

How clashes between trademarks and Terms of Geographical Significance can be avoided

Aims

The aim of this paper is to propose a Strawperson solution to the issue of terms which may have a geographical context at the Top Level for future TLD releases (Subsequent Procedures).

We hope that interested parties will send feedback and will be prepared to use this idea as the starting point for constructive dialogue in Johannesburg.

Background

In April 2017 we, the co-chairs of the New gTLD Subsequent Procedures PDP Working Group, invited interested parties including members of the Government Advisory Committee (GAC) of ICANN to participate in a webinar at which perspectives and possible solutions to the management of geographical terms at the Top Level could be presented.

We received ten presentations from:

- Johanne Asselin/John McElwaine, representing INTA
- Jorge Cancio/Olga Cavalli, GAC representatives of Switzerland and Argentina respectively
- Sebastien Ducos, representing the GeoTLD Group
- Heather Forrest
- Thomas Lowenhaupt
- Paul McGrady
- Flip Petillon, representing MARQUES
- Alexander Schubert
- Martin Sutton, representing the Brand Registry Group
- Peter Van Roste, representing CENTR

Four of the presenters proposed solutions:

1. Jorge Cancio, the GAC representative from Switzerland and Olga Cavalli, the GAC representative from Argentina, proposed the creation of a "Repository of Names of Geographical Significance" (the Repository). They identified this as a proposal which is being discussed within the GAC WG on Geographic Names but which has not been adopted as a formal recommendation by that WG or by the GAC as a whole. The Repository is a database into which Governments could freely place names with

geographic significance, for example the names of places, rivers, mountains, regions, national monuments etc. They propose that all future applicants should research the Repository and if a clash with a Term of Geographic Significance is found, seek permission from the country which had inserted the term in the Repository, before applying for the TLD.

2. Paul McGrady, an intellectual property lawyer from the United States who is known to many as one of the GNSO Council representatives for the Intellectual Property Constituency, but was presenting a proposal in his personal capacity. Paul presented the idea of a Geographic Public interest Commitment (Geo-PIC) whereby applicants for a term which may conflict with a geographical name protected under national law add into their Registry Agreement a binding undertaking not to use the registry in a way that might confuse or mislead an internet user into thinking there was a connection between the registry and a national government or geographical feature.
3. Sebastian Duclos, from registry operator Neustar, representing the GeoTLDs Group made the proposal that all names being used to indicate geographic, linguistic or cultural origin should have government support or non-objection, and that in cases of contention a geographic TLD should take precedence.
4. Alexander Schubert, from dotBerlin, made a proposal dealing with the ISO 3166 alpha 3 codes, which are currently prohibited from use, that these should be available for use as gTLDs provided there is governmental support or non-objection, whilst 2-characters should be reserved to ccTLDs.

The six other presentations presented perspectives on the issue:

- Heather Forrest on the legal framework.
- Martin Sutton, BRG – concerns of brand registry operators
- Flip Petillon, MARQUES and Johanne Asselin/John McElwaine, INTA – importance of defense to agreed principles of international law; many brands match names with a geographic connotation; context is key.
- Peter Van Roste, CENTR – supports the existing restrictions in the Round 1 AGB; if the alpha-3 codes are released they should be subject to governmental consent.
- Thomas Lowenhaupt - need for informed consent from the community being represented, with a focus on City TLDs.

Reflecting community concerns

This strawperson solution seeks to reflect in particular both the solutions proposed above which dealt with the issue of geographic names in the widest sense, as well as the perspectives of the other presenters and those who submitted questions or comments.

The strawperson to design a solution which:

- Offers applicants predictability
- Meets international law whilst not creating new legal rights or giving any single group the ability to veto applications
- Takes into account context of use
- Does not restrict any member of any group from applying or demonstrating concern
- Does not diminish the rights of others
- Is cost effective,
- Can be simply implemented
- Can be simply enforced; and
- Works across all types of registry – Open, Closed, IDN

The strawperson proposal - Summary

1. The existing restrictions set out in the First Round Applicant Guidebook would basically continue, except:
 - a. Applications for *all* three character strings (including those that match ISO 3166-1 alpha-3 codes) would be allowed unless the applicant desires to use a the three character string that matches one contained in the ISO 3166-1 alpha-3 code in its geographic capacity. (eg., one applies for .can intending it to be a TLD for all Canadians) In which case, the process set forth in Section 2.2.1.4.2 of the Applicant Guidebook would apply (ie available for use subject to governmental consent/non-objection). If the three character string is contained within the RGN (described below), then the processes described in Section 4 shall apply.
 - b. Applications for strings that exactly match a sub-national place name on the ISO 3166-2 list (county, province, state) would be allowed unless the applicant desires to use the string in its geographic capacity; in which case, the process set forth in Section 2.2.1.4.2 of the Applicant Guidebook would apply (ie, available for use subject to governmental consent / non-objection). If the string is contained within the RGN (described below), then the process described in Section 4 shall apply.

A searchable advisory Repository of Geographical Names (RGN) is created and maintained by ICANN. Any Government can add any term to the RGN provided that there is a basis to protect that term under that government's existing law. In seeking to place a term into the RGN, the Government must list:

- The term
 - The name of the country that wishes to protect the term
 - The contact authorized in the country to discuss the term and who has the authority to grant permission to use the term if appropriate
 - Whether the term is protected by national law or if the country desires to protect it for cultural or other stated reason.
 - The context in which the country seeks protection for the term
 - The date the term was entered: all terms must be reviewed every five years.
2. The RGN is paid for and maintained by ICANN. Governments can put an unlimited number of terms into the RGN free of charge.
 3. Every potential applicant is encouraged to consult the RGN before submitting an application.
 4. If the potential applicant finds an exact match to his/her preferred term in the RGN:
 - a. If the proposed use by the applicant of the TLD is in its geographic sense, the applicant must reach out to the authorized contact (s) in the impacted country (or countries) for a Letter of Consent or Non-objection.
 - b. If the proposed use by the potential applicant is in a context that does not imply any association with the country, the potential applicant can either:
 - i. Get a Letter of Consent or Non-objection from the applicable government(s); or
 - ii. Submit a Geo-Pic that the TLD Applicant will not use TLD in a manner that falsely suggests to the public that a connection exists between the TLD or its Operator and the geographic term. The Geo-PIC will be included in the TLD Applicant's Registry Agreement, should such

Agreement be executed by ICANN. This GeoPIC shall be enforced in the same manner and process currently contained in the Registry Agreement for other Public Interest Commitments (PICs). PICS are enforced through:

1. Complaints to ICANN Contractual Compliance which may result in ICANN Compliance Action and
2. Formal PICDRP complaints to the PICDRP Standing Panel which can make a formal ruling of compliance or non-compliance

5. In the case of (5bii) above, if the government does not consider that the Geo-PIC alone is adequate and raises a formal objection the following additional paths are available:

- a. Formal mediation procedure with ICANN staff to be involved which addresses potential additional ways to avoid misleading or confusing use of the TLD to the country/geographic term. Applicants will be able to amend their application based on outcome of mediation. Potential outcomes could include sharing arrangements, blocking the use of second-level strings that imply a connection between the TLD and the geographic term or the reservation of terms for use by the impacted governments.
- b. If an agreement cannot be reached, there could be a hearing from a geographic panel of experts whose mandate it will be to (a) determine whether the applicant's proposed use will be of a nature as to mislead the public as to the existence of a connection between the TLD and the geographic term and, if so, (b) recommend any additional measures needed to address GAC concerns. Potential outcomes could include sharing arrangements, blocking the use of second-level strings that imply a connection between the TLD and the geographic term or the reservation of terms for use by the impacted governments. Only in exceptional circumstances would an outcome be the rejection of the TLD application.