrush) to GAC (Karklins), September 22, 2009.**

### 2010:

With regard to the definition of country names, the Board has sought to ensure both clarity for applicants, and appropriate safeguards for governments and the broad community. A considerable amount of time has been invested in working through the treatment of country and territory names to ensure it meets these two objectives. [...]

The resulting definition for country and territory names is based on ISO 3166-1 and other published lists to provide clarity for potential applicants and the community. [...]

While the revised criteria may have resulted in some changes to what names are afforded protection, there is no change to the original intent to protect all names listed in ISO 3166-1 or a short or long form of those names (and, importantly, translations of them). This level of increased clarity is important to provide process certainty for potential TLD applicants, governments and ccTLD operators – so that it is known which names are provided protection.

The definition is objectively based on the ISO list, which is developed and maintained by a recognized international organization.

[...]

[T]he Board has sought to ensure, throughout the process of developing a framework for new gTLDs, that there is 1) clarity for applicants, and 2) appropriate safeguards for the benefit of the broad community. . . . The current definitions, combined with the secondary avenue of recourse available by way of objections are considered adequate to address the GAC's concerns.

It should be noted that much of the treatment of geographic names in the Applicant Guidebook was developed around the GAC Principles regarding new gTLDs, and conversations and correspondence with the GAC on this issue going back to 2008.

[...]

During the teleconference of 8 September 2008, GAC members identified the ISO 3166-2 List, as an option for defining sub-national names. Accordingly, version 4 of the Applicant Guidebook provides protection for all the thousands of names on that list. Also during the call the idea of the GAC creating a list of geographic and geopolitical names was discussed, however, it is understood that the GAC moved away from this suggestion because it would be a resource intensive effort for all governments to undertake.

**Source: Letter from ICANN (Dengate-Thrush) to GAC (Dryden), August 5, 2010.**

Sub-national place names: Geographic names protection for ISO 3166-2 names should not be expanded to include translations. Translations of ISO 3166-2 list entries can be protected through community objection process rather than as geographic labels appearing on an authoritative list.

**Source: Adopted Board Resolutions – Trondheim, Norway, September 25, 2010**

The Board has sought to ensure, throughout the process of developing a framework for new gTLDs, that there is 1) a clear process for applicants, and 2) appropriate safeguards of the benefit of the broad community including governments. The current criteria for defining geographic names as reflected in version 4 of the Draft Applicant Guidebook are considered to best meet the Board’s objectives and are also considered to address to the extent possible the GAC principles. These compromises were developed after several consultations with the GAC – developing protections for geographical names well beyond those approved in the GNSO policy recommendations. The current definitions, combined with the secondary avenue of recourse available by way of objections were developed to address the GAC’s concerns.

[...]

*Objection Process*

The criteria for community objections were created with the possible objections to place names in mind and as such the objection process “appropriately enables governments to use this”.

[...]

[T]he new gTLD implementation to date has addressed the issues described in the Affirmation of Commitments: competition, consumer protection, security, stability and resiliency, malicious abuse issues, sovereignty concerns, and rights protection. The issues raised by the GAC are neither stability / security nor AoC issues – but they merit the full attention of the community.

The solution that appears in version 4 of the Applicant Guidebook was developed following extensive legal research that examined restrictions in a representative sample of countries, which included Brazil, Egypt, France, Hong Kong, Malaysia, South Africa, Switzerland and the United States of America. Various competing interests are

potentially involved, for example the rights of freedom of expression versus sensitivities associated with terms of national, cultural, geographic and religious significance. While freedom of expression in gTLDs is not absolute, those claiming to be offended on national, cultural, geographic or religious grounds do not have an automatic veto over gTLDs. The standards summarized by Recommendation No. 6 indicate that a morality and public order objection should be based upon norms that are widely accepted in the international community.

[...]

Importantly, in addition to the Morality and Public Order objection and dispute resolution process, the Community Objection standards were developed to address potential registration of names that have national, cultural, geographic and religious sensitivities.

[...]

I understand that some GAC members have expressed dissatisfaction with this process as it was first described in version 2 of the Guidebook. The treatment of this issue in the new gTLD context, was the result of a well-studied and documented process which involved consultations with internationally recognized experts in this area. [...] The expression of dissatisfaction without a substantive proposal, does not give the Board or staff a toehold for considering alternative solutions. While the report of a recently convened working group still does not constitute a policy statement as conceived in the ICANN bylaws, ICANN staff and Board are working to collaborate with the community to adopt many of the recommendations.

**Source: Letter from ICANN (Dengate-Thrush) to GAC (Dryden), November 23, 2010.**

**2011:**

The Board has sought to ensure, throughout the process of developing a framework for new gTLDs, that there is a clear process for applicants, and appropriate safeguards for the benefit of the broad community including governments. The current criteria for defining geographic names as reflected in the Proposed Final Version of the Applicant Guidebook are considered to best meet the Board's objectives and are also considered to address to the extent possible the GAC principles. These compromises were developed after several consultations with the GAC – developing protections for

geographic names well beyond those approved in the GNSO policy recommendations. These definitions, combined with the secondary avenue of recourse available by way of objections were developed to address the GAC's concerns.

In developing the process for geographic names, ICANN has relied upon ISO or UN lists to assist with geographical definitions in the context of new gTLDs. The combined total of names currently protected in the new gTLD process is well in excess of 5000 names, and providing protection for "commonly used" interpretations of these names would multiply the number of names and the complexity of the process many-fold.

[...]

#### Use and protection of geographical names

- The inclusion of geographic names, as defined in the Guidebook, was developed in response to GAC principle 2.2.
- The protection of government interests in geographic names is accounted for by the requirement that no application for a geographic name (as defined in the Guidebook) can be approved without documentation of the support or non-objection from the relevant government or public authority.
- Country and territory names, as defined in the Applicant Guidebook, have been excluded from the first application round of the gTLD process based on GAC advice.

[...]

- The capacity for an objection to be filed on community grounds, where there is substantial opposition to an application from a community that is targeted by the name also provides an avenue of protection for names of interest to a government which are not defined in the Applicant Guidebook.

**Source: ICANN Board – GAC Consultation: Geographic Names, February 21, 2011.**

The GAC states that the current objection procedures do not effectively address strings that raise national, cultural, geographic, religious and/or linguistic sensitivities or objections that could result in intractable disputes. . . .

Under the Guidebook, protections for these types of names are provided by a series of objections and processes: The requirement for government approval of

certain geographic names, Community-based objections (Rec 20), and Limited Public Interest (or Morality & Public Order Rec 6) objections. The last provides that a string will be excluded if it [...] is a determination that an applied-for gTLD string would be contrary to specific principles of international law as reflected in relevant international instruments of law. . . . It is recognized that principles from international treaties are incorporated into national laws in a range of ways and a panel would need to consider the relevant text in national laws.

**Source: ICANN Board – GAC Consultation: Objections, February 21, 2011.**

[The GAC, in its Scorecard of February 23, 2011, requested a mechanism to protect their interests and define names they consider geographic. ICANN’s Board responded as follows.]

ICANN will investigate a mechanism for the forthcoming round under which GAC members could be exempted from paying fees for objections in some circumstances...

The process relies on pre-existing lists of geographic names for determining which strings require the support or non-objection of a government. Governments and other representatives of communities will continue to be able to utilize the community objection process to address attempted misappropriation of community labels. ICANN will continue to explore the possibility of pre-identifying using additional authoritative lists of geographic identifiers that are published by recognized global organizations.

[The GAC then requested clarification that such a mechanism “implies that ICANN will exclude an applied for string from entering the new gTLD process when the government formally states that this string is considered to be a name for which this country is commonly known as.” ICANN’s Board responded as follows.]

ICANN will continue to rely on pre-existing lists of geographic names for determining which strings require the support or non-objection of a government. This is in the interest of providing a transparent and predictable process for all parties.

**Source: Letter from ICANN (Dengate-Thrush) to GAC (Dryden), March 5, 2011 (attaching the February 23, 2011 Scorecard).**



The Internet Corporation for Assigned Names and Numbers

22 September 2009

Janis Karklins  
Chairman of the Governmental Advisory Committee  
Ambassador of Latvia to France  
via email: janis.karklins@icann.org

Dear Janis

Thank you for the GAC's letter of 18 August, containing the GAC's comments on version 2 of the Draft Applicant Guidebook. I appreciate the detailed consideration given by the GAC to the issue of new gTLDs. Outlined below is a detailed response to the GAC's comments, which I trust the GAC will find useful. I look forward to the Board continuing discussions with the GAC in Seoul, on version 3 of the Draft Applicant Guidebook which will be published by the end of September 2009.

## **I. ICANN'S PREPAREDNESS FOR NEW gTLD ROUND**

### **1. Scalability of gTLD Expansion and Stability of the Internet**

*The GAC is aware that many root server operators have raised concerns about the effect that a major expansion of the gTLD space would have on the stability of the Internet. The GAC considers that a controlled and prudent expansion of the DNS space is of primary importance for safeguarding the stability, security and interoperability of the Internet on which the global economy and social welfare relies so much.*

*The GAC notes that the SSAC and RSSAC have been asked to prepare a report on the scalability of the root zone and the impact of the potential simultaneous introduction of new gTLDs, DNSSEC, IPv6 glue, and IDNs into the root zone, which will be published in August. The GAC will look to this report to provide reassurance that the scaling up of the root will not impair the stability of the Internet and that the technical safeguards are sufficient. The GAC is hopeful the report will stress the importance of developing an alert or warning system, as well as the need for a process for halting the adoption of new top level domains should the root zone begin to show signs of breach or weakness. It should be noted that although the GAC is encouraged this study is underway there is some concern as to why the proper analysis did not occur earlier.*

## **RESPONSE**

In February 2009, with Resolution 2009-02-03-04, the ICANN Board requested the Root Server System Advisory Committee (RSSAC), the Security and Stability Advisory Committee (SSAC),



*public authorities, as representatives of the sovereign state or territory, cannot be limited as such by ICANN or by any procedures introduced by ICANN for new gTLDs.*

*The GAC is of the opinion that the DAG2 is a substantial improvement on its predecessor, but that it does not yet fully reflect the GAC position that governments and other public authorities, as representatives of citizens of a sovereign state, territory, province or city, have a legitimate interest in the use of geographical names as new TLDs.*

*The GAC therefore proposes the following amendments to be incorporated in version 3 of the Draft Applicant Guidebook (further in the text - DAG3):*

**i. Strings that are a meaningful representation or abbreviation of a country name or territory name should not be allowed in the gTLD space**

*These strings represent countries or territories and the principle of sovereignty must apply. TLDs in this category should therefore be treated in the same way as ccTLDs.*

*The use of exhaustive listings (e.g. ISO 3166-1) will not cover all the ccTLD-like applications envisaged by the GAC and ccNSO, in particular in the following categories:*

*'Commonly referred to as' type strings representing a country or territory but which are not official titles, e.g. .america, .ceylon, .holland;*

*Common or general names that are often applied to more than one country, e.g. .guinea*

## RESPONSE

While understanding the sentiment that a country name TLD should be treated as a ccTLD, ICANN policy constrains the way in which it is possible to provide country name TLDs to all countries and territories is under the new gTLD program at this time.<sup>1</sup> The treatment of country and territory names, in version 2 of the Draft Applicant Guidebook, was developed in the context of the points raised by the GAC, the ccNSO, and the GNSO policy recommendations and trying to find a balance among the somewhat contrary views. Applications for country and territory names will require evidence of support or non-objection from the relevant government or public authority which is consistent with GAC principle 2.2.<sup>2</sup>, and that evidence must clearly indicate that the government or public authority understands the purpose of the TLD string and the process and obligations under which it is sought.

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<sup>1</sup> Meaningful representations of country or territory names in non-Latin scripts will be available under the IDN Fast Track process but country and territory names in Latin scripts are available in the gTLD program only, until the ccTLD policy development is complete.

<sup>2</sup> ICANN should avoid country, territory or place names, and country, territory or regional language or people descriptions, unless in agreement with the relevant governments or public authorities





Safeguards have been developed to ensure that the relevant government or public authority's sovereign rights are respected, and that the process is understood. It is ultimately the government or public authority's discretion whether to support, or not support, an application for a country name TLD, and the circumstances under which they would be willing to do so.

The Board raised concerns that the criteria for country and territory names, as it appeared in version 2 of the Draft Applicant Guidebook was ambiguous and could cause uncertainty for applicants. Subsequently, on 6 March 2009, the ICANN Board directed staff to, among other things, "... revise the relevant portions of the draft Applicant Guidebook to provide greater specificity on the scope of protection at the top level for the names of countries and territories listed in the ISO 3166-1 standard".

The revised definition, provided in a Geographical Names excerpt of the guidebook posted on 30 May 2009, continues to be based on the ISO 3166-1 standard and fulfills the Board's requirement of providing greater clarity about what is considered a country or territory name in the context of new gTLDs. It also removes the ambiguity that resulted from the previous criteria that the term 'meaningful representation' created.

The Board's intent is, to the extent possible, to provide a bright line rule for applicants. While the revised criteria may have resulted in some changes to what names are afforded protection, it has not changed the original intent to protect all names listed on the ISO 3166-1 list, including the short or long form of the name. It is felt that the sovereign rights of governments continue to be adequately protected as the definition is based on a list developed and maintained by an international organisation.

In the context of the revised definition, the name America is afforded protection, while the names Ceylon and Holland are not. However, the objection process does provide a secondary avenue of recourse. An application 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. With regard to the names .Guinea and .Guinea-Bissau, only the relevant government or public authority for the respective countries can agree to support, or not-object, to the use of their respective names.

**ii. gTLDs using strings with geographic names other than country names or territories (so called geoTLDs) should follow specific rules of procedure**

*The Draft Applicant Guidebook already provides for specific rules of procedure, such as the creation of a Geographic Names Panel or the requirement that an applicant for a geoTLD must document the government's or public authority's support for, or non-objection to, the applicant's application, and must demonstrate the government's or public authority's understanding of the string being requested and its intended use.*



The evaluation fee was based on detailed analyses of specific tasks and steps needed to perform the evaluation. ICANN has taken a detailed and thorough approach to estimating program development costs, process and risk costs associated with this new program, and consistently used a set of principles in applying the estimation methodology. The results have been tested with sensitivity and other analysis, and appropriate expertise has been retained and applied.

The costs of the program have recently been re-evaluated and the results of the re-evaluation and the supporting data will be posted with the next version of the Applicant Guidebook.

Although the evaluation fee of \$185,000 may be burdensome for certain organizations that are considering applying for a new gTLD, the evaluation fee was developed based upon a policy of revenue-cost neutrality, conservatism, and a detailed cost estimating exercise. The impact on a specific applicant or a class of applicant, by policy, is not a factor in the development of the evaluation fee. While it is acknowledged that some applications may have lower processing costs than others, and the costs associated with evaluating applications may vary, it is difficult, if not impossible, to determine which applications will require more or less resources. The application fee is based upon the estimated average cost of all applications based upon principles of fairness and conservatism.

In the event that there is a surplus from the new gTLD application round, the excess funds will not be used for ICANN's general operations. They will be disposed of in a manner consistent with the community's feedback and the policy recommendations. ICANN's multi-stakeholder model for decision making will be employed to ensure that all decisions regarding the underlying guiding principles, amounts, recipients, timing and manner of disposition of surplus funds, if any, will be handled in accordance with the communities' wishes.

To conclude, I hope you found this information useful and clear. Please contact my office with follow-up that the GAC might have and I will ensure that those questions are addressed. We look forward to comments of the GAC to the Guidebook excerpts and associated material published at <http://www.icann.org/en/announcements/announcement-2-31may09-en.htm> and to the third version of the Guidebook that will be published prior to the Seoul meeting.

Sincerely,

Peter Dengate Thrush  
Chairman of the Board



The Internet Corporation for Assigned Names and Numbers

5 August 2010

Heather Dryden  
Chair of the Governmental Advisory Committee  
Senior Advisor to the Government of Canada

Dear Heather

**GAC Comments on new gTLDs and Draft Applicant Guidebook version 3**

Thank you for the GAC's letter of 10 March 2010, providing comments on new gTLDs and version 3 of the Draft Applicant Guidebook. I believe the Board and GAC share a similar viewpoint that it would be in the global public interest that "... the opening up of the gTLD space is undertaken in a way that does not compromise the resilience and integrity of the DNS and serves the global public interest". The Board is pleased with the way in which the various iterations of the guidebooks are evolving, and is particularly pleased by the mechanism whereby the overarching issues are being resolved through working groups comprised of members of the ICANN community and independent experts.

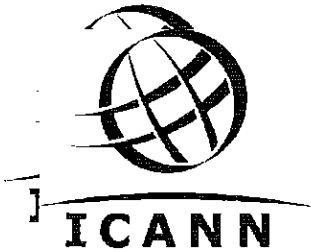
I respond below to each of the areas of concern raised by the GAC.

**Root scaling implications**

ICANN supports the principle that the scale and rate of changes must not negatively impact the resilience, security and stability of the DNS. In February 2009, the ICANN Board requested the Root Server System Advisory Committee (RSSAC), the Security and Stability Advisory Committee (SSAC), and the ICANN staff (including ICANN Staff members dealing with technical issues and the IANA functions) to study the potential issues regarding the addition of IDNs, IPv6 addresses, DNSSEC and substantial numbers of new TLDs to the root zone. This study was completed in August 2009 and posted for comment at <http://www.icann.org/en/committees/dns-root/root-scaling-study-report-31aug09-en.pdf>. A complementary report (<http://www.icann.org/en/committees/dns-root/root-scaling-model-description-29sep09-en.pdf>) describes the characteristics of the quantitative model developed by TNO for dynamic analysis of root scaling issues.

In addition, and as part of ongoing efforts to ensure the stability of the DNS, ICANN contracted with the DNS Operations, Analysis and Research Center (<https://www.dns-oarc.net/>) as independent and well-respected experts to provide an analysis of the impact of adding IPv6, DNSSEC, and additional top-level domains to the ICANN-operated L root server. This study, while independent of the Root Server System

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## The Internet Corporation for Assigned Names and Numbers

in a reconsideration of the treatment of country and territory names in the new gTLD process. This has resulted in a change of approach as reflected in the recently published draft version 4 of the Applicant Guidebook: namely, that country and territory names will not be available for delegation in the first round of the new gTLD application process.

With regard to the definition of country names, the Board has sought to ensure both clarity for applicants, and appropriate safeguards for governments and the broad community. A considerable amount of time has been invested in working through the treatment of country and territory names to ensure it meets these two objectives. Following discussion at the Mexico City meeting, the Board recommended that the Applicant Guidebook be revised in two areas regarding this subject: (1) provide greater specificity as to what should be regarded as a representation of a country or territory name in the generic space, and (2) provide greater specificity in defining the qualifying support requirements for continent names, with a revised position to be posted for public comment.

The resulting definition for country and territory names is based on ISO 3166-1 and other published lists to provide clarity for potential applicants and the community. It seeks to remove the ambiguity created by use of the term 'meaningful representation.' Therefore, the definition of country and territory names has not been amended in the recent Guidebook draft and remains consistent with the Board goals and resolution on this issue.

While the revised criteria may have resulted in some changes to what names are afforded protection, there is no change to the original intent to protect all names listed in ISO 3166-1 or a short or long form of those names (and, importantly, translations of them). This level of increased clarity is important to provide process certainty for potential TLD applicants, governments and ccTLD operators – so that it is known which names are provided protections.

The definition is objectively based on the ISO list, which is developed and maintained by a recognised international organisation.

It is acknowledged that ICANN has used the concept of 'meaningful representation' of a country or territory in the context of the IDN ccTLD Fast Track. This reflects the objective of rapid initial deployment of IDNs and the associated need to remove as many potential obstacles as possible. There have always been particular sensitivities about geographic names where non-Latin scripts and a range of languages are involved. It does not follow that these considerations should automatically apply to the broader ccTLD and gTLD spaces. It is reasonable that the criteria for including names (the Fast Track) could be different than the criteria for excluding names (gTLDs).

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geographical strings could be allowed in the gTLD space if in agreement with the relevant government or public authority."



The ccNSO will be undertaking policy discussions, which may result in a change in position on these two issues. In particular, defining the distinction between country code and generic names may warrant a broader cross-SO/AC policy discussion. Once policy is developed, it will be appropriate for the Board to reconsider these positions.

#### **Definition of geographical strings insufficient and not in line with paragraphs 2.2 and 2.7 of the GAC principles regarding new gTLDs**

As mentioned above, the Board has sought to ensure, throughout the process of developing a framework for new gTLDs, that there is 1) clarity for applicants, and 2) appropriate safeguards for the benefit of the broad community. The current criteria for defining geographic names as reflected in version 4 of the Draft Applicant Guidebook are considered to meet the Board's objectives and are also considered to address to the extent possible the GAC principles. The current definitions, combined with the secondary avenue of recourse available by way of objections are considered adequate to address the GAC's concerns.

It should be noted that much of the treatment of geographic names in the Applicant Guidebook was developed around the GAC Principles regarding new gTLDs, and conversations and correspondence with the GAC on this issue going back to 2008.

On 2 October 2008, (<http://www.icann.org/correspondence/twomey-to-karklins-02oct08.pdf>) following a teleconference with the GAC on 8 September 2008, the then CEO & President, Paul Twomey, wrote to the GAC explaining proposed principles to guide a procedure for implementing elements of paragraph 2.2. Place names were split into two categories, as follows: 1) sub-national geographical identifiers such as countries, states, provinces; and, 2) city names. Regional language or people descriptions were considered difficult to develop an implementation plan for this element of paragraph 2.2, because it will be difficult to determine the relevant government or public authority for a string which represents a language or people description as there are generally no recognised established rights for such descriptions.

As described in the 2008 letter, city names were considered challenging because a city name can also be a generic term, or a brand name, and in many cases city names are not unique. Therefore, where it is clear that an applicant intends to use the gTLD for purposes associated with the city name evidence of support, or non-objection is necessary. However, provision is made in the Guidebook to protect sovereign rights by requiring government approval for capital city names in any language, of any country or territory listed in the ISO 3166-1 standard.



During the teleconference of 8 September 2008, GAC members identified the ISO 3166-2 List, as an option for defining sub-national names. Accordingly, version 4 of the Applicant Guidebook provides protection for all the thousands of names on that list. Also during this call the idea of the GAC creating a list of geographic and geopolitical names was discussed, however, it is understood that the GAC moved away from this suggestion because it would be a resource intensive effort for all governments to undertake.

In relation to paragraph 2.7, at the Board's request, Paul Twomey (who was ICANN's CEO and President), wrote to the GAC on 17 March 2009 (<http://www.icann.org/correspondence/twomey-to-karklins-17mar09-en.pdf>), requesting the GAC's input on possible options to resolve the outstanding implementation issues regarding the protection of geographic names at the second level. The end result of this request was a letter from the GAC to Paul Twomey, dated 26 May 2009 (<http://www.icann.org/correspondence/karklins-to-twomey-29may09-en.pdf>), which proposed a solution, that was accepted by the Board and ultimately reflected in the draft Registry Agreement developed for new gTLDs. On this basis, the Board considers that this matter has been dealt with to the satisfaction of the Board and the GAC.

#### **Mechanisms for dealing with post-delegation deviation from conditions of government approval**

The GAC's suggestion of including a clause in the registry agreement requiring that in the case of a dispute between a relevant Government and the registry operator, ICANN must comply with a legally binding decision in the relevant jurisdiction has been adopted. The Registry Agreement has been amended accordingly.

In addition, the processes and remedies of the Registry Restrictions Dispute Resolution Procedure are available to governments in cases where the geographic name is applied for as a community-based TLD. The remedies that can be recommended to ICANN under this procedure include:

- remedial measures for the registry to employ to ensure against allowing future registrations that do not comply with community-based restrictions;
- suspension of accepting new domain name registrations in the gTLD until such time as violation(s) is cured; or, in extraordinary circumstances;
- providing for the termination of a registry agreement.



The Internet Corporation for Assigned Names and Numbers

**ICANN**

relating to the implementation of the new gTLD program. We will likely follow the Board Workshop with a Special Board Meeting focusing on the new gTLD topics.

I understand the GAC is preparing their comments on version 4 of the Draft Applicant Guidebook, and we very much look forward to the GAC's input for use in that Board Workshop.

Yours sincerely

Peter Dengate-Thrush

Peter Dengate-Thrush  
Chair  
ICANN Board of Directors

CC: Rod Beckstrom, CEO and President, ICANN

## Internet Corporation for Assigned Names and Numbers

GROUPS (/EN/GROUPS) › BOARD (/EN/GROUPS/BOARD) › DOCUMENTS (/EN/GROUPS/BOARD/DOCUMENTS)

### Adopted Board Resolutions

25 September 2010

Trondheim, Norway

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1. **New gTLD (generic Top Level Domain) Program Budget**
  2. **New gTLDs – Directions for Next Applicant Guidebook**
    - 2.1. Geographic Names
    - 2.2. New gTLD (generic Top Level Domain) Applicant Support
    - 2.3. Root Zone Scaling
    - 2.4. String Similarity
    - 2.5. Variant Management
    - 2.6. Trademark Protection
    - 2.7. Role of the Board
    - 2.8. Mitigating Malicious Conduct
    - 2.9. GNSO (Generic Names Supporting Organization) New gTLD (generic Top Level Domain) Recommendation 6 Objection Process
    - 2.10. Registry Agreement
    - 2.11. Vertical Integration
  3. **Data and Consumer Protection Working Group**
  4. **Board Global Relationships Committee**
  5. **Nominating Committee Chair**
  6. **March 2011 International Public Meeting**
  7. **Appointment of Akram Atallah as Chief Operating Officer**
- 

#### 1. New gTLD (generic Top Level Domain) Program Budget

Whereas, the Board Finance Committee considered the New gTLD (generic Top Level Domain) Deployment Budget at its meeting on 20 September 2010 and unanimously recommended that the Board adopt the Deployment Budget <<http://www.icann.org/en/topics/new-gtlds/explanatory-memo-new-gtld-program-budget-22oct10-en.pdf> (/en/topics/new-gtlds/explanatory-memo-new-gtld-program-budget-22oct10-en.pdf)>.



Resolved (2010.09.25.03), the Board gives the CEO the following directions relating to the forthcoming version of the Applicant Guidebook for new gTLDs, which is intended to be posted for public comment before the ICANN (Internet Corporation for Assigned Names and Numbers) meeting in Cartagena in December 2010:

## ~~2.1 Geographic Names~~

~~Sub-national place names: Geographic names protection for ISO (International Organization for Standardization) 3166-2 names should not be expanded to include translations. Translations of ISO (International Organization for Standardization) 3166-2 list entries can be protected through community objection process rather than as geographic labels appearing on an authoritative list.~~

Continents and UN Regions: The definition of Continent or UN Regions in the Guidebook should be expanded to include UNESCO's regional classification list which comprises: Africa, Arab States, Asia and the Pacific, Europe and North America, Latin America and the Caribbean.

Governments that file objections should be required to cover costs of the objection process just like any other objector; the objection process will be run on a cost-recovery and loser-pays basis (so the costs of objection processes in which governments prevail will be borne by applicants). Also, the Board notes that the GAC (Governmental Advisory Committee) proposal for free government objections is not specific as to particular objection grounds or particular government objectors (for example whether both national and local government objectors would be covered).

## 2.2 New gTLD (generic Top Level Domain) Applicant Support

Support to applicants will generally include outreach and education to encourage participation across all regions, but any direct financial support for applicant fees must come from sources outside of ICANN (Internet Corporation for Assigned Names and Numbers).

Staff will publish a list of organizations that request assistance and organizations that state an interest in assisting with additional program development, for example pro-bono consulting advice, pro-bono in-kind support, or financial assistance so that those needing assistance and those willing to provide assistance can identify each other and work together.

Owing to the level of uncertainty associated with the launch of new gTLDs, the fee levels currently in the Applicant Guidebook will be maintained for all applicants.

## 2.3 Root Zone Scaling

Real-world experience in root zone scaling has been gained as a result of the implementation of IPv6 (Internet Protocol version 6), DNSSEC (DNS Security Extensions) and IDNs (Internationalized Domain Names) and the hard work of RSSAC and SSAC (Security and Stability Advisory Committee) members in tackling the underlying stability question. Staff is directed to publish its analysis of the impact of IPv6 (Internet Protocol version 6), DNSSEC (DNS Security Extensions) and IDN deployment on the root zone so far.

Staff has also developed a model and a rationale for the maximum rate of applications that can be processed over the next few years. Staff is directed to publish this model and rationale and to seek Board support for the judgment embodied in this model, thereby providing a firm basis for limiting the rate of new delegations. Based on the discussions to date, this limit is expected to be in the range of 1,000 new delegations per year, with this number to be defined precisely in the publication.

The Board notes that an initial survey of root server operators' ability to support this rate of growth has been conducted successfully, and directs staff to revisit the estimate on a regular basis and consider whether a further survey should be repeated.

Further, ICANN (Internet Corporation for Assigned Names and Numbers) will periodically consult with root zone



The Internet Corporation for Assigned Names and Numbers

**ICANN**

23 November 2010

Heather Dryden  
Interim Chairman of the Governmental Advisory Committee  
Senior Advisor to the Government of Canada

GAC Comments on version 4 of the new gTLD Applicant Guidebook

Dear Heather

Thank you for your letter of 23 September 2010, providing GAC comments on version 4 of the Draft Applicant Guidebook. I also thank you for your letter of 4 August 2010, relating to procedures for addressing culturally objectionable and/or sensitive strings. I will respond to both letters in this communication.

As you know the Board met in Trondheim on 24 and 25 September 2010, and discussed outstanding issues relating to the implementation of the New gTLD program in order to identify potential ways forward. To the extent possible, the Board took into account the GAC's comments of 23 September 2010; however, as much of the preparation briefing had been provided to the Board well before the meeting, this was difficult to do. You will note, in the resolutions from Trondheim, that staff is directed to determine if the directions indicated by the Board are consistent with GAC comments, and recommend any appropriate further action in light of the GAC's comments.

The adopted Board resolutions from the Trondheim meeting are available at:

<http://www.icann.org/en/minutes/resolutions-25sep10-en.htm>

I would encourage the GAC to read these resolutions in conjunction with the response to the GAC letter.

As you will appreciate, the development of the Applicant Guidebook and the resolution of the overarching issues identified during the process, has been a challenging task. The multi-stakeholder model under which ICANN operates means that we are responsible to a diverse range of stakeholders, and I believe that the ICANN community has done an outstanding job of considering, in many cases, diverse views on issues and finding workable solutions. That said, we do recognize that the new gTLD process cannot be all things to all people, and that some issues can be better addressed in successive rounds.

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<http://icann.org>

This detail is set out in the New gTD Program Explanatory Memorandum—Withdrawal of Government Support for Registry – Post-delegation options  
<http://www.icann.org/en/topics/new-gtlds/withdrawal-government-support-28may10-en.pdf>

### Use of geographical names

The Board has sought to ensure, throughout the process of developing a framework for new gTLDs, that there is 1) a clear process for applicants, and 2) appropriate safeguards for the benefit of the broad community including governments. The current criteria for defining geographic names as reflected in version 4 of the Draft Applicant Guidebook are considered to best meet the Board's objectives and are also considered to address to the extent possible the GAC principles. These compromises were developed after several consultations with the GAC – developing protections for geographical names well beyond those approved in the GNSO policy recommendations. The current definitions, combined with the secondary avenue of recourse available by way of objections were developed to address the GAC's concerns.

A detailed account was provided in my letter of 5 August 2010, to the GAC.

### *Country and territory names*

I understand that the issue of the use of country and territory names will not be part of the IDN ccPDP; however, the ccNSO is considering options available to consider this issue and the Board anticipates a policy process which provides direction on this issue. The Board will, after the first round of new gTLDs, reconsider the treatment of country and territory names in the new gTLD process.

As stated in previous communications, the Board sought to remove the ambiguity of the term 'meaningful representation' from the definition of country and territory names to provide greater clarity for applicants and appropriate safeguards for governments and the broad community. The current definition is objectively based on the ISO 3166-1 and other published lists to provide clarity for potential applicants and the community.

### *City names*

It is acknowledged in the Guidebook (and in previous missives to the GAC) that city names present challenges because city names may also be generic terms or brand names, and in many cases no city name is unique. Unlike other types of geographic names, there are no established lists that can be used as objective references in the evaluation process. Thus, city names can not be afforded universal protection. However, the process does provide a means for cities and applicants to work together where desired.

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Applicants are required to provide a description/purpose for the TLD, and to adhere to the terms and conditions of submitting an application including confirming that all statements and representations contained in the application are true and accurate.

*Objection process*

The criteria for community objections was created with the possible objections to place names in mind and as such the objection process "appropriately enables governments to use this." The *New gTLD Dispute Resolution Procedure* is outlined in an Attachment to Module 3, pp P-1 to P-11 and was also developed so that it is equally accessible to those who wish to utilize the process.

The Board discussed the GAC's position that governments should not be required to pay a fee for raising objections to new gTLD applications, and does not agree with the GAC on this point. It is the Board's view that governments that file objections should be required to cover costs of the objection process just like any other objector; the objection process will be run on a cost-recovery and loser-pays basis (so the costs of objection processes in which governments prevail will be borne by applicants). How would the dispute resolution process be funded: a speculative increase in application fees or increased fees to gTLD registrants? Either of these cases or others seem difficult to implement and unfair.

*Letter of support*

While appreciating that governments need time to consult internally before deciding whether to support an application, obtaining government support or non-objection is the responsibility of the applicant and is stated in Module 2 of the Applicant Guidebook. While it has not been decided how long the application period will be open from the time of launching the new gTLD program, there is a requirement that a four month communications campaign be undertaken prior to launch.

Legal recourse for applicants

As stated earlier in this letter, one of the guiding principles in developing the Applicant Guidebook has been to address and mitigate risks and costs to ICANN and the global Internet community.

ICANN reaffirms its commitment to be accountable to the community for operating in a manner that is consistent with ICANN's Bylaws, including ICANN's Core Values such as "making decisions by applying documented policies neutrally and objectively, with integrity and fairness." The Board does not believe however that ICANN should expose itself to costly lawsuits any more than is appropriate.

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The Board welcomes the report from the Recommendation 6 Working Group and has requested staff to undertake analysis of the report to determine how recommendations could be incorporated into the Guidebook and conduct a consultation with the Working Group before the Cartagena meeting with the aim of finding additional areas of agreement for incorporation into the Applicant Guidebook.

I wish to make a few points regarding the GAC letter of 4 August on this topic. I do not consider this to be a stability issue per se but rather a policy issue where ICANN is implementing the consensus position developed by the GNSO. There are controversial names delegated and registered now at different levels of the domain name system that do not result in security or stability issues.

Additionally, the new gTLD implementation to date has addressed the issues described in the Affirmation of Commitments: competition, consumer protection, security, stability and resiliency, malicious abuse issues, sovereignty concerns, and rights protection. The issues raised by the GAC are neither stability / security nor AoC issues – but they merit the full attention of the community.

The solution that appears in version 4 of the Applicant Guidebook was developed following extensive legal research that examined restrictions in a representative sample of countries, which included Brazil, Egypt, France, Hong Kong, Malaysia, South Africa, Switzerland and the United States of America. Various competing interests are potentially involved, for example the rights of freedom of expression versus sensitivities associated with terms of national, cultural, geographic and religious significance. While freedom of expression in gTLDs is not absolute, those claiming to be offended on national, cultural, geographic or religious grounds do not have an automatic veto over gTLDs. The standards summarized by Recommendation No. 6 indicate that a morality and public order objection should be based upon norms that are widely accepted in the international community.

In addition to the Draft Applicant Guidebook (Module 3), ICANN has published explanatory memoranda, dated 29 October 2008 <http://www.icann.org/en/announcements/announcement-29oct08-en.htm> and 30 May 2009 <http://www.icann.org/en/topics/new-gtlds/morality-public-order-30may09-en.pdf>, that set out the specific standards that have been adopted for such objections and the legal research upon which those standards is based.

Importantly, in addition to the Morality and Public Order objection and dispute resolution processes, the Community Objection standards were developed to address potential registration of names that have national, cultural, geographic and religious sensitivities.

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I understand that some GAC members have expressed dissatisfaction with this process as it was first described in version 2 of the Guidebook. The treatment of this issue in the new gTLD context, was the result of a well-studied and documented process which involved consultations with internationally recognized experts in this area. Advice containing thoughtful proposals for amending the treatment of this issue that maintains the integrity of the policy recommendation would be welcomed. The expression of dissatisfaction without a substantive proposal, does not give the Board or staff a toehold for considering alternative solutions. While the report of the recently convened working group still does not constitute a policy statement as conceived in the ICANN bylaws, ICANN staff and Board are working to collaborate with the community to adopt many of the recommendations.

Once again, I appreciate the GAC's commitment to the new gTLD process and hope you find this letter responsive to GAC concerns.

The proposed final version of the Applicant Guidebook has now been posted and I look forward to discussing the introduction of new gTLDs in Cartagena.

Regards,



Peter Dengate-Thrush

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## ICANN Board-GAC Consultation: Geographic Names

### EXPLANATION OF ISSUE/HISTORY

The GAC Principles regarding New gTLDs contain two paragraphs addressing geographic names. Paragraph 2.2<sup>1</sup> relates to names at the top level and paragraph 2.7<sup>2</sup> relates to names at the second level. In its policy recommendations, the GNSO provided that no specific protections be put in place beyond those afforded in the objection and dispute resolution process:

- that community objection procedures provided protections the GAC sought at the top level, and
- protections at the second level should be left to individual registries.

There has been regular communication in the form of face-to-face meetings, communiqués and correspondence between the GAC, staff and the Board on the treatment of geographic names and other issues, since the Board approved the GNSO recommendations for the introduction of new gTLDs in Paris in June 2008.

Many amendments have been made to the Guidebook that incorporate GAC requests regarding the treatment of geographical names.

### REMAINING AREAS OF DIFFERENCE:

1. The current Guidebook states that country and territory names will not be available in the first round. The GAC requests that Country and territory names not be available until the completion of the IDN ccPDP, and that it may be more appropriate to consider country and territory names outside the new gTLD program.
2. The current Guidebook protects country and territory names that appear on specific U.N. lists and their translations. The GAC requests that names by which countries, cities or regions are commonly known as, or abbreviations of, and which do not appear in the lists used to define geographic names in the Applicant Guidebook should also be given the same protection as names that do appear.

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<sup>1</sup> 2.2 ICANN should avoid country, territory or place names, and country, territory or regional language or people descriptions, unless in agreement with the relevant governments or public authorities.

<sup>2</sup> 2.7 Applicant registries for new gTLDs should pledge to:

a) adopt, before the new gTLD is introduced, appropriate procedures for blocking, at no cost and upon demand of governments, public authorities or IGOs, names with national or geographic significance at the second level of any new gTLD;

b) ensure procedures to allow governments, public authorities or IGOs to challenge abuses of names with national or geographic significance at the second level of any new gTLD

- **Names by which countries, cities or regions are commonly known as and which do not appear in the ISO lists should also be given the same protection as names that do appear.**

The Board has sought to ensure, throughout the process of developing a framework for new gTLDs, that there is a clear process for applicants, and appropriate safeguards for the benefit of the broad community including governments. The current criteria for defining geographic names as reflected in the Proposed Final Version of the Applicant Guidebook are considered to best meet the Board's objectives and are also considered to address to the extent possible the GAC principles. These compromises were developed after several consultations with the GAC – developing protections geographic names well beyond those approved in the GNSO policy recommendations. These definitions, combined with the secondary avenue of recourse available by way of objections were developed to address the GAC's concerns.

In developing the process for geographic names, ICANN has relied upon ISO or UN lists to assist with geographical definitions in the context of new gTLDs. The combined total of names currently protected in the new gTLD process is well in excess of 5000 names, and providing protection for "commonly used" interpretations of these names would multiply the number of names and the complexity of the process many-fold.

In correspondence to the GAC on 5 August 2010, the Board Chair indicated that the Board had sought to remove the ambiguity of the term 'meaningful representation' from the definition of country and territory names. The current definition is objectively based on the ISO 3166-1 and other published lists to provide greater clarity for applicants and appropriate safeguards for governments and the broad community.

Holland has been raised in this context as an example on a number of occasions by the GAC. However, while not appearing on the ISO 3166-1 list, Holland appears to be protected, as it the Danish translation of 'the Netherlands'.

Language has been added to the Guidebook indicating that governments may send notifications regarding national laws directly to applicants or via public comment forum (see Applicant Guidebook, Module 1, section 1.1.2.5 <http://www.icann.org/en/topics/new-gtlds/draft-rfp-clean-12nov10-en.pdf>) once the applications are publicly posted. Such notifications are not meant to serve as formal objections or be cause for a modification to an application. It was decided early in the process development that applicants should not be able to amend applications or applied for strings in order to prevent abuses.



## SUMMARY OF ACTIONS TAKEN RESPONDING TO GAC AND PUBLIC COMMENTS

### Use and protection of geographical names

- The inclusion of geographic names, as defined in the Guidebook, was developed in response to GAC principle 2.2.
- The protection of government interests in geographic names is accounted for by the requirement that no application for a geographic name (as defined in the Guidebook) can be approved without documentation of the support or non-objection from the relevant government or public authority.
- Country and territory names, as defined in the Applicant Guidebook, have been excluded from the first application round of the gTLD process based on GAC advice.
- A minimum list of reserved names was added to the Registry Agreement based on GAC principle 2.7 which called for protections at the second level. Similarly, all applicants are required to describe in the application their proposed measures for ensuring the protection of geographic names at the second and other levels in the TLD. This information is posted for public information and comment, in accordance with GAC advice.
- The capacity for an objection to be filed on community grounds, where there is substantial opposition to an application from a community that is targeted by the name also provides an avenue of protection for names of interest to a government which are not defined in the Applicant Guidebook.

**ICANN Board-GAC Consultation:**

- **Objection Procedures, including requirements for governments to pay fees**
- **Procedures for the Review of Sensitive Strings**
- **Early warning to applicants: whether a proposed string would be considered controversial or to raise sensitivities (including geographical names)**

**EXPLANATION OF ISSUES/HISTORY**

The GNSO and ICANN Board approved policy recommendations for new gTLDs included four major areas where a third party can raise an objection to the creation of a new gTLD. A new gTLD string should: (i) not be confusingly similar to an existing top-level domain or a Reserved Name (Rec. 2); (ii) not infringe the existing legal rights of others (Rec 3); (iii) not be contrary to generally accepted legal norms relating to morality and public order that are recognized under international principles of law (Rec 6); and (iv) be rejected if there is substantial opposition to it from a significant portion of the community to which the string may be explicitly or implicitly targeted (Rec. 20). See [http://gnso.icann.org/issues/new-gtlds/pdp-dec05-fr-part-08aug07.htm#\\_Toc43798015](http://gnso.icann.org/issues/new-gtlds/pdp-dec05-fr-part-08aug07.htm#_Toc43798015).

The GNSO also recommended that “[d]ispute resolution and challenge processes must be established prior to the start of the [new gTLD] process,” and “[e]xternal dispute providers will give decisions on objections.”

In Brussels in June 2010, and then in a letter to ICANN dated 4 August 2010 (<http://www.icann.org/en/correspondence/gac-to-dengate-thrush-04aug10-en.pdf>), the GAC:

[R]ecommends that community-wide discussions be facilitated by ICANN in order to ensure that an effective objections procedure be developed that both recognizes the relevance of national laws and effectively addresses strings that raise national, cultural, geographic, religious and/or linguistic sensitivities or objections that could result in intractable disputes. These objection procedures should apply to all pending and future TLDs.

In response to the GAC’s recommendation, a cross-community working group was formed to deal specifically with Rec 6 objections (“Rec6 CWG”). The Rec6 CWG has since issued recommendations on both Morality & Public Order, and Community based objections.<sup>1</sup>  
(<http://gnso.icann.org/bitcache/27d221c45bd9d8c234246849d716202bacd6f3ee?vid=14699&disposition=attachment&op=download>).

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<sup>1</sup> Suggesting the governments should be able to protect place names, and country, territory or regional language or people descriptions using the community based objection process

2. The GAC suggests that Governments should not have to pay the same costs as others to file an objection. See Letter from GAC to ICANN, dated 23 September 2010 at <http://www.icann.org/en/correspondence/dryden-to-dengate-thrush-23sep10-en.pdf>. The GAC points to the fact that it has a Bylaws process whereby it can provide advice to the Board for consideration. See Letter from the GAC to ICANN, dated 18 August 2009 at <http://www.icann.org/en/correspondence/karklins-to-dengate-thrush-18aug09-en.pdf>

Since publication of the last version of the Applicant Guidebook, the Board has considered the Rec6 CWG recommendation that the GAC (and ALAC), as a group, should be able to file some or all objections at no or a reduced cost. Although the Board has not reached a formal decision, there is a sense of the Board that it will agree to allow the GAC (and the ALAC) to file objections as a group on behalf of its members so long as doing so is based on some type of consensus of the group members. Further, the Board also thinks that providing some level of funding for objections filed by the GAC (or the ALAC) as a group is an appropriate change to the process.

3. The GAC states that the current objection procedures do not effectively address strings that raise national, cultural, geographic, religious and/or linguistic sensitivities or objections that could result in intractable disputes. See Letter from GAC to ICANN dated 4 August 2010 at <http://www.icann.org/en/correspondence/gac-to-dengate-thrush-04aug10-en.pdf>

Under the Guidebook, protections for these types of names are provided by a series of objections and processes: the requirement for government approval of certain geographical names, Community-based objections (Rec 20), and Limited Public Interest (or Morality & Public Order Rec 6) objections. The last provides that a string will be excluded if there is a determination that an applied-for gTLD string would be contrary to specific principles of international law as reflected in relevant international instruments of law. See Applicant Guidebook, Module 3, section 3.3.4 at <http://www.icann.org/en/topics/new-gtlds/draft-dispute-resolution-procedures-clean-12nov10-en.pdf>. It is recognized that principles from international treaties are incorporated into national laws in a range of different ways, and a panel would need to consider the relevant text in national laws.

4. The GAC suggests that the objection procedures should apply to all pending and future TLDs. See Letter from GAC to ICANN dated 4 August 2010 at <http://www.icann.org/en/correspondence/gac-to-dengate-thrush-04aug10-en.pdf>. ICANN has been asked to note that both the UK and New Zealand take the position that the objection procedures should apply only to new gTLDs.

The Guidebook, and all of the procedures developed for processing applications for and objections to new gTLDs, apply only to new gTLDs and not to existing TLDs or other TLDs (e.g IDN-ccTLDs) that will not be evaluated under the New gTLD Program.

From: On Behalf Of Peter Dengate Thrush  
Sent: Saturday, March 05, 2011 12:50 PM  
To: Heather Dryden  
Cc: ICANN Board of Directors  
Subject: [icann-board] Documenting the Board/GAC Brussels consultation

Dear Heather,

On behalf of the Board of Directors of ICANN, I would like to formally thank the ICANN's Governmental Advisory Committee for participating in the first intersessional Board/GAC meetings, held in Brussels on 28 February and 1 March 2011, regarding ICANN's proposed implementation of the new gTLD program.

We appreciate the preparatory work and time commitment of the GAC Members in participating in these discussions. We also look forward to continuing to work with you on the best ways to evaluate and implement changes to the program resulting from your advice, in the consultation scheduled to be held at the Silicon Valley ICANN Meetings to be held in San Francisco later this month. We are still holding the 17 March consultation slot open and look forward to adding the other day to these consultations following on from your recent offer to be available for this additional time.

The Board looks forward to continuing to collaborate with the GAC in order to conclude the consultation process on the new gTLD program during the Silicon Valley/San Francisco Meeting.

The Board has made a good faith effort toward narrowing the outstanding issues as evidenced by the production of Board Papers, and the subsequent use of the GAC scorecard to frame and shape the issues. The clarity gained during these efforts has significantly reduced the amount of work that needs to be done in order to reach agreement on most issues.

We have included the ICANN Board's response to the GAC scorecard entitled 'Board Notes GAC Actionable Scorecard, attached. We have provided this response, to set out information regarding the Board's evaluation of the GAC advice, which has been summarized within your scorecard. We look forward to discussing this with you further as part of the evaluation. The issues that you have raised are responded to point-by-point.

While discussion in Brussels confirmed that we would work together to clarify implementation of the issues marked as "1(b)", a narrowed focus in San Francisco on the issues that are still in contention would be a best use of the Board and GAC's time during the two days of consultations, and should represent the final stages in our required consultation. Accordingly, we propose focusing there on those items marked with a "2", in the Board's response to the Scorecard attached. Those items marked 1(b) might result in follow on discussions with the GAC regarding implementation in the time leading up to the launch of the program, but do not appear that they will require the same consultation that we have triggered on the "2"'s since we are not in fundamental disagreement on those items categorized as 1(b)'s.

## ICANN Board Notes on the GAC New gTLDs Scorecard

4 March 2011

This document contains the ICANN Board's notes on the "GAC indicative scorecard on new gTLD outstanding issues" of 23 February 2011. Each GAC scorecard item is noted with a "1A", "1B", or "2":

- "1A" indicates that the Board's position is consistent with GAC advice as described in the Scorecard.
- "1B" indicates that the Board's position is consistent with GAC advice as described in the Scorecard in principle, with some revisions to be made.
- "2" indicates that the Board's current position is not consistent with GAC advice as described in the Scorecard, and further discussion with the GAC in San Francisco is required.

Item #	GAC Scorecard Actionable Item	Position	Notes
<b>1.</b>	<b>The objection procedures including the requirements for governments to pay fees</b>		
1.	Delete the procedures related to "Limited Public Interest Objections" in Module 3.	<b>1B</b>	The GAC indicated in Brussels that its concern relates to requiring governments to use this objection process. The Board and GAC therefore agreed that it would be consistent with GAC advice to leave the provision for Limited Public Interest Objections in the Guidebook for general purposes, but the GAC (as a whole) would not be obligated to use the objection process in order to give advice.
<b>2.</b>	<b>Procedures for the review of sensitive strings</b>		
2.1.1	<b>1. String Evaluation and Objections</b>	<b>1B</b>	A procedure for GAC review will be

ICANN Board Notes on the GAC New gTLDs Scorecard

			be appropriate to implement a particular action based on one such decision.
<b>8.</b>	<b>Use of geographic names:</b>		
8.1.1.1	<b>1. Definition of geographic names</b> Implement a free of charge objection mechanism would allow governments to protect their interest	<b>1B</b>	ICANN will investigate a mechanism for the forthcoming round under which GAC members could be exempted from paying fees for objections in some circumstances (subject to constraints imposed by budget and other considerations).
8.1.1.2	and to define names that are to be considered geographic names.	<b>2</b>	The process relies on pre-existing lists of geographic names for determining which strings require the support or non-objection of a government. Governments and other representatives of communities will continue to be able to utilize the community objection process to address attempted misappropriation of community labels. ICANN will continue to explore the possibility of pre-identifying using additional authoritative lists of geographic identifiers that are published by recognized global organizations.
8.1.2	This implies that ICANN will exclude an	<b>1B</b>	ICANN will continue to rely on pre-

## ICANN Board Notes on the GAC New gTLDs Scorecard

	<p>applied for string from entering the new gTLD process when the government formally states that this string is considered to be a name for which this country is commonly known as.</p>		<p>existing lists of geographic names for determining which strings require the support or non-objection of a government. This is in the interest of providing a transparent and predictable process for all parties. (See related note above.)</p>
<p>8.1.3</p>	<p>Review the proposal in the DAG in order to ensure that this potential [city name applicants avoiding government support requirement by stating that use is for non-community purposes] does not arise. Provide further explanations on statements that applicants are required to provide a description/purpose for the TLD, and to adhere to the terms and condition of submitting an application including confirming that all statements and representations contained in the application are true and accurate.</p>	<p><b>2</b></p>	<p>There are post-delegation mechanisms to address this situation. In addition, the "early warning" opportunity will offer an additional means to indicate community objections.</p>
<p>8.1.4</p>	<p>Governments should not be required to pay a fee for raising objections to new gTLD applications. Implement a free objection mechanism would allow governments to protect their interest.</p>	<p><b>1B</b></p>	<p>ICANN will investigate a mechanism for the forthcoming round under which GAC members could be exempted from paying fees for objections in some circumstances (subject to constraints imposed by budget and other</p>

## **APPENDIX E**



Coordinates: 23°35′29″S 46°36′28″W﻿ / ﻿23.59139°S 46.60778°W﻿ / -23.59139; -46.60778

# Ipiranga (district of São Paulo)

From Wikipedia, the free encyclopedia

(Redirected from Ipiranga)

**Ipiranga** (Portuguese pronunciation: [ipiˈɾɐ̃ŋa], from the Tupi (*y*, river; *pirang*, vermelho) for "red river") is an historical district located in the subprefecture of the same name of São Paulo, Brazil.<sup>[1]</sup> The name Ipiranga comes from the river (which now is a brook) of the same name located in the region, which means "red river" in a Tupí–Guaraní language. The Independence Park (Parque da Independência), where supposedly the Emperor Pedro I of Brazil proclaimed the independence of Brazil, the Paulista Museum, which exhibits classic architecture and a collection of Brazilian colonial artifacts, and the Zoology Museum, are also located in Ipiranga.

The Ipiranga Brook is perhaps one of the most famous Brazilian brooks, because it is mentioned in the very first line of the Brazilian National Anthem.

The region near the Tamanduateí River had industrial characteristics, to the point where buses and trams heading there had the destination labeled "Factory". The area next to Nazaré Avenue, in contrast, is filled with mansions of wealthy families and an amount of colleges, like Unesp and São Camilo, and workers of the factories houses.

The commercial center of Ipiranga concentrates on Silva Bueno Street. There are banks, clothes stores and grocery stores like the famous Chocolândia.

## References

- ↑ Subprefecture of Ipiranga (http://www.prefeitura.sp.gov.br/cidade/secretarias/subprefeituras/ipiranga/)

Retrieved from "http://en.wikipedia.org

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<div><div><div><div><span></span><div><div><span><span></span></span></div><div><div>Paulista Museum, in Ipiranga district, crowded in the celebration of the Brazilian Independence Day.</div></div></div></div><div></div></div></div></div>	
<b>Country</b>	Brazil
<b>State</b>	São Paulo
<b>City</b>	São Paulo
<b>Government</b>	
• <b>Type</b>	Subprefecture
• <b>Subprefect</b>	Danilo Antão Fernandes
<b>Population</b> (2000)	

<b>• Total</b>	98.863
<b>HDI</b>	0.883 –high
<b>Website</b>	Subprefecture of Ipiranga ( <a href="http://www.prefeitura.sp.gov.br/cidade/secretarias/subprefeituras/ipiranga/">http://www.prefeitura.sp.gov.br/cidade/secretarias/subprefeituras/ipiranga/</a> )

/w/index.php?title=Ipiranga\_(district\_of\_São\_Paulo)&oldid=546553591"

Categories: Districts of São Paulo

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# Ipiranga Brook


From Wikipedia, the free encyclopedia

The **Ipiranga Brook** is a river of São Paulo state in southeastern Brazil, historically known as the place where Dom Pedro I declared the independence of Brazil from the United Kingdom of Portugal, Brazil and the Algarves.

Its name derives from the Tupi words: "Y", which means water or river, and "Piranga", which means red. It is also mentioned in the country's national anthem.

## Contents

- 1 Declaration of Independence
- 2 See also
- 3 References
- 4 External links

<b>Ipiranga Brook</b>	
	
<b>Origin</b>	São Paulo state
<b>Basin countries</b>	Brazil

## Declaration of Independence

On September 2, 1822, a decree with Lisbon's demands arrived in Rio de Janeiro, while Prince Pedro was in São Paulo. Princess Maria Leopoldina, acting as Princess Regent, met with the Council of Ministers and decided to send her husband a letter advising him to proclaim Brazil's independence. The letter reached Prince Pedro on September 7, 1822. That same day, in a famous scene at the shore of the Ipiranga Brook, he declared the country's independence, ending 322 years of colonial dominance of Portugal over Brazil.<sup>[1]</sup> According to journalist Laurentino Gomes, who wrote a book about the event, *1822*, Prince Pedro "could not wait for his arrival to São Paulo to announce the decision";<sup>[2]</sup> Pedro "was a reckless man in his decisions but he had the profile of leader that Brazil needed at the time, because there was no time to think".<sup>[2]</sup>



Prince Pedro declares the Independence of Brazil on September 7, 1822.

"Independência ou morte" (Independence or death) (1888), oil on canvas painting by Pedro Américo.

## See also

- List of rivers of São Paulo
- Independence Day (Brazil)
- *1822* (book by Laurentino Gomes)

## References

- ↑ **(Portuguese)** Sete de Setembro ([http://www.multirio.rj.gov.br/historia/modulo02/sete\\_setembro.html](http://www.multirio.rj.gov.br/historia/modulo02/sete_setembro.html)) Prefeitura do Rio de Janeiro. Retrieved on 2009-07-05.
- ↑ <sup>*a*</sup> <sup>*b*</sup> Brasil, Ubiratan. "O impetuoso que o país precisava" ([http://www.estadao.com.br/estadaodehoje/20100905/not\\_imp605427,0.php](http://www.estadao.com.br/estadaodehoje/20100905/not_imp605427,0.php)). *O Estado de S. Paulo*. September 5, 2010.

## External links

- Brazilian Ministry of Transport ([http://www.zonu.com/imapa/americas/md\\_SaoPaolo\\_brazil.pdf](http://www.zonu.com/imapa/americas/md_SaoPaolo_brazil.pdf))

Retrieved from "[http://en.wikipedia.org/w/index.php?title=Ipiranga\\_Brook&oldid=564429723](http://en.wikipedia.org/w/index.php?title=Ipiranga_Brook&oldid=564429723)"

Categories: Rivers of São Paulo (state) | São Paulo (state) geography stubs

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# Brazilian National Anthem

From Wikipedia, the free encyclopedia

The **Brazilian national anthem** (Portuguese: *Hino Nacional Brasileiro*) was composed by Francisco Manuel da Silva in 1831 and had been given at least two sets of unofficial lyrics before a 1922 decree by President Epitácio Pessoa gave the anthem its definitive, official lyrics, by Joaquim Osório Duque-Estrada, after several changes were made to his proposal, written in 1909.

The anthem's lyrics have been described as Parnassian in style and Romantic in content.<sup>[1]</sup>

## Contents

- 1 History
- 2 Lyrics
- 3 Tupi lyrics
- 4 Footnotes
- 5 See also
- 6 External links

## History

The melody of the Brazilian national anthem was composed by Francisco Manuel da Silva and was presented to the public for the first time in April 1831.<sup>[2]</sup> On 7 April 1831, the first Brazilian Emperor, Pedro I, abdicated the Crown and days later left for Europe, leaving behind the then-five-year-old Emperor Pedro II.

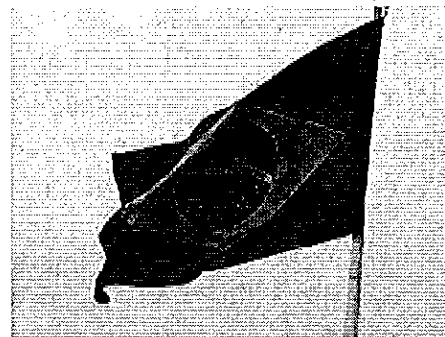
From the proclamation of the independence of Brazil in 1822 until the 1831 abdication, an anthem that had been composed by Pedro I himself, celebrating the country's independence (and that now continues to be an official patriotic song, the *Independence Anthem*), was used as the National Anthem. In the immediate aftermath of the abdication of Pedro I, the Anthem composed by him fell in popularity.

Francisco Manuel da Silva then seized this opportunity to present his composition, and the Anthem written by him was played in public for the first time on April 13, 1831.<sup>[3]</sup> On that same day, the ship carrying the former Emperor left the port of Rio de Janeiro. The date of April 13 now appears in official calendars as the *Day of the Brazilian National Anthem*.

As to the actual date of composition of the music presented in April 1831, there is controversy among historians. Some hold that Francisco Manuel da Silva composed the music in the last four months of 1822

## Hino Nacional Brasileiro

*English: Brazilian National Anthem*



National anthem of



Brazil

**Lyrics** Osório Duque-Estrada, 1909

**Music** Francisco Manuel da Silva, 1831

**Adopted** 1831 during the Empire of Brazil and 1890 in the Federative Republic of Brazil (then named *Republic of the United States of Brazil*).

### Music sample

Hino Nacional Brasileiro (Instrumental)

0:00

to commemorate Brazil's independence (declared on 7 September 1822), others hold that the hymn was written in early 1823 and others consider the evidence of composition dating back to 1822 or 1823 unreliable, and hold that the Anthem presented on 13 April 1831 was written in 1831, and not before.<sup>[4]</sup> In any event, the Anthem remained in obscurity until it was played in public on 13 April 1831. In style, the music resembles early Romantic Italian music such as that of Gioachino Rossini.

Initially, the music composed by Francisco Manuel da Silva was given lyrics by Appeals Judge Ovídio Saraiva de Carvalho e Silva not as a National Anthem, but as a hymn commemorating the abdication of Pedro I and the accession of Pedro II to the Throne. It was known during this early period as "April 7 Hymn".<sup>[5]</sup> The lyrics by Ovídio Saraiva soon fell out of use, given that they were considered poor, and even offensive towards the Portuguese. The music, however, continued enjoying sustained popularity, and by 1837 it was played, without lyrics, in all public ceremonies.<sup>[6]</sup>

Although no statute was passed during the imperial period to declare Francisco Manuel da Silva's musical composition as the National Anthem, no formal enactment was considered necessary for the adoption of a National Anthem. A National Anthem was seen as resulting from praxis or tradition. Thus, by 1837, when it was played in all official solemnities, Francisco Manuel da Silva's composition was already the Brazilian National Anthem.

A new set of lyrics was proposed in 1841, to commemorate the coming of age and Coronation of Emperor Pedro II; those lyrics, popular but also considered poor, were soon abandoned too, this time by order of Emperor Pedro II, who specified that in public ceremonies the Anthem should be played with no lyrics. Emperor Pedro II directed that Francisco Manuel da Silva's composition, as the National Anthem of the Empire of Brazil, should be played, without lyrics, on all occasions when the monarch presented himself in public, and in solemnities of military or civilian nature; the composition was also played abroad in diplomatic events relating to Brazil or when the Brazilian Emperor was present.<sup>[7]</sup>

During the Empire of Brazil era, the American composer and pianist Louis Moreau Gottschalk, then residing in Rio de Janeiro, Brazil, composed two nationalistic works of classical music based on the Brazilian National Anthem that achieved great popularity during the imperial period: the *Brazilian Solemn March* ("Marcha Solene Brasileira", in the modern Portuguese spelling or "Marcha Solemne Brasileira", in the original spelling in force at the time of composition<sup>[8]</sup>) and the *Great Triumphant Fantasy on the Brazilian National Anthem* ("Grande Fantasia Triunfal sobre o Hino Nacional Brasileiro"). The former was dedicated to Emperor Pedro II, and the latter was dedicated to his heiress presumptive, the Princess Imperial Isabel, comtesse d'Eu. Those works are in the vein of similar compositions written at the time in other Nations, such as Charles Gounod's *Fantasy on the Russian National Anthem*. The *Grand Triumphant Fantasy*, long forgotten, resurfaced in popularity in 1985, at the dawn of Brazil's *New Republic*, during the country's re-democratization process, when it was played to accompany the funeral cortège of President Tancredo Neves.

After the Proclamation of the Republic in 1889, the new rulers made a competition in order to choose a new anthem, and the competition was won by Leopoldo Miguez. After protests against the adoption of the proposed new anthem, however, the Head of the Provisional Government, Deodoro da Fonseca, formalized Francisco Manuel da Silva's composition as the National Anthem, while Miguez's composition was deemed the Anthem of the Proclamation of the Republic. Deodoro himself was said to prefer the old anthem to the new composition that became the Anthem of the Proclamation of the Republic. The Decree of the Provisional Government (Decree 171 of 1890) confirming Francisco Manuel da Silva's music, that had served as the National Anthem of the Empire of Brazil, as the National Anthem of the new Republic, was

issued on 20 January 1890.

In the early days of the new Federal Republic, the National Anthem continued without official lyrics, but several lyrics were proposed, and some were even adopted by different states of Brazil. The lack of uniform, official lyrics would only be terminated in 1922, during the celebrations of the first centennial of the Proclamation of Independence, when an adapted version of Joaquim Osório Duque Estrada's lyrics, first proposed in 1909, were deemed official.

The official lyrics of the Brazilian National Anthem were proclaimed by decree of President Epitácio Pessoa (Decree 15.761 of 1922), issued on 6 September 1922, at the height of the celebrations of the Independence Centennial. This presidential decree was issued in execution of a legislative decree adopted by Congress on 21 August 1922.

The National Anthem is considered by the current Constitution of Brazil, adopted in 1988, one of the four national symbols of the country, along with the Flag, the Coat of Arms and the National Seal. The legal norms currently in force concerning the National Anthem are contained in a statute passed in 1971 (Law 5.700 of 1 September 1971), regulating the national symbols.

The music of the National Anthem was originally intended to be played by symphonic orchestras; for the playing of the National Anthem by bands, the march composed by Antão Fernandes is included in the instrumentation. This adaptation, long in use, was made official by the 1971 statute regulating national symbols. This same statute also confirmed as official the traditional vocal adaptation of the lyrics of the National Anthem, in F major, composed by Alberto Nepomuceno.

## Lyrics

The song consists of two consecutive stanzas. The adoption in 1922 of lyrics containing two stanzas thus created the present situation of the music of the anthem being played twice so as to allow for the singing of both stanzas.

Brazilian law stipulates that the music needs to be played only once in instrumental renditions of the anthem without vocal accompaniment (thus, in instrumental renditions without vocal accompaniment, the playing of the music twice is optional), but both stanzas must be sung in vocal performances.

The second stanza is often dropped when played at sporting events, but most renditions of the Brazilian National Anthem for sporting events are instrumental and not vocal.

In the lyrics, the opening line's mention of the Ipiranga river refers to the stream near (and now part of) the city of São Paulo where Prince Dom Pedro, the future Emperor Dom Pedro I of Brazil, declared Brazilian independence from Portugal.<sup>[9]</sup>

### Portuguese lyrics

### English translation

#### First stanza

Ouviram do Ipiranga as margens plácidas

The placid shores of Ipiranga heard

De um povo heroico o brado retumbante,  
E o sol da Liberdade, em raios fúlgidos,  
Brilhou no céu da Pátria nesse instante.

Se o penhor dessa igualdade  
Conseguimos conquistar com braço forte,  
Em teu seio, ó Liberdade,  
Desafia o nosso peito a própria morte!

Ó Pátria amada,  
Idolatrada,  
Salve! Salve!

Brasil, um sonho intenso, um raio vívido,  
De amor e de esperança à terra desce,  
Se em teu formoso céu, risonho e límpido,  
A imagem do Cruzeiro resplandece.

Gigante pela própria natureza,  
És belo, és forte, impávido colosso,  
E o teu futuro espelha essa grandeza.

Terra adorada  
Entre outras mil  
És tu, Brasil,  
Ó Pátria amada!

Dos filhos deste solo  
És mãe gentil,  
Pátria amada,  
Brasil!

the resounding cry of a heroic people  
and in shining rays, the sun of liberty  
shone in our homeland's skies at this very moment.

If the assurance of this equality  
we achieved by our mighty arms,  
in thy bosom, O freedom,  
our chest shall defy death itself!

O beloved,  
idolized homeland,  
Hail, hail!

Brazil, an intense dream, a vivid ray  
of love and hope descends to earth  
if in thy lovely, smiling and clear skies  
the image of the (Southern) Cross  
shines resplendently.

Giant by thine own nature,  
thou art beautiful, thou art strong, an intrepid colossus,  
and thy future mirrors thy greatness.

Beloved Land  
amongst a thousand others  
art thou, Brazil,  
O beloved homeland!

To the children of this land  
thou art a gentle mother,  
beloved homeland,  
Brazil!

### Second stanza

Deitado eternamente em berço esplêndido,  
Ao som do mar e à luz do céu profundo,  
Fulguras, ó Brasil, florão da América,  
Iluminado ao sol do Novo Mundo!

Do que a terra mais garrida  
Teus risonhos, lindos campos têm mais flores,  
"Nossos bosques têm mais vida",  
"Nossa vida" no teu seio "mais amores". (\*)

Eternally laid on a splendid cradle,  
by the sound of the sea and the light of the deep sky,  
thou shinest, O Brazil, finial of America,  
illuminated by the sun of the New World!

Than the most elegant land abroad,  
thy smiling, pretty prairies have more flowers  
"Our meadows have more life",  
"our life" in thy bosom "more love". (\*)



Ó Pátria amada,  
Idolatrada,  
Salve! Salve!

Brasil, de amor eterno seja símbolo  
O lábaro que ostentas estrelado,  
E diga o verde-louro dessa flâmula  
- Paz no futuro e glória no passado.

Mas se ergues da justiça a clava forte,  
Verás que um filho teu não foge à luta,  
Nem teme, quem te adora, a própria morte.

Terra adorada  
Entre outras mil  
És tu, Brasil,  
Ó Pátria amada!

Dos filhos deste solo  
És mãe gentil,  
Pátria amada,  
Brasil!

O beloved,  
idolized homeland,  
Hail, hail!

Brazil, of eternal love be the symbol  
the starred banner thou showest forth  
and proclaim the laurel-green of thy pennant  
'Peace in the future and glory in the past.'

But if thou raisest the strong gavel of Justice,  
thou wilt see that a son of thine flees not from battle,  
nor does he who loves thee fear his very own death.

Beloved Land,  
amongst a thousand others  
art thou, Brazil,  
O beloved homeland!

To the children of this land  
thou art a gentle mother,  
beloved homeland,  
Brazil!

(\*) The passages in quotation marks were extracted from Gonçalves Dias' poem "Canção do exílio".

## Tupi lyrics

These are unofficial Tupi language.

First stanza: Embeyba Ypiranga sui, pitúua, Ocendu kirimbaúa sacemossú Cuaracy picirungára, cendyua, Retama yuakaupé, berabussú.

Cepy quá iauessáua sui ramé, Itayiuá irumo, iraporepy, Mumutara sáua, ne pyá upé, I manossáua oiko iané cepy.

Iassalssú ndê, Oh moetéua Auê, Auê !

Brasil ker pi upé, cuaracyáua, Caissú í saarússáua sui ouié, Marecê, ne yuakaupé, poranga. Ocenipuca Curussa iepé !

Turussú reikô, ara rupí, teen, Ndê poranga, i santáua, ticikiyé Ndê cury quá mbaé-ussú omeen.

Yby moetéua, Ndê remundú, Reikô Brasil, Ndê, iyaissú!

Mira quá yuy sui sy catú, Ndê, ixaissú, Brasil!

Second stanza: Ienotyua catú pupé reicô, Memê, paráteapú, quá ara upé, Ndê recendy, potyr America sui. I

Cuaracy omucendy iané !

Inti orecó purangáua pyrê Ndê nhu sorryssára omeen potyra pyrê, ìCicuê pyrê orecó iané caaussú. Iané cicuê, indê pyá upé, saissú pyrêí.

Iassalsú ndê, Oh moetéua Auê, Auê !

Brasil, ndê pana iacy-tatá-uára Toicô rangáua quá caissú retê, I quá-pana iakyrá-tauá tonhee Cuire catuana, ieorobiára kucê.

Supí tacape repuama remé Ne mira apgáua omaramunhã, Iamoetê ndê, inti iacekyé.

Yby moetéua, Ndê remundú, Reicô Brasil, Ndê, iyaissú !

Mira quá yuy sui sy catú, Ndê, ixaissú, Brasil!

## Footnotes

- <sup>^</sup> Você entende o Hino Nacional Brasileiro? (<http://www.soportugues.com.br/secoes/curiosidades/hino.php>) - Só Português (in Portuguese)
- <sup>^</sup> <http://www.clerioborges.com.br/hinonacional.html#0002>
- <sup>^</sup> <http://www.clerioborges.com.br/hinonacional.html#0002>
- <sup>^</sup> [http://www.miniweb.com.br/cidadania/hinos/historia/hist\\_hino\\_nacional.html](http://www.miniweb.com.br/cidadania/hinos/historia/hist_hino_nacional.html)
- <sup>^</sup> <http://www.clerioborges.com.br/hinonacional.html>
- <sup>^</sup> <http://www.clerioborges.com.br/hinonacional.html>
- <sup>^</sup> <http://www.clerioborges.com.br/hinonacional.html>
- <sup>^</sup> Because the spelling of Brazil with a "z" became obsolete in the Old Republic due to changes in the orthography of the Portuguese language, and the country's name has since then been spelled with an "s" in Portuguese - Brasil - sometimes the title of that composition is rendered as "Marcha Solemne Brasileira", the adjective "Solemne" retaining the 19th century spelling, while the adjective "Brasileira" is rendered in the modern spelling to avoid writing the country's name with a "z".
- <sup>^</sup> <http://nationalanthems.me/brazil-hino-nacional-brasileiro/>

## See also

- Brazilian Flag Anthem (Hino à Bandeira)
- Brazilian Anthem of Independence (Hino da Independência)
- Brazilian Republic Anthem (Portuguese: Hino da Proclamação da República)

## External links

- Brazil: *Hino Nacional Brasileiro* - Audio of the national anthem of Brazil, with information and lyrics (<http://nationalanthems.me/brazil-hino-nacional-brasileiro/>)
- Free sheet music ([http://cantorion.org/pieces/1600/Brazilian\\_National\\_Anthem\\_\(Hino\\_Nacional\\_Brasileiro\)](http://cantorion.org/pieces/1600/Brazilian_National_Anthem_(Hino_Nacional_Brasileiro))) of the Brazilian National Anthem from *Cantorion.org*
- Other patriotic songs - Brazilian Government portal website (<http://www.brasil.gov.br/sobre/o-brasil/estado-brasileiro/simbolos-e-hinos>)

Retrieved from "[http://en.wikipedia.org/w/index.php?title=Brazilian\\_National\\_Anthem&oldid=562401608](http://en.wikipedia.org/w/index.php?title=Brazilian_National_Anthem&oldid=562401608)"

Categories: [National anthems](#) | [National symbols of Brazil](#) | [Portuguese-language songs](#)  
| [Brazilian patriotic songs](#)

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## **APPENDIX F**



## NEW GTLD CURRENT APPLICATION STATUS

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### FILTER RESULTS

[Apply Filters](#)

### QUICK SEARCH

[IE Result - Pass](#)

[Reset All](#)

Prioritization Number	String [1]	Applicant	Location [2]
▶ 1357	IPIRANGA	Ipiranga Produtos de Petroleo S.A.	BR

Displaying 1 - 1 of 1

#### Notes:

1. **String [1]:** ASCII or Unicode for IDN strings
2. **Location [2]:** Indicated by applicant as principal place of business. Two-letter country code is based on ISO 3166-1 code lists. See [http://www.iso.org/iso/country\\_codes/iso\\_3166\\_code\\_lists/country\\_names\\_and\\_code\\_elements.htm](http://www.iso.org/iso/country_codes/iso_3166_code_lists/country_names_and_code_elements.htm)
3. **Community:** Based on applicant's answer to question 19
4. **Geographic:** Based on applicant's answer to question 21
5. **Applicant Support:** Three applications have applied for applicant support. See application IDs: 1-1309-46695 (KIDS), 1-1873-71868 (IDN) and 1-2104-81541 (UMMAH)
6. **Format:** In some cases the display of the application data has been adjusted for format consistency
7. The Geographic Names Panel has determined that the string does not fall within the criteria for a geographic name contained in the Applicant Guidebook Section 2.2.1.4.
8. The Geographic Names Panel has determined that the string falls within the criteria for a geographic name contained in the Applicant Guidebook Section 2.2.1.4. The applicant was contacted to provide documentation of support/non-objection per Section 2.2.1.4.3 of the Applicant Guidebook.
9. The String Similarity Panel has determined that this string is visually similar to an existing TLD (.mil), creating a probability of user confusion.
10. Per the 4 June 2013 New gTLD Program Committee (NGPC) approved [resolution](#) to adopt the "NGPC Scorecard of 1As Regarding Non-Safeguard Advice in the GAC Beijing Communiqué."



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Search

### FILTER RESULTS

Application Status

Updates

Objections

Has GAC EW

Contention Sets

PICs

Apply Filters

### QUICK SEARCH

IE Result - Pass

Reset All

There are no applications matching your search/filter criteria.

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3. **Community:** Based on applicant's answer to question 19
4. **Geographic:** Based on applicant's answer to question 21
5. **Applicant Support:** Three applications have applied for applicant support. See application IDs: 1-1309-46895 (KIDS), 1-1873-71868 (IDN) and 1-2104-81541 (UMMAH)
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### FILTER RESULTS

### QUICK SEARCH

[IE Result - Pass](#)

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