

# Geographic Internet domains Challenges for the developing DNS

---

Heather Ann Forrest

Australian Catholic University

---

Geographic names have posed challenges for Internet domain name policy makers since the earliest days of the Domain Name System (or 'DNS', as it is most commonly known). As the DNS develops with the addition of hundreds of new top-level domains and the challenges posed by geographic domains are addressed only on an ad hoc basis, DNS policy on these names reduces coherency, thus reducing confidence in the DNS and its controlling authority, the Internet Corporation for Assigned Names and Numbers (ICANN). The broad range of issues currently and foreseeably raised by the use of geographic names in the DNS means that all Internet stakeholders are affected, not simply those claiming rights or interests in such names. This article offers insight into why geographic domain names remain problematic more than two decades after these issues first arose, identifies trends in DNS policy respecting geographic names and highlights the impact on various Internet stakeholders of current policy and decisions.

## Introduction

Geographic names have posed challenges for Internet domain name policy makers since the earliest days of the Domain Name System (or 'DNS', as it is most commonly known). As the DNS develops with the addition of hundreds of new top-level domains and the challenges posed by geographic domains are addressed only on an ad-hoc basis, DNS policy on these names reduces coherency, thus reducing confidence in the DNS and its controlling authority, the Internet Corporation for Assigned Names and Numbers (ICANN). The broad range of issues currently and foreseeably raised by the use of geographic names in the DNS means that all Internet stakeholders are affected, not simply those claiming rights or interests in such names. All domain name registrants must understand the implications of registering domain names incorporating geographic terms (for example, 'fordaustralia' or 'paris.cafe'). All new generic top-level domain operators ('gTLD operators') must ensure that their domain name registration policies satisfy ICANN requirements, which are increasingly influenced by government interests. Brand owners must be aware of the exemptions that new geographic gTLD operators seek from rights protection requirements. Governments

challenging geographic names' use must be aware of the legal basis, or lack thereof, for their claims to priority rights or interests in geographic names. This article offers insights into why geographic domain names remain problematic more than two decades after these issues first arose, identifies trends in DNS policy respecting geographic names and highlights the impact on various Internet stakeholders of current policy and decisions.

## Why are geographic domain names problematic in the DNS?

In the early 1990s the DNS, which had been operational since 1984, experienced a major shift in focus with the transition of funding from the United States Department of Defense to the United States government's National Science Foundation. (NTIA 1998) Far from simply being a change in the United States government's financial ledger, with this shift the Internet transitioned from military project to public communications resource. The commercialisation of the Internet took another great leap as the twentieth century wound to a close with the incorporation of the Internet Corporation for Assigned Names and Numbers (ICANN), a California non-profit public benefit corporation, and its assumption of responsibility for the DNS by contract with the United States Department of Commerce. At that point, the total number of domain name registrations worldwide in the then only three publicly available gTLDs (.com, .net and .org) barely surpassed ten million. (ZookNIC 2008) Yet even in that relatively small Internet community, conflicts arose over geographic domain names.

One of the first items of business for the newly formed ICANN was developing a dispute resolution policy to resolve the increasing incidence of 'cybersquatting', the practice of registering a domain name that comprises or incorporates a term in which another party has legal rights. In leading ICANN's efforts to develop the dispute resolution policy that would become the Uniform Domain Name Dispute Resolution Policy (or 'UDRP', as it is now universally known), the World Intellectual Property Organization (WIPO) recommended that the policy apply to 'any dispute concerning the domain name arising out of the alleged violation of an intellectual property right.' (WIPO 1998) This recommendation came to life in the first ground that all UDRP claimants must demonstrate, namely, 'the registrant's domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights'. (ICANN 1999)

This requirement operates to restrict government challenges where the geographic name in question is not protected by trade mark rights - a significant hurdle due to trade mark law's reluctance to protect a term that consumers may interpret as having multiple associations or meanings. (Forrest 2013a) As a result, complaints against geographic domain names registrations have notably succeeded 'in only a few exceptional cases'. (Bettinger 2005)

Government influence on DNS policy-making, meanwhile, has increased with greater awareness of and participation in the ICANN policy development process through Governmental Advisory Committee (GAC) representatives. The GAC has progressively increased its demands in relation to geographic names, from 'interim ad hoc' measures to restrict 'the use of names of countries and distinct economies as recognised in international fora as second level domains in the .info TLD' in 2004 (GAC 2001) to preventing in 2012 applications for new gTLDs constituting country or territory names and requiring applicants of new gTLDs comprising other forms of geographic name to demonstrate the consent or non-objection of relevant governments or public authorities. (ICANN 2012a) The purportedly 'interim ad hoc' restriction on registering names of countries and territories now applies to all new gTLDs. (ICANN 2013a)

Geographic names remain problematic in the DNS as a result of this decidedly ad hoc approach to policy-making. While governments' interests in geographic names are not actionable under the UDRP (unless recognised through trade mark law), ICANN policy on top-level (.turkey) and second-level (nyc.restaurant) naming increasingly favours government interests over even third party legal rights. This creates significant uncertainty for the market, to the detriment of the DNS as a whole. Brand owners, commercial and non-commercial domain name registrants, new gTLD applicants and governments are particularly affected.

## What is a 'geographic name' for DNS purposes?

One explanation for the ad hoc approach to policy-making with respect to geographic names is the difficulty of defining the term with any precision. Geographic names take many forms: just at the national level there are long-form ('United States of America'), short-form or common usage ('United States'), shorter colloquial names ('America'), acronyms ('US' and 'USA'), and others, along with their translations in other languages. At the sub-national or supra-national levels, further questions arise as to not only the form of the name but the proof of its existence. The gTLD Applicant Guidebook, the principal policy instrument to which all new gTLD applicants in 2012 were bound, incorporated a wide variety of concepts within 'country or territory names', which were excluded from the application program and defined as:

- (i) An alpha-3 code listed in the ISO 3166-1 standard;
- (ii) A long-form name listed in the ISO 3166-1 standard, or a translation of the long-form name in any language;
- (iii) A short-form name listed in the ISO 3166-1 standard, or a translation of the short-form name in any language;

- (iv) The short- or long-form name association with a code that has been designated as 'exceptionally reserved' by the ISO 3166 Maintenance Agency;
- (v) A separable component of a country name designated on the 'Separable Country Names List,' (a list developed by ICANN and included as an Annex to the *gTLD Applicant Guidebook*) or a translation of a name appearing on the list, in any language;
- (vi) A permutation or transposition of any of the names included in items (i) through (v)/ Permutations include removal of spaces, insertion of punctuation, and addition or removal of grammatical articles like 'the'. A transposition is considered a change in the sequence of the long or short-form name, for example, 'RepublicCzech' or 'IslandsCayman'.
- (vii) A name 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.

Other 'geographic names' that required the demonstration of government support or non-objection were defined as follows:

1. 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.
2. An application for a city name, where the applicant declares that it intends to use the gTLD for purposes associated with the city name.
3. 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.
4. An application for a string listed as a UNESCO region or appearing on the 'Composition of macro geographical (continental) regions, geographical sub-regions, and selected economic and other groupings' list.

In late 2013, a Study Group was formed within ICANN (specifically, the ccNSO, which deals with country code top-level domain administration) to identify current uses of country and territory names within the DNS. This group reported on various efforts in the Internet community prior to and including the current new top-level expansion policy set out in the gTLD Applicant Guidebook to develop a definitive list or definition of 'geographic name'. The volume and complexity of issues raised by such a task led to the recommendation of the establishment of a Working Group to investigate 'the feasibility of developing a consistent and uniform definitional framework' that would apply across ICANN DNS policy-making efforts. (ccNSO 2013) The definitions, agreed upon for current expansion purposes through the gTLD Applicant Guidebook, set an exceptionally broad precedent upon which to build future policy, capturing names of businesses (Virgin, Iceland), names of products, in particular food and beverage products associated with and protected by a geographical indication (Champagne, Parma), and terms with other, non-geographic meanings (Turkey/turkey). These definitions expand significantly upon the level of protection afforded country and territory names established with the launch of the .info TLD; the issues

discussed below suggest that further expansion is inevitable but puts ICANN policy in conflict with international law.

## Issues for brand owners

ICANN's new gTLD policy framework is significant in many ways, not least its heightened mandatory mechanisms to protect trademark rights. In addition to implementing the UDRP and a new rapid-relief procedure, 'Uniform Rapid Suspension', all new gTLDs are required to launch with two targeted mechanisms in place: a 'sunrise' registration period, during which trademark holders have priority, and a 'Trademark Claims' period, during which notice of existing trade mark rights is provided to registrants and notice of matching registrations provided to rights holders. (Forrest 2013b) The ICANN-developed technical and operational requirements for implementing these mechanisms make explicit that '[r]egistration of domain names in the TLD during the Sunrise Period MUST be restricted to' verified trade marks; Registry Operators intending to deviate must 'apply to IANN for approval to conduct a registration program not otherwise permitted'. (ICANN 2013b) Reflecting the trend towards heightened recognition of government interests in geographic names, special consideration is given in these requirements to geographic new gTLDs, the applicants of which are encouraged to cooperate with intellectual property interests within ICANN (as represented through the Intellectual Property Constituency) to develop a list of names that may be prioritised over trademark rights during or before the sunrise period.

A wide range of exceptions are envisaged by the launch plans set out in geographic gTLD applications, such as reserving names related to government departments and initiatives, reserving geographically significant place and street names, prioritising registrants involved in the promotion of the new gTLD, and granting priority on the basis of an existing registration in an existing gTLD. Each of these proposals has a significant impact upon brand owners' rights to the extent that these overlap with or could be construed as a geographic name.

Two geographic brand owners' rights, and thus their future business models, in particular have become entangled in the convoluted ICANN geographic name policy web: Amazon and Patagonia. Each of these companies applied for a new gTLD comprised of their trading name, which each had registered and used as a trade mark in various jurisdictions around the world. Governmental Advisory Committee 'Early Warnings' were issued to each applicant articulating an expectation of peoples inhabiting geographic regions associated with these names to identify themselves by these names (GAC 2012a; GAC2012b). Patagonia Inc. withdrew its application soon after issuance of the 'Early Warning', (Patagonia) while Amazon, Inc. opted to defend its application, the progression of which depends upon a

decision by ICANN's Board of Directors to accept or reject GAC Advice recommending rejection. (GAC 2013a) The Board of Directors is not obliged to follow GAC advice, however, ICANN's Bylaws require at Article XI that this 'be duly taken into account', and further, 'it shall so inform the Committee and state the reasons why it decided not to follow that advice.' The GAC and Board are then obliged as a next step to 'find a mutually acceptable solution'. (ICANN 2012b)

The decision of the Board of Directors will be a watershed moment for the DNS and the worldwide Internet community. Rejection puts ICANN at odds with international law, as discussed further under the heading 'Issues for governments', below, in that it prioritises government interests in geographic names - which are not protected under international law - over trade mark rights - which are protected under international law. Such a decision will have the effect of preventing future non-government initiatives for any geographically associated top-level domain name; companies such as Patagonia and Amazon, whose names do not even fall within ICANN's carefully crafted, Internet community-agreed definition of 'geographic name', need not apply in future rounds. Approval, by contrast, puts ICANN at odds with the GAC and the now decade-long policy trend commenced with the launch of .info to restrict non-government use of geographic names.

## Issues for domain name registrants

All new gTLD Registry Operators are required to restrict registration of country and territory names as domain names. This may significantly hinder new .brand TLDs, many of which plan to use the domain for internal purposes only, from creating a logical structure that follows the company's geographic footprint. For example, despite the fact that it would not be available to the general public and would be entirely unlikely to cause confusion, the domains `canada.yahoo` and `china.toyota` cannot be registered. User confusion is equally unlikely in the case of a generically termed TLD, for example `australia.cars` or `japan.wedding`, yet these registrations are likewise prohibited by the Registry Agreement into which all new gTLD Registry Operators must enter with ICANN. (ICANN 2013a)

GAC Advice to the ICANN Board extends beyond these express requirements to other categories of geographic name, recalling the breadth of the definitions set out in the gTLD Applicant Guidebook. In its most recent Communiqué following the 48th public ICANN meeting in Buenos Aires, Argentina, for example, the GAC advised that 'appropriate safeguards against possible abuse' are needed in the .wine and .vin proposed new gTLDs. (GAC 2013b) Such safeguards would presumably restrict registration of many, if not most, of the most desirable domain names in these TLDs, but agreement as to the scope and nature of

such safeguards is difficult if not impossible to reach. As the Communiqué appropriately notes:

The current protections for geographical indications are the outcome of carefully balanced negotiations. Any changes to those protections are more appropriately negotiated among intellectual property experts in the World Intellectual Property Organization and the World Trade Organization. (GAC 2013b)

The clearly non-committal wording of the Communiqué exposes the lack of agreement on this matter amongst GAC members, but their willingness to observe international law is remarkable, particularly in the face of attacks which lack of support in international law against such strings as .amazon and .patagonia, as discussed in the next section.

## Issues for governments and their citizens

Government motivation in restricting access to geographic names in the DNS is frequently stated as being the protection of Internet users against confusion; users are likely, it is argued, to wrongfully associate any geographic name with the named territory and therefore assume that a related government is responsible for, affiliated with or otherwise endorses the domain and any information accessible through it. Formal studies of this have yet to be mentioned in ICANN policy development processes to support such concerns.

Challenge processes were put into place in the gTLD Applicant Guidebook, including a mechanism whereby members of a community could object to a new gTLD application on the basis of a string's impact on community identity. Identity was key to standing on this objection ground, which was available only to '[e]stablished institutions associated with clearly delineated communities' with a strong association to the applied-for string. (ICANN 2012a) Further, objectors were required by the gTLD Applicant Guidebook to demonstrate 'substantial opposition' within the affected community. The evidentiary burden proved too great for this objection to be of significant use to communities that identify along geographic lines.

The second basis upon which governments call for restrictions on geographic names is claims to rights in such names, yet in 2001, the World Intellectual Property Organization ('WIPO') reported that the principal international treaty on the protection of intellectual property, the Agreement on Trade Related Aspects of Intellectual Property Rights (the 'TRIPS Agreement'), did not expressly recognize governments' rights in geographic names. (WIPO 1999) UDRP decisions involving government names reached over the years since are consistent with this position and indeed the requirements of UDRP itself offer no support for per se prioritisation of government interests. The experience of the registrant of *andalucia.com*, discussed in detail in '*andalucia.com Revisited*' in this issue, is instructive



for private parties facing government challenges. In more than a decade of UDRP decisions, panels have repeatedly rejected governments' claims, as advanced in a well-known case by the government of Puerto Rico in a dispute with a company called Virtual Countries, to "better rights or more legitimate interests" than private parties. (Puerto Rico Tourism Company v. Virtual Countries, Inc.) Such prioritisation is equally unsupported by the Uniform Rapid Suspension procedure and the sunrise registration period, both rights protection mechanisms that must be implemented in new gTLDs.

Governments' claims to rights in geographic names have subsequently been demonstrated to lack recognition under other bases of international law, including trade law, unfair competition, principles of sovereignty and human rights law. (Forrest 2013a) Challenges such as the GAC's Early Warning against Patagonia, Inc.'s application for .patagonia lack legal basis and can only diminish applicants' confidence in the TLD expansion process when existing legal rights are usurped by such legally immaterial facts as:

PATAGONIA is the name of the south part of Argentina, comprising six provinces of the country. The region is globally known by its name, as a major tourist destination, it is an important region of Argentina because of the importance of mining, oil and agriculture industries and several other activities. It is the home of a vibrant community. (GAC 2012a)

Significant resources have now been expended by ICANN (thus depleting resources that would otherwise benefit the system as a whole), new gTLD applicants (who have agreed to participate on the basis of express requirements and guidelines as agreed by the Internet community) on challenges to new gTLD applications that do not fall within the definition of 'geographic name' set out in the community agreed policy framework to which all new gTLD applicants agreed to submit. While it may be politically convenient to the GAC to resort to the complexities of international legal treaty negotiation in relation to geographical indications' use in the DNS, reference to international law is not a convenience but a necessity.

## Conclusion

Geographic naming issues in the DNS are no longer merely the concern of registrants of domain names such as andalucia.com. The expanding definition of 'geographic name' affects businesses, trade mark holders and Internet users.

## References

Bettinger, Torsten (ed). 2005. *Domain Name Law and Practice: An International Handbook*. Oxford: Oxford University Press.



- ccNSO. 2013. 'ccNSO Study Group on the Use of Country and Territory Names: Final Report'. [Internet] Published 2 July 2013. Accessed 7 February 2014. Available from <http://ccnso.icann.org/workinggroups/unct-final-02jul13-en.pdf>.
- Forrest, Heather. 2013a. Protection of Geographic Names in International Law and Domain Name System Policy. Alphen aan den Rijn, The Netherlands: Kluwer Law International.
- Forrest, Heather. 2013b. 'Rights Protection Mechanisms in New gTLDs: The multi-stakeholder Internet governance model at work'. 63(2) Telecommunications Journal of Australia. <http://doi.org/10.7790/tja.v63i3.427>
- Governmental Advisory Committee ('GAC'). 2001. 'Meeting 10 Communique: Montevideo 7-8 September 2001'. [Internet]. Accessed 7 February 2014. Available from <https://gacweb.icann.org/display/gacweb/GAC+10+Meeting+Montevideo%2C+Uruguay+-+7-8+September+2001>.
- GAC. 2012a. 'GAC Early Warning: Submittal Patagonia-AR-78254'. Issued 20 November 2012. [Internet] Accessed 7 February 2014. Available from <https://gacweb.icann.org/download/attachments/27131927/Patagonia-AR-78254.pdf?version=1&modificationDate=1353465809000&api=v2>.
- GAC. 2012b. 'GAC Early Warning: Submittal Amazon-BR-PE-58086'. Issued 20 November 2012. [Internet] Accessed 7 February 2014. Available from <https://gacweb.icann.org/download/attachments/27131927/Amazon-BR-PE-58086.pdf?version=1&modificationDate=1353452622000&api=v2>.
- GAC. 2013a. 'GAC Communiqué - Durban, South Africa'. [Internet]. Published 18 July 2013. Accessed 7 February 2014. Available from <https://gacweb.icann.org/display/GACADV/2013-07-18-Obj-Amazon>.
- GAC. 2013b. 'GAC Communiqué - Buenos Aires, Argentina'. [Internet]. Published 20 November 2013. Accessed 7 February 2014. Available from: <https://gacweb.icann.org/display/gacweb/Meeting+48%3A+Buenos+Aires%2C+Argentina>.
- NTIA. 1998. National Telecommunications and Information Administration of the United States Department of Commerce. 1998. 'Management of Internet Names and Addresses'. 63 Federal Register 31,741, 31,745 (10 June 1998) (White Paper). ('NTIA').
- ICANN. 1999. Uniform Domain Name Dispute Resolution Policy. [Internet] As approved by ICANN on October 24, 1999. Accessed 7 February 2014. Available from <http://www.icann.org/en/help/dndr/udrp/policy>.
- ICANN. 2012a. 'New gTLD Applicant Guidebook'. [Internet]. Released online 4 June 2012. Accessed 19 March 2013. Available from: <http://newgtlds.icann.org/en/applicants/agb>.
- ICANN. 2012b. 'Bylaws for the Internet Corporation of Assigned Names and Numbers, a California Non-Profit Public Benefit Corporation, as last amended 20 December 2012'. [Internet]. Accessed 19 March 2013. Available from: <http://www.icann.org/en/about/governance/bylaws#AnnexA>.
- ICANN. 2013a. 'Base Registry Agreement'. Updated 20 November 2013. Accessed 7 February 2014. Available from <http://newgtlds.icann.org/en/applicants/agb/agreement-approved-20nov13-en.pdf>.
- ICANN. 2013b. 'Trademark Clearinghouse Rights Protection Mechanism Requirements'. [Internet]. Published 30 September 2013. Accessed 7 February 2014. Available from

<http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-30sep13-en.pdf>.

Puerto Rico Tourism Company v. Virtual Countries, Inc., WIPO Case No. D2002-1129. Apr. 14, 2003. Available from <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-1129.html>.

World Intellectual Property Organization (WIPO). 1998. 'Interim Report of the WIPO Internet Domain Name Process, The Management of Internet Names and Addresses: Intellectual Property Issues'. [Internet]. Published 23 December 1998. Accessed 7 February 2014. Available from <http://www.wipo.int/amc/en/processes/process1/rfc/3/index.html>.

WIPO. 1999. 'Final Report of the WIPO Internet Domain Name Process: The Management of Internet Names and Addresses: Intellectual Property Issues'. [Internet]. Published 30 April 1999. Accessed 19 March 2013. Available from <http://www.wipo.int/amc/en/processes/process1/report/index.html>.

ZookNIC. 2008. 'History of gTLD domain name growth'. Available from: <http://www.zooknic.com/Domains/counts.html>

**Cite this article as: Forrest, Heather Ann. 2014. 'Geographic Internet domains: Challenges for the developing DNS'. *Australian Journal of Telecommunications and the Digital Economy* 2 (1): 22.1-22.10. DOI: <http://doi.org/10.7790/ajtde.v2n1.22>. Available from: <http://telsoc.org/journal>**