

INTERNATIONAL TRADEMARK ASSOCIATION

Joint Statements of Internet and Geographic Indications Committees on Geographic Names in the Domain Name System (DNS)

ICANN Webinar on Geographic Names
Subsequent Procedures Policy Development Working Group
April 25, 2017

International Trademark Association

Statement on Geographic Names in the Domain Name System

The International Trademark Association (INTA) is increasingly concerned about the development of a reserved names list and a government objection mechanism/consent requirement with regard to the use of geographic names at both the top and second levels of the Domain Name System (DNS).

International Trademark Association

Statement on Geographic Names in the Domain Name System

(cont.)

Any objection to the use of a geographic term that is determined to be of either national, cultural, geographic or religious significance to a particular country or region has no legal basis, whether under agreed principles of international law or national sovereignty. The express recognition of private legal ownership rights in trademarks, trade names and geographical indications by sovereign states and by international treaties contradicts any governmental claim to exclusive rights in geographic domain names. No interpretation of the public interest as it relates to ICANN policy justifies disregard for the established international legal framework as it applies to trade marks and geographical indications of origin. In particular, such an approach is inconsistent with the legal obligations of the 176 member states of the Paris Convention under Article 6 quinquies and in this regard would not be upheld by the national courts of those countries.

International Trademark Association

Statement on Geographic Names in the Domain Name System

(cont.)

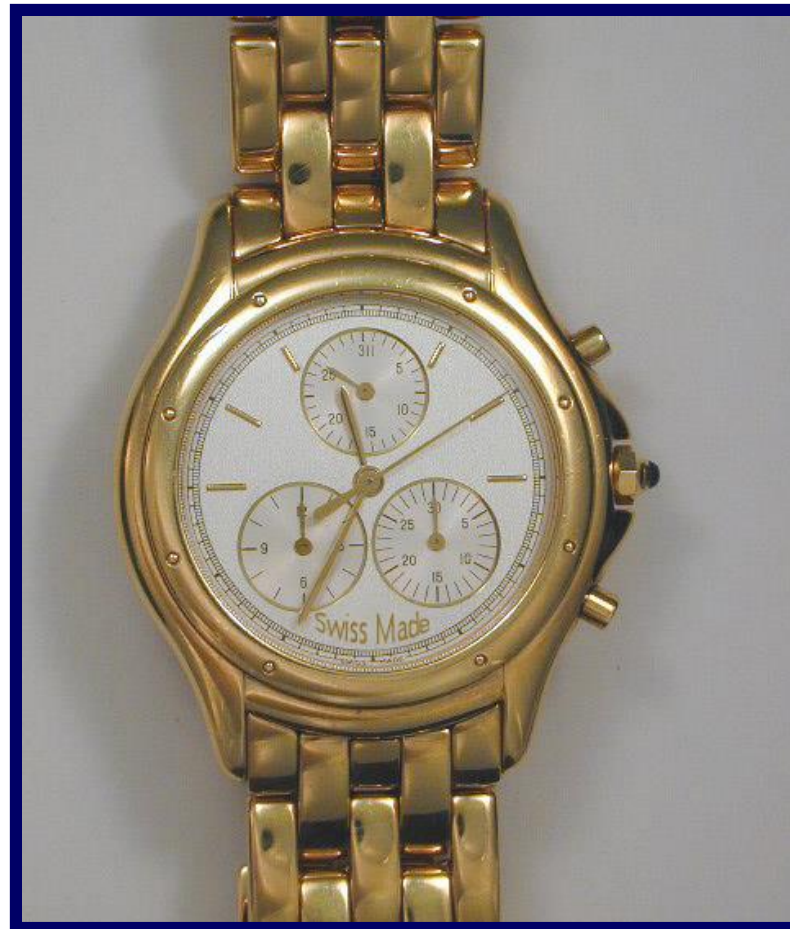
A thorough analysis of international law and legal principles on this issue must be undertaken and must be given proper deference in relation to the proposal from the Governmental Advisory Committee (GAC) Working Group to Examine the Protection of Geographic Names in any Future Expansion of gTLDs for a reserved names list or government objection mechanism/consent requirement.

Protection of Geo-names under International Law

- **Geo-names, names which have some geographical significance, are not protected or protectable per se under international law unless they fit into a specific legal category of protection, e.g., trademark law, geographical indications (GIs) , etc.**
- **Despite assertions of various governmental sources, the mere statement that a term is “owned” by a country or region does not establish legal rights in a geoname.**
- **Determining whether a geo-name is legally protectable or not depends, in part, on how the term is used. The same term can have different functions. A good example is the term SWISS.**

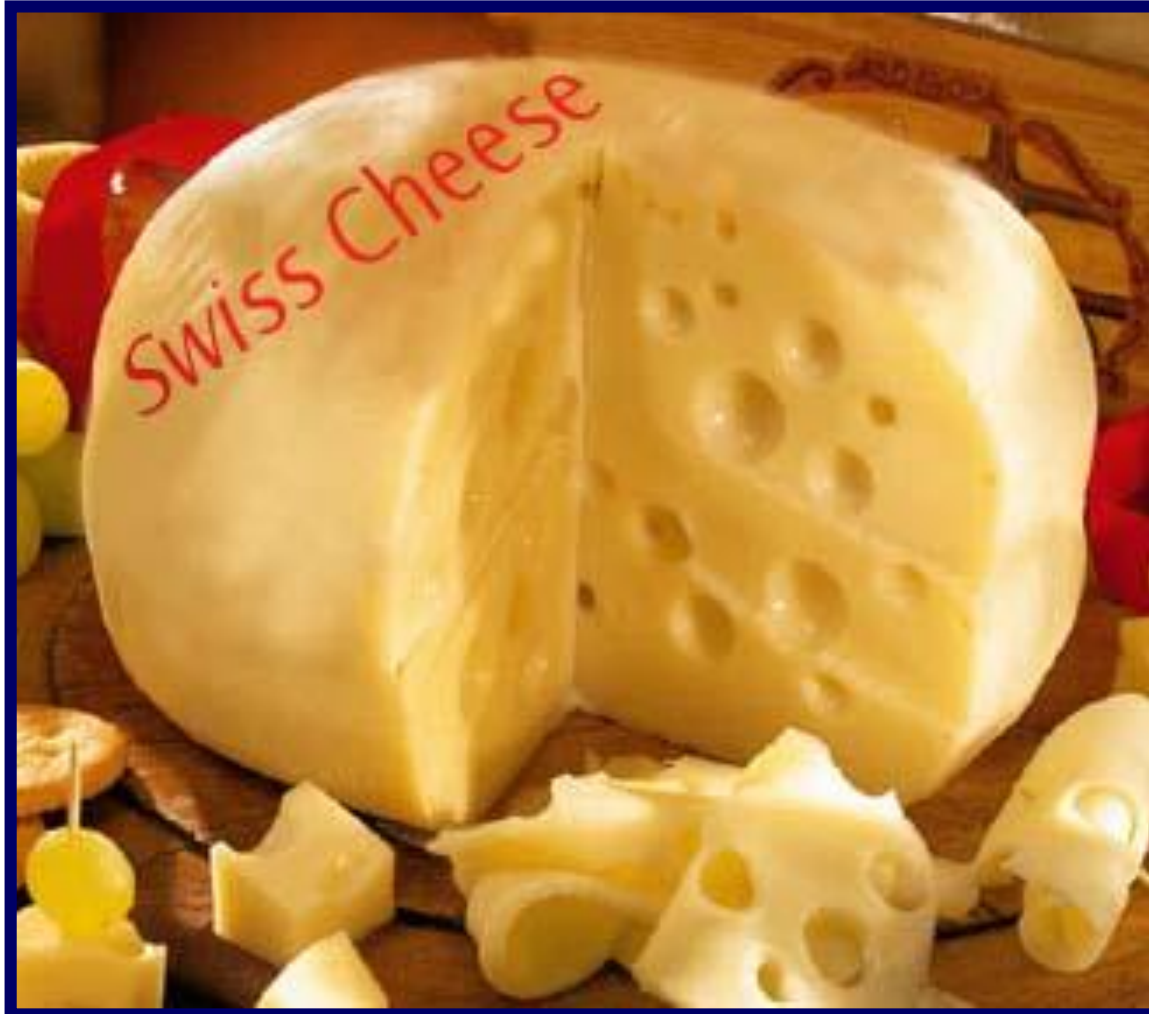
SWISS watches

**(here SWISS is a Geographical Indication “GI”
since it indicates origin in Switzerland)**



SWISS *cheese*

**(here SWISS is Generic for a type of cheese,
although in some countries it is a GI)**



SWISS *airlines*
(here **SWISS** is a Trademark for an airline
company)



Geonames ≠ GIs

- Despite popular belief, geo-names are not GIs. GIs have a very specific meaning in the WTO TRIPS Agreement, namely:

“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.”

TRIPS 22 (emphasis added)

- GIs are a *very small subset* of all geo-names.

How does this relate to domain names?

- In order for a geo-name or even a GI to be included in the TMCH, it must be protected under the legal framework of *trademark law* (as a certification mark or a collective mark) and registered as such.
- In order to object to a proposed geo-name gTLD, therefore, recognizable, verifiable, legal rights should be submitted, as in done with trademarks, such objection not being based on an open ended list of every term which may have a geographical significance with no possibility to verify or challenge such claims. To give geo-names which are not legally protected such rights would create uncertainty and confusion in the domain name space.