INTERNATIONAL LAW ON GEOGRAPHIC NAMES: CONTEXT FOR ICANN POLICY-MAKING

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I QUESTION: DO GOVERNMENTS HAVE SOVEREIGN RIGHTS IN GEOGRAPHIC NAMES?

ANSWER: No. The legal principle of "sovereignty" does not give countries rights in geographic names outside of their own borders.

There is no international law that requires that a country have a name in order to be considered a "country" (or "state", or "sovereign state" – the word "country" will be used here to reflect the use of the word "country" in ICANN policies), and the agreed definitions setting out what is required to be considered a "country" make no mention of having a name. We therefore cannot conclude that countries have sovereign rights in "their" names because having a name is not a requirement of sovereignty.

"Sovereignty" is a principle based in international law, meaning the relationship between countries. It makes sense to ask, therefore, whether countries have a right to select and use a name, and require that others outside of the country use the chosen name. The answer to this question is that

international law does not require that countries select and use a name, but if they do (which, in historical and modern practice normally happens), they are free to use that name (and regulate how it is used or not used), but only within the country's borders. In other words, countries' laws only have effect within a country's borders, so countries cannot dictate how others behave outside of those borders. This is the very heart of the principle of sovereignty. This means that countries can create restrictions, not only on the use of "their" names (meaning country names) but on the use of any other names – including names of geographical places and features – within their borders. Because of the principle of sovereignty, these restrictions would only apply within the country's borders. This means that any national laws restricting the use of geographic names apply *in that country only*; they do not ordinarily apply to others outside of the country.

What happens if a country selects a name (perhaps the country name, or the name of a city or other geographical feature in the country) that another country disapproves of? The principle of sovereignty applies here, too. As a basic rule, Country A cannot interfere with Country B's choice of geographical name, because to do so would violate Country B's sovereignty (in other words, sovereignty gives Country B the right to do whatever it chooses within its borders, and other countries cannot interfere with this). The exception to this basic rule comes into play in the rare case that a country's choice of name threatens another country's sovereignty; there is an example of this in today's international diplomacy, and after more than twenty years of negotiations and discussions, the dispute has yet to be resolved. This problem should only have a very limited effect on the DNS, because it only arises when the choice of a geographic name risks threatening the peace and stability of another country; ICANN should not make any policy on allocating these types of names until this problem is solved in the diplomatic environment. The vast majority of geographic names will not generate disputes involving another country's sovereignty, however. This is obvious from the many cases worldwide of the same or similar geographic name being used in more than one country.

EXAMPLE

The example provided below contemplates a country having law that its country name cannot be registered as a trademark. International law does not require that countries have such law in place. The specific provision of international law that is relevant to this discussion is Article 6*ter* of the Paris Convention for the Protection of Industrial Property, which requires countries to prevent the names and symbols of international intergovernmental organizations (IGOs) from being registered as a trademark. This same article requires countries to prevent certain sovereign symbols of a country – such as flags, official signs and armorial bearings – from being registered as a trademark. Article 6*ter* does not require the same of country names, or indeed other geographic names, as it does of IGO names and the sovereign symbols referred to above. What does this mean? Article 6*ter* does not give governments sovereign rights in geographic names.

EXAMPLE

If Country A has law requiring that the name of Country A and its major geographical locations (states, counties, cantons, regions, cities, rivers, etc.) cannot be registered as a trademark, this law applies only to those in Country A registering trademarks in Country A. The law would not apply to people or companies or governments registering trademarks or conducting other activity in Country B, C, etc.

Equally, if Country A has law requiring that only a government body in Country A can use the name of Country A or a name of its geographical locations (states, counties, cantons, regions, cities, rivers, etc) as a domain name or TLD, this law applies only to domain name registrants or TLD applicants in Country A. The law would not apply to registrants or applicants in Country B, C, etc.

What does this mean for the DNS? The legal principle of sovereignty does not give governments rights to reserve or restrict geographic domain names.

What if Article 6*ter* were amended through the appropriate international legal fora (in this case, the World Intellectual Property Organization, WIPO) to specify that countries must prevent country names from being registered as a trademark? Would this give governments rights to reserve or restrict geographic names in the DNS?

No. Even adding country names to Article 6*ter* would not give governments rights to reserve or restrict geographic names in the DNS, for two reasons. First, the purpose of this provision of international law is not to *grant* or *create* property rights, but rather exactly the opposite – to prevent property rights from being granted or created. Second, adding country names to this provision of international law would have no impact on the DNS, because it would only prevent *country names from being registered as a trademark*. Just because a name is not a registered trademark does not mean that it cannot be registered as a domain name. There are many, many examples in all TLDs of domain names that do not comprise a registered trademark.

II QUESTION: DO OTHERS HAVE RIGHTS IN GEOGRAPHIC NAMES?

ANSWER: Yes. International law requires that all countries' laws permit registration of trademarks satisfying the requirements of trademark registrability; some countries' national laws prohibit

certain geographic names from being registered as a trademark even if the general requirements of trademark registrability are satisfied. Some countries' national laws protect geographical indications (names of products that originate from and have connection to a geographic place), allowing parties other than governments to possess legal rights in geographic names.

A *Trademarks*

International law requires that all countries' laws permit the registration of signs as a trademark if the sign satisfies the basic criteria of trademark registrability. International trademark law does not say anything specifically about geographic names: it neither requires countries to permit or prevent them from being registered as trademarks. That said, one of the basic criteria of trademark registrability makes it challenging for geographic names to become registered trademarks. This criterion is referred to in international law as "distinctiveness". A mark is "distinctive" when the consumer recognizes the mark as linking particular goods or services to the particular trader responsible for putting them on the market. The clearest way to achieve this is by inventing a brand new word or symbol; consumers have no pre-existing understanding of this word or symbol, so it can only bring to mind the particular trader and their goods or services.

Geographic marks, by contrast, are not newly invented by the trademark applicant. They already have a meaning to consumers: they identify a particular geographic location. As a result, historically, geographic names were unable to be registered as trademarks because it was believed that the consumer could never overcome their existing mental connection between the name and the geographic place. Such names, it was thought, could never come to signify the relationship between a particular trader and the particular goods or services of that trader. In 1967, the relevant international convention (the Paris Convention) was amended to recognize that the modern consumer is much smarter than the law originally supposed, and that even existing names, words and symbols with existing meanings could, over time and with use and exposure, come to have another meaning (what the law refers to as "secondary meaning") in consumers' minds. From that point onwards, geographic names were no longer inherently unregistrable. While consumers in faraway markets may be entirely unaware of the name's geographic connotation and so only recognise the "secondary" or brand meaning, in a local market, significant effort may be required on the part of the brand owner to develop this "secondary meaning" in local consumers' minds. When the consumer attaches this other meaning to the name, the name is registrable as a trademark.

There are other types of registered trademark that can also potentially assist geographic names. International law requires that countries offer a type of mark called a "collective mark", which is owned not by a single individual but by an association, for use by members of the association. Membership in such an association could, for example, be based on members' geographic location. Many countries also offer a type of mark called a "certification mark", which identifies goods meeting specified, agreed standards or certification criteria. These standards or criteria could, for example, draw on geography (e.g., by requiring that a particular good's production and handling all take place within a clearly defined geographic area).

Although Article 6*ter* of the Paris Convention (which is discussed above in the context of sovereignty) does not *require* countries to prevent businesses, individuals and organizations from registering geographic trademarks, it also does not stop countries from making law to this effect. Some countries therefore have national laws, enforceable only within the country's borders, preventing certain geographic names from being registered as trademarks.

In the many countries in which geographic names not specifically prevented from being registered as trademarks, the registration itself is considered proof of ownership of the mark. In legal terms, trademarks are private property; like other forms of private property, they can be bought, sold, gifted, transferred by will and licensed to others. The registrant is the owner of these rights. Registrants can be people, companies, organizations, and even government bodies.

Trademark rights are a form of monopoly right, but that monopoly is strictly limited. The trademark owner is not the outright "owner" of the protected name, so they cannot prevent any and all uses of the mark by all others. Rather, when marks are registered, the owner specifies those goods and services on which the mark is or will be used. The owner's rights extend only to those goods and services. Thus the owner of a trademark "Captiva" for refrigerators cannot ordinarily prevent others' use of the mark on, for example, event planning services or footwear or bicycles. This is the case irrespective of who (company, individual, government) owns the trademark registration.

What does this mean for the DNS? First, the fact that, in many countries, rights in geographic names are held by someone other than government in the form of a trademark means that governments do not have exclusive rights in geographic names. Thus, governments do not have exclusive rights to restrict or reserve geographic domain names, because trademark law permits others to have rights in those names. Next, trademark law establishes no hierarchy or priority; it merely lets equivalent marks co-exist provided they are used on different products and services in ways that will not mislead or confuse consumers. If a government possesses trademark rights, its rights are not given higher priority or greater importance than other, non-government trademark owners' rights. Governments thus do not have priority rights to geographic domain names merely because they have trademarked those names.

B *Geographical Indications*

International law only specifically mentions geographic names in the special context of geographical origin. Countries are required to stop imports of goods in international trade if those goods falsely represent their origin. Countries are also required to have laws in place that prevent certain (but not all) uses of names "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." This special legal category of names is called a "geographical indication".

The uses of geographical indications that countries must prevent depend on the type of product the indication identifies. For wines and spirits, countries must have in place laws that prevent uses of geographical indications on products other than the wines identified by the indication. This has only

a limited application to the DNS: domain names cannot be used by someone other than the geographical indication holder to offer for sale the named wine or spirit or wines and spirits of that type.

EXAMPLE

All countries must have laws that prevent or terminate the registration of the domain name www.champagne.com, but only if the website operated under that name offers for sale sparkling wines not originating in Champagne, France, or "Champagne-type" sparkling wines.

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Only 28 countries are required to have laws that prevent or terminate the registration of a domain name such as www.champagne.com if the website operated under that name does something other than advertise Champagne for sale, such as providing tourist information about the Champagne region or advertising a business called "Champagne" in another industry:

These same 28 countries' laws must prevent or terminate the registration of a domain name incorporating the indication for products other than wine and spirits, such as www.roquefort.com and www.roquefort.cheese.

Other countries have not agreed to the requirement to have these laws in place.

For all products other than wines and spirits, countries must only have in place laws that prevent falsely representing a product's place of origin or making unfairly competitive use of the name on a product. This has no impact on the DNS, because registering a name as a domain name or TLD is not the same as using the name on products for sale.

Twenty-eight countries around the world have entered into a separate agreement which grants much more protection to these types of names. This agreement grants "absolute rights", meaning that these countries' laws must prevent *any* use or imitation of the name by anyone other than the registered rights holder. All products receive this high level of protection; distinction is made between wine/spirits and other products. Because international law is enforceable only in the countries that have agreed to it, this higher level of protection is available only in the 28 countries that have entered into this separate agreement.

There are many possible uses of these types of names. Consider the name "Graves", which is protected in France (France is one of the 28 countries that has entered into the separate agreement offering higher protection) for wines produced within the department of Gironde. The word "graves" has multiple meanings in various languages: in addition to the name of the French region and wines from that region, the English word "graves" means "burial places", and it is also the name of a

medical condition (Graves' Disease). Graves is a common surname in some countries, and it is the name of a television series, a video game character, and a pop music band.

Many trademarks comprise geographical indications, and may have done so for longstanding historical reasons having nothing to do with the named geographical location or products made there. The website linked to www.madeira.com, for example, is owned and operated by a company in Switzerland that has been producing high quality embroidery threads since 1919. This domain name and the company that has registered it have nothing to do with the Portuguese geographical indication "Madeira", or the product with which the name is associated. Another Portuguese (Portugal is another of the 28 countries that has entered into the separate agreement offering higher protection) indication, "Porto", is registered as a trademark in New Zealand for medical equipment, in Australia and the United States for light fittings and fixtures, and in the European Union for packaging. These are but a few of many examples.

Consumers in some countries can also interpret names differently than consumers in other countries. While consumers in the 28 countries party to the separate agreement understand a name to signify a particular product having a particular origin and characteristics of that origin, consumers in other countries understand the name to refer merely to a type of product. The laws of these other countries do not recognize geographical indications as having any special recognition or status beyond the limited requirements noted earlier.

International law treats geographical indications very differently from the way it treats trademarks. The term "trademark" means the same thing in nearly all countries of the world, and the requirements that must be satisfied in order to register a trademark are standardized. Trademark owners in all countries have the right to prevent uses of their trademark on identical or similar goods and services. These rights are private property rights that are owned by the registrant. By contrast, under international law, countries must only have laws that prevent using the name of wines and spirits on that type of wines and spirits, and laws that prevent false or misleading labelling of other products. There is no internationally mandated register of geographical indications to identify the owner of rights. Some countries offer only the minimum required protection, while others offer much more. Some countries apply a different definition when determining whether a name is protectable. Where there is great variety in the approaches taken around the world, there is no international standard. DNS policy depends on an international standard because it can be equally applied in all jurisdictions. The principle of sovereignty demands that the national laws of one country cannot be imposed on those in other countries; agreements made by some countries cannot be imposed on other countries that have not agreed.

What does this mean for the DNS? The fact that names recognized in some countries as geographical indications may be the subject of trademark rights or may have other meanings to consumers in other countries means that geographical indication producers' rights are not exclusive. The limited rights granted by international law to geographical indication holders establish no hierarchy or priority; further, these rights are only relevant to the DNS when a second-level domain name is used to sell the named wine or spirit, or wines or spirits described as of that "type". Geographical indication producers do not have exclusive or priority rights to

geographic domain names, and thus cannot mandate policy reserving or prioritizing those names in the DNS.

III QUESTION: IS USE OF A GEOGRAPHIC DOMAIN NAME BY SOMEONE OTHER THAN GOVERNMENT INHERENTLY UNFAIRLY COMPETITIVE AGAINST GOVERNMENT?

Answer: No, the law does not permit the conclusion that anyone else's use of a geographic domain name, irrespective of how the name is used, is unfairly competitive against government, simply because the use is by someone other than government.

For this argument to stand, it must be the case that governments are the only ones with rights or legitimate interests in geographic names, and that all uses of a geographic domain name by someone other than a relevant government is unfair or dishonest. There are many UDRP decisions involving geographic names (which, in order to be actionable under the UDRP must be legally recognized as a trademark) in which non-governmental registrants have demonstrated a legitimate right to use the domain name. This can be done by demonstrating, for example, that the domain name is used to express opinions or to provide tourist information.

It is impossible and inaccurate to say, as a general rule in all countries around the world, that any use of a geographic domain name by someone other than government is unfair or dishonest. This is impossible because the standards of what is considered fair or honest practices in one country will very likely differ from the standards of what is considered fair or honest in another country. There is no universal standard of fairness or honesty; these things depend on the commercial and social and cultural conditions of each country. International law recognizes this by ensuring that each country can determine, by its own standards, what is fair and honest in commercial practices. Similarly, it is impossible to say, as a general rule, that any use of a geographic domain name by someone other than government is confusing or likely to confuse internet users. We know this because even trademark law acknowledges that not every use of a trademark by someone other than the trademark owner is inherently confusing or likely to confuse consumers. The law recognizes the potential for shared experience – commercial and non-commercial – and the savvy of today's consumer in recognising that a sign can have more than one meaning.

What does this mean for the DNS? International unfair competition law does not give governments automatic priority rights to geographic domain names, because doing so would require that we crudely assume that all uses – whether commercial or non-commercial – by anyone other than government, are unfairly competitive. This does not mean that principles of fairness and honesty have no relevance to domain names; of course they do, but on a case-by-case basis, not as the basis of a rule the effect of which would be to prohibit any and all non-governmental use of geographic domain names.

IV QUESTION: IN CONCLUSION, WHAT DOES INTERNATIONAL LAW MEAN FOR DNS POLICY-MAKING, AND WHY DOES INTERNATIONAL LAW MATTER AT ALL?

The fundamental points to be extracted from the current position under international law are:

1. International law does not give governments sovereign rights in geographic names. DNS policy cannot prevent domain names merely because a user is not government. This has a significant impact on any requirement for government consent: consent cannot be withheld arbitrarily or for unspecified reasons or simply because the user is not government.
2. Governments do not have exclusive or priority rights in geographic names because international law allows others to acquire legal rights in geographic names, and does not prioritize the interests of multiple rights-holders. DNS policy cannot reserve geographic names exclusively to government or give government automatic priority.
3. Geographical indication holders do not have exclusive or priority rights in geographic names in all countries of the world. DNS policy cannot reserve geographic indication names exclusively to GI holders or give GI holders automatic priority.

In conclusion, there can be:

- No exclusive reservation of geographic domain names or strings to government or GI holders.
- No priority of registration by government or GI holders.
- No refusal merely because a registrant or applicant is not government or a GI holder.

These points must be taken account of in ICANN policy-making, even though ICANN is not itself obliged to conform to international law. International law is made through agreement between countries, and is binding only on agreeing countries. ICANN is not a country. Therefore, international law is not binding on ICANN, and ICANN is not obliged to conform to it. Nevertheless, given the special nature of ICANN and its role in the global DNS, ICANN voluntarily undertakes to ensure that its actions are consistent with international law. It does this through the Articles of Incorporation, which state: "The Corporation shall operate in a manner consistent with these Articles and its Bylaws for the benefit of the Internet community as a whole, carrying out its activities in conformity with relevant principles of international law and international conventions and applicable local law and through open and transparent processes that enable competition and open entry in Internet-related markets. To this effect, the Corporation shall cooperate as appropriate with relevant international organizations."[1] The international legal framework must, therefore, be observed when developing policy on the use of geographic names in the DNS.

[1] ICANN, Amended and Restated Articles of Incorporation of the Internet Corporation for Assigned Names and Numbers, as approved by the ICANN Board on 9 August 2016, and filed with the California Secretary of State on 3 October 2016, https://www.icann.org/resources/pages/governance/articles-en.