Work Track 5 meeting

28 November 2018

Agenda

1. Welcome/Agenda Review/SOI Updates
2. Initial Report - Outstanding Items
3. AOB

Welcome/Review Agenda/SOI Updates

Agenda Item #1

Initial Report Outstanding Items

Agenda Item #2

Recommendations - Page 12

- Current text of Preliminary Recommendation 1: “As described in recommendations 2-9, Work Track 5 recommends, unless or until decided otherwise, maintaining the reservation of certain strings at the top level in upcoming processes to delegate new gTLDs. As described in recommendations 10-13, Work Track 5 recommends, unless or until decided otherwise, requiring applications for certain strings at the top level to be accompanied by documentation of support or non-objection from the relevant governments or public authorities, as applicable.”

- Comment: Greg Shatan “What does as applicable refer to?” [Greg had previously requested adding “some or all” after the word “requiring” in the final sentence. Greg stated: “This takes into account the “intended use” aspect.” Some members had expressed discomfort with that edit and suggested adding “as applicable” at the end of the sentence instead.

- Staff suggestion: “Remove “as applicable” and add a sentence “In these recommendations, non-capital city names only require documentation of support/non-objection if the applicant intends to use the gTLD for purposes associated with the city name.”

Recommendations - Page 16

- In Preliminary Recommendation 8, there is currently a sentence: “Permutations and transpositions of alpha-3 codes listed in the ISO 3166-1 standard should be allowed.”

- Comment: Justine Chew suggests changing this sentence to “Strings resulting from permutations and transpositions of alpha-3 codes listed in the ISO 3166-1 standard should be allowed.” Justine states: “After all those will no longer be alpha-3 codes.”

- Staff note: This can be changed if the WT agrees. Note that the original text mirrors the way the 2012 Applicant Guidebook referred to permutations and transpositions.

Deliberations - Page 33

- Bullet prefaced by “some believe that” states “National and local law providing protection for geographic names does not give governments rights beyond those of other stakeholders in the context of the New gTLD Program, including the application process. National and local laws only apply in the jurisdiction where the applicant is located, therefore Work Track 5 should look to international law as a basis for any recommendations related to geographic names.”

- Comment: Ann-Catherin Marcussen “The question of jurisdiction and the applicability of national law, is much more complicated than stated in this bullet point, and I suggest that it should be modified; it is not given that it will always be the national law of the _applicant_ that will be applicable in a possible legal dispute concerning a part of an application for a next-round gTLD-string.”

- Staff suggestion: added footnote “Some believe that the question of jurisdiction and the applicability of national law is more complicated than stated in this bullet point. From this perspective, it is not given that it will always be the national law of the applicant that will be applicable in a possible legal dispute concerning a part of an application for a next-round gTLD-string.”

Deliberations - Page 34

- Text: Bullet prefaced by “some believe that” states ““Monopolization” of a city name by private parties is forbidden under laws pertaining to business names and trademark registration in some jurisdictions.” [footnote on the word monopolization reads “One Work Track member stated that this is a term with a specific meaning in antitrust/competition law, and it is not used properly in this context. Note that the point is written as expressed by another Work Track member, and therefore the Initial Report seeks to reflect the point as it was raised.”]

- Comment:
  - Justine Chew: “How about just “Exclusive use of a city name …”? If change considered too drastic then I’m fine with the existing footnote.
  - Ann-Catherin Marcussen: “I suggest to add which jurisdiction this word has specific legal meaning – in the text or in the footnote – so that it becomes clear that the word “monopolization” may have other legal meaning in for example European legislation.”

- Staff note: Is there any agreement in the WT about what changes should be made to the above text, if any, at this point?

Deliberations - Page 34

- Text: Bullet prefaced by “some believe that” states “Rights granted to geographic locations to protect geographic names are qualitatively different than intellectual property rights. In this view, civil rights are more general in scope and therefore more significant.”

- Comment:
  - Ann-Cathrin Marcussen: “I am not sure I understand the purpose of adding the last sentence. I suggest that the sentence should be put into a separate bullet-point to better separate the meaning of the original statement from the suggested one.”
  - Greg Shatan: Suggested edit: “In this view, rights granted to geographic locations to protect geographic names are “civil rights,” and civil rights are more general in scope and therefore more significant.”

- Staff suggested edit attempting to incorporate feedback from both comments above while retaining original meaning:
  - “Rights granted to geographic locations to protect geographic names are civil rights, which are qualitatively different than intellectual property rights.”
  - Civil rights are more general in scope than intellectual property rights and therefore more significant.”

Deliberations - Page 35 – 36 (1/3)

- Original Text: “TLDs are a unique resource. Some Work Track members have contrasted this unique quality of TLDs with the use of names under trademark law. From this perspective, under trademark law, the principles of specialty and of trademark "fair use" apply, according to which it is possible for two brands to register trademarks for the same term in the same jurisdiction, as long as no confusion or infringement pursuant to the law arises. In this view, the DNS is different because “parallel use” is not possible. In other words, if a string corresponding to a geographic term is delegated to one party, others who have an interest in that string are prevented from using it, potentially for a significant period of time or permanently.”

- Comments summary: Greg Shatan raised concerns about the accuracy of this text and proposed edits. Jorge Cancio proposed additional edits to the text. Greg Shatan proposed additional footnotes.

- Staff note: Staff attempted to add both edits suggested by Jorge Cancio and Greg Shatan. Please see next slide for adjusted text.

Deliberations - Page 35-36 (2/3)

- New Text: “TLDs are a unique resource. Some Work Track members have contrasted this unique quality of TLDs with the use of names under trademark law. From this perspective, under trademark law, a sign is always registered in relation to certain goods and/or services (principle of specialty), so it is possible for two brands to register trademarks for the same term in the same jurisdiction, as long as no confusion or infringement pursuant to the law arises. [1] In addition, mechanisms [2] [3] exist in domestic trademark laws to allow third parties to use descriptive terms (like for instance geographic terms, which are generally descriptive for the origin of goods and services) [4], even if these terms are part of a registered trademark. In this view, the DNS is different because “parallel use” is not possible. In other words, if a string corresponding to a geographic term is delegated to one party, others who have an interest in that string are prevented from using it, potentially for a significant period of time or permanently.”

[1] Some Work Track members believe that it would be a more accurate reflection of the law to state: “. . . under trademark law, it is possible for two brands to register trademarks for the same term in the same jurisdiction for unrelated goods and services, as long as no confusion or infringement pursuant to the law arises.”

[2] Certain jurisdictions apply a disclaimer on descriptive terms. The "fair use" exception used in certain jurisdictions allows a trademarked word or phrase to be used by a third party in a non-trademark sense, as a descriptor of the third party’s goods or services or their geographic origin. Under other jurisdiction, the protection granted by trademark law does simply not extend to descriptive terms.

(see additional footnotes on the next slide)

Deliberations - Page 35-36 (3/3)

[3] With regard to the prior footnote: Some Work Track members believe that it would be a more accurate reflection of the law to state “Certain jurisdictions may require a disclaimer in a trademark registration when a descriptive term is used generically as an element of the mark." Also, some Work Track members believe that it would be a more accurate reflection of the law to state: “In other jurisdictions, the protection granted by trademark law does simply not extend to descriptive terms when used in connection with the goods and/or services they describe. However, trademark protection may be extended to a descriptive term when it acquires distinctiveness through use and promotion of the brand.”

[4] Some Work Track members believe that it would be a more accurate reflection of the law to state: "In addition, mechanisms exist in domestic trademark laws to allow third parties to use descriptive terms in a non-trademark sense (like for instance geographic terms, which are geographically descriptive when the goods and services originate from that place, the place is generally known to the public, and the public would make an association between the goods or services and the place named in the mark), even if these terms are part of a registered trademark.”

Deliberations - Page 50 (1/2)

- Text: a series of bullet points regarding the future treatment of alpha-3 codes.

- Comments:
  - Ann-Catherin Marcussen: Based on the discussions we have had I suggest to add a separate bullet-point something like this: “A large number of, if not almost all, countries/nations have political, cultural and societal or even legal reasons for the need to be in charge of the use of the alpha-3 codes.” I also suggest to reflect somewhere in this section the view taken by some WT members that the principle of subsidiarity/sovereignty would/should be applied to a potential use of these 3.letter-codes. Even if there are no legal rights, there are other kind of rights, like political, territorial and local needs.”
  - Greg Shatan “If these points are added, the following counterpoints need to be added as well: 1. “Other Work Track members question the validity of this expansive claim, made without evidence, particularly as it regards TLDs.” 2. “The “principle of subsidiarity/sovereignty” is not a principle of ICANN policy-making. The question of whether and how these would ever be applied to ICANN policy, and the extent to which they are consistent or inconsistent with ICANN policy-making is beyond the scope of this discussion.”

(continued on the next slide)

Deliberations - Page 50 (2/2)

Staff suggestion: add the following bullets to the relevant sections (please see document for details). Each is prefaced with “some believe that”:

- A large number of, if not almost all, countries/nations have political, cultural and societal or even legal reasons for the need to be in charge of the use of the alpha-3 codes.
- Regarding the point “A large number of, if not almost all, countries/nations have political, cultural and societal or even legal reasons for the need to be in charge of the use of the alpha-3 codes,” some Work Track members question the validity of this claim, particularly as it regards TLDs, and invite Work Track members to provide supporting evidence.
- The principle of subsidiarity/sovereignty should be applied to a potential use of these alpha-3 codes.
- The “principle of subsidiarity/sovereignty” is not a principle of ICANN policy-making. The question of whether and how these would be applied to ICANN policy, and the extent to which they are consistent or inconsistent with ICANN policy-making is beyond the scope of this discussion.

Deliberations - Page 79

- Text: “Proposal 32: “Apply a clear and unambiguous rule that any geographic term that is not explicitly and expressly protected is unprotected. No objection or non-consent can be used to stop its delegation.”

- Comments:
  - Justine Chew: I’m not comfortable with this sentence – are we not talking only about letters of support/non-objection and application? There are still string confusion etc to be considered. Suggest replacing it with “A lack of letter of support/non-objection alone will not be a cause to suspend hinder or suspend an application for such unprotected term.”
  - Alexander Schubert: Suggested altering the proposal to state “A brand or generic term based application that is NOT a city, subnational division, unesco region would simply pass the geographic names review WITHOUT any further investigation. So it would not be “impacted” by it. However a non-capital city name would be always impacted, as the panel had to start evaluating the application – trying to find out whether the applicant intends to use it “primarily for purposes associated with the city name”.

- Staff note: It would be helpful to get feedback from the author of this proposal on any additional suggested edits. At this time staff has not proposed any edits.

Any Other Business

Agenda Item #3