



Intellectual Property Constituency (IPC) Comment on Release of Country and Territory Names within the .EMERCK, .HAMBURG and .BERLIN TLDs

April 14, 2015

A. Introduction

The GNSO Intellectual Property Constituency (“IPC”) appreciates this opportunity to comment on a proposed amendment to the .EMERCK, .HAMBURG and .BERLIN Registry Agreements, to implement requests submitted through the Registry Services Evaluation Policy (“RSEP”) process to allow the registration of all country and territory names currently required to be reserved by Section 4 of Specification 5 of the Registry Agreement. See <https://www.icann.org/public-comments/emerck-hamburg-berlin-amendment-2015-03-02-en>.

B. The .EMERCK Request

The IPC maintains its historic position supporting the release of country and territory names within .BRAND TLDs, and for the reasons reiterated below, extends this same support to the current .EMERCK request.

On June 11, 2013, the IPC commented on the Proposed Final New gTLD Registry Agreement (April 29, 2013 version), noting:

Trademark owners (dot.brands) already regularly use geographic names to target specific consumers and audiences around the world. dot.brand TLDs are unique in that they will be restricted spaces, i.e., they will exercise a degree of control over domain name registrations within their respective TLDs. Thus, it seems unnecessary to rigidly apply current blanket restrictions against all second-level country codes and country names within restricted dot.brand registries. Consumers would benefit from trusted use of geographic names at the second level (e.g., <canada.brand> or <uk.brand>). It would be inefficient to force .brands to individually reach agreement with ICANN and each respective government and country-code manager. As an alternative to ICANN recognizing an exemption to Registry Agreement §2.6 and Specification 5, ICANN should define a clear and timely path forward for .brands to release geographic names at the second level.¹

¹ See IPC Comments on the Proposed Final New gTLD Registry Agreement (June 11, 2013).

In addition, on January 9, 2014, the IPC commented generally on the proposed Specification Thirteen to the ICANN Registry Agreement (December 6, 2013 version), observing that:

.Brand TLDs offer the potential benefits of:

- Promoting global trade and trust by adapting to various business models of trademark holders;
- Guarding consumers from potential harm through the reduction of phishing and fraud;
- Protecting and honoring intellectual property that conforms to international standards while not expanding any intellectual property right beyond that granted by the national governments issuing such rights;
- Encouraging innovation within the new gTLD namespace; and
- Allowing rights holders (for profit and non-profit) to provide maximum value and choice to their customers and constituencies while maintaining strict quality control standards applicable to maintaining trademarks.²

In its November 10, 2014 comment in support of the RSEP from .NEUSTAR to release country and territory names, the IPC also opined that:

New .BRAND TLDs will own all domains associated with the TLD, which will more tightly and responsibly control the registration and use of such names and thereby significantly minimize the opportunity for confusion, intellectual property violations, and other potential abuse.³

Consistent with its previous comments, the IPC supports Registry Operator Merck KGaA's RSEP request, and continues to support more broadly the release of country and territory names in .BRAND TLDs, given the unique nature of these TLDs. The ability to use country and territory names at the second level in .EMERCK, or any .BRAND TLD, serves the purposes and goals of new .BRAND TLDs by providing user-friendly, safe and secure geographically-targeted spaces for consumer-brand online interactions, which aligns more broadly with new gTLD program goals of consumer trust, choice, and competition in the online global marketplace.⁴

² See IPC Comments on: Proposal for a Specification 13 to the ICANN Registry Agreement to Contractually Reflect Certain Limited Aspects of ".Brand" New gTLDs (January 9, 2014).

³ <http://forum.icann.org/lists/comments-ctn-release-neustar-19sep14/pdfXhbnhe7e4Q.pdf>.

⁴ See New gTLD Applicant Guidebook, Version 2012-01-11, Preamble (stating that one of the primary goals of the new gTLD program is to "foster diversity, encourage competition, and enhance the utility of the DNS").

Furthermore, nearly all legacy and sponsored TLDs, including .COM and .NET, are already permitted to freely register country and territory names at all available levels to any registrant for any purpose. New .BRAND TLDs, including .EMERCK, which will own all domains associated with the TLD, will much more tightly and responsibly control the registration and use of such names and thereby significantly minimize the opportunity for confusion, intellectual property violations, and other potential abuse. .EMERCK should therefore be afforded the same privilege to freely register country and territory names in its .BRAND TLD.

For these reasons, the IPC supports the proposed amendment to the .EMERCK Registry Agreement.

D. The .BERLIN and .HAMBURG Requests

The IPC also comments on the RSEP requests submitted by dotBERLIN GmbH & Co. KG and Hamburg Top-Level Domain GmbH (together, the “Registry Operators”) for the release of country and territory names in the .BERLIN and .HAMBURG TLDs, respectively. Because these TLDs are geographic rather than .BRAND, the considerations outlined above do not apply to the same extent. However, as both Registry Operators have the backing and support of the municipalities of Berlin and Hamburg, respectively, there will likely be greater security, stability, and safety measures implemented to avoid abuse of country and territory names at the second level in these TLDs.

Further, given the geographic nature of these TLDs, user confusion as to any connection between a government and a domain name incorporating the corresponding country or territory name is likely to be low. For example, TURKEY.BERLIN is unlikely to confuse users into believing that the domain name is somehow associated with the official government of Turkey; rather, Internet users will likely discern that the domain name correlates to a Turkey-related resource pertaining to the City of Berlin or its citizens. That said, the IPC recognizes that certain country and territory names with a nexus to the geographic area reflected in the TLD could potentially cause confusion, such as GERMANY.BERLIN. In such limited cases, the IPC would approve of a limited ability of these governments to object to such use (in the event the name was not already registered to that government).

Otherwise, the IPC is unaware of any national or international law giving ownership or priority over country and territory names to governments. Rather, these names are used for purposes of free speech, and often correspond to trademarks (such as CANADA, CARIBBEAN, TEXAS, etc.).

Furthermore, as noted above, nearly all legacy and sponsored TLDs, including .COM and .NET, are already permitted to freely register country and territory names at all available levels to any registrant for any purpose. New geographic TLDs, including .BERLIN and .HAMBURG, should therefore be afforded the same privilege to freely register country and territory names.

For these reasons, the IPC generally supports the proposed amendment to the .BERLIN and .HAMBURG Registry Agreements, subject to the limited caveat discussed above.

E. Conclusion

The IPC supports the proposed amendment to the .EMERCK Registry Agreement and reiterates its historic support for the ability of all .BRAND TLDs to freely register country and territory names at all available levels. The IPC also supports in general the proposed amendment to the .BERLIN and .HAMBURG Registry Agreements, and the general ability of geographic TLDs to register country and territory names at all levels, although it recognizes that a select few such names may be confusing in the event of a logical nexus between the country or territory and the city represented in the TLD, and would approve of a limited ability of these governments to object to such use.

Respectfully submitted,

Intellectual Property Constituency