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**Domain Name Allocation and
Government Super-Prioritization:
Lessons Learned From the UDRP
Keep ICANN Out of the Business of
Deciding What Is or Is Not a Country**

*Heather Ann Forrest**

ABSTRACT

Governments' growing awareness of the Domain Name System (DNS), the Internet Corporation for Assigned Names and Numbers (ICANN), and its stewardship of DNS policy development fuel recent attempts to steer Internet domain name allocation toward policies that prioritize government interests ahead of all other rights and interests, including trademark rights. As the DNS expands, the top level in its hierarchical structure (the level of domains such as ".com" and ".uk") assumes the characteristics and attributes, and therefore also the conflicts and challenges, of its second level (the level of public-registered names). This Article argues that these developments necessitate a new, holistic approach to developing name allocation policy in which established Uniform Domain-Name Dispute-Resolution Policy (UDRP) norms are brought to bear in evaluating government claims to name priority beyond the limited scope of the UDRP.

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Governments' requests for exemptions from trademark protections to super-prioritize their interests in geographic names bear striking resemblance to the claims made and rejected by UDRP panels in challenges to geographic second-level domain registrations by non-government parties. A unified framework of allocating geographic names in the DNS renders such decisions relevant and indeed integral to current and future policy development.

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I. INTRODUCTION

At the heart of the allocation of names in the Internet Domain Name System (DNS) lies the early, fundamental decision to allocate names on a first-come, first-serve basis.¹ In adopting this approach, the DNS's architects ensured an immediate and uncomplicated registration process that contributed much to the Internet's rapid expansion and widespread utilization. As the steward of DNS policy development, the Internet Corporation for Assigned Names and Numbers (ICANN) has largely maintained the status quo, as evidenced by its agreements with the operators of top-level domains

1. See MILTON MUELLER, RULING THE ROOT: INTERNET GOVERNANCE AND THE TAMING OF CYBERSPACE 36 (2002).

and the businesses that sell domain names to the public.² Accordingly, ICANN has, as a general principle, deliberately avoided assuming responsibility for validating or weighing claims to rights or interests in names. Where prioritization has occurred for other than technical and operational reasons, its legitimacy has been firmly grounded in international law as interpreted by a qualified external body.

Consistent with this approach, ICANN has made it abundantly clear in relation to the use of country code top-level domains (TLDs), the spaces at the highest level in the DNS hierarchy with the familiar “.com,” “.net,” and “.org” suffixes but designated by a two-letter code that corresponds to an existing international standard of English-language country names,³ that it “is not in the business of deciding what is and what is not a country. Instead, [it] employ[s] a neutral standard maintained by the ISO 3166 Maintenance Agency.”⁴ Yet, this Article argues, ICANN steps into “the business of deciding what is and what is not a country” when it accedes to demands from ICANN’s Governmental Advisory Committee that geographic names be reserved for governments, or used only with government consent, and that government registrations of such names be prioritized over all others.⁵ This is, for ICANN, a new and potentially litigious sphere of responsibility in which its decisions lack the support of a qualified external authority. International law, which ICANN’s Board of

2. ICANN’s relationships with these entities are contractual in nature. In relation to registry operators, see, e.g., *asia Registry Agreement*, ICANN art. III, § 3.1(b) (Jun. 22, 2010), <https://www.icann.org/resources/unthemed-pages/asia-agreement-2006-12-06-en> [<https://perma.cc/3FYF-UJUY>]. In relation to registrars, see *Registrar Accreditation Agreement 2013*, ICANN 17 cl. 3.8 (Jun. 27, 2013), <https://www.icann.org/resources/pages/approved-with-specs-2013-09-17-en> [<http://perma.cc/3RU6-PG45>].

3. See JON POSTEL, RFC 1591: DOMAIN NAME SYSTEM STRUCTURE AND DELEGATION 1 (Mar. 1994), <https://www.ietf.org/rfc/rfc1591.txt> [<http://perma.cc/7BSJ-V2VS>]. For a fuller definition of “ccTLD,” see *Glossary*, ICANN, <https://www.icann.org/resources/pages/glossary-2014-02-03-en#cc> [<http://perma.cc/UQ5H-ZXK6>].

4. *User Documentation on Delegating and Re-Delegating a Country-Code Top-Level Domain*, ICANN (Sept. 9, 2013), <https://www.icann.org/en/system/files/files/drd-ui-09sep13-en.pdf> [<http://perma.cc/MZ8B-HSJQ>].

5. See, e.g., GAC SUB-WORKING GROUP FOR PROTECTION OF GEOGRAPHIC NAMES IN NEXT ROUNDS OF NEW GTLDS, *The Protection of Geographic Names in the New gTLDs Process*, ICANN (Aug. 29, 2014), <https://gacweb.icann.org/display/gacweb/Community+Input+-+The+protection+of+Geographic+Names+in+the+New+gTLDs+process?preview=/35455403/35622234/Geo%20names%20in%20new%20gTLDs%20Updated%20%20V3%20%2029%20august%202014%5B4%5D.pdf> [<http://perma.cc/2FBH-KVB2>]; see GOVERNMENTAL ADVISORY COMMITTEE, *Singapore Communiqué*, ICANN (Feb. 11, 2015), <https://www.icann.org/en/system/files/correspondence/gac-to-board-11feb15-en.pdf> [<http://perma.cc/8UHJ-R2GV>].

Directors undertook to comply with in expanding the DNS,⁶ offers no support for the prioritization that governments seek.⁷

The World Intellectual Property Organization (WIPO), the qualified external body upon which ICANN can and should rely in developing DNS policy affecting trademark rights, acknowledged this void of authority soon after ICANN's formation, reporting: "While the misuse of geographical attributions may offend many feelings, only certain types of such misuse are sanctioned by the law."⁸ This assessment is plainly reflected in the elements of the widely adopted Uniform Domain-Name Dispute-Resolution Policy (UDRP), the WIPO-developed administrative procedure for resolving disputes involving trademarks registered as domain names by parties other than a trademark owner.⁹ A significant body of policy has developed out of disputes resolved under this procedure, which now applies to all generic TLDs in the DNS.¹⁰ It may be argued that these decisions lack precedential significance or are too limited by their context to be relevant to ICANN policy-making more broadly. The objective of this Article is to preempt such arguments, particularly in the context of governments' demands for special treatment of geographic, cultural, and other names of national significance throughout the DNS,¹¹ and to reveal the applicability and necessity of applying the rationales of existing UDRP decisions to geographic domain name allocation policy.

Part II of this Article discusses the hierarchical structure of the DNS and reflects upon how this has influenced policy development on the use of names. This discussion reveals that policy development at the top level—the level of domains such as ".com" and ".org"—has occurred independently of and without meaningful reference to policy

6. *Resolution 2008-06-26 GNSO Recommendations on New gTLDs*, ICANN (Jun. 26, 2008), <https://features.icann.org/2008-06-26-gnso-recommendations-new-gtlds> [<http://perma.cc/8K7F-TEVD>].

7. *See generally* HEATHER ANN FORREST, PROTECTION OF GEOGRAPHIC NAMES IN INTERNATIONAL LAW AND DOMAIN NAME SYSTEM POLICY (P. Bernt Hugenholtz ed., 2012) (evaluating ICANN's new gTLD policy on geographic names and concluding that no basis exists in international law for government claims to ownership of or priority rights in geographic names).

8. WIPO, THE RECOGNITION OF RIGHTS AND THE USE OF NAMES IN THE INTERNET DOMAIN NAME SYSTEM: REPORT OF THE SECOND WIPO INTERNET DOMAIN NAME PROCESS 205 (2011), <http://www.wipo.int/amc/en/processes/process2/report/html/report.html> [<http://perma.cc/A35H-SHRA>] [hereinafter *WIPO II*].

9. *See Uniform Domain-Name Dispute-Resolution Policy*, ICANN, <https://www.icann.org/resources/pages/help/dndr/udrp-en> [<http://perma.cc/QD2Y-5NTW>].

10. *See id.*

11. *See* GOVERNMENTAL ADVISORY COMMITTEE, *Community Input - The Protection of Geographic Names in the New gTLDs Process*, ICANN (Aug. 29, 2014), <https://gacweb.icann.org/display/gacweb/Community+Input+-+The+protection+of+Geographic+Names+in+the+New+gTLDs+process> [<http://perma.cc/9P8L-U5W9>].

applicable to the second level—the level of public-registered names. The rationales and mechanisms for prioritization at the top and second levels of the DNS are identified as a basis from which to make the case for unifying these two currently separate streams of policy development going forward. This line of reasoning additionally serves to illustrate the relevance of the UDRP, a policy applicable to second-level domain names, to current and future geographic domain name allocation policy at all levels of the DNS. In Part III, governments' assertions of priority rights in geographic domain names are then assessed against UDRP-derived norms, revealing the full extent of the void into which ICANN steps as it accedes to the advice of the Governmental Advisory Committee.

II. PRIORITIZATION IN THE DNS

Prioritization in domain name allocation is fundamentally driven by the DNS's functional requirement of uniqueness. Uniqueness is imposed at each level of the DNS such that there can only be one single custodian of a given name: only one “.com,” only one “.book,” only one “book” domain name registered in the “.com” registry (e.g., “book.com”), only one “paris” in “.book” (e.g., “paris.book”), and so on. The end result is absolute uniqueness, such that each domain name corresponds to one—and only one—location of stored information from an ever-expanding number of locations. Without this requirement, the DNS cannot function.

Because there can be only one single custodian of a given name, conflicting claims are inevitable. At the top level—the level of generic top-level domains (gTLDs), such as “.com,” “.org,” and “.net,” and country code top-level domains (ccTLDs), such as “.uk,” “.ca,” and “.jp”—naming disputes have arisen significantly less frequently than at the second level (i.e., the “book” in “book.com”) for several reasons inherent in the DNS's hierarchical design. First, the top level has expanded substantially more slowly than lower levels as a result of the DNS architects' vision of a deeply hierarchical system.¹² Between the implementation of the DNS in the early 1980s and 2011, fewer than three hundred generic country code and internationalized country code domains were created at the top level,¹³ while in the same period the second level came to comprise more than 225 million

12. See J. POSTEL & J. REYNOLDS, RFC 920: DOMAIN REQUIREMENTS 6–7 (Oct. 1984), <https://tools.ietf.org/rfc/rfc920.txt> [<http://perma.cc/5KAC-WPTZ>] (“There are very few top level domains, each of these may have many second level domains”); POSTEL, *supra* note 3, at 1 (declaring it “extremely unlikely that any other TLDs will be created” beyond the initial eight gTLDs and country code TLDs).

13. See generally FORREST, *supra* note 7, at 44–58.

domain name registrations.¹⁴ Second, naming disputes rarely arise in top-level domains because prioritization is, by design, irrelevant to ccTLDs and was not a pressing problem for gTLDs until recently. Prioritization is irrelevant to ccTLDs because they are strictly derived from the International Standardization Organization's ISO3166-1 standard of "English country names and code elements,"¹⁵ which, given its nature as an international standard of unique naming elements, contains no duplicate entries. Until recently, prioritization was also not appreciably implicated in the creation of gTLDs. The DNS launched with eight gTLDs: ".arpa," ".gov," ".mil," ".edu," ".com," ".net," ".org," and ".int."¹⁶ An initial attempt at expansion commencing in 2000 produced seven additional gTLDs, joined by a further eight in the period of 2005 to 2011.¹⁷ Only twenty-three gTLDs existed by the end of 2011.¹⁸ Few applications received by ICANN in those early expansion efforts implicated names with a semantic value beyond an obviously non-proprietary, generic meaning.¹⁹

As a consequence of the varied growth paces and design intentions of the DNS's top and second levels, domain name allocation policy addressing this uniqueness has bifurcated, with divergent policy mechanisms applying to each. A review of these mechanisms and the rationales by which they are underpinned in light of the rapidly changing structure of the DNS engenders two key observations: first, the circumstances justifying bifurcated policy development and applicability have radically changed; and second, those changes support merging these two separate streams to form a single, coherent policy framework applicable at all levels of the DNS. Such a unified policy framework rejects a universal role of super-prioritizing government interest in geographic domain names. As this Article will show, this framework would also refocus current and future geographic domain name allocation policy on issues and concerns already addressed by UDRP decisions.

14. See VERISIGN, 9 DOMAIN NAME INDUSTRY BRIEF (1st ed. Mar. 2012), <https://www.verisigninc.com/assets/domain-name-brief-march2012.pdf> [<http://perma.cc/V7NC-4YBK>].

15. *Country Codes - ISO 3166*, ISO, http://www.iso.org/iso/country_codes.htm [<http://perma.cc/TLY2-Q3F2>].

16. POSTEL, *supra* note 3; POSTEL & REYNOLDS, *supra* note 12.

17. See INTERNET CORP. FOR ASSIGNED NAMES & NUMBERS, NEW GTLD PROGRAM – NEW GTLD PROGRAM IN BRIEF (2009). See generally FORREST, *supra* note 7, at 47–54.

18. See *supra* note 17 and text accompanying. The gTLDs ".post" and ".xxx" were very slow to enter the root due to rather complex negotiations. See *Root Zone Database*, INTERNET ASSIGNED NUMBERS AUTHORITY, <http://www.iana.org/domains/root/db> [<http://perma.cc/WD5W-2H34>].

19. See *infra* note 20.

A. Prioritization Mechanisms at the Top Level

A total of twenty-one conflicts arose in the applications for new gTLDs received by ICANN in 2000 and 2004, including “.kids,” “.sex,” “.inc,” and “.site.”²⁰ Six of the fifteen new gTLDs ultimately added to the DNS from these processes had also been applied for by other applicants,²¹ but all were generic, non-proprietary terms such that ICANN was not forced to prioritize on any basis other than the strength of the application against stated evaluation criteria. At this point, it was not necessary for ICANN to validate or balance between several competing interests in names at the top level of the DNS.

Conflicts were inevitable, however, when ICANN launched a new expansion round in 2012. This round placed no restrictions on the type or number of successful applications. Certain conflicts were precisely anticipated and dealt with preventatively to avoid technical instability; ICANN’s name and names of other bodies responsible for DNS addressing were “reserved,”²² consistent with technical advice and the recommendations of the Generic Names Supporting Organization (GNSO), the body within ICANN responsible for policy making regarding gTLDs.²³ Similarly, two-letter names, such as “.go” and “.bp,” were deemed ineligible due to their potential confusion with ccTLDs.²⁴ More controversially, the gTLD Applicant Guidebook,²⁵ the document setting out the policy framework contractually imposed by ICANN on all new gTLD applicants participating in the 2012 expansion round, deemed some names ineligible other than for technical or operational reasons. The reservation of names relating to the International Olympic Committee (IOC) and the International Red

20. See *Status Report on the sTLD Evaluation Process*, ICANN (Dec. 3, 2005), <https://archive.icann.org/en/tlds/stld-apps-19mar04/stld-status-report.pdf> [<http://perma.cc/2H3L-HZTP>]; *TLD Applications Lodged*, ICANN (Oct. 10, 2000), <http://www.icann.org/en/tlds/tld-applications-lodged-02oct00.htm> [<http://perma.cc/32Z2-A3ZU>].

21. These six applications were: “.xxx,” “.biz,” “.info,” “.tel,” “.pro,” and “.travel.” See *supra* note 20.

22. INTERNET CORP. FOR ASSIGNED NAMES & NUMBERS, NEW GTLD APPLICANT GUIDEBOOK § 2.2.1.2.1 (rev. ed. 2012), <http://newgtlds.icann.org/en/applicants/agb/> [<http://perma.cc/CG8Y-A3JA>] [hereinafter ICANN, APPLICANT GUIDEBOOK].

23. See INTERNET CORP. FOR ASSIGNED NAMES & NUMBERS, RESERVED NAMES WORKING GROUP FINAL REPORT annex 1 (Sept. 4, 2009) (ICANN/IANA Sub Group Report), <http://gnso.icann.org/en/issues/new-gtlds/final-report-rn-wg-23may07.htm> [<http://perma.cc/YC7U-DHAV>] [hereinafter ICANN, RESERVED NAMES].

24. APPLICANT GUIDEBOOK, *supra* note 22, at § 2.2.1.3.2 (“Two character ASCII strings are not permitted, to avoid conflicting with current and future country codes based on the ISO 3166-1 standard.”); see ICANN, RESERVED NAMES, *supra* note 23 at annex 2 (Single & Two Character Reserved Names Sub Group Report (Including Symbols)).

25. ICANN, APPLICANT GUIDEBOOK, *supra* note 22.

Cross and Red Crescent Movement (IRC)²⁶ drew support from the widespread practice in domestic legislation of restricting these names from trademark registrability.²⁷ Country and territory names were, at the urging of ICANN's Governmental Advisory Committee (GAC)²⁸ but against the recommendations of the GNSO,²⁹ also deemed ineligible.³⁰ This restriction cut a broad path, rendering ineligible applications for domain names with three-letter country codes on the ISO 3166-1 standard, short- and long-form names, translations in any language, separable components, permutations, and transpositions of country names.³¹ Various sub-national geographic names and supra-national region names were not excluded outright but were eligible only with proof of support or non-objection from relevant governments.³² Applications for any of these restricted names were rejected by ICANN in a preliminary "Initial Evaluation" phase.³³

Initial Evaluation additionally entailed a review of applications to identify conflicts. From the 1,930 applications received,³⁴ ICANN formed 233 "contention sets" of applications competing for "identical or similar"³⁵ strings. As in the earlier, smaller-scale expansion rounds launched in 2000 and 2004, most of the names placed in contention sets were generic, rather than proprietary, in nature. Consistent with its previous avoidance of responsibility for validating or weighing conflicting interests, ICANN mandated that any conflicts not resolved by the affected applicants themselves would go to auction.³⁶ As a result, even right-holders with applications in contention sets—for example, applications for ".guardian" by Guardian News and Media

26. See *id.* at § 2.2.1.2.3.

27. See *Unredacted Version of Board Workshop Paper on IOC/Red Cross Protections*, ICANN (Aug. 28, 2012), <https://www.icann.org/en/system/files/bm/briefing-materials-unredacted-20jun11-en.pdf> [<http://perma.cc/YXD6-ZBNC>].

28. See ICANN GOVERNMENTAL ADVISORY COMMITTEE, *GAC Principles Regarding New gTLDs* § 2.2 (2007), <https://archive.icann.org/en/topics/new-gtlds/gac-principles-regarding-new-gtlds-28mar07-en.pdf> [<http://perma.cc/D7HZ-VPAT>] ("ICANN should avoid country, territory or place names, and country, territory or regional language or people descriptions, unless in agreement with the relevant governments or public authorities.").

29. See ICANN, *RESERVED NAMES*, *supra* note 23 at 19 tbl. 22.

30. ICANN, *APPLICANT GUIDEBOOK*, *supra* note 22, at § 2.2.1.4.1.

31. *Id.*

32. *Id.* at § 2.2.1.4.2.

33. *Id.* at § 2.2.

34. See *New Generic Top-Level Domains – Program Statistics*, ICANN, <http://newgtlds.icann.org/en/program-status/statistics> [<http://perma.cc/7MAY-7NT3>].

35. ICANN, *APPLICANT GUIDEBOOK*, *supra* note 22, at § 1.1.2.10 (defining "similar" as "strings so similar that they create a probability of user confusion if more than one of the strings is delegated into the root zone").

36. *Id.* at § 4.2.2.

Limited³⁷ and The Guardian Life Insurance Company of America³⁸—were not prioritized on any basis other than pocket depth.

ICANN has previously avoided prioritization of rights and interests at the top level of the DNS except as required by technical and operational security and stability. New expansion initiatives unimpeded by quotas, like those of the 2012 expansion round, however, have generated protectionist policy. In this new status quo heralded by new gTLD policy as recorded in the gTLD Applicant Guidebook, only geographic names stand out for the lack of technical, operational, or legal basis for their protection through the prioritization of government interests against all other parties, including trademark holders.

B. Prioritization Mechanisms at the Second Level

The conflicts created by recent efforts to expand the top level of the DNS, resolved in some instances on non-technical grounds, have long been an issue at the second level, where the term “cybersquatting” had emerged even prior to ICANN’s formation, in the earliest days of the commercialized DNS.³⁹ In the first-come, first-served domain name registration process, where there were no pre-registration eligibility checks, early registrants seized trademark names without restraint, leaving trademark holders with the expense, in time and money, of trademark infringement litigation. Since then, various mechanisms, including the UDRP, have evolved to combat this practice.

One of the first initiatives of the newly formed ICANN was the adoption of the WIPO-proposed administrative dispute-resolution mechanism, the UDRP. To make the UDRP binding upon all gTLD domain name registrants, ICANN contractually requires all registrars, the companies that sell domain names to the public, to include the applicability of the UDRP in their registration

37. *Application Details for Application ID: 1-1728-88967*, ICANN: NEW GENERIC TOP-LEVEL DOMAINS, <https://gtldresult.icann.org/application-result/applicationstatus/applicationdetails/430> [http://perma.cc/K7TA-Y35X].

38. *Application Details for Application ID: 1-1298-37058*, ICANN: NEW GENERIC TOP-LEVEL DOMAINS, <https://gtldresult.icann.org/application-result/applicationstatus/applicationdetails/1038> [http://perma.cc/3EFB-JZBL].

39. *Avery Dennison Corp. v. Sumpton*, 999 F. Supp. 1337, 1338 (C.D. Cal. 1998) *rev'd*, 189 F.3d 868 (9th Cir. 1999) (“Like all ‘cybersquatters,’ defendants merely ‘squat’ on their registered domain names until someone else comes along who wishes to use them. Like all ‘cybersquatters,’ defendants usurp all of the accepted meanings of their domain names, so as to prevent others from using the same domain names in any of their accepted meanings. And like all ‘cybersquatters,’ defendants seek to make a financial return by exacting a price before consenting to allow others to use the domain names on which they have chosen to ‘squat.’”).

agreements.⁴⁰ ICANN additionally contractually requires all gTLD operators to sell domain names only through registrars that meet this requirement.⁴¹ Numerous ccTLDs have also adopted the UDRP,⁴² although ICANN does not require that they do so. Given this broad applicability of the UDRP and a high volume of disputes resulting from steady registration volumes in the TLDs in which this dispute resolution mechanism applies, UDRP decisions form a significant body of policy in their own right. The Uniform Rapid Suspension System (URS), a rapid response version of the UDRP targeted at “those cases in which there is no genuine contestable issue as to the infringement and abuse that is taking place,”⁴³ is mandated in all new gTLDs. Late 2014 data revealing fifteen times more UDRP and URS disputes being filed against new gTLD domain names than other TLDs⁴⁴ suggest that over time, the URS may also develop into a significant resource for shaping future name allocation policy.

Another mechanism of relatively longstanding use at the second level of the DNS is the sunrise period. This period helps prioritize certain registrants by providing a registration period prior to the availability of domain names to the general public. To date, it has overwhelmingly been used to prioritize trademark holders. In 2012, the gTLD Applicant Guidebook introduced a mandatory sunrise requirement upon all new gTLDs resulting from the 2012 application round to provide a priority registration period of no less than thirty days⁴⁵ for “all word marks” meeting the following criteria:

40. See *Registrar Accreditation Agreement 2013*, ICANN 17 cl. 3.8 (Jun. 27, 2013), <https://www.icann.org/resources/pages/approved-with-specs-2013-09-17-en> [<http://perma.cc/X5YH-J7AF>].

41. This requirement is imposed through an obligation in the Registry Agreement into which gTLD registry operators enter with ICANN to comply with and implement ICANN Consensus Policies (of which the UDRP is one). See, e.g., *asia Registry Agreement*, ICANN art. III, § 3.1(b) (Jun. 22, 2010), <https://www.icann.org/resources/unthemed-pages/asia-agreement-2006-12-06-en> [<http://perma.cc/3FYF-UJUY>].

42. See, e.g., *Domain Name Registration Agreement*, U. OF CYPRUS COUNTRY CODE TLD REGISTRAR FOR .CY, <http://www.nic.cy/rulesreg.htm> [<http://perma.cc/6CJS-RLGJ>]; *Domain Registration Agreement*, AMERICAN SAMOA DOMAIN REGISTRY, <http://www.nic.as/policy.cfm> [<http://perma.cc/5VYJ-WCHV>]; *FJ – Uniform Domain Name Dispute Resolution Policy*, FJ DOMAIN REGISTRY, <http://www.register.bs/terms.html> [<http://perma.cc/2KKP-8V7V>].

43. IMPLEMENTATION RECOMMENDATION TEAM, *Final Report on Trademark Protection in New gTLDs*, ICANN 25 (May 29, 2009), <https://archive.icann.org/en/topics/new-gtlds/irt-final-report-trademark-protection-29may09-en.pdf> [<http://perma.cc/5XDP-C7PV>].

44. See Michael Berkens, *Guess I Was Wrong There Is a Lot of Cybersquatting Going on in the New gTLD's: 15X as Much?*, THE DOMAINS (Dec. 15, 2014), <http://www.thedomains.com/2014/12/15/guess-i-was-wrong-there-is-a-lot-of-cybersquatting-going-on-in-the-new-gtlds-15x-as-much/> [<http://perma.cc/6BFW-9Z7S>].

45. See ICANN, APPLICANT GUIDEBOOK, *supra* note 22, at Trademark Clearinghouse § 6.2.1.

- (i) nationally or regionally registered and for which proof of use—which can be a declaration and a single specimen of current use—was submitted to, and validated by, the Trademark Clearinghouse; or
- (ii) that have been court-validated; or
- (iii) that are specifically protected by a statute or treaty currently in effect and that was in effect on or before June 26, 2008.⁴⁶

Notable here is ICANN's reliance upon external parties—the specially created Trademark Clearinghouse, courts, and domestic and international law—to validate marks' eligibility.

It would be inappropriate to characterize the Trademark Claims period as a prioritization mechanism because it does not strictly establish priority. However, for completeness it should be noted as the second major rights-protection mechanism introduced by the gTLD Applicant Guidebook resulting from the 2012 application round. During the first sixty days in which domain names are available for registration by the general public in new gTLDs, the registry operator is required to provide a notification service to put domain name registrants on notice of existing trademark rights in an applied-for name.⁴⁷ During new gTLD policy development, much discussion revolved around the mitigation of chilling effects of such a notice through precise wording to avoid the message being interpreted as an assertion of priority.⁴⁸

The gTLD Applicant Guidebook thus imposed a minimum standard of protection, affording priority in second-level domain name registration only to trademark holders and only during the sunrise period, without prohibiting operators from extending the mandated trademark protection mechanisms or implementing additional mechanisms. One such approach involves prioritizing the registrants of names in existing TLDs as proposed by the operator of “.xxx” in relation to the launch of the new gTLDs “.sex” and “.adult.”⁴⁹ This “grandfathering” plan was abandoned in late 2014 after unsuccessful negotiations with ICANN and replaced by a post-sunrise and pre-general availability alternative “Domain Matching Program.”⁵⁰

46. See *id.* at Trademark Clearinghouse § 7.2.

47. See *id.* at Trademark Clearinghouse § 6.1.1.

48. See ICANN, NEW GTLD TRADEMARK CLEARINGHOUSE SUNRISE AND TRADEMARK CLAIMS PROCESSES: SUMMARY OF INPUT FROM THE IMPLEMENTATION ASSISTANCE GROUP 25 (2012), <https://newgtlds.icann.org/en/about/trademark-clearinghouse/summary-iag-input-26sep12-en.pdf> [http://perma.cc/8H2P-LPEV].

49. See Michael Berkens, *ICM Owner of .XXX Applies for .Sex, .Porn & .Adult to Give .XXX Owners Grandfather Rights*, THE DOMAINS (Apr. 12, 2012), <http://www.thedomains.com/2012/04/12/icm-owner-of-xxx-applies-for-sex-porn-adult-to-give-xxx-owner-grandfather-rights/> [http://perma.cc/GCA9-JF69].

50. See *Get Priority Entry into .PORN and .ADULT*, ICM REGISTRY, (Apr. 14, 2015), <http://www.icmregistry.com/media/press/?article=58> [http://perma.cc/V7E9-TYC6].

Another approach, reserved names, has long been a feature of second-level domain name allocation policy.⁵¹ This is evident from the Final Report of the GNSO's Reserved Names Working Group, which was formed to evaluate reservations as part of the new gTLD policy development process.⁵² As noted in the context of top-level domains above, many status quo reservations address technical and operational stability. A separate stream of work during new gTLD policy development explored reserving well-known trademarks on a Globally Protected Marks List (or, as it is most commonly referred to, GPML).⁵³ This mechanism was ultimately not mandated by the gTLD Applicant Guidebook, but the concept has been voluntarily implemented by, for example, large portfolio applicant Donuts,⁵⁴ whose new domains include ".tennis," ".apartments," ".school," and ".casino."⁵⁵

Prioritization on bases other than trademark rights has been adopted by various ccTLDs and gTLDs, although, to be clear, this was not mandated by ICANN. For example, when the European Union's ".eu" launched, "[h]olders of prior rights recognised or established by national and/or [c]ommunity law," defined to include trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works, were accorded registration priority.⁵⁶ When the new gTLD ".jobs" launched in 2005, holders of trade names were eligible to apply during a sunrise-like priority period.⁵⁷ Where additional mechanisms are voluntarily adopted by gTLDs, they must comply with, and not circumvent, the trademark rights protection mechanisms contractually mandated by ICANN.

C. The Case for Unified Geographic Name Allocation Policy

The New gTLD Program, which by March 30, 2015 had added nearly 550 gTLDs to the DNS from 1,930 applications received, has

51. See generally ICANN, RESERVED NAMES, *supra* note 23.

52. See generally *id.*

53. See IMPLEMENTATION RECOMMENDATION TEAM, *supra* note 43, at 16.

54. See *Domains Protected Marks List*, DONUTS, <http://www.donuts.domains/services/dpml> [<http://perma.cc/97WY-D7D8>].

55. *Available Domain Names*, DONUTS, <http://www.donuts.domains/services/domain-names> [<http://perma.cc/8AAT-WEZ8>].

56. Commission Regulation 874/2004 of Apr. 28, 2004, Laying Down Public Policy Rules Concerning the Implementation and Functions of the .eu Top Level Domain and the Principles Governing Registration, 2004 O.J. (L 162) 40, 44 (EC).

57. See Steve Quinn, *Follow-up File: The Internet.jobs Domain Registrars*, DALL. MORNING NEWS, (June 25, 2005), <http://www.goto.jobs/news/2005-6-23-dallas.asp> [<http://perma.cc/NY37-NH4A>].

fundamentally altered the DNS landscape. The potential for conflict at the top level is now no less a concern than at lower levels, and the rationales underpinning prioritization policy at the second level now apply with equal logic at the top level. Where the impact of the uniqueness requirement may previously have been mitigated at the second level by the potential availability of the name in other non-semantic gTLDs (e.g., “book.com,” “book.net,” and “book.org”), the addition to the DNS of new gTLDs with obvious semantic or proprietary value may eliminate any such benefits. Domain name registrations in new gTLDs are not fungible in the way that domain name registrations in the pre-2011 DNS were: a “marriott.hotel” domain name is not substituted by the registration of the name “marriott” in some other gTLD (“marriott.restaurant,” for example). There is likewise no substitute for a “.marriott” gTLD. In today’s DNS, uniqueness is relevant at *all* levels of the system.

The conditions at the top and second levels of the DNS are no longer sufficiently different to justify separate bodies of policy, rendering the continued bifurcation of geographic domain name allocation policy by level both inefficient and impractical. Going forward, prioritization policy should take a whole-of-system view. The success of such an approach requires clearly defining the right or interest being prioritized; a harmonized definition can then be applied across all levels of the DNS. Transparency, accountability, and consistency demand that definitions be sufficiently clear to enable domain name applicants—at every level—to reliably assess whether a name is subject to a protection mechanism. Policy establishing eligibility for participation in a mandated sunrise process in the launch of a new gTLD, for example, generated few questions and gave ICANN no responsibility in validating claims. Eligibility was expressly limited to “Sunrise-Eligible Rights Holders,” defined as holders of “marks . . . verified by the Trademark Clearinghouse.”⁵⁸ Clearly, what constitutes a trademark, for example, does not change between the top and lower levels of the DNS, nor does the evidence of the existence of a trademark change between the top and lower levels of the DNS. On the other hand, application of the definition of “geographic name” in the gTLD Applicant Guidebook has proved particularly difficult because the interests captured by the defined term cannot readily be identified or verified. Rights or interests such as these that are incapable of clear definition or verification are, quite

58. ICANN, TRADEMARK CLEARINGHOUSE: RIGHTS PROTECTION MECHANISM REQUIREMENTS § 2 (Sept. 30, 2013), <http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-30sep13-en.pdf> [<http://perma.cc/NAM4-47NW>] [hereinafter ICANN, RPM REQUIREMENTS].

simply, patently out of place in a system with transparency, accountability, and consistency as its core values.

Governments' interests in geographic, cultural, and related names are not clearly or consistently documented, making their prioritization difficult not only to justify, but also to implement. The fragmented definition of "geographic name" in ICANN's gTLD Applicant Guidebook, which cobbles together various external resources, is clear evidence of the difficulty in prioritizing an interest not elsewhere clearly defined.⁵⁹ ICANN relies on existing external lists seemingly to excuse itself from the responsibility of validation. This is particularly evident in the politically-fraught context of geographic names, where adoption of the International Standardization Organization's ISO3166-1 standard of "English country names and code elements"; the ISO3166-2 standard of "Country subdivision codes"; and the United Nations' "Composition of macro geographical (continental) regions, geographical sub-regions, and selected economic and other groupings" has historically removed ICANN from "the business of deciding what is and what is not a country."⁶⁰ Yet in fact, ICANN has assumed that responsibility simply in deciding to prioritize *someone's* rights in *something*, irrespective of who that one or what that thing is. In other words, by reserving country and territory names and by imposing a consent requirement on other geographic names, ICANN inherently validates governments' claims to geographic names. Because there is no external qualified body or express international law upon which it can rely, the only way ICANN can avoid the responsibility of validation in this situation is to avoid making policy that prioritizes as yet unverifiable, indefinable government interests.

Consistent implementation is the crucial second step in achieving effective uniform prioritization policy. In addition to complete ignorance of the convoluted definition of "geographic name" just noted, ICANN went on to characterize sixty-six of the 1,930 new gTLD applications it received as "geographic."⁶¹ This characterization

59. See ICANN, APPLICANT GUIDEBOOK, *supra* note 22, at §§ 2.2.1.4–2.2.1.4.4.

60. INT'L ORG. FOR STANDARDIZATION, ENGLISH COUNTRY NAMES AND CODE ELEMENTS 1, http://www.choralfestivalnetwork.org/admin/filez/26_Country%20codes.pdf [<http://perma.cc/ZC6A-JS6L>]; U.N. Stat. Div., Composition of Macro Geographical (Continental) Regions, Geographical Sub-regions, and Selected Economic and Other Groupings (Oct. 31, 2013), <http://unstats.un.org/unsd/methods/m49/m49regin.htm> [<http://perma.cc/6D4N-K74K>]; U.N. Ctr. for Trade Facilitation and E-Business, UN/LOCODE Country Subdivisions ISO 3166-2, <http://www.unece.org/cefact/locode/subdivisions.html> [<http://perma.cc/ST66-WV5T>]; *User Documentation on Delegating and Re-Delegating a Country-Code Top-Level Domain*, *supra* note 4.

61. *Program Statistics*, ICANN: NEW GENERIC TOP-LEVEL DOMAINS (Sept. 18, 2015), <http://newgtlds.icann.org/en/program-status/statistics> [<http://perma.cc/7MAY-7NT3>].

inexplicably includes such domains as “.bar,”⁶² “.nrw,”⁶³ “.ist,”⁶⁴ and “.zulu”⁶⁵—none of which are a capital city name of a country or a territory listed in the ISO3166-1 standard, a city name to be used for purposes associated with the city name, an exact match of sub-national place names on the ISO3166-2 standard, a UNESCO region, or included on the UN “[c]omposition of macro geographical (continental) regions . . .” list. Interests neither clearly defined nor legally justified usurp ICANN’s new gTLD policy of legally recognized and demonstrable trademark rights. In some cases, this occurred by preventing applications outright,⁶⁶ and in other cases by rejecting applications not expressly or impliedly ineligible.⁶⁷ Would-be applicants in future expansion rounds have undoubtedly been discouraged by ICANN’s inconsistency in this space.⁶⁸ Leaving to one side the question of whether one agrees with the substance of

62. See *Application Details for Application ID: 1-1870-98363*, ICANN: NEW GENERIC TOP-LEVEL DOMAINS, <https://gtldresult.icann.org/application-result/applicationstatus/applicationdetails/246> [<http://perma.cc/29AM-NQWU>] (last visited Mar. 30, 2015) (PDF of public portion of application available calling “.bar” a geographic TLD).

63. See *Application Details for Application ID: 1-994-3470*, ICANN: NEW GENERIC TOP-LEVEL DOMAINS, <https://gtldresult.icann.org/application-result/applicationstatus/applicationdetails/1010> [<http://perma.cc/Y7Z4-HHKH>] (PDF of public portion of application available calling “.nrw” a geographic TLD).

64. *Application Details for Application ID: 1-896-64208*, ICANN: NEW GENERIC TOP-LEVEL DOMAINS, <https://gtldresult.icann.org/application-result/applicationstatus/applicationdetails/1786> [<http://perma.cc/HN32-Z52Q>] (PDF of public portion of application available calling “.ist” a geographic TLD).

65. *Application Details for Application ID: 1-994-74713*, ICANN: NEW GENERIC TOP-LEVEL DOMAINS, <https://gtldresult.icann.org/application-result/applicationstatus/applicationdetails/1618> [<http://perma.cc/N3LW-G4DC>] (answering “no” to the self-designation as a geographic name). *But see* ICANN, NEW GENERIC TOP-LEVEL DOMAINS: NEW GTLD CURRENT APPLICATION STATUS, <https://gtldresult.icann.org/application-result/applicationstatus/viewstatus> [<https://perma.cc/JD6J-8CHB>] (identifying “.zulu” as “geographic” in the search by application type).

66. For example, American turkey farmers, cooks, and enthusiasts were denied by ICANN APPLICANT GUIDEBOOK at § 2.2.1.4.2 from applying for “.turkey.”

67. Well-known brands Amazon and Patagonia, for example, have both had their trademark rights displaced for lacking government support when neither falls within the agreed gTLD Applicant Guidebook definition of “geographic name.” See M.E., *New Internet Addresses: .patience*, THE ECONOMIST, (July 25, 2013, 12:30 PM), <http://www.economist.com/blogs/schumpeter/2013/07/new-internet-addresses-0> [<http://perma.cc/Y2KA-F58D>]; Eric Pfanner, *Amazon Rejected as Domain Name After South American Objections*, N.Y. TIMES, (July 18, 2013, 5:21 PM), http://bits.blogs.nytimes.com/2013/07/18/amazon-rejected-as-domain-name-after-south-american-objections/?_r=0 [<http://perma.cc/UH3F-7WL4>].

68. See ICANN GENERIC NAMES SUPPORTING ORG. BUS. CONSTITUENCY, BC COMMENT ON GAC PROPOSAL FOR PROTECTION OF GEOGRAPHIC NAMES IN NEW GTLDS 1 (2014), <https://gacweb.icann.org/download/attachments/35455403/BC%20Comment%20on%20GAC%20proposal%20for%20Geographic%20Names.pdf?version=1&modificationDate=1415614595000&api=v2> [<http://perma.cc/C3VA-NFWX>] (arguing that the requirement that applicants for geographic names seek government consent “sets an unclear burden for business users applying for new gTLDs”).

ICANN's definition of "geographic name," or indeed even the legality of prioritization in geographic names, it is unquestionably the case that once a consensus-driven definition is formulated, ICANN must unerringly apply that definition and only that definition.

Further, implementation by ICANN staff must align with and enable the intentions of a policy's drafters. In law, this notion takes shape as an expectation or obligation upon judicial bodies to interpret and apply legislation in a manner consistent with the purpose that legislation is intended by its drafters to fulfill.⁶⁹ An expectation of purposive implementation of ICANN's domain name policy would promote critical evaluation rather than acquiescent acceptance of ad hoc special requests to deviate from consensus-driven policy requirements. Such an expectation would certainly have changed the course of ICANN's new gTLD policy implementation, which expressly invited such requests from governments seeking super-prioritization above trademark rights holders.

Clearly sensitive to concerns expressed by the GAC in relation to certain new gTLD applications considered by governments to be geographic in nature but not falling within the gTLD Applicant Guidebook definition of protected "geographic name,"⁷⁰ ICANN staff developed the Rights Protection Mechanism (RPM) Requirements document,⁷¹ which set out technical and operational requirements for implementing the mandated sunrise and Trademark Claims notice periods and expressly invited deviations from these agreed mechanisms.⁷² Appropriately detailed launch plans set out in a new gTLD application were presumed approved "unless ICANN reasonably determines that such requested registration program could contribute to consumer confusion or the infringement of intellectual property rights."⁷³ Thus, before ICANN had even begun to constructively apply

69. See, e.g., DENNIS C. PEARCE & ROBERT S. GEDDES, STATUTORY INTERPRETATION IN AUSTRALIA 37–39 (8th ed. 2014).

70. See, e.g., *GAC Advice Response Form for Applicants for string .amazon*, ICANN: NEW GENERIC TOP-LEVEL DOMAINS, <http://newgtlds.icann.org/sites/default/files/applicants/03sep13/gac-advice-response-1-1315-58086-en.pdf> [<http://perma.cc/8ZCU-RYH6>]; *GAC Advice Response Form for Applicants for string .patagonia*, ICANN: NEW GENERIC TOP-LEVEL DOMAINS, <http://newgtlds.icann.org/sites/default/files/applicants/23may13/gac-advice-response-1-1084-78254-en.pdf> [<http://perma.cc/BUH7-H23D>]; *GAC Advice Response Form for Applicants for string .spa*, ICANN: NEW GENERIC TOP-LEVEL DOMAINS, <http://newgtlds.icann.org/sites/default/files/applicants/08may14/gac-advice-response-1-1309-81322-en.pdf> [<http://perma.cc/L66P-ENYV>].

71. ICANN, RPM REQUIREMENTS, *supra* note 58.

72. *Id.* at § 4.5.2.

73. *Id.*

its hard-earned, bottom-up, consensus-driven policy, it undermined that outcome by prescribing the pathway to exemption.

In the case of geographic new gTLDs, the RPM requirements went beyond anticipating some applicants' plans to request exemption from the mandated, consensus-driven rights protection mechanisms and positively invited such requests:

If registry operators that indicated in their applications for their TLDs that their TLD would be a geographic name ("Geo TLDs") and representatives of the Intellectual Property Constituency recommend to ICANN the creation of a registration program that sets forth a defined list of labels or categories of labels that Geo TLDs MAY Allocate [sic] or register to third parties prior to or during the Sunrise Period, and ICANN accepts and implements such recommendation ("Approved Geo Launch Program"), registration programs submitted by the Geo TLDs pursuant to Section 4.5.2 for the Approved Geo Launch Program will carry a presumption of being approved, unless ICANN reasonably determines that such requested program could contribute to consumer confusion or the infringement of intellectual property rights.⁷⁴

The RPM requirements thus opened the door to governments' exerting control over domain name registration by any or all of the following mechanisms:

- (1) Allocating a limited number of names outside of the sunrise process to promote the TLD;
- (2) Restricting, reserving, or pre-allocating names specifically related to governmental functions, departments, interests, or initiatives;
- (3) Grandfathering based on registrations in existing TLDs;
- (4) Expanding sunrise eligibility to include registrants other than trademark holders; and
- (5) Offering priority rights to champion stakeholders who promote the new TLD and are actively involved in its launch and development.

To fully appreciate the impact of the exceptions sought for geographic domains, one must acknowledge the critical decision to be made by all new gTLD applicants, including those applying for geographic names: sell domain names to the public (e.g., "juliescafe.paris") or operate an internal TLD making names available only to the TLD applicant and its constituent parts or divisions (e.g., "police.miami"). Where names are sold to the public, ICANN's base Registry Agreement and related documentation present only narrow opportunities for the registry operator to itself reserve or register names.⁷⁵ This is a policy that dates to ICANN's formation, put in place to prevent the registry operator from "gaming the system" by

74. ICANN, RPM REQUIREMENTS, *supra* note 58, at § 4.5.3.

75. ICANN, BASE REGISTRY AGREEMENT § 2.8 (2015) [hereinafter ICANN, BASE REGISTRY], <http://newgtlds.icann.org/en/applicants/agb/agreement-approved-20nov13-en.pdf> [<http://perma.cc/CG8Y-A3JA>]; ICANN, APPLICANT GUIDEBOOK, *supra* note 22, at Specification 5 § 3.2, Specification 9 § 1(b).

registering choice names itself or manipulating the registration process to maximize profit.⁷⁶ Geographic new top-level domain applicants (and the governments that back them) that seek to “have their cake and eat it too” argue that such restrictions open the door to public registration of names commonly associated with the geographic location, thus producing confusion and abuse. This risk is said to be exacerbated by the community-developed, mandated thirty-day sunrise which prioritizes only trademark holders.

So it came to be that both the rules and the exceptions in new gTLD name allocation prioritized government interests in geographic names at both the top and second levels of the DNS. This super-prioritization relies upon an imprecise definition of interests that cannot be proven by reference to an existing law or standard and are not protected under international law, to the diminishment of rights that can be proven and are protected under international law. It relies upon inconsistent application of an imprecise definition and the willingness of domain name applicants to bear the risk of entirely unpredictable outcomes. This is simply not sustainable in a system that derives its legitimacy from transparency, accountability, and consistency.

Taking a whole-of-system view, as the current DNS now necessitates, consistency and transparency demand that domain name allocation policy at one level of the DNS not be ignored when developing policy at other levels. Such an approach means that existing policy at the second level should be brought to bear on analysis at the top level. It seems to have been forgotten that geographic domain names were some of the first to be challenged under the now more than a decade old UDRP, and that good reasons were clearly provided for not including geographic names as such within its scope. Landmark UDRP decisions in challenges to the domain names “newzealand.com”⁷⁷ and “andalucia.com”⁷⁸ have normative value in the recognition of non-governmental interests in geographic names’ use in the DNS, while decisions in challenges to the domain names “brisbane.com,”⁷⁹ “rouen.net,” and “rouen.com”⁸⁰ have

76. See *Vertical Integration: History of Vertical Separation*, ICANN, http://icannwiki.com/index.php/Vertical_Integration [<http://perma.cc/V7YU-JKQ7>].

77. HM the Queen *ex rel* New Zealand v. Virtual Countries, Inc., WIPO Case No. D2002-0754 (Nov. 27, 2002), <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0754.html> [<http://perma.cc/QEN9-WCA5>].

78. Junta de Andalucía Consejería de Turismo, Comercio y Deporte, Turismo Andaluz, S.A. v. Andalucía.Com Ltd., WIPO Case No. D2006-0749 (Oct. 13, 2006), <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0749.html> [<http://perma.cc/SY8G-6NCE>].

79. Brisbane City Council v. Joyce Russ Advert. Pty. Ltd., WIPO Case No. D2001-0069 (May 14, 2001), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0069.html>

established that government use of a geographic name is not equivalent to trademark rights. Geographic domain name disputes arise with less frequency at the second level of the DNS today, despite the fact that UDRP decisions have no strict precedential value.⁸¹ This is certainly evidence of the normative value of these early decisions, which were “overwhelmingly unsuccessful,”⁸² with complainant governments succeeding “in only a few exceptional cases.”⁸³ In the aggregate, these decisions unequivocally reject the absolute priority of government interests over trademark rights. As the ICANN community lays the foundation for the next generation of domain name allocation policy in a new environment where conflicts arise at every level of the DNS, the substantial and growing body of UDRP decisions should, at a minimum, be reflected upon or, more appropriately, relied upon as a starting point.

III. LESSONS LEARNED FROM THE UDRP ON PRIORITIZING GOVERNMENT INTERESTS IN GEOGRAPHIC NAMES

A. Elements of the UDRP

The Registry Agreement into which each new gTLD registry operator enters with ICANN requires the sale of domain names only through ICANN-accredited registrars,⁸⁴ which in turn are bound by ICANN’s Registrar Accreditation Agreement to implement the UDRP through the domain name registration agreement into which registrants enter.⁸⁵ Under the UDRP, a domain name registration is deemed abusive on proof of each of the following three elements:

- (i) the registrant’s domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;

[<http://perma.cc/N5WY-BSKJ>]; see also *Brisbane City Council v. Warren Bolton Consulting Pty. Ltd.*, WIPO Case No. 2001-0047 (May 7, 2001), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0047.html> [<http://perma.cc/RW84-6YE8>].

80. *Chambre de Commerce et d’Industrie de Rouen v. Stenzel*, WIPO Case No. D2001-0348 (Jun. 18, 2001), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0348.html> [<http://perma.cc/2N2H-GD3S>].

81. See *Uniform Domain Name Dispute Resolution Policy*, ICANN § 4(k), <http://www.icann.org/en/help/dndr/udrp/policy> [<http://perma.cc/3V5L-LLPT>] [hereinafter *UDRP*]; see also *Weber-Stephen Prods. Co. v. Armitage Hardware & Bldg. Supply, Inc.*, No. 00 C 1738, 2000 WL 562470 (N.D. Ill. May 3, 2000).

82. JOHN R. OLSEN ET AL., *DOMAIN NAMES: GLOBAL PRACTICE AND PROCEDURE* 65 (2007).

83. TORSTEN BETTINGER, *DOMAIN NAME LAW AND PRACTICE: AN INTERNATIONAL HANDBOOK* 1015 (2005).

84. ICANN, *BASE REGISTRY*, *supra* note 75.

85. *2013 Registrar Accreditation Agreement*, ICANN, <https://www.icann.org/resources/pages/approved-with-specs-2013-09-17-en> [<http://perma.cc/X5YH-J7AF>].

- (ii) the registrant has no rights or legitimate interests in respect of the domain name; and
- (iii) the registrant's domain name has been registered and is being used in bad faith.⁸⁶

The two-step analysis undertaken to determine the first element underscores the limited scope of applicability to trademarks only:

- (1) Is there a trademark upon which the UDRP claim can be raised?
- (2) If yes, is the domain name identical or confusingly similar?

This initial hurdle presents significant difficulties for government complainants challenging geographic names, which in ordinary circumstances connote a geographic location, rather than a particular trader and its goods, and therefore lack distinctiveness.⁸⁷ Critically, the first element of the UDRP makes clear that without a trademark, the UDRP is not available to a would-be complainant. It is worth specifically noting, however, that the first element does not require that a mark be registered; specific examples are provided below of common law and statutory rights having formed the basis of successful challenges.

The second element of the UDRP, an assessment of a registrant's "legitimate interests" in a domain name, also presents difficulty because geographic names' ordinarily geographic connotation makes them a desirable and logical descriptive choice for a multitude of domain name registrants, commercial or otherwise. Where the complainant government is able to make a prima facie case based upon a lack of rights or legitimate interests, the burden of proof shifts to the domain name registrant to affirmatively demonstrate rights or legitimate interests.⁸⁸ Rights and legitimate interests can be demonstrated by use or preparations to use the name at issue "in connection with a bona fide offering of goods or services"; being "commonly known by the domain name" even in the absence of trademark rights; and making "legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."⁸⁹

The third element, bad faith, has traditionally been less an obstacle to governments seeking to challenge geographic domain

86. *UDRP*, *supra* note 81.

87. *See* FORREST, *supra* note 7, at 149–51.

88. WIPO, WIPO OVERVIEW OF WIPO PANEL VIEWS ON SELECTED UDRP QUESTIONS § 2.1 (2nd ed. 2011), <http://www.wipo.int/amc/en/domains/search/overview2.0/#21> [<http://perma.cc/C9NG-ELK7>].

89. *UDRP*, *supra* note 81.

names once the burden of proving the first and second elements is met.⁹⁰ An attempt to ransom a name to its “rightful owner”⁹¹ is perhaps the clearest indication of bad faith, but as the DNS has matured and awareness of the UDRP has increased, the number of blatant cybersquatting cases has declined. Other bad faith activities include disrupting the business of a competitor or diverting business by creating a likelihood of confusion.⁹² Disclaimers may, but are not guaranteed to, avoid a finding of bad faith.⁹³

While not binding on national courts⁹⁴ or on other UDRP panelists, prior decisions evidence the rationale behind prioritization on the basis of demonstrable, verifiable legal rights and elucidate the norms present in weighing government interests in geographic names against those verifiable legal rights. These norms provide a baseline for evaluating government requests for prioritization in the DNS more broadly. From this baseline, successful government challenges to third party use depend upon a narrow and relatively uncommon constellation of facts, while unsuccessful challenges to third party use fall into two (at times overlapping) categories. Both of those categories serve to emphasize the recognition of trademark rights in the DNS and the non-recognition of government interests in names: (1) complainant government lacks trademark rights, and (2) domain name registrant demonstrates a legitimate right or interest in the name. These categories are analyzed in detail in the remaining sections of this Article.

B. Where Government Succeeds

1. No Use by Domain Name Registrant

One clear path to success in UDRP challenges is laid by the respondent being unable to demonstrate use of the domain name registration. This series of decisions illustrates that UDRP challenges brought by state actors against third-party geographic domain name

90. See, e.g., *SAM Marques de l’Etat de Monaco v. Swartz*, WIPO Case No. D2013-0099 (Mar. 15, 2013), <http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2013-0099> [<http://perma.cc/SXK5-GLW7>]; *Australian Stock Exch. Ltd. v. Cmty. Internet (Australia) Pty. Ltd.*, WIPO Case No. D2000-1384 (Nov. 30, 2000), <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1384.html> [<http://perma.cc/8J5W-PE4C>].

91. *UDRP*, *supra* note 81, at § 4(b)(1).

92. *Id.* at § 4(b)(2)–(4).

93. *City of Hamina v. Paragon Int’l Projects Ltd.*, WIPO Case No. D2001-0001 (Mar. 12, 2001), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0001.html> [<http://perma.cc/P6LZ-MDV3>].

94. See *UDRP*, *supra* note 81, at § 4(k); see also *Weber-Stephen Prods. Co. v. Armitage Hardware & Bldg. Supply, Inc.*, No. 00 C 1738, 2000 WL 562470 (N.D. Ill. May 3, 2000).

registrants may succeed where there is no evidence of the respondent's use of the name, provided that the claimant demonstrates trademark rights. Facts in such disputes range from obvious cybersquatting to unrealized intentions to use the domain name registration.

For example, the Sydney Market Corporation, of Sydney, Australia, successfully challenged the registration of the domain name "sydneymarkets.com" by a registrant who claimed to have registered the name for use in connection with an IT consultancy business known as "Shell Information Systems."⁹⁵ The Sydney Market Corporation was not itself a government entity but had taken on the operation of the Sydney Markets from a statutorily created state-owned enterprise, the Sydney Market Authority.⁹⁶ The state government-owned site from which the markets operated was named "Sydney Markets," a name it acquired in 1996, prior to which it had been known as the suburb of "Flemington."⁹⁷ The panelist noted in his decision that "the Sydney Markets occupy the entire suburb 'Sydney Markets,'" but nevertheless considered the case as involving more a local landmark name than a strictly geographical name.⁹⁸ The website accessed through the respondent's domain name was headed "Sydney I.T. Markets," but no other evidence of use was presented.⁹⁹ Although there was "no evidence that the Respondent registered the contested domain name primarily for the purpose of disrupting the business of a competitor, or even that the Complainant was a competitor of the Respondent," bad faith was found on the basis that the respondent, a Sydney resident, could be assumed to have awareness of the local markets and had registered the domain name to "attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website."¹⁰⁰ The first UDRP element was satisfied not by a registered mark, but by common law rights in the name "Sydney Markets," and the absence of a link between the respondent's IT consultancy and the name "Sydney Markets" supported a finding of no right or legitimate interest.¹⁰¹

95. Sydney Mkts. Ltd. v. Rakis, WIPO Case No. D2001-093 (Oct. 8, 2001), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0932.html> [<http://perma.cc/44SE-WB4D>].

96. *Id.*

97. *Id.*

98. *Id.*

99. *Id.*

100. *Id.*

101. *Id.*

An equivalent outcome resulted in an earlier Australian dispute involving the domain name “australianstockexchange.com.”¹⁰² At the time of the UDRP complaint, the domain name resolved to a “parked” web page which presented the following message: “This domain was registered through . . . registrars.com. We are Moving in Shortly. . . . [P]lease come back soon.”¹⁰³ The respondent ran an “Internet Newspaper” but failed to present evidence of use of the domain name at issue in connection with that business or any other activity.¹⁰⁴ The UDRP panelist inferred from this lack of evidence that the respondent had registered the domain name defensively, “as a way of ‘protecting’ it ‘from being registered by hostile persons.’”¹⁰⁵ The first complainant, Australian Stock Exchange Limited, was a statutorily created corporation “formed to operate the first national exchange, which was named the ‘Australian Stock Exchange,’” the amalgamation of the six independent stock exchanges that had been operated by the various states of Australia.¹⁰⁶ The corporation notably did not possess a registered trademark at the time of the dispute.¹⁰⁷ However, it was found to have satisfied the first UDRP element through the establishment of common law rights.¹⁰⁸ Finding no right or legitimate interest, it was determined that:

[the] domain name bears no relationship to any legitimate business or other activity of the Respondent, because that domain name is not one that the Respondent, in the context of provision of goods, services or information via a web site, would use unless seeking to create a false impression of an association with the Complainants, and because that domain name is not one that the Respondent could legitimately use under Australian law.¹⁰⁹

This final point is notable: that statutorily created complainants may find that their legislative origin speaks to both the first and second UDRP elements, potentially demonstrating the requisite trademark right or preventing third parties from acquiring legitimate rights or interests. Another example of this is provided by the disputed domain name “sydneyoperahouse.net.”¹¹⁰ The

102. Australian Stock Exch. Ltd., v. Cmty. Internet (Australia) Pty Ltd., WIPO Case No. D2000-1384 (Nov. 30, 2000), <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1384.html> [<http://perma.cc/6ZVR-RAKG>].

103. *Id.*

104. *Id.*

105. *Id.*

106. *Id.*

107. *See id.*

108. *See id.*

109. *Id.*

110. Sydney Opera House Trust v. Trilynx Pty. Ltd., WIPO Case No. D2000-1224 (Oct. 31, 2000), <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1224.html> [<http://perma.cc/SQH2-W4UG>].

respondent's IT business specialized in building "web networks," one of which organized various sites including "www.AustNews.com," "www.AustArt.com," "www.AustStocks.com," "www.AustMusic.com," and "www.SydneyHomes.com" under the domain name "Harbourbridge.com." The respondent submitted that it registered the name "sydneyoperahouse.net" and others to "protect" them and create free web networks to be used by the public "for the common good."¹¹¹ As in the case of the domain name "australianstockexchange.com," no use by the respondent was demonstrated and the domain name resolved to a holding page.¹¹² The complainant, Sydney Opera House Trust, was a statutory corporation established under an act of state legislation, the Sydney Opera House Trust Act. The panelist focused on the Trust's legislative mandate, which both confirmed the complainant's trademark rights and prevented the respondent and others from acquiring legitimate rights or interests:

By conferring upon the complainant the right to acquire and register trademarks in connection with its objects and to exercise its rights thereunder, the NSW Parliament, on behalf of the people of New South Wales, Australia, designated the complainant as the appropriate entity to manage and administer the famous building and protect its reputation. Accordingly, sincere though the respondent may be in seeking to be a responsible owner of the disputed domain name and to prevent others from significantly damaging the cultural heritage of all peoples of the world, as expressed in the Sydney Opera House, the law of New South Wales (where both the complainant and the respondent are located) prevents the respondent from establishing a legitimate right or interest in a domain name which incorporates the complainant's trademark.¹¹³

This series of decisions illustrates that UDRP challenges by state actors to third-party geographic domain name registrations may succeed where there is no evidence of the respondent's use of the name, provided that the claimant demonstrates trademark rights. Such cases are not guaranteed to succeed. Consider, for example, a 2001 decision rejecting a challenge to the registrations of "rouen.com" and "rouen.net."¹¹⁴ In that case, the claimant's failure to establish trademark rights made it unnecessary for the panel to reach a determination on the second and third elements of the UDRP. However, one of the three panelists attributed some significance to the respondent's stated intentions to use the domain names at issue.¹¹⁵

111. *Id.*

112. *See id.*

113. *Id.*

114. *Chambre de Commerce et d'Industrie de Rouen v. Stenzel*, WIPO Case No. D2001-0348 (Jun. 18, 2001), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0348.html> [<http://perma.cc/NA3R-TPCP>] (finding that the response was silent as to the respondent's business but expressed an intention to use the domain name registrations in connection with a website providing travel information).

115. *See id.*

Another significant norm emanating from this series of decisions is the recognition of name rights of statutorily created claimants, who may rely upon such statutory origin to prove possession of requisite trademark rights and to disprove third party rights or legitimate interests. Where legislation deals with the name of the created entity, this speaks against third-party rights or legitimate interests, but the mere fact of statutory origin does not displace the need to specifically satisfy each of the three UDRP elements.

2. No Nexus Between Registrant and Domain Name

A related stream of UDRP challenges succeed where there is use of a geographic domain name by its registrant, but this use has little or no actual connection to the domain name registrant. From these decisions the principle can be extrapolated that mere use of a domain name by its registrant is not sufficient; rather, the use must be in connection with genuine ongoing activity not aimed at confusing the public. A prime example is Wembley National Stadium Limited's challenge to the registration of "wembleystadium.net" by a registrant named "Bob Thomson [aka Wembleystadium.net]."¹¹⁶ The panelist had no difficulty in finding the first element satisfied by the complainant's registered and unregistered trademarks, there being "every likelihood that at least members of the British Public [sic] will expect a domain name comprising the words wembleystadium to have some connection with the famous Stadium of that name and the organisation which runs that Stadium, the Complainant."¹¹⁷ The domain name registrant's claim to the name at issue was unconventional: "one week after the Notification of Complaint and Commencement of the Administrative Proceeding was issued to the Respondent by the Center, the Respondent changed his name by deed poll from Robert Thomson to wembleystadium.net." This evidence gave little difficulty in the panel's finding the second and third elements of the stadium's UDRP claim satisfied.

While geographic names' inherently descriptive character legitimizes third-party use, the strength of this registrant-favorable evidence on the second UDRP element is limited by the need for an actual connection between the respondent, its products or services, and the location. For example, a website associated with the domain

116. Wembley Nat'l Stadium Ltd. v. Thomson, WIPO Case No. D2000-1233 (Nov. 16, 2000), <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1233.html> [<http://perma.cc/TN4R-CYUT>].

117. *Id.*

name “montecarlovodka.com” advertised the pending availability of a vodka named “Monte Carlo Vodka.”¹¹⁸ The US-based registrant demonstrated no link to the principality of Monte Carlo or any link between the vodka, which was produced in both France and Monte Carlo.¹¹⁹ The respondent’s pending US trademark application was noted by the panel but considered unlikely to succeed due to its false use of a geographical indication in connection with spirits and use of a logo similar to the coat of arms of the Principality of Monaco, both prohibited under US trademark law.¹²⁰ Although the respondent had made use of the domain name, it was considered unlikely that the market knew of the respondent and its products by that name. Thus, the use was found to be insufficient to support a finding of legitimate rights or interest in the name.¹²¹

This stream of decisions illustrates that use of the domain name by its registrant will not per se defeat government challenges to geographic domain name registrations by third parties. These decisions also highlight the need for a genuine factual connection between registrant and domain name. It must be carefully noted, however, that just as trademark law recognizes acquired distinctiveness,¹²² UDRP panels will probe for consumer awareness where the connection is not patently evident. That said, the factual underpinnings of cases falling in this basket are relatively uncommon because they tend not to involve local citizens who identify their business or other activity with the name of its location.

3. Domain Name Registrant Defaults

Finally, government challenges to geographic domain name registrations are successful where the respondent fails to participate in the UDRP process. In a dispute involving the domain name “sydneyairports.com,”¹²³ for example, the complainant operator of Kingsford Smith Airport—which the panel noted was “known

118. SAM Marques de l’Etat de Monaco v. Swartz, WIPO Case No. D2013-0099 (Mar. 15, 2013), <http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2013-0099> [<http://perma.cc/2PSA-PL9Z>].

119. *See id.*

120. *See id.* (citing 15 U.S.C. §§ 1052 (2)(a)–(b)).

121. *See id.*

122. Agreement on Trade-Related Aspects of Intellectual Property Rights, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, art. 15(1), Apr. 15, 1994, 1869 U.N.T.S. 299 (“Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use.”).

123. Sydney Airport Corp. v. John Crilly, WIPO Case No. D2005-0989 (Nov. 22, 2005), <http://www.wipo.int/amc/en/domains/decisions/html/2005/d2005-0989.html> [<http://perma.cc/4UYP-5DSF>].

nationally and internationally as Sydney Airport and has been so since 1998 when the airport was privatised¹²⁴—satisfied the first UDRP element with its stylized Australian registered trademark “comprising the words ‘Sydney Airport.’”¹²⁵ The panel drew inferences from the respondent’s default in finding no rights or legitimate interests.¹²⁶ Due to the similarity between the complainant’s trademark and “sydneyairport” domain names registered in the “.com,” “.info,” “.net,” “.org,” and “.com.au” domains, the panel also found bad faith, characterizing the registration as “a clear attempt by the Respondent to divert users to Internet sites other than the Complainant’s.”¹²⁷

Each of the three streams of successful challenge circumstances highlighted above is narrowly limited by the facts. Notably, the key to the complainant government’s success is an omission or failing on the part of the domain name registrant more than a positive act on the part of the government (although as the discussion immediately following highlights, this assumes that government has taken the affirmative steps needed to secure trademark rights). Accordingly, successful challenges tend not to implicate local citizens and businesses that self-identify according to geography or who acquire a reputation through use of the name.

C. Where Government Fails

1. No Government Trademark

A significant obstacle to success in challenging geographic domain names in UDRP proceedings is the UDRP’s limited scope, reflected in its elements, under which only trademarks are actionable.¹²⁸ From this stream of UDRP challenges emerges the guiding principle that claims to sovereignty, governments’ expressions of dissatisfaction, or public interest-type concerns are not valid bases upon which to construct geographic domain name challenges.

The benchmark for actionability, set according to the harmonized minimum standards of Article 15(1) of the TRIPS

124. *Id.*

125. *Id.*

126. *See id.*

127. *Id.*

128. *See Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”),* ICANN (July 31, 2015), <https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en> [<http://perma.cc/R97K-44DL>] (requiring at Cl. 3(b)(viii) that the UDRP complaint “[s]pecify the trademark(s) or service mark(s) on which the complaint is based and, for each mark, describe the goods or services, if any, with which the mark is used”).

Convention, is relatively high. These standards allow World Trade Organization members to recognize marks that are not simply inherently distinctive, but have acquired distinctiveness through use.¹²⁹ Inherent distinctiveness essentially demands that a sign bring to mind one and only one message;¹³⁰ this is extremely unlikely for geographic names because in addition to any other connotations a commercial enterprise might attempt to create in the mind of the consuming public, they identify a particular geographic location. Trademark distinctiveness can only be achieved through commercial use to replace the inherent connotation of geography with a trader and its particular goods or services.

Challenges to geographic names have consequently—and unsurprisingly—failed on the first UDRP element. From these decisions emerge norms that strike the balance of public and private rights and interests in geographic domain names. The oft-cited dispute between the government of New Zealand and a US-based company called Virtual Countries over the domain name “newzealand.com”¹³¹ is a logical starting point in this analysis, as it elucidates the limits of asserting sovereign rights and makes clear that these are not equivalent to the trademark rights upon which a UDRP claim must be based.

Virtual Countries registered a number of countries’ names as domain names and used them in connection with websites providing information about the named country. In the case of “newzealand.com,” Virtual Countries had taken the additional step of registering “newzealand.com” as a US trademark. At the time of the dispute, the complainant government of New Zealand had five trademark applications pending in New Zealand for the mark “NEW ZEALAND;” the applications were not considered by the panel because none had been issued. New Zealand’s claim was therefore based on common law unregistered trademark rights, but no evidence of secondary meaning was presented, prompting the panel to note that “to support the claim to trade/service mark rights the Complainant relies solely and exclusively upon the geographical significance of the name.”¹³² The first UDRP element was found not satisfied, so the claim failed. Common law rights were similarly rejected in a

129. See *supra* note 122 and accompanying text.

130. See Charles Martin, *The Meaning of Distinctiveness in Trademark Law*, 45 U. ILL. L. REV. 535, 536 (1951).

131. HM the Queen *ex rel* New Zealand v. Virtual Countries, Inc., WIPO Case No. D2002-0754 (Nov. 27, 2002), <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0754.html> [<http://perma.cc/GMA2-96LL>].

132. *Id.*

challenge to the domain name “cityofdearborn.com” by the city of Dearborn in Michigan.¹³³

Equivalent determinations have been made in relation to marks from civil law countries. Challenges to the domain names “olkiluoto.com” and “olkiluoto.net,”¹³⁴ as well as “portofhelsinki.com,”¹³⁵ for example, relied unsuccessfully on Article 2 of the Finnish Trademark Law. Article 2 establishes trademark rights on the basis of establishment of the mark on the market. According to the third paragraph of Article 2, “a trade symbol shall be regarded as established if it has become generally known in the appropriate business or consumer circles in Finland as a symbol specific to its proprietor’s goods.”¹³⁶

In the “portofhelsinki.com” dispute, the complainant authority of the Finnish capital city of Helsinki had made extensive and long-time use of the name “Port of Helsinki,” but had not registered the term as a trademark. Thus, it relied on the establishment of the mark under Article 2. The panelist rejected this argument for lack of supporting evidence. Similarly, in the challenge to an environmental group’s registrations of the name “Olkiluoto,” the name of the island on which the complainant’s nuclear power facility is situated, the complainant failed to demonstrate that the “general Finnish public through the considerable press coverage has come to identify Olkiluoto.” Olkiluoto was not part of the complainant’s trade name, which was used by other businesses on the island along with the complainant’s power services.¹³⁷

The “portofhelsinki.com” decision was referenced by a subsequent UDRP panel in a challenge by the German city of Heidelberg to the domain name “heidelberg.net.”¹³⁸ In that dispute, the city asserted protection of the name “Heidelberg” under German

133. City of Dearborn v. Mekled, Nat’l Arb. F. Case no. 99602 (Nov. 12, 2001), <http://www.udrpsearch.com/naf/99602> [<http://perma.cc/XNT2-Y6M6>].

134. Teollisuuden Voima OY v. Vastamäki, WIPO Case No. D2001-0321 (May 4, 2001), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0321.html> [<http://perma.cc/Z6GP-WJTD>].

135. Port of Helsinki v. Paragon Int’l Projects Ltd., WIPO Case No. D2001-0002 (Feb. 12, 2001), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0002.html> [<http://perma.cc/DQQ7-3V2P>]. Cf. City of Hamina v. Paragon Int’l Projects Ltd., WIPO Case No. D2001-0001 (Mar. 12, 2014), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0001.html> [<http://perma.cc/WF9F-AG6M>] (valid trademark established, relying on the *Chiemsee* decision of the European Court of Justice interpreting Article 3(3) of the First Directive 89/104/EEC, but second and third UDRP elements not established).

136. *Port of Helsinki*, WIPO Case No. D2001-0002 at § 6.

137. *Teollisuuden Voima*, WIPO Case No. D2001-0321 at § 5A.

138. Stadt Heidelberg v. Media Factory, WIPO Case No. D2001-1500 (Mar. 6, 2002), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-1500.html> [<http://perma.cc/5ZA8-WT57>].

legislation but failed to specify the precise statutory origin in German law of this protection.

The Brisbane City Council's challenge to the domain name registration "brisbane.com" in 2001 was similarly hampered by private action.¹³⁹ This dispute also highlights the limits of asserting a government trademark portfolio of marks that include, but are not identical to, the challenged registration. The respondent advertising agency had registered the name "brisbane.com" and the names of other Australian state capital cities as part of a business plan "to develop a network of visual information booths or kiosks to be located in areas including major shopping centres."¹⁴⁰ The complainant city council sought to satisfy the first UDRP element by asserting statutory rights under the City of Brisbane Act 1924 to exercise powers under the name "Brisbane City Council" and trademark rights in the following registrations:

E-BRISBANE logo;

WATER SAVE IT! – BRISBANE CITY logo (the panel highlighted that the registration disclaimed right to the exclusive words "Brisbane City"); and

BRISBANE CITY WORKS logo.¹⁴¹

Just prior to lodging its UDRP claim, the City Council filed an application for the trademark "BRISBANE CITY" in a number of classes.¹⁴² The application, which could only be characterized as optimistic in light of the disclaimer on the City Council's existing "WATER SAVE IT!—BRISBANE CITY" trademark noted above, was pending when the UDRP panel was convened.¹⁴³ The panel considered this and the respondent's demonstration of extensive third-party registration of business names, corporate names, and trademarks in Australia incorporating or comprising the name "Brisbane" or "Brisbane City" to be "an indication that the Complainant does not have trademark rights to 'Brisbane City' or 'Brisbane.'"¹⁴⁴

139. Brisbane City Council v. Joyce Russ Advert. Pty Ltd., WIPO Case No. D2001-0069 (May 14, 2001), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0069.html> [<http://perma.cc/N5WY-BSKJ>]; see also Brisbane City Council v. Warren Bolton Consulting Pty Ltd., WIPO Case No. 2001-0047 (May 7, 2001), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0047.html> [<http://perma.cc/MYG4-JZGB>].

140. *Joyce Russ Advert.*, WIPO Case No. D2001-0069 at § 4B.

141. *Id.* at § 4A.

142. *See id.* at § 6.

143. *See id.*

144. *Id.*

In another challenge to a domain name registered by Virtual Countries, “puertorico.com,”¹⁴⁵ the complainant, a public corporation of the Commonwealth of Puerto Rico, owned multiple registered trademarks consisting of slogans comprising the name “Puerto Rico” and other words (for example, “Puerto Rico ¡Lo hace mejor!”).¹⁴⁶ The challenge was defeated because no registration was comprised solely of the name “Puerto Rico.” The Madrid City Council’s registrations for marks comprising the name “Madrid” along with other words (for example, “PROMOTION MADRID” and “MADRID CIUDAD 2000”) were likewise found to be insufficient to challenge the domain name registration “madrid.com.”¹⁴⁷ While trademark rights were established in a challenge to the domain name registration “andalucia.com,” the panel in that dispute notably characterized the finding as a “close call.”¹⁴⁸

The domain name registrations “rouen.com” and “rouen.net” were also unsuccessfully challenged by the Chamber of Commerce of the city of Rouen, France, despite the fact that the city’s name was mentioned twice in a registered trademark, “C.C.I. ROUEN E.S.C. ROUEN L’ESPRIT DE CONQUETE.”¹⁴⁹ The three members of the UDRP panel agreed that the first element had not been satisfied, offering differing reasons that converged on a lack of identity or confusing similarity.¹⁵⁰ It was acknowledged that the “attractive element” of the complainant’s French trademark registration, the geographic name “Rouen,” was identical to the domain name registration at issue.¹⁵¹ The panel nevertheless found it impossible for “Rouen” to “be stripped of the abbreviations and the tag or epithet Spirit of Conquest, such that in essence the distinctive element is ROUEN.”¹⁵²

145. Puerto Rico Tourism Co. v. Virtual Countries, Inc., WIPO Case No. D2002-1129 (Apr. 14, 2003), <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-1129.html> [<http://perma.cc/SEQ7-LCEQ>].

146. This slogan is translated in English as: “Puerto Rico does it better!” *Id.*

147. Empresa Mun. Promoción Madrid S.A. v. Easylink Servs. Corp., WIPO Case No. D2002-1110 (Feb. 26, 2003), <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-1110.html> [<http://perma.cc/YN59-62QT>].

148. Junta de Andalucía Consejería de Turismo, Comercio y Deporte, Turismo Andaluz, S.A. v. Andalucía.com Ltd., WIPO Case No. D2006-0749 (Oct. 13, 2006), <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0749.html> [<http://perma.cc/MQ7Z-RETM>].

149. Chambre de Commerce et d’Industrie de Rouen v. Marcel Stenzel, WIPO Case No. D2001-0348 (Jun. 18, 2001), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0348.html> [<http://perma.cc/2N2H-GD3S>].

150. *See id.*

151. *Id.*

152. *Id.*

Finally, rarely has local trademark law played a more prominent role in a UDRP dispute than in the 2000 challenge to the domain name registration “barcelona.com.”¹⁵³ The local government based its UDRP claim on various trademark registrations consisting of “one main element, namely the expression ‘BARCELONA’ and another element of different importance, namely ‘Excelentísimo Ayuntamiento de Barcelona.’” The sole panelist (who had also served on the three-member panel in the “andalucia.com” dispute) found the first UDRP element to be established on the basis that the “distinctive character” of the local government’s mark was the name “Barcelona.” The domain name had initially been registered in 1996 by a resident of Barcelona, who in 2000 transferred the name to a New York company wholly owned by the original registrant and her husband. The respondent’s claim to rights or legitimate interests of the domain name was based on priority under the first-come, first-served system. The panelist rejected the claim to legitimate interests and also found bad faith. The respondent subsequently brought an action against the Barcelona local government in US courts under the Anticybersquatting Consumer Protection Act (ACPA).¹⁵⁴ The district court supported the outcome of the UDRP.¹⁵⁵ The Fourth Circuit Court of Appeals subsequently reversed the decision,¹⁵⁶ finding that the lower court had inappropriately applied Spanish law and that the Lanham Act (which incorporates the ACPA) should have been applied.

Applying the ACPA, the court came to:

the ineluctable conclusion . . . that Bcom, Inc.’s registration and use of the name “Barcelona” is not unlawful. Under the Lanham Act, and apparently even under Spanish law, the City Council could not obtain a trademark interest in a purely descriptive geographical designation that refers only to the City of Barcelona. Under United States trademark law, a geographic designation can obtain trademark protection if that designation acquires secondary meaning. On the record in this case, however, there was no evidence that the public—in the United States or elsewhere—associates “Barcelona” with anything other than the City itself. Indeed, the Chief Director of the City Council submitted an affidavit stating that “[t]he City does not own and is not using any trademarks in the United States, to identify any goods or services.” Therefore, under United States trademark law, “Barcelona” should have been treated as a purely descriptive geographical term entitled to no trademark protection. It follows then that there was nothing unlawful about Nogueras’ registration of <barcelona.com>,

153. *Excelentísimo Ayuntamiento de Barcelona v. Barcelona.com Inc.*, WIPO Case No. D2000-0505 (Aug. 4, 2000), <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0505.html> [<http://perma.cc/6HAJ-5LN9>].

154. 15 U.S.C. § 1125(d).

155. *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento de Barcelona*, 189 F. Supp. 2d 367 (E.D. Va. 2002).

156. *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento de Barcelona*, 330 F.3d 617 (4th Cir. 2003).

nor is there anything unlawful under United States trademark law about Bcom, Inc.'s continued use of that domain name.¹⁵⁷

What emerges from this stream of UDRP challenges is that government prioritization is rejected when interests are based purely on sovereignty, government dissatisfaction, or public interest-type concerns—the very bases upon which governments seek priority over trademark holders and others at both the top and second levels through new gTLD policy. Sovereignty claims are not equivalent to, and do individually provide a basis for, challenging a private party's use of the name in the DNS. This rejection of government prioritization is, of course, explained by the strict limitation of the UDRP to actionable trademark rights, but here it must be highlighted that sovereignty offers no legal (and, specifically, no trademark-equivalent) claim to a particular name.¹⁵⁸ Arguably, this point is inherently acknowledged by WIPO in its having limited the scope of applicability of the UDRP (as is evident from the first UDRP element cited above) to trademarks. In summary, these UDRP decisions explain the limitations of the status quo of prioritization in domain name allocation to recognized legal rights—trademark rights—as an exception to first-come, first-served domain name allocation.

2. Use of the Name by the Registrant

Satisfaction of the first UDRP element, that the complainant has rights in a confusingly similar mark, does not automatically precede satisfaction of the second element, that a registrant lacks legitimate rights in the domain name.¹⁵⁹ Each element must be proven, but the two are conceptually linked.¹⁶⁰ The obvious consequence of the requirement of trademark distinctiveness is that the descriptive nature of geographic terms weakens governments' position in establishing trademark rights. The logical corollary to this should be that the descriptive nature of geographic terms serves to weaken governments' argument that third parties lack rights or legitimate interests in geographic names. Arguments to this effect

157. *Id.* at 628–29 (internal citations omitted).

158. *See* FORREST, *supra* note 7, at 170–88.

159. *See, e.g.,* HM the Queen *ex rel* New Zealand v. Virtual Countries, Inc., WIPO Case No. D2002-0754 (Nov. 27, 2002), <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0754.html> [<http://perma.cc/YE6A-XU5Q>] (noting that “even if the Complainant does have trademark or service mark rights in respect of the Domain Name, the Panel would have required a lot more evidence than the Complainant has put before the Panel to persuade it that the Respondent has no rights or legitimate interests in respect of the Domain Name”).

160. *UDRP, supra* note 81, at § 4(a) (“In the administrative proceeding, the complainant must prove that each of these three elements are present.”).

have not been universally accepted by UDRP panels, as evidenced by the “barcelona.com” UDRP decision,¹⁶¹ in which the respondent’s claims to rights or legitimate interests based on first registration of a descriptive term were rejected by the panel but notably formed, ultimately, the basis for the subsequent litigation in the United States.¹⁶²

The element of legitimacy divided the three-member panel in a challenge brought by the authority of Manchester Airport to the domain name registration “manchesterairport.com.”¹⁶³ Two of the three panelists found the second UDRP element unmet. The two panelists based their finding on the respondent’s claims that they have registered the domain name to offer website services to a group of businesses established at the airport. The presiding panelist questioned whether the choice of name had been motivated solely by descriptive reference and not with the intention to trade as, or suggest affiliation with, the airport.

By contrast, the three-member panel that administered the challenge by the local commerce and tourism department of Andalusia, Spain, to “andalucia.com”¹⁶⁴ agreed in finding legitimacy in the respondent’s nexus to the domain name. The respondent had registered the domain name in 1996 and incontrovertibly used it to operate a website providing information about Andalusia for tourists and expatriates.¹⁶⁵ The panel found:

[W]here, as here, a respondent is using a geographic indication to describe his product/business or to profit from the geographic sense of the word without intending to take advantage of complainant’s rights in that word, then the respondent has a legitimate interest in respect of the domain name.¹⁶⁶

This is a logical point to highlight that proof of the second element of the UDRP does not hinge on a subjective evaluation of the quality of a website. In other words, there are no “minimum

161. Excelentísimo Ayuntamiento de Barcelona v. Barcelona.com Inc., WIPO Case No. D2000-0505 (Aug. 4, 2000), <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0505.html> [<http://perma.cc/L7ZN-PSUW>].

162. See *supra* notes 155 and 156.

163. Manchester Airport PLC v. Club Club Ltd., WIPO Case No. D2000-0638 (Aug. 22, 2000), <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0638.html> [<http://perma.cc/H3T6-2TQQ>].

164. Junta de Andalucía Consejería de Turismo, Comercio y Deporte, Turismo Andaluz, S.A. v. Andalucía.com Ltd., WIPO Case No. D2006-0749 (Oct. 13, 2006), <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0749.html> [<http://perma.cc/75PR-WQCB>].

165. See *id.*

166. *Id.*

standards for development”¹⁶⁷ of a site operated under a particular domain name. Although the panel found it unnecessary to reach a decision on rights or legitimate interests in the government of New Zealand’s challenge of the “newzealand.com” domain name registration,¹⁶⁸ its comments on this point are instructive. The threshold of legitimate use is not so high as the well-maintained and clearly functional website operated under the “andalucia.com” domain name registration; even a website that is “sketchy and badly in need of being updated”¹⁶⁹ may suffice.

While the “anyone can use it” argument tends to defeat the first UDRP element, the existence of a trademark, it is too simplistic to say that the same argument also defeats the second element, the absence of rights or legitimate interests. A more precise articulation of the norm derived from this series of disputes is the fact that anyone can use a geographic name means that private party (i.e., non-government) use of a geographic domain name is not inherently illegitimate. This norm is a cornerstone of domain name allocation at the second level of the DNS. Geographic domain name registrations by private party registrants are not inherently illegitimate, and domain name allocation policy should not be developed at any level that treats them as such. Each dispute turns on its own facts, and allocation policy must facilitate the evaluation of those facts.

IV. CONCLUSIONS

UDRP-derived norms provide meaningful insight into the process and substance of evaluating governments’ assertion of priority rights at all levels of the DNS, not simply the second level where the UDRP is applicable. This is not based on an underlying principle of binding precedent—quite clearly, UDRP decisions are not binding on courts, other UDRP panels, or any other decision maker—but rather on the value of relying upon established norms within a system whose core values are transparency, accountability, and consistency.¹⁷⁰

167. Empresa Mun. Promoción Madrid S.A. v. Easylink Servs. Corp., WIPO Case No. D2002-1110 (Feb. 26, 2003), <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-1110.html> [<http://perma.cc/WD8L-25EY>], quoting Penguin Books Ltd. v. Katz Family and Anthony Katz, WIPO Case No. D2000-0204 (May 20, 2000), <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0204.html> [<http://perma.cc/AP6S-4VVT>].

168. HM the Queen *ex rel* New Zealand v. Virtual Countries, Inc., WIPO Case No. D2002-0754 (Nov. 27, 2002), <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0754.html> [<http://perma.cc/8HKM-FJXQ>].

169. *Id.*

170. See UDRP, *supra* note 81, § 4(k); see also Weber-Stephen Prods. Co. v. Armitage Hardware & Bldg. Supply, Inc., No. 00 C 1738, 2000 WL 562470 (N.D. Ill. May 3, 2000).

Governments' requests to ICANN—to exempt governments' applications for geographic domain names from sunrise requirements, to impose consent requirements on private party uses of geographic names, and to preemptively reserve geographic names for government use—bear striking resemblance to the claims made in a series of “overwhelmingly unsuccessful”¹⁷¹ UDRP challenges more than a decade ago. The UDRP and decisions under it offer no support for per se prioritization of government interests in domain name allocation. Panels have repeatedly and consistently found that governments do not have what the government of Puerto Rico in its challenge against Virtual Countries, and indeed more recently and broadly by the GAC in new gTLD policy-making, argued were “better rights or more legitimate interests”¹⁷² than non-government parties.

The existing body of UDRP decisions assessing government interests in geographic domain names serves a normative function that contributes to the consistency, accountability, and transparency of ICANN DNS policy making. Procedurally, government claims are treated no differently than private parties' claims. As in all disputes there must be, as a first step, a valid trademark. The existence of a trademark is not of itself dispositive; claimants must additionally prove that the respondent has no legitimate rights or interests, as well as bad faith. The domain name registrant must, therefore, succeed in the context of such ordinary and legitimate business enterprises such as online tourism products and services and where descriptive use is related to geographically identified goods and services.¹⁷³

As the DNS expands, its top level (the level of gTLDs, such as “.com,” “.org,” and more recently, “.cars” and “.lawyer”), at which expansion has until very recently occurred at a very measured and carefully controlled rate, assumes the characteristics and attributes—and therefore also the conflicts and challenges—of the rapid, conflict-ridden expansion at the second level, where the general public registers domain names. One impact of this convergence of circumstances and challenges in top-level and second-level DNS expansion is that established UDRP norms are now relevant and instructive in evaluating government claims to priority beyond the UDRP context. Governments' requests for exemptions from

171. OLSEN, *supra* note 82.

172. Puerto Rico Tourism Co. v. Virtual Countries, Inc., WIPO Case No. D2002-1129 (Apr. 14, 2003), <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-1129.html> [<http://perma.cc/W7Q2-D6MQ>].

173. See, e.g., Junta de Andalucía Consejería de Turismo, Comercio y Deporte, Turismo Andaluz, S.A. v. Andalucía.com Ltd., WIPO Case No. D2006-0749 (Oct. 13, 2006), <http://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0749.html> [<http://perma.cc/SY8G-6NCE>].

trademark protections to super-prioritize their interests in geographic names bear striking resemblance to the claims made by government complainants in UDRP challenges. UDRP panels have expressly rejected the claim that geographic domain names belong to government in challenges to both:

“portofhelsinki.com”: “The Panel cannot agree with the contention that a unique geographical name should be considered as belonging to the legal authority of the geographical area in question under the Policy”,¹⁷⁴ and

“portofhamina.com”: “The Administrative Panel takes definite exception to the Complainant’s view that rights to a unique geographical name should, evidently as a matter of principle, be regarded to belong to the owner of the geographical area in question.”¹⁷⁵

Further, the claim that private parties have no rights or legitimate interests in geographic domain names because only governments have rights or legitimate interests in geographic domain names has been expressly rejected by UDRP panels, including the panel that administered the challenge to “newzealand.com”: “[T]he Panel would have required a lot more evidence than the Complainant has put before the Panel to persuade it that the Respondent has no rights or legitimate interests in respect of the Domain Name.”¹⁷⁶

Where governments possess trademark rights, these rights under the UDRP do not—and should not in any context of DNS policy be permitted to—automatically trump non-government parties’ rights. UDRP claims brought by governments possessing trademarks have failed despite the claimant government’s ownership of registered or unregistered marks; all elements of the UDRP must be established. Where geographic terms are permitted to be registered as trademarks, their registration and use by many is indicative of the non-exclusivity of government’s interests. Where geographic terms are disclaimed in a trademark registration, the result is the same.

Finally, it is clear that each UDRP decision turns on its facts, with the outcome depending heavily not only upon the claimant’s rights to the name in dispute, but also on the respondent’s use and intentions. The varied factual constellations identified above reveal the impracticality and unworkability in developing a uniform name-allocation framework applicable across all levels of the DNS, of

174. Port of Helsinki v. Paragon Int’l Projects Ltd., WIPO Case No. D2001-0002 (Feb. 12, 2001), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0002.html> [<http://perma.cc/J8AC-5PYB>].

175. City of Hamina v. Paragon Int’l Projects Ltd., WIPO Case No. D2001-0001 (Mar. 12, 2014), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0001.html> [<http://perma.cc/522S-ZJZ7>].

176. HM the Queen *ex rel* New Zealand v. Virtual Countries, Inc., WIPO Case No. D2002-0754 (Nov. 27, 2002), <http://www.wipo.int/amc/en/domains/decisions/html/2002/d2002-0754.html> [<http://perma.cc/QEN9-WCA5>].

a universal rule of government super-prioritization in geographic domain name allocation. While it can be said that “merely because the contested domain name has a geographic connotation does not mean that the Complainant should fail,”¹⁷⁷ neither, as more than a decade of UDRP precedent shows, does this mean that the complainant government should succeed. This conclusion is notably consistent with not only the findings of WIPO on the availability of legal protection for government interests in geographic domain names, but also with the limited scope of application of the UDRP.¹⁷⁸ Applying the principles elucidated from UDRP decisions on geographic domain names and the rationale of the UDRP, with its dependence upon clearly demonstrable legal rights as a basis for a valid complaint, would provide ICANN with a rational, legally justified method of assessing government claims to geographic names in the DNS as a whole.

177. Sydney Mkts. Ltd. v. Nick Rakis trading as Shell Info. Sys., WIPO Case No. D2001-093 (Oct. 8, 2001), <http://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0932.html> [<http://perma.cc/XE4L-AVPR>].

178. WIPO II, *supra* note 8, at 205.