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

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PROPOSAL BY THE DELEGATIONS OF GEORGIA, ICELAND, INDONESIA, ITALY, JAMAICA, LIECHTENSTEIN, MALAYSIA, MEXICO, MONACO, PERU, SENEGAL, SWITZERLAND AND THE UNITED ARAB EMIRATES

Document prepared by the Secretariat

In a communication dated March 6, 2018, the Delegations of Georgia, Iceland, Indonesia, Italy, Jamaica, Malaysia, Mexico, Monaco, Peru, Switzerland and the United Arab Emirates transmitted to the International Bureau of the World Intellectual Property Organization (WIPO) the proposal contained in the Annex to the present document.

In a communication dated April 13, 2018, the Delegation of Liechtenstein requested to be added to the list of co-sponsors of the proposal.

In a communication dated April 18, 2018, the Delegation of Senegal requested to be added to the list of co-sponsors of the proposal.

[Annex follows]

The Delegations of GEORGIA, ICELAND, INDONESIA, ITALY, JAMAICA, LIECHTENSTEIN,
MALAYSIA, MEXICO, MONACO, PERU, SENEGAL, SWITZERLAND
and UNITED ARAB EMIRATES

REQUEST

the SCT to invite the WIPO General Assembly to adopt the following

PROPOSAL

CONCERNING THE PROTECTION OF COUNTRY NAMES AND GEOGRAPHICAL NAMES OF NATIONAL SIGNIFICANCE

A. OBJECTIVES AND RATIONALE

Registering the name of a sovereign nation or geographical names of national significance by private owners results in a monopolisation of common assets by these private interests. Such misappropriation of national assets has negative consequences. For examples, firms from a country may be prevented from using the name of their own country to market their goods or services, or the reputation of a country may be damaged by the behaviour of the owner of such a registered sign. The same problem may occur in the Domain Name System (DNS). Once assigned, a top-level domain is unique. Allowing private companies to register geographic names as a top-level domain results in the monopolisation of these names, thereby depriving the concerned community from the possibility of using such names.

Country names and geographical names of national significance shall be protected against their delegation as top-level domain names in the DNS and their registration as distinctive signs, such as trademarks, if the sign consists exclusively of such names or if it would amount to a monopolisation of the name concerned.

B. PROTECTION OF COUNTRY NAMES AND GEOGRAPHICAL NAMES OF NATIONAL SIGNIFICANCE

1. IN THE AREA OF TRADEMARKS

The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) has been working on the protection of country names in the context of trademarks since its twenty-first session.

Within this framework, the SCT members have shared information regarding national law and legal practices. On the basis of these contributions, the Secretariat drafted a reference document in November 2015¹. According to this document, country names are excluded from registration as word marks in the majority of countries, as they are deemed to be descriptive and do not distinguish the products and services of one company from those of another company.

This indirect protection of country names against monopolisation by an individual mark is highly relative in its effectiveness. Iceland, for example, has learned this lesson to its detriment, sharing its experience in a note issued at the SCT's thirty-seventh session².

Furthermore, indirect protection does not prevent improper use of a country name deemed to be unknown or generic in the country where the application for the trademark registration has been made.

2. WITHIN THE FRAMEWORK OF THE DOMAIN NAME SYSTEM (DNS)

The Internet Corporation for Assigned Names and Numbers (ICANN) is planning to open a second round of registration for new generic top-level domains (gTLDs)³ which is expected to take place in 2020.

Two working groups were set up at ICANN to evaluate the conditions of protection for country names and geographical names within the scope of this second round of top-level domains registration⁴. It is clear from these discussions that the protection of country names and other important geographical names, such as capital cities, towns and regions (states in federal countries, provinces and departments as well as the UNESCO regions), are being challenged by special interest groups.

Within the ICANN's decision-making process, the interests of the countries are expressed through the Governmental Advisory Committee (GAC). The GAC's role is to provide advice and recommendations to ICANN's board. The board, however, is not bound by the GAC's recommendations. Therefore states have very limited means to safeguard their legitimate interests at ICANN.

In March 2007, the GAC issued advice intended to inform ICANN's board of the views of the GAC regarding public policy issues. This advice concerned new gTLDs and recommended that the inherently sensitive nature of terms with national, cultural, geographic and religious significance be respected. It also recommended that country, territory or place names, and in addition country, territory or regional language groups or descriptions of peoples, unless otherwise agreed upon by the relevant governments or public authorities, should not be allowed in the gTLD space⁵. The GAC has consistently reiterated these principles⁶, with limited effect, given its purely advisory role.

It is crucial, therefore, that the SCT continues its efforts in this area with a view that the General Assembly adopt the present proposal. The adoption of the present proposal by the WIPO General Assembly would safeguard, at the top level within the DNS, countries' sovereign rights to protect their identities and reputations as well as their legitimate public policy interests.

C. PROPOSED SOLUTION: PROTECTING NAMES ON EXISTING LISTS

In the early 2000s, at the request of several member states, WIPO launched a consultation process on internet domain names, in particular, the issue of registration of domain names that infringe upon indications of source and geographical names. Within this framework, the SCT held two special sessions in December 2001 and May 2002 and adopted the *Second Special Sessions Report* ("Report", SCT/S2/8) that recommends to protect country names against registration or use by persons with no link to the state authorities of the country in question. The Report also gave concrete guidance and established principles for the recommended protection⁷. A large majority of delegations approved these recommendations⁸. This strong support has also been noted at the WIPO General Assembly during its autumn session in 2002⁹.

The present proposal builds on the recommendations of the Report that were already supported by the SCT in 2002 and puts forward the following principles for the protection of country names:

- (i) The names of countries protected are those listed on the United Nations Terminology Bulletin for Country Names¹⁰ as well as on the standard ISO 3166-1¹¹ (alpha 2 codes and alpha 3 codes).
- (ii) Both the long or formal names and the short names of countries are protected.
- (iii) Protection covers the exact names and, in order to include misleading variations, the former name of a country, its common name, the translation and transliteration of that name, as well as the name in a short or adjectival form.
- (iv) Each country name should be protected in the official language(s) of the country concerned and in the six official languages of the United Nations.

As regards the geographical names of national significance, the present proposal also protects them based mainly on existing lists, namely:

- (i) The ISO 3166-2 list concerning regions.
- (ii) The list of sites forming part of the cultural and natural heritage (“World Heritage List”) which fall under the scope of the Convention concerning the Protection of the World Cultural and Natural Heritage¹².
- (iii) The names of capitals of the countries listed in the United Nation bulletin shall also be protected as names of national significance.

In order to give each state the possibility to obtain protection for geographical names that are not capitals, nor listed on the ISO 3166-2 list or on the World Heritage List, the present proposition suggests that each country can, within a timeframe of 18 months, notify to the WIPO Secretariat a list of geographical names with national significance according to its relevant public policy or applicable national law.

D. RELATIONSHIP TO OTHER ONGOING WORK ON COUNTRY NAMES IN THE SCT

The present proposal serves a specific purpose, namely, as mentioned in Section A, the protection of country names and geographical names against monopolisation. It thus complements the revised proposal by the Delegation of Jamaica (“Jamaican Proposal”; SCT/32/2) and the proposal of the delegations of Bulgaria, the Czech Republic, France, Germany, Hungary, Italy, Poland, Portugal, Republic of Moldova, Romania, Spain and Switzerland (“Joint Proposal”; SCT31/8/5 Rev.). The present proposal should also be considered within the context of the envisaged second round of top-level domains.

1. RELATIONSHIP WITH THE JAMAICAN PROPOSAL

The Jamaican Proposal, tabled at the SCT’s thirty-second session, seeks to define a legal framework for the use and registration of trademarks, business identifiers and domain names which consist of or contain a country name.

The Jamaican Proposal does not directly seek to prevent the monopolisation of a country name, but primarily wants to prevent the use of country names in a misleading manner, in other words, in connection with products and services that do not originate from the country concerned.

2. RELATIONSHIP WITH THE JOINT PROPOSAL

During the SCT's thirty-first session, the delegations of the Czech Republic, Germany, Hungary, Italy, Republic of Moldova and Switzerland tabled the Joint Proposal on the protection of geographical names and country names in the DNS. The delegations of France, Spain, Portugal, Poland, Romania and Bulgaria subsequently signed up as co-sponsors of the proposal.

The Joint Proposal addresses the necessity to re-examine and extend to geographical names and country names the Uniform Domain-Name Dispute Resolution Policy (UDRP) principles, which are currently limited to trade mark law.

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On the basis of the above

- I. Country names and geographical names of national significance shall be protected against their delegation as top-level domain names in the DNS and their registration as distinctive signs, such as trademarks, if the top-level domain name or the sign consists exclusively of such a name or if it would amount to a monopolisation of the concerned name.

The conditions for the registration of country names and geographical names of national significance as distinctive signs, such as trademarks, shall be determined in each country according to its national legislation.

- II. The above principle shall apply to:

1. The formal and short country names in all language versions contained in the United Nations Terminology Bulletin for Country Names.
2. Country names listed under II.1 in translations and transliterations into the national language(s) of the country where a distinctive sign is registered, and for top-level domains, into national languages of all countries.
3. The former name of a country, its common name, as well as the country name in adjectival form in the six official languages of the United Nations and the concerned country's national language(s).
3. The alpha 2 codes and alpha 3 codes as listed in the standard ISO 3166-1.
4. The geographical names of national significance, *inter alia*:
 - the name of capitals of the countries as listed in the United Nations Terminology Bulletin for Country Names in the six official languages of the United Nations and the concerned country's national language(s);
 - the names of regions such as states in federal countries, provinces and departments as listed in the standard ISO 3166-2;
 - the names of the UNESCO regions listed as World Heritage Sites; other geographical names with national significance according to the concerned country's relevant public policy or applicable national law. WIPO member states may notify a list of such names to the WIPO Secretariat within a deadline of 18 months following the adoption of this proposal by the WIPO General Assembly.

[End of Annex and of document]

¹ WIPO/STrad/INF/7.

² SCT/37/6.

³ A first round of registrations of new gTLDs took place in spring 2012. Within this framework, ICANN adopted allocation rules for its new gTLD names gathered in the gTLD Applicant Guidebook (AGB 2012).

AGB 2012 can be found here: <https://newgtlds.icann.org/en/applicants/agb>

⁴ The "GNSO New gTLD Subsequent Procedures Policy Development Process (New gTLD Subsequent Procedures Policy PDP)" and the "Cross-Community Working Group on Use of Names of Countries and Territories as Top Level Domains (CWG-UCTN)".

[Endnote continued on next page]

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⁵ GAC PRINCIPLES REGARDING NEW gTLDs, Presented by the Governmental Advisory Committee in March 28, 2007. Can be consulted here: <https://archive.icann.org/en/topics/new-gtlds/gac-principles-regarding-new-gtlds-28mar07-en.pdf>

⁶ Nairobi Communiqué in 2010, Durban Communiqué in 2013, Helsinki Communiqué in 2016 and Johannesburg Communiqué in 2017.

⁷ Document SCT/S2/8. The Report recommended the following protection for Country Name domain names: "(1) A list of Country Names should be made, using both the United Nations Terminology Bulletin 347/Rev. 1 and, as necessary, ISO Standard 3166, including both formal names and the short names of countries and any additional names by which countries are commonly known; (2) protection should cover both the exact names and misleading variations; (3) the Country Names should be protected in the official language (s) of the country concerned and in the six official languages of the United Nations; (4) the protection should be extended to all top-level domains, both gTLDs and ccTLDs; and (5) the protection should be operative against the registration or use of a domain name which is identical or misleadingly similar to a country name, where the domain name holder has no right or legitimate interest in the name and the domain name is of a nature that is likely to mislead users into believing that there is an association between the domain name holder and the constitutional authorities of the country in question." Para 210.

⁸ Document SCT/S2/8: "The Chair concluded that most delegations favored some form of protection for country names against registration or use by persons unconnected with the constitutional authorities of the country in question." Para 210.

⁹ Document WO/GA/28/7, para. 80.

¹⁰ The most recent list of country names approved by the Working Group was submitted on behalf of UNGEGN for the Tenth UN Conference on the Standardization of Geographical Names in August 2012. It is available as E/CONF.101/25 at https://unstats.un.org/unsd/geoinfo/UNGEGN/docs/10th-uncsgn-docs/econf/E_CONF.101_25_UNGEGN%20WG%20Country%20Names%20Document.pdf

¹¹ ISO 3166 is the International Standard for country codes and codes for their subdivisions established by the International Organization for Standardization (available at <https://www.iso.org/iso-3166-country-codes.html>).

¹² Convention concerning the Protection of the World Cultural and Natural Heritage adopted on 23 November, 1972, under the auspices of the United Nations Educational, Scientific and Cultural Organization (UNESCO). The WIPO considered this list as a useful instrument in this regard in its Final Report of the Second WIPO Internet Name Process. The World Heritage List as well as the ISO list have served as the basis for the allocation of rules in the AGB2012.