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Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

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SURVEY OF THE EXISTING STATE OF PLAY OF GEOGRAPHICAL INDICATIONS, COUNTRY NAMES, AND OTHER GEOGRAPHICAL TERMS IN THE DOMAIN NAME SYSTEM (DNS)

INTRODUCTION

1.   At the thirty-eighth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held from October 30 to November 2, 2017, the SCT adopted its Workplan on Geographical Indications, as reflected in the Summary by the Chair of the SCT (see the Annex to document SCT/38/5).

2.   In accordance with the Workplan on Geographical Indications, the Chair of the SCT requested the Secretariat "to describe the existing state of play of geographical indications, country names, and other geographical terms in the Domain Name System (DNS), with a view to further discussions on the matter by the SCT".

3.   Accordingly, the Secretariat prepared the present Survey document and the accompanying Annex. The document consists of two parts. The first part of the document surveys the existing state of play of geographical indications, country names, and other geographical terms in generic Top Level Domains (gTLDs), while the second part does so for country code Top Level Domains (ccTLDs). The Annex contains more specific information on ccTLD registration terms and dispute resolution policies with respect to the surveyed identifiers. For easy reading and reference, a Table of Contents is included.

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GENERIC TOP LEVEL DOMAINS

GEOGRAPHICAL INDICATIONS

4.   Geographical indications are, for the purposes of this Survey, "indications which identify a good as originating in the territory of a [State], 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"[1].

5.   Generic Top-Level Domains, gTLDs or TLDs, are the portion of a domain name to the right of the "dot" (e.g., the "int" portion of <wipo.int>).

6.   Briefly, domain names are the user-friendly format for an Internet Protocol address. This routing functionality allows users to type <wipo.int> instead of 193.5.93.80 to access the WIPO website.

I.   In "existing" gTLDs

7.   Beginning in 1984, the first available gTLDs included ".com", ".edu", ".gov", ".mil", ".net", and ".org". In 1998, ".int" was added. Following applications from interested parties, from 2000 to 2002, ".aero", ".biz", ".coop", ".info", ".museum", and ".pro" were approved. Further so-called sponsored gTLDs, namely ".asia", ".cat", ".jobs", ".mobi", ".tel", and ".travel" were approved in 2003 and 2004. In 2011 and 2012, ".xxx" and ".post" were respectively approved.

8.   More recently launched "new gTLDs" available since 2014, are discussed in paragraphs 25 to 33.

    (a)   At the Top Level

        (i)   Registration conditions

9.   As stated in "New Registries and the Delegation of International Top Level Domains" (1996), a so-called Internet-Draft of the Internet Engineering Task Force (IETF): "Domain names are intended to be an addressing mechanism and are not intended to reflect trademarks, copyrights or any other intellectual property rights[2]."

10.   This document further stated: "The Domain Name System was created to simply name computers attached to the Internet. There was no intention that domain names identify products or services in any way, or that domain names have any relationship to trademarks[3]."

11.   Drawing a perhaps somewhat artificial distinction, while early DNS protocols recognized the potential overlap between domain names as such and (existing) trademarks, they did so primarily *to distinguish* domain names from trademarks, and sought to avoid creating or providing any particular legal status.

12.   In much the same way as trademarks, early DNS pioneers did not as such attend to potential conflicts between domain names and other identifiers such as geographical indications, country names, and other geographical terms.

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[1]   The definition of geographical indication is taken from the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs Agreement).
[2]   See https://tools.ietf.org/html/draft-postel-iana-itld-admin-01.
[3]   Id.

13.   There was however some early recognition of country-specific domains (albeit narrowly, and in the ccTLD context). To this end, the IETF document "Domain Name System Structure and Delegation" stated that: "The [Internet Assigned Numbers Authority (IANA)] is not in the business of deciding what is and what is not a country. The selection of the ISO 3166 list as a basis for country code top-level domain names was made with the knowledge that ISO has a procedure for determining which entities should be and should not be on that list[4]."

(ii)   *Dispute resolution options*

14.   As to the selection and approval of gTLDs themselves, the initial focus of the IETF, whose role was taken over by the Internet Corporation for Assigned Names and Numbers (ICANN) in 1998, was on technical competency – the TLDs themselves being thought of as something of a directory service. More specifically, in terms of limitations, the above-mentioned IETF document merely stated that gTLDs would "be restricted to alpha numeric strings of exactly 3 characters" and that "applications are judged on three criteria: Registration Services, Operational Resources, and Business Aspects[5]."

15.   At the same time, as mentioned above, to the extent IP-related identifiers were considered, the primary early DNS focus appears to have been limited to consideration of domains' relationship to (existing) trademarks.

16.   As stated in the above-mentioned IETF document: "[gTLDs] must be generic, i.e., not well known company identifiers or trademarks [such terms being] specifically excluded from consideration. […] The applicants to operate registries and manage [gTLDs] are on their honor not to select [gTLD] names knowingly in violation of this condition[6]."

17.   The document continued: "disputes over Intellectual Property Rights […] are best left to arbitration or the courts[7]."

18.   In sum, from the DNS' inception, potential conflicts with identifiers such as geographical indications, country names, and other geographical terms were not specifically considered in relation to gTLDs – except insofar as there was a degree of functional recognition of country-specific domains, and limited to the relevant ISO 3166-2 list at that.

(b)   At the second Level

(i)   *Registration conditions*

19.   By design, domain name registrations operate on a first-come-first-served basis, with virtually no restrictions on terms that may be registered, nor with any pre-screening or registration conditions[8]. Rather, any disputes concerning a domain name, *once registered*, were meant to be handled by courts or other dispute resolution options[9].

20.   ICANN's contract structure provides that registrars, the entities which facilitate registration by end-users, agree "to comply with applicable statutes and regulations limiting the domain names that may be registered[10]." Any such (national law) limitations by their own contractual

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[4]   See https://tools.ietf.org/html/rfc1591.
[5]   See footnote 2.
[6]   Id.
[7]   Id.
[8]   Primarily for technical and/or perceived DNS stability security reasons, ICANN prohibited a select few terms (called "labels") from registration. These include ICANN-related terms: aso, gnso, icann, internic, ccnso; and IANA-related names: afrinic, apnic, arin, example, gtld-servers, iab, iana, iana-servers, iesg, ietf, irtf, istf, lacnic, latnic, rfc-editor, ripe, root-servers. Other terms have been reserved for registry operations: nic, whois, www.
[9]   See footnote 2.
[10]   See e.g., section 2.14 at https://www.icann.org/resources/pages/appendix-08-2012-07-13-en.

terms are not intended to confer rights on third parties in relation to such registration (except as might be explicitly provided in the applicable registration terms or dispute resolution policy), and are outside the scope of this Survey.

21.   As described in more detail below, subject to certain processes allowing for their release, single- and two-character labels at the second level were historically initially reserved from registration[11].

(ii)   Dispute resolution options

22.   Aside from limited specific labels reserved from registration in the ICANN contract constellation (i.e., a handful of technical terms, and (subject to release) single- and two-character labels – noted in footnotes 8 and 11 respectively), conflicts between domain name registrations and protected identifiers are governed by post-registration dispute resolution options.

23.   Primarily, this concerns trademarks, as covered under the Uniform Domain Name Dispute Resolution Policy (UDRP). The UDRP resulted from the First WIPO Internet Domain Name Process (First WIPO Process). Adopted by ICANN in 1999, under the stewardship of the WIPO Arbitration and Mediation Center some 40,000 trademark-based cases have been resolved.

24.   Other identifiers, including those which are the subject of this Survey, namely geographical indications, country names, and other geographical terms, were addressed in the Second WIPO Internet Domain Name Process (second WIPO Process); they are not as such covered by the UDRP[12].

II.   In "new gTLDs"

25.   As mentioned above, beginning in 2014, ICANN began a process to launch "new" gTLDs, for which it received some 1,900 applications (for roughly 1,400 unique terms)[13].

(a)   At the Top Level

26.   As also described in document SCT/39/5, potential conflicts with certain identifiers, namely country names and other geographical terms, are addressed by ICANN in its new gTLD "Applicant Guidebook" terms and conditions. The specific scope of their coverage in ICANN's Applicant Guidebook is discussed in paragraphs 48 to 60 and 69 to 77 respectively.

(i)   Registration conditions

27.   Unlike country names and other geographic terms, geographical indications are not as such addressed in ICANN's Applicant Guidebook.

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[11]   See, e.g., https://www.icann.org/resources/pages/appendix-06-2012-12-07-en.

[12]   A number of issues were identified as being outside the scope of the First WIPO Process, and yet requiring further consideration. These issues concern the bad faith use, as domain names, of: (i) personal names, (ii) International Nonproprietary Names (INNs) for Pharmaceutical Substances, (iii) Intergovernmental Organization (IGO) names and acronyms, (iv) geographical indications, indications of source, or geographical terms, (v) country names, and (vi) trade names. The outcome as to geographical indications, indications of source, or geographical terms was that the WIPO General Assembly decided that the issue should be referred back to the SCT. The outcome as to country names was that the WIPO General Assembly noted that, as concluded by the SCT, most delegations favored some protection for country names against registration or use, as domain names, by persons unconnected with the relevant national authority and where such registration would cause confusion as to source. The Delegations of Australia, Canada, and the United States of America dissociated themselves from this recommendation.

[13]   See also document SCT/39/5 paragraphs 8 and 9.

> *(ii)   Dispute resolution options*

28.   While geographical indications are not expressly covered by ICANN's Applicant Guidebook terms, ICANN did however provide for the possibility of several types of formal pre-delegation objections to applied-for new gTLDs on the basis of (i) legal rights, (ii) limited public interest, (iii) string confusion, or (iv) community grounds[14]. It, therefore, could conceivably at least have been possible for an objection to a new gTLD application to have been filed on geographical indication-related grounds[15].

29.   ICANN's new gTLD application process also provided the possibility for ICANN's Governmental Advisory Committee (GAC) to issue "early warnings" or "advice" on public policy grounds.

30.   In its Beijing *Communiqué*, the GAC advised ICANN that "strings that are linked to regulated or professional sectors should operate in a way that is consistent with applicable laws." The GAC furthermore proposed that specific safeguards should apply to new gTLDs related to "consumer protection, sensitive strings, and regulated markets[16]." These conditions do not, however, appear to have been specifically focused on GIs.

> (b)   At the second Level

> *(i)   Registration conditions*

31.   Following DNS norms, registrations at the second level in new gTLDs have generally been facilitated on a first-come first-served basis. ICANN did however require that new gTLD registries provide a "sunrise" window during which relevant rights holders may purchase (typically for a premium fee) domain names ahead of the general public. While focused on trademark holders, ICANN's Trademark Clearinghouse (and it appears, not without some controversy) facilitated acceptance of geographical indications and designations of origin for sunrise purposes[17]. ICANN moreover provided in its Registry Agreement that certain terms should be initially reserved from registration; these included certain country and territory names, but not geographical indications.

> *(ii)   Dispute resolution options*

32.   Dispute resolution options in new gTLDs at the second level were limited to trademark rights as such, in particular through the existing UDRP.

33.   While there were significant discussions around the protection of geographical indications in particular in the ".vin" and ".wine" new gTLDs, the prevailing applicant[18] and the European Union and wine trade association ultimately reached a compromise by way of private agreement. The terms were not disclosed, and the parties' agreement notably did not result in changes to these Registry Agreements.

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[14]   The full list of objections, a number of which relate to new gTLD applications in the food industry (e.g., ".bio", ".food", ".halal", ".organic"), is at: https://newgtlds.icann.org/en/program-status/odr/determination.

[15]   Several geographical indications listed in the oriGIn Worldwide geographical indications Compilation (www.origin-gi.com/i-gi-origin-worldwide-gi-compilation-uk.html) were applied for as new gTLDs, namely Alsace, Ryukyu, Swiss, and Tirol. No formal objections were filed against these applications. There was however a "GAC Early Warning" filed against the ".swiss" application by Swiss International Air Lines Ltd., resulting in the applicant withdrawing its application, and the application for the same TLD by the Swiss Confederation proceeding to delegation (see <nic.swiss>).

[16]   See https://www.icann.org/en/system/files/files/resolutions-new-gtld-annex-2-05feb14-en.pdf.

[17]   See section 2.4.1 at: http://www.trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.2.pdf.

[18]   United States-based Donuts, Inc. (see <donuts.domains>).

COUNTRY NAMES

I.   In "existing" gTLDs

(a)   At the Top Level

(i)   Registration conditions

34.   Similar to the circumstances described above for geographical indications, historically there has been no specific consideration or protection as such, for country names at the top level in the DNS.

35.   As is also noted above however, the relevant historical documentation concerning country names has referred only to the ISO 3166-2 list.

36.   Illustrating the narrowness of this somewhat technical approach, the ".com" TLD corresponds to the ISO 3166-3 designation for the Union of the Comoros.

(ii)   Dispute resolution options

37.   As mentioned above with respect to the DNS' historical (technical) origins, insofar as there were strict limitations on the types of strings that were available for delegation, dispute resolution with regard to country names at the top level was effectively not applicable.

38.   Recall that the relevant IETF documentation merely stated that gTLDs would "be restricted to alpha numeric strings of exactly 3 characters" and that "applications are judged on three criteria: Registration Services, Operational Resources, and Business Aspects[19]."

(b)   At the second Level

(i)   Registration conditions

39.   While initially (e.g., in ".com") there was no specific protection in the form of registration restrictions for country names, insofar as they were understood to function as country codes, two-character labels were at least initially reserved from registration[20].

40.   Over time however, and further to updated ICANN contractual terms in a number of "existing" gTLDs[21], two-character labels have been released for registration where the registry operator reaches agreement with the government and country-code manager or the ISO 3166 maintenance agency, or where the registry operator implemented measures to avoid confusion with the corresponding country codes. As a matter of practice, two-character labels seem to have been released for registration in existing TLDs based on application of the latter provision.

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[19]   See footnote 2.

[20]   See e.g., Specification 6 of the 2006 ".com" Agreement (limiting country-related reserved names to single- and two-character labels) at https://www.icann.org/resources/unthemed-pages/appendix-06-2006-03-01-en.

[21]   For example, Appendix 6: List of Reserved TLD Strings, to the 2006 ".biz" Registry Agreement provided that all two-character labels were initially reserved.
See https://www.icann.org/resources/unthemed-pages/appendix-06-2006-12-08-en.
A subsequent modification of that contract in 2013 however provided that "two-character labels that were previously reserved […] may be allocated through […] a phased allocation program."
See https://www.icann.org/en/about/agreements/registries/biz/biz-appx-06-html-22aug13-en.htm.

41.   At the same time, at least for a number of gTLDs delegated in the sponsored round (e.g., ".asia", ".cat", ".mobi", ".travel") the relevant ICANN contractual terms required that so called geographic and geopolitical names contained in the ISO 3166-1 list both in English and in all related official languages, should be initially reserved[22].

42.   These contractual terms are however subject to modification, e.g., in the ".asia" TLD, an amendment in 2012 removed this reservation[23]. A similar approach seems to have been taken in the ".mobi" TLD[24]. An amendment in 2010 to the ".travel" TLD seems to have permitted allocation of single- and two-character labels, whereas the reservation for geographic and geopolitical names contained in the ISO 3166-1 list seems to remain in place[25].

(ii)   Dispute resolution options

43.   As noted above, beyond the UDRP (addressing conflicts between domain names and trademarks) created through the First WIPO Process, the Second WIPO Process considered identifiers such as country names.

44.   Concerning country names, it is recalled that the WIPO General Assembly noted that most delegations favored some protection for country names against their unauthorized and confusing registration or use in the DNS. The Delegations of Australia, Canada, and the United States of America dissociated themselves from this recommendation.

45.   Insofar as existing TLDs were concerned, no specific protection has been available.

46.   It is noted in this respect that in some instances third parties have registered two-character labels in TLDs such as ".com" to then facilitate registrations at the third-level (i.e., "example" in <example.ru.com>, <example.uk.net>, or <example.us.com>)[26].

47.   Those "second-level registries" allowing third-level registrations tend to adopt dispute resolution policies similar to the trademark-based UDRP[27]. Such disputes are not however currently managed by the WIPO Arbitration and Mediation Center.

II.   In "new gTLDs"

48.   Relevant portions of ICANN's Applicant Guidebook concerning the use of country names as new gTLDs were informed by the GAC further to its remit to provide public policy advice to ICANN's Board[28].

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[22]   See e.g., Appendix 6, Schedule of Reserved Names, for the 2006 ".cat" registry agreement at https://www.icann.org/resources/unthemed-pages/cat-appendix6-2006-03-22-en.
This Schedule of Reserved Names further provided that "In addition, Registry shall reserve names of territories, distinct economies, and other geographic and geopolitical names as ICANN may direct from time to time. Such names shall be reserved from registration during any sunrise period, and shall be registered in ICANN's name prior to start-up and open registration in the TLD. Registry shall post and maintain an updated listing of all such names on its website, which list shall be subject to change at ICANN's direction. Upon determination by ICANN of appropriate standards and qualifications for registration following input from interested parties in the Internet community, such names may be approved for registration to the appropriate authoritative body."
[23]   See https://www.icann.org/resources/pages/appendix-6-2012-03-02-en.
[24]   See Appendix 6 and Amendment No. 2 available at https://www.icann.org/resources/agreement/mobi-archive-2005-07-10-en.
[25]   See Appendix 6 and Amendment No. 1 respectively at https://www.icann.org/en/about/agreements/registries/travel/travel-appendix-6-12apr06-en.htm and https://www.icann.org/en/tlds/agreements/travel/registry-agmt-amendment-1-23aug10.htm. See more generally https://www.icann.org/resources/agreement/travel-archive-2005-05-05-en for related archived documents.
[26]   For one such example of third-level registration possibilities, see UK-based CentralNic (www.centralnic.com/portfolio/slds, and www.centralnicdomains.com).
[27]   See https://www.centralnic.com/support/dispute/overview.

49.   At the same time, ICANN's policy organ, the Generic Names Supporting Organization (GNSO) in its 2007 Final Report on the Introduction of New Generic Top-Level Domains suggested that owing to ambiguity in terms of a practical definition, "[t]he term 'geopolitical names' should be avoided until such time that a useful definition can be adopted"[29]. (Recall that several of ICANN's previous contracts reserved country names under the notion of "geopolitical names".)

(a)   At the Top Level

50.   Further to the GAC expressing concerns about their use as, and protection in, new gTLDs[30], as to the top level, ICANN's Applicant Guidebook provides that "applications for strings that are country or territory names will not be approved, as they are not available under the New gTLD Program in this application round[31]."

(i)   Registration conditions

51.   ICANN's Applicant Guidebook therefore prohibited applications for new gTLDs that met any of the following criteria:

−   alpha-three codes listed in the ISO 3166-1 standard;

−   long-form names listed in the ISO 3166-1 standard, or a translation of the long-form name in any language;

−   short-form names listed in the ISO 3166-1 standard, or a translation of the short-form name in any language;

−   short- or long-form names association with a code that has been designated as "exceptionally reserved" by the ISO 3166 Maintenance Agency;

−   separable components of a country name designated on the "Separable Country Names List," or is a translation of a name appearing on the list, in any language;

−   permutations or transpositions of any of the names listed above[32], and

−   names by which a country is commonly known, as demonstrated by evidence that the country is recognized by that name by an intergovernmental or treaty organization.

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[28]   Per ICANN's Bylaws, the GAC should consider and provide advice on the activities of ICANN as they relate to concerns of governments, particularly matters where there may be an interaction between ICANN's policies and various laws and international agreements or where they may affect public policy issues.

[29]   See https://gnso.icann.org/en/issues/new-gtlds/pdp-dec05-fr-parta-08aug07.htm.

[30]   In 2007, the GAC issued the "GAC Principles regarding New gTLDs", which states *inter alia* that ICANN should avoid delegation of New gTLDs concerning country, territory or place names, and regional language or people descriptions, unless in agreement with the relevant governments or public authorities. The GAC Principles further stated that new gTLD registries should adopt procedures for blocking or challenge of names with national or geographical significance at the second level upon demand of governments.
See https://archive.icann.org/en/topics/new-gtlds/gac-principles-regarding-new-gtlds-28mar07-en.pdf.

[31]   See http://newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf, section 2.2.1.4.1 "Treatment of Country or Territory Names".

[32]   According to ICANN's Applicant Guidebook, permutations include removal of spaces, insertion of punctuation, and addition or removal of grammatical articles like "the" and a transposition is considered a change in the sequence of the long- or short-form name, for example, "RepublicCzech" or "IslandsCayman".

(ii)   Dispute resolution options

52.   As new gTLD applications for country (and territory) names were not permitted, there were no specific dispute resolution options.

53.   For some time now, however, various ICANN working groups have been discussing treatment of geographical terms in future new gTLD application rounds.

(b)   At the second Level

54.   ICANN's new gTLD Applicant Guidebook provided for a range of country and territory names to be protected in the form of an *initial* block from availability for registration[33].

(i)   Registration conditions

55.   Drawn from various internationally recognized lists, these protected country and territory names include:

–   the short form in English of country and territory names on the ISO 3166-1 list (including the European Union which is exceptionally reserved);

–   the United Nations Group of Experts on Geographical Names, Technical Reference Manual for the Standardization of Geographical Names, Part III Names of Countries of the World; and

–   the list of United Nations member states in 6 official United Nations languages prepared by the Working Group on Country Names of the United Nations Conference on the Standardization of Geographical Names.

56.   ICANN's Applicant Guidebook however provided a process for the eventual lifting of this initial block from availability for registration.

57.   This process allowed for the block to be lifted if the registry operator reached an agreement with the applicable government(s).

58.   Similar to the below-described process relating to two-character labels, this ICANN process alternatively allowed the registry operator itself to propose a methodology for the block to be lifted; such proposed methodology would be "subject to review by [the GAC]" and finally subject to "approval by ICANN."

(ii)   Dispute resolution options

59.   In December 2016, ICANN authorized the release of all *two-character domain names* at the second level in New gTLDs provided that: (i) registry operators first allow respective governments a thirty-day period to acquire these domain names; (ii) registrants are required to represent that they would not falsely imply government affiliation in connection with the use of two-character domain names; and, (iii) the registry provides a means for investigating complaints about confusion with the corresponding country code[34]. Together these comprise ICANN's so-called "confusion mitigation" plan[35].

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[33]   See Specification 5 "Schedule of Reserved Names at the Second Level in gTLD Registries" at: http://newgtlds.icann.org/en/applicants/agb/base-agreement-specs-04jun12-en.pdf.

[34]   In this context, the WIPO Center submitted comments to ICANN noting that the Second WIPO Process considered the possibility of exploring measures for the UDRP to at least apply to third level registrations in order to mitigate the potential for trademark abuse. This proposal (similar to the "CentralNic model" mentioned in footnotes 26 and 27) was not adopted by ICANN. See http://www.wipo.int/amc/en/docs/icann05082016.pdf.

[35]   See https://www.icann.org/en/system/files/files/two-character-ltr-ltr-authorization-release-13dec16-en.pdf.

60.   It is expected that the above-described ICANN model allowing for the release of initially blocked two-character domain names in new gTLDs may eventually be applied to the still currently blocked country names.

OTHER GEOGRAPHICAL TERMS

I.   In "existing" gTLDs

    (a)   At the Top Level

        (i)   Registration conditions

61.   Consideration of geographical terms in this context effectively tracks the above discussion on country names, namely that historically there has been no specific consideration or protection as such, for geographic terms at the top level in the DNS. Rather, as is described above, there was limited consideration of country names by reference to the ISO 3166-2 list.

62.   It is noted however that in ICANN's sponsored gTLD round, an application for the ".asia" TLD was approved and delegated. This application contained support of a number of ccTLD and Internet-related organizations from the relevant region[36]. It is also relevant to note that the ".asia" TLD itself was chosen as an alternative to a possible ".ap" (representing Asia Pacific) TLD both as this latter designation was reserved to the African Regional Industrial Property Organization and moreover as two-character TLDs were reserved for use as ccTLDs[37].

        (ii)   Dispute resolution options

63.   As also mentioned above, insofar as there were strict limitations on the types of strings that were available for delegation, dispute resolution with regard to geographic terms at the top level was effectively not applicable.

    (b)   At the second Level

        (i)   Registration conditions

64.   Similar to the situation described in paragraphs 43 to 45 for country names, initially there was no specific protection in the form of registration restrictions for geographic terms.

65.   As also described above, in a number of gTLDs delegated in ICANN's sponsored round (e.g., ".asia", ".cat", ".mobi", ".travel") the relevant ICANN contractual terms required that certain geographic and geopolitical names be reserved. These included "names of territories, distinct economies, and other geographic and geopolitical names as ICANN may direct from time to time[38]."

66.   The relevant ICANN contract further specifies that "following input from interested parties in the Internet community, such names may be approved for registration to the appropriate authoritative body[39]." Typically this would require requisite authorization from the relevant entity[40].

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[36]   See https://archive.icann.org/en/tlds/stld-apps-19mar04/asia.htm, in particular the section titled "Appropriateness of Sponsored TLD Community".
[37]   See "The DotAsia Story" at https://www.dot.asia/dotasia-organisation/about-dotasia.
[38]   See e.g., Appendix 6, Schedule of Reserved Names, for the 2006 ".cat" registry agreement at https://www.icann.org/resources/unthemed-pages/cat-appendix6-2006-03-22-en.
[39]   Id.
[40]   See e.g., https://www.dot.asia/policies/DotAsia-Reserved-Names--COMPLETE-2007-08-10.pdf describing processes for allocation of three tiers of Governmental Reserved Names.

     (ii)   Dispute resolution options

67.   For the most part, as is also described above for geographical indications, aside from the possibility of the relevant entity claiming rights in a geographic term demonstrating trademark rights to support standing under the UDRP, geographic terms are not as such covered by gTLD dispute resolution polices.

68.   For those few existing TLDs reserving certain geographic and geopolitical names, in theory a dispute resolution policy would not be relevant, insofar as their allocation would be screened[41].

II.   <u>In "new gTLDs"</u>

    (a)   At the Top Level

        (i)   Registration conditions

69.   Concerning geographical terms, as to the top level, ICANN's Applicant Guidebook provided that a range of such terms were to be accompanied by documentation of support or non-objection from all relevant governments or public authorities[42]. These include (emphasis as in ICANN's Applicant Guidebook):

–   An application for any string that is a representation, in any language, of the *capital city name* of any country or territory listed in the ISO 3166-1 standard;

–   An application for a *city name*, where the applicant declares that it intends to use the gTLD for purposes associated with the city name[43],

–   An application for 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;

–   An application for a string listed as a UNESCO region[44] or appearing on the "Composition of macro geographical (continental) regions, geographical sub-regions, and selected economic and other groupings" list[45] [46].

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[41]   See e.g., Section 2 "Pre-Sunrise & Sunrise 1 (SR1): Governmental Reserved Names" at https://www.dot.asia/policies/DotAsia-Sunrise-Policies--COMPLETE-2007-08-10.pdf.

[42]   See http://newgtlds.icann.org/en/applicants/agb/evaluation-procedures-04jun12-en.pdf, section 2.2.1.4.2 "Geographic Names Requiring Government Support".

[43]   As per the relevant section of ICANN's Applicant Guidebook:
"City names present challenges because city names may also be generic terms or brand names, and in many cases city names are not 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 are not universally protected. However, the process does provide a means for cities and applicants to work together where desired. An application for a city name will be subject to the geographic names requirements (i.e., will require documentation of support or non-objection from the relevant governments or public authorities) if: (a) It is clear from applicant statements within the application that the applicant will use the TLD primarily for purposes associated with the city name; and (b) The applied-for string is a city name as listed on official city documents."
It is further noted in ICANN's Applicant Guidebook the "City governments with concerns about strings that are duplicates, nicknames or close renderings of a city name should not rely on the evaluation process as the primary means of protecting their interests in a string. Rather, a government may elect to file a formal objection to an application that is opposed by the relevant community, or may submit its own application for the string."

[44]   See http://www.unesco.org/new/en/unesco/worldwide.

[45]   See http://unstats.un.org/unsd/methods/m49/m49regin.htm.

[46]   According to ICANN's Applicant Guidebook, "In the case of an application for a string appearing on either of the lists above, documentation of support will be required from at least 60 per cent of the respective national governments in the region, and there may be no more than one written statement of objection to the application from relevant governments in the region and/or public authorities associated with the continent or the region. Where the 60 per cent rule is applied, and there are common regions on both lists, the regional composition contained in the

70.   ICANN's Applicant Guidebook further provided that in case of any doubt applicants were to consult with any relevant governments, but also that strings that include but do not match a geographic name (as defined immediately above) were not considered to require documentation of government support.

71.   Concerning yet further rounds of new gTLDs, a GAC sub-group on Geographic Names (a Sub-group of the GAC Working Group on Future New gTLDs) has developed a draft document for future new gTLD rounds outlining several public policy aspects related to geographic names which is currently subject to further ICANN discussions[47].   In a number of respects, ICANN community discussions on geographic terms as new gTLDs continue[48].

(ii)   Dispute resolution options

72.   As noted immediately above, applications for strings falling into the above categories would have required government support. At the same time, as noted at paragraph 28, ICANN also provided for the possibility of several types of formal pre-delegation objections to applied-for new gTLDs. Objections were filed for a number of strings including ".africa", ".amazon", ".gcc", and ".thai"[49].

73.   As noted above, another possibility was for the issuance of an "early warning" by a GAC member or members[50]. Merely by way of example, such early warnings concerning strings considered to have geographic implications included: ".africa", ".amazon", ".date", ".delta", ".gcc", ".广州" (".guangzhou"), ".patagonia", ".persiangulf", ".roma", ".shangrila", ".深圳" (".shenzhen"), ".spa", ".swiss", and ".zulu"[51].

74.   Some such applications (e.g., ".广州" (".guangzhou"), ".patagonia", ".深圳" (".shenzhen")) were withdrawn following receipt of GAC early warnings.

75.   ICANN's new gTLD application process also provided the possibility for the GAC to issue "advice" on public policy grounds. In the particular case of the application for ".amazon" the GAC early warning considered this not only to raise certain sensitivities, but also as relating to a geographical region[52]. At present, and following a number of formal ICANN dispute resolution-oriented processes[53], discussions between relevant governments, ICANN, and the applicant continue. In February 2018, the ICANN Board requested via resolution that ICANN's President and CEO facilitate negotiations between the Amazon Cooperation Treaty Organization's (ACTO) member states and the new gTLD applicant, the Amazon Corporation[54].

"Composition of macro geographical (continental) regions, geographical sub-regions, and selected economic and other groupings" takes precedence."

[47]   See inter alia https://gacweb.icann.org/download/attachments/27132037/Geo%20names%20in%20new%20gTLDs%20Updated%2 0%20V3%20%2029%20august%202014%5B4%5D.pdf?version=1&modificationDate=1411549935000&api=v2.

[48]   See e.g., https://www.gac.icann.org/activity/new-gtlds-geographic-names-as-tlds-wt5.

[49]   See https://gacweb.icann.org/display/GACADV/New+gTLDs.

[50]   The full list of new gTLD applications receiving early warnings is at https://gacweb.icann.org/display/gacweb/GAC+Early+Warnings.

[51]   The status of all applied-for new gTLDs can be ascertained at https://gtldresult.icann.org.

[52]   See https://gacweb.icann.org/display/gacweb/GAC+Early+Warnings?preview=/27131927/27197938/Amazon-BR-PE-58086.pdf.

[53]   For example, submission under ICANN's application process to an Independent Review Panel, see https://www.icann.org/resources/pages/irp-amazon-v-icann-2016-03-04-en.

[54]   See https://www.icann.org/resources/board-material/resolutions-2018-02-04-en#2.d.

(b)   At the second Level

   (i)   Registration conditions

76.   Registration restrictions concerning geographic terms have not been specifically considered beyond those provided for in ICANN's Applicant Guidebook as to country and territory names[55].

   (ii)   Dispute resolution options

77.   As noted at paragraph 67, aside from the possibility of the relevant entity claiming rights in a geographic term demonstrating trademark rights to support standing under the UDRP, geographic terms are not as such covered by gTLD dispute resolution polices.

COUNTRY CODE TOP LEVEL DOMAINS

METHODOLOGY

78.   The Survey on the existing state of play of geographical indications, country names, and other geographical terms in the ccTLDs is based on a selection of 85 ccTLDs plus the European Union ".EU" regional domain; these are listed alphabetically in the Annex.

79.   The selection methodology for the information described below and in particular in the Annex accounts for a range of factors, including regional distribution, use of *sui generis* and trademark law-based systems to protect geographical indications, WIPO World Intellectual Property Indicators 2017 in respect of geographical indications, domain name registration volume, and national registries for which the Secretariat (through the Arbitration and Mediation Center) provides dispute resolution services.

80.   The Survey and Annex cover a range of sources including publicly available domain name registration agreements (i.e., contractual terms and conditions), various applicable domain name-related policies, as well as available Alternative Dispute Resolution (ADR) options.

81.   The sources were identified on the basis of ccTLDs' public websites, as listed in the Root Zone Database[56]. Where available, the English version of the text was consulted and is presented in the Annex. For some ccTLDs the sources were available in the respective national language only, in which case the relevant provisions have been identified and translated by the Secretariat into English in the Annex. In a few cases it was not possible to locate relevant documentation.

82.   The Survey and Annex do not purport to interpret national laws related to geographical indications, country names, and other geographical terms, but rather look to each ccTLD's specific registration conditions and dispute resolution policies. Moreover, the various means of addressing geographical indications, country names, and other geographical terms described below and captured in the accompanying Annex remain subject to review by the competent authorities as may be considered appropriate. The Secretariat is prepared to look more closely at specific situations where requested by the SCT.

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[55]   See footnote 33.
[56]   See https://www.iana.org/domains/root/db.

GENERAL FINDINGS

83.   Practices concerning domain names in ccTLDs vary in terms of their specific registration policies/conditions and dispute resolution options. However, it is generally observed that:

–   before registering a domain name, the registrant must agree not to infringe the intellectual property (and other) rights of third parties, and that he/she is acting lawfully and assumes full responsibility for the consequences of registration and use of the domain name;

–   there is generally no pre-screening or prior examination in the domain name registration process, including as to a third party rights;

–   claims of infringement are handled after a registration takes effect, typically through ADR services or by resort to the courts.

84.   As to registration policies concerning geographical indications, country names, and other geographical terms in ccTLDs, and drawing on the data presented in the Annex, the following statistics are observed:

–   three per cent of the ccTLDs surveyed have registration policies that contain provisions regulating the use or registration of geographical indications[57] as a domain name (three out of 86);

–   twenty-seven per cent of the ccTLDs surveyed have registration policies that contain provisions regulating the use or registration of country names[58] as a domain name (23 out of 86);

–   forty-five per cent of the ccTLDs surveyed have registration policies that contain provisions regulating the use or registration of geographical terms[59] as a domain name (39 out of 86).

85.   Note that some of the above statistics categories may cover the same ccTLD, i.e., 49 per cent of ccTLDs surveyed have registration policies that cover at least one of the three surveyed identifiers (42 out of 86).

86.   As to dispute resolution policies, and drawing on the data presented in the Annex, the following statistics are observed:

–   seventy-nine per cent of the ccTLDs surveyed appear to provide for resolution of disputes (68 out of 86);

–   the majority of such policies refer to trademarks as a ground on which a claim may be based;

–   in addition to referring to trademarks, the policies in question also refer to other grounds on which a claim may be based as follows:

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[57]   For purposes of the Survey and Annex, this is broadly understood to include concepts, as described in the relevant ccTLD-specific documents, such as designations of origin, denominations or indications of origin, geographic denominations, appellations of origin, appellations or indications of origin, geographic designations, etc.
[58]   In some cases it was not clear whether this was meant to refer to "all" country names, or a more limited set.
[59]   This is broadly understood to cover a range of defined terms, which as can be seen in the Annex differ by jurisdiction both in terminology and scope. See paragraph 110.

- in eight per cent of such policies, a right in a name/interest/other right (six out of 68);
- in 16 per cent of such policies, a geographical indication (11 out of 68);
- in three per cent of such policies, a country name (two out of 68);
- in three per cent of such policies, a geographical name (two out of 68).

GEOGRAPHICAL INDICATIONS

I.   At the Top Level

87.   As ccTLDs correspond to their ISO 3166-2 designation, there is no consideration as such of geographical indications[60].

II.   At the second Level

88.   As documented in the Annex, a relatively limited number of ccTLDs surveyed specifically consider geographical indications in their registration conditions (three of 86) and dispute resolution policies (11 of 68)[61].

(a)   Registration Conditions

89.   For the relatively few ccTLDs that regulate geographical indications in their registration terms, the results illustrate that the prevailing concept is to limit their availability for registration as domain names, or to require particular conditions to be met for allocation[62].

90.   In cases where such domain names may have been registered, they may be subject to cancellation or revocation by the registry.

(b)   Dispute Resolution Options

91.   As with registration conditions, relatively few ccTLD ADR policies seem to expressly allow for claims to be brought on the basis of rights in geographical indications.

92.   Those ccTLDs which allow claims to be based on geographical indications under their ADR policies (11 of those surveyed) appear to allow for a degree of co-existence insofar as registrants may advance claims to a legitimate interest in such terms and/or can put forward evidence purporting to show a lack of bad faith, usually without reference to specific national law.

93.   In some specific cases, e.g., .IE (Ireland) a claimant would have standing to bring a claim only if it would also have standing to bring an action based on infringement of rights in a geographical indications before a national court.

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[60]   See also paragraph 13.

[61]   The registration and ADR policies themselves use a range of terminology, including: designation of origin or guaranteed traditional product, geographic names, geographical and/or geopolitical concepts, geographical indications, denominations or indications of origin, geographic denominations, appellations of origin, appellations or indications of origin, geographic designations. Whether these terms have specific different meanings in the jurisdiction concerned is unclear.

[62]   In the .AM (Armenia) ccTLD for example, seeming to allow for a degree of co-existence, the validity of a domain name registration corresponding to a geographical indication will depend on whether such registration was undertaken before or after the respective geographical indication obtained protection.

COUNTRY NAMES

I.   At the Top Level

94.   Country names are represented in ccTLDs by reference to their two-character codes.

   (a)   Registration Conditions

95.   The delegation of such TLDs was by reference to the ISO 3166 list. (See also paragraph 13.)

   (b)   Dispute Resolution Options

96.   This is an area that largely remains unclear. In early 2000, the GAC produced Principles for Delegation and Administration of ccTLDs[63]. These Principles provided a broad framework for delegation – including the possibility of reassignment – of a ccTLD by the relevant government or public authority[64]. These Principles were revised in 2005; in pertinent part, they state that "authority over the relevant ccTLD rests with the relevant government or public authority"[65]. At the same time however, ICANN more recently convened a "Framework of Interpretation Working Group" to explore the relationship between the above-mentioned GAC Principles and IANA[66], the net result of these later recommendations (endorsed by ICANN's country code Names Supporting Organization (ccNSO), which is separate from the GAC)[67] seems to have been a continuing lack of clarity on the process for ccTLD reassignment requests.

97.   Despite, and in some ways because of these various inputs, it is difficult to ascertain the precise IANA process for resolving disputes concerning ccTLDs, the current functional equivalent of country names at the top level in the DNS.

II.   At the second Level

98.   Both in terms of registration conditions and dispute resolution options, the specific treatment of country names in ccTLDs, where applicable, is captured in detail in the Annex accompanying this Survey.

   (a)   Registration Conditions

99.   Roughly one-quarter of surveyed ccTLDs surveyed provide specific registration regulations concerning country names. Of those, the majority either prohibit their registration, or place them on a reserve list. In either event, the registry would typically retain the discretion to cancel or revoke the corresponding registration if it violated the specified criteria.

100.   In the case of a reserved list, country names may in some cases be released for registration under certain conditions, e.g., registration only by the relevant corresponding authority. There are also varied practices regarding the language of such reservations; often this would be in the language of the particular ccTLD itself, and sometimes also in English and/or the language of the corresponding authority.

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[63]   See https://archive.icann.org/en/committees/gac/gac-cctldprinciples-23feb00.htm.
[64]   Two examples of such ccTLD reassignment include .AU (Australia) and .LY (Libya). See respectively https://www.iana.org/reports/2001/au-redelegation/disspain-to-alston-18jun01.html, and https://www.iana.org/reports/2005/ly-report-05aug2005.pdf.
[65]   See https://archive.icann.org/en/committees/gac/gac-cctld-principles.htm.
[66]   See https://ccnso.icann.org/sites/default/files/filefield_46435/foi-final-07oct14-en.pdf.
[67]   See https://ccnso.icann.org/sites/default/files/filefield_46795/foi-final-resolutions-11feb15-en.pdf.

101.   It is also noted that 39 per cent of registration policies that contain a reference to country names (nine out of 23) appear to limit the scope of the provisions to the country name of the jurisdiction concerned. The remaining 61 per cent of such policies (14 out of 23) appear to cover country names without specific limitations to the jurisdiction concerned. A number of these policies furthermore indicate that the names of countries are reserved for their respective embassies or consulates.

(b)   Dispute Resolution Options

102.   Broadly speaking, country name are not considered as a specific ground for standing to file a claim under surveyed dispute resolution policies. (Only two of those ccTLDs surveyed, namely .FR (France) and .EE (Estonia) provided such standing, and in these cases, it appears that this standing is limited to names of the State concerned.)

103.   To the extent there may however be trademark rights in such identifiers, this could provide a basis for standing to file a claim (e.g., under the UDRP or its equivalent).

104.   It is important to note however that in the event there would be standing to bring a case on the basis of (trademark) rights in a country name, in the very few UDRP (i.e., gTLD) cases filed on this basis, co-existence principles have been recognized in favor of third-party registrants[68].

105.   In two cases finding in favor of the claimant (one ccTLD, one gTLD), it is noted that both parties were from the jurisdiction concerned, and the appointed external expert appeared to apply what it understood to be relevant principles of national law[69].

OTHER GEOGRAPHICAL TERMS

I.   At the Top Level

106.   To the extent they would be considered geographical terms, such identifiers would be represented in ccTLDs by reference to their two-character codes.

(a)   Registration Conditions

107.   See above by way of reference to the ISO 3166 list.

(b)   Dispute Resolution Options

108.   To the extent they would be considered geographic terms, dispute resolution options for such identifiers would follow the same delegation and reassignment parameters as those described above for country terms.

II.   At the second Level

109.   Both in terms of registration conditions and dispute resolution options, the specific treatment of geographic terms in ccTLDs, where applicable, is captured in detail in the Annex accompanying this Survey.

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[68]   See
www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0754.html (<newzealand.com>);
www.wipo.int/amc/en/domains/decisions/html/2002/d2002-1129.html (<puertorico.com>);
www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0242.html (<mexico.com>);
www.wipo.int/amc/en/domains/decisions/html/2009/dco2009-0001.html (<principadodemonaco.edu.co>).
[69]   See
www.wipo.int/amc/en/domains/decisions/html/2006/dch2006-0003.html (<schweiz.ch>, <suisse.ch>, <svizzera.ch>);
www.wipo.int/amc/en/domains/search/text.jsp?case=D2014-2042 (<marcaperu.org>).

(a)   Registration Conditions

110. Nearly half of the ccTLDs surveyed provide some form of registration regulations concerning geographic terms. The specific treatment and scope of geographic terms varies widely. Merely to provide some illustrative examples, such terms refer to national places, towns, names or abbreviations of local regions or districts, provinces, cities, municipalities, geographic names, geographical terms, place names, states, etc.

111. As with country names, the majority either prohibit their registration, or place them on a reserve list. In either event, the registry would typically retain the discretion to cancel or revoke the corresponding registration if it violated the specified criteria.

112. Also similar to country names, in the case of a reserved list concerning geographic terms, they may in some cases be released for registration under certain conditions, e.g., registration only by the relevant corresponding authority.

(b)   Dispute Resolution Options

113. Broadly speaking, geographic terms are not considered as a specific ground for standing to file a claim under surveyed dispute resolution policies. (Only two of those ccTLDs surveyed, namely .AM (Armenia) and .BF (Burkina Faso) provided such standing, and in the former case, it appears that this is linked to national legislation.)

114. To the extent there may however be trademark rights in such identifiers (i.e., where such term is not used in its geographical sense), this could provide a basis for standing to file a claim (e.g., under the UDRP or its equivalent).

115. It is important to note here however that in the event there would be standing to bring a case on the basis of (trademark) rights in a geographical term, in the very few UDRP cases filed on this basis, co-existence principles have been recognized in favor of third-party registrants[70].

CONCLUSION

116. As described above, in terms of gTLDs, historically there was little and in some cases no specific consideration or protection of geographical indications, country names, and other geographical terms both in terms of registration conditions and dispute resolution policies. Over time however, certain of these identifiers were subject to varying limited degrees of protection at both the top and second levels. Moreover, this is an area on which discussions continue, e.g., in the context of ICANN's New gTLD Program.

117. As also described above, both in terms of registration conditions and dispute resolution policies, there are a number of similarities with respect to the treatment of geographical indications, country names, and other geographical terms in ccTLDs. Geographical terms, often individually defined in the relevant ccTLD have the broadest coverage as it relates to registration terms, followed closely by country names; very few ccTLDs surveyed expressly recognize geographical indications in their registration terms. In terms of dispute resolution policies, relatively few expressly cover geographical indications, and even fewer cover country names and other geographic terms. At the same time, their treatment is not uniform, but rather varies in terms of legal scope and practical application. It may also be the case that such identifiers are covered by various provisions of relevant national laws, which may of course find application in the DNS through local courts.

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[70]   See e.g., as it relates to UDRP decisions in the gTLD context, Section 1.6 of the WIPO (Jurisprudential) Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (www.wipo.int/amc/en/domains/search/overview3.0/#item16), and cases cited therein.

118. The WIPO Arbitration and Mediation Center aims to provide links to a range of ccTLD-related information, including registration and dispute resolution policies, inter alia at: www.wipo.int/amc/en/domains/cctld and www.wipo.int/amc/en/domains/cctld_db, and invites Member States to provide any relevant policy updates to the Secretariat at arbiter.mail@wipo.int.

117.   The SCT is invited to consider the content of the present document.

[Annex follows]