An international uniform dispute resolution policy regarding geographic terms is not practical at this time. A brief comparative glance at city's rights to their own names in Germany and the United States elucidates the problems with a uniform international policy. In Germany, a city has a legal right to use its name; however, no such name right exists in the United States. As a result, a German city might have a domain name right, but a U.S. city might not. Any uniform policy suggested by WIPO, therefore, would not be able to protect a German city's right without possibly contradicting U.S. law. Likewise, minimal protection that does not contradict U.S. law would not realize any protection to German cities. The result: Developing a policy at this time would be a futile exercise *unless* WIPO's goal is to create international law. In the latter case, WIPO's hope would be that member nations would bend their laws to conform to WIPO's suggestions (as adopted by the UDRP). If WIPO's ambition is to become an international law making body, then suggesting a city name dispute policy is appropriate. Otherwise, based on a quick glance at German and U.S. law, WIPO cannot suggest a meaningful city name dispute policy at this time.

In order to illustrate possible implications of expanding UDRP's scope to include geographic terms, I specifically address WIPO's Second Request for Comments ("WIPO2 RFC-2"), note 23, which regards the use of geographic terms in domain names. Section 1 summarizes a leading German case regarding a city's right to use its name as a domain name. Section 2 overviews the current U.S. state of affairs regarding city domain names. In the United States, the law is not yet clear, but very creative maneuvering would be required before a city could claim a superior right to a domain name. Section 3 describes a dispute resolution adopted by ICANN in which a city successfully enjoined a company

from using the city name as a domain name. Section 4 concludes this comment with reservations I believe WIPO should have regarding making recommendations to ICANN about geographic terms.

1. German Law: A city has a right to use its name

Under the German Civil Code, a city has a legal right to use its name.[1] The question regarding whether a city has a right to the domain name "city.de" can be resolved by determining whether having a domain name is the use of a name. In a leading German case, the Landgericht (German middle court acting as an appellate court in this case) held that a domain name is the use of a name, and therefore a city does have a right to use its name as a domain name.[2] Notably, this case deals with a ccTDL, whereas WIPO is seeking suggestions regarding gTDLs. Nonetheless, the reasoning employed by the Landgericht in this case might still apply to gTDLs. A company that operated a database containing information about the geographical region Rhein-Neckar registered the domain name "heidelberg.de."—Heidelberg is a well-known city in the Rhein-Neckar region. The company had no trademark containing the word "heidelberg," and had no legal name right to the word "heidelberg." When the city Heidelberg demanded an order for the company to cease and desist use of its domain name, the company argued that internet users do not necessarily believe "heidelberg.de" is maintained by the famous Heidelberg city. There are two other Heidelberg cities in Germany, not to mention over 400 families with that name. Moreover, internet users recognize that domain names do not necessarily reflect the identities of domain name

[1] § 12 [2] Burgerliches Gesetzbuch ("BGB"). This is part of the German civil code, and in part provides that a name holder has the right to order the cease and desist of infringing uses of his name.

owners. The German appellate court was not persuaded by the defendant's arguments. In delivering its opinion, the court first stated that it would rely on § 12 [2] BGB, which grants a party the right to order a cease and desist of infringing uses of its name—a city, of course, is a name holder. The court then evaluated whether having a domain name constituted the use of a name. Since the function of a name is to distinguish one party from the next, the distinguishing function is a name use, according to the court. And since a domain name distinguishes one party from the next, use of a domain name is certainly use of a name. Moreover, the company's use of "heidelberg.de" precluded the city from using the domain name, so the company's use infringed the city's rights. As a result, Heidelberg had the right to stop the company from using the domain name "heidelberg.de."

In Heidelberg case, the company had no rights, neither trademark nor name, in the word "Heidelberg." The German appellate court acknowledged this fact, stating that it did not need to decide what the outcome would have been had the registrant been named "Heidelberg," or had some other right to the name. While it is certain that cities have a legal right to use their names in domain names and to stop infringing uses, whose to say what happens when two parties have a legal name right to the same domain name. Either party would be infringing the other's use, so the question becomes one of who has the superior right.

Based on the Heidelberg case and observations of the case, I have a few comments regarding the recommendations WIPO should make.

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[2] Landgericht Mannheim [appellate court] 70 60/96 (1996) "heidelberg.de" (hereinafter "Heidelberg") *available at* http://www.-uni-muenster.de/Jura.itm/netlaw/heidelberg.html.

First, unlike Heidelberg, the region in which it is situated, Rhein-Neckar, does not have a legal name right.[3] So, the scope of UDRP arbitration should not, based on German law, include region names.

Second, if WIPO were to recommend a policy regarding city names to WIPO that complied with German law, the policy would state that if a city has legal title to its name, it should have domain name rights. Unfortunately, it is not clear that cities have name rights in all WIPO participating countries (discussed below). As a result, a WIPO recommendation based on name rights to a city runs the risk of lacking validity in participating countries. Also, as stated earlier, the Heidelberg case involved a "ccTDL." Had the case involved an American travel agency owning "Heidelberg.com," the case could not have been so easily resolved by a German court.

2. U.S. Law: As with a lot of U.S. law, the law on a city's right to its own name is not clear

How a U.S. court would decide in a dispute between a city and a domain name holder is not at all clear. There are no U.S. court decisions on the matter.[4] Nor does it yet seem evident that a city could claim a common law trademark, so it seems trademark law might not offer solutions in resolving the rights a city has to its name.[5] And only the most creative mind would try to argue something like misrepresentation or false personation (*e.g.*, a city is a personality, and a private individual operating "city.com" is impersonating the city). Since cities do not seem to have a clear name right, it is difficult

[3] In-person interview with Holger Hestermeyer, German citizen (Nov. 30, 2000).
[4] My search for U.S. court cases regarding disputes between municipalities/regions/states and domain name holders yielded no court cases. I conducted the search on Lexis, looking at All Fed Cases over the last two years, using the search string "domain w/1 name." I conducted the search November 30, 2000.

to find any law under which a city could file a claim to get the transfer or cancellation of "city.com." That cities do not have a clear right to use of their names is quite different from German law, so WIPO must consider the non-uniformity between U.S. and German law. Even more detrimental to increasing UDRP's breadth of scope is that, if cities in member countries have no legal name right, then UDRP cannot cancel or transfer city-name domain names. A second deeply disconcerting issue is that of "bad faith" and "abuse." WIPO intends to make recommendations regarding "bad faith" use of geographic terms in domain names, but there is also lack of definition as to what "bad faith" is. Use of some U.S. city-name URLs evinces this point.

Currently, the U.S. corporation Boulevards of America.com owns the domain names of over thirty U.S. city.coms, including high-profile cities such as San Francisco, New York, and Washington, D.C.[6] Boulevards sites all are branded with Boulevard's trademark, so customer's who visit the sites know what kind of quality to expect from the site, and all cites have the same look-and-feel.[7] The city sites "integrate advanced community features with content and commerce systems and which aims to be the leading local destination site for entertainment, information, news, e-commerce, and community."[8] Clearly, Boulevards' sites benefit from the use of the city names in their domain names, as they receive more visitors as a result. But whether Boulvards behavior is "abusive" or in "bad faith" depends on the definition of those terms. Boulevards offers a legitimate service in good faith. The sites contain Boulevards trademark in plain site at

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[5] While an arbitration panel—not a court—found that Julia Robert's name was a common law trademark, there is no indication that a city has a common law trademark.

[6] Turbotrip Lands Deal With Boulevards.com Enabling Online Hotel Bookings on 11 of the Top 15 Metropolitan Area City.com Websites, Business Wire, October 28, 1999, *available at* http://www.businesswire.com.

the top of their pages,[9] and perhaps might be a mark of quality that indicates to customers what they can expect from the site. Such uniformity in city-specific sites might even be beneficial to consumers. For these reasons, it is impossible to declare that benefiting from the name of a city is "bad faith" use and "abusive" per se. WIPO, in issuing its recommendation, needs to consider whether such a use constitutes "bad faith." I would argue that it does not, since Boulevards is trying to promote its own trademark. Moreover, there can be no "bad faith" use of a name if no one else has rights to the name, so once again , the city's name rights is at issue.

One other example of city use in a domain name is that of "boston.com." The Boston Globe newspaper owns it.[10] The Boston Globe has trademark rights in the word "boston," and would most likely get to keep its domain name under U.S. law. Under the Anticybersquatting Consumer Protection Act, Boston Globe would win because it does not use the name in bad faith.[11] Though under federal trademark law, a company can lose its use of a domain name that is confusing to customers, Boston Globe has a trademark right to use "boston.com." Finally, cities cannot register their names as trademarks under the Lanham Act, so no action under federal trademark law could lie anyway.[12] These things in mind, it does not seem likely that a U.S. court would deprive Boston Globe of the use of its domain name in favor of granting the URL to the city of Boston.

Given that U.S. law, I predict, would not find in favor of a city, a UDRP decision granting superior rights to cities would not be upheld by U.S. Courts.

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[7] *Id.*
[8] *Id.*
[9] For example, visit http://www.losangeles.com.
[10] *See* Turbotrip, *supra* note 6.
[11] Anticybersquattin Consumer Protection Act (1999), 15 U.S.C § 1125(c).

3. "Barcelona.com" To Be Taken Away From Trademark Owner and Given to City: A UDRP arbitrator's decision defines "bad faith" too broadly, and brings superiority of trademark rights into issue

A recent WIPO domain name dispute ordered a cancellation of Barcelona, Inc.'s domain name "barcelona.com."[13] The city of Barcelona, Spain filed the complaint, alleging that it had registered over 1000 trademarks since 1984 that contained the string "barcelona," *e.g.*, "teatre barcelona" and "la municipal de barcelona." Though respondent registered "barcelona.com" in 1996, the respondent did not register the trademark "Barcelona.com, Inc." until June 15, 2000, nearly a month after having received notification of the city's complaint. The respondent countered that it had rights in the domain name because everyone has a general right to register domain names. The respondent also noted that it intended to use the site to offer links to other cities named Barcelona, and to include information on Barcelona, Spain. The arbiter decided that since the city had so many trademarks containing the string "barcelona," the domain name "barcelona.com" is confusingly similar to the city's trademark. The arbitrator further found that the respondent did not have rights or legitimate interests in the domain name, and that respondent used the mark in "bad faith." The arbitrator's discussion stated that a right of interest is always subject to comparison with parties that have "better rights," and in this case, the city clearly had a strong right, whereas the respondent failed to demonstrate a legitimate interest in the name. The arbitrator further noted that anybody requiring information about Barcelona would naturally start at "barcelona.com,"

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[12] *See* Lanham Act § 2(e)(2), 15 U.S.C. § 1052(e)(2).

hence respondent was definitely taking advantage of the city's name. The logic here is a little disturbing. Clearly, if I operate a surfboard shop, registering "surfboards.com" would definitely be taking advantage of the word "surfboards" because surfers will naturally start with my URL. But I would not be operating in "bad faith" because "surfboards " is a common word that no one has property rights in. The question therefore looms: is a geographical term to be treated like a common word or not? WIPO cannot suggest that "bad faith" exists if geographic terms are treated like common words (a geographic region is more convincingly a geographic term than is a city name, as mentioned in Section 1).

The Barcelona decision blurs the line between trademarks and city names, so it is difficult to evaluate from this case whether cities have superior rights in a domain name in the absence of having registered the city name in as part of a trademark. Also, this decision does not make a clearly convincing case that a city has a superior right over all others. For example, in the United States, perhaps consumers might expect "city.gov" to be operated by a city, but not "city.com."—of course, under U.S. trademark law this is a question of fact that has not yet been resolved. For these reasons, WIPO definitely should not use the Barcelona case as an example to be applied to geographical terms.

4. WIPO cannot yet provide recommendations regarding disputes between geographical regions and domain name owners

Regarding the use of geographic terms in domain names, *e.g.*, regions, towns cities or other subdivisions, the UDRP should definitely not consider region names.

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[13] Excelentismo Ayuntamiento de Barcelona v. Barcelona.com Inc., Case D2000-0505 (WIPO Domain Name Dispute) (August 4, 2000) *available at* http://arbiter.wipo.int.domains/decisions/html/d2000-0505.html.

Consideration of city names is dangerous at this point, so WIPO should wait before issuing a recommendation on city names.

Geographic regions are not personalities having name rights. So, the UDRP cannot order the transfer or cancellation of any domain names involving region names. Given that regions, such as the "Outer Banks," are not legal entities or personalities, there is no party that could claim a legal right to such words, therefore, there can be no such thing as "bad faith." Consequently, there is no room for region-name disputes within the UDRP.

City-name issues weave a more tangled web. For the following reasons, WIPO cannot issue recommendations that harmonize with all nations' laws: U.S. law is not yet settled on the matter so it is impossible to predict what recommendations would conflict with U.S. law; and German and U.S. law, I predict, are different. If my prediction is correct, WIPO protection of city names will need to be minimal in order to comply with all countries' laws. Effectively, the UDRP would fail to present meaningful protection to countries having city name rights. If WIPO protection were not minimal, then either UDRP proceedings would begin to lose credibility from being overturned by courts, or it would look like WIPO was attempting to generate international law. If the later were true, in countries where the law is unsettled courts would defer to UDRP arbitration decisions. Well beyond the scope of this comment is whether WIPO should be the international law making body governing domain names. For purposes of this comment, it is enough to conclude that region-name domain names cannot be regulated by UDRP, and that city-name domain name resolution requires further review, unless WIPO's aim is to draft international law.