

INFORMATION LAW SERIES

**PROTECTION OF GEOGRAPHIC
NAMES IN INTERNATIONAL LAW
AND DOMAIN NAME SYSTEM**
SECOND EDITION

Heather Ann Forrest



Wolters Kluwer

Protection of Geographic Names in International Law and Domain Name System

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Objective & Readership

Publications in the Information Law Series focus on current legal issues of information law and are aimed at scholars, practitioners, and policy makers who are active in the rapidly expanding area of information law and policy.

Introduction & Contents

The advent of the information society has put the field of information law squarely on the map. Information law is the law relating to the production, marketing, distribution, and use of information goods and services. The field of information law therefore cuts across traditional legal boundaries, and encompasses a wide set of legal issues at the crossroads of intellectual property, media law, telecommunications law, freedom of expression, and right to privacy. Recent volumes in the Information Law Series deal with copyright enforcement on the Internet, interoperability among computer programs, harmonization of copyright at the European level, intellectual property and human rights, public broadcasting in Europe, the future of the public domain, conditional access in digital broadcasting, and the 'three-step test' in copyright.

The titles published in this series are listed at the end of this volume.

Foreword

The World Wide Web, conceived in the 1980s as a specialized tool facilitating computer-based information flows among a few professionals, exponentially grew in recent years and became a principal tool of general communication, indispensable to business, government, science and society at large with some 205 million second-level domain names by 2010. The network grew without a proper legal framework – perhaps thanks to that, it rapidly conquered the world beyond all initial expectations. It was not designed to fit the law, nor was the law ready for it. This is true both in domestic and international law.

When ICANN's Board of Directors announced preparations for new top-level domain names in 2008, largely with a view to meet new demands and to diversify an overstretched .com top-level, it was by no means clear whether the possibility of recourse to geographical names was compatible with international law and law in general. This book undertakes to assess the legal regime accompanying geographical top-level domain names. Is it lawful and possible to allocate names such as .asia, or .europe, or a particular locality, such as .newyork, as a prime organizational structure for the internet Domain Name System? Who is entitled to use these denominations?

Given the global dimension of the internet, this study seeks to answer these questions from a perspective of international law. The author examines the implications of positive international law with a view to assess to what extent geographical names are currently protected by different titles, and to what extent they can be exclusively claimed by governments in defence of territorial prerogatives under the principle of sovereignty. In doing so, this book walks a number of avenues, ranging from intellectual property to unfair competition and to human rights. It offers a comprehensive analysis of a field

Foreword

which raises more questions than clear answers can be provided, given the flux and novelty of the field.

The author concludes her survey in finding that States cannot claim exclusive rights, and a great number of different factors will need to be taken into account in shaping future rules on the subject. Her work offers a most valuable contribution to this effort, as it sets out all the different legal facets which internet law should take into account in the field of internet domain name allocation.

This book is of great interest both to practitioners and to academics focusing on internet governance and its challenges in the process of legal globalization. It is based upon a thesis submitted to the Faculty of Law at the University of Bern, Switzerland in 2011. Working with Heather Forrest during regular visits to the World Trade Institute was a pleasure, as well as an experience of gradually understanding an entirely new and emerging field of international economic law, thanks to the effort of the author of this highly commendable work.

Prof. Thomas Cottier

"In the absence of justice, what is sovereignty but organized robbery?" Saint Augustine

Since the first edition of Heather's book which was published three years ago, the world of ICANN has become surprisingly unpredictable. Whether you are an IP attorney or a policy advisor, a representative of civil society or a government official, if you are seeking truth and certainty in regard to the protection of geographic names in the domain name system, the road ahead is long and winding.

When the stewardship of IANA transferred away from the US Government to the private sector in October 2016, there was much talk in ICANN, the IGF and even the ITU about accountability and transparency. This unexpectedly positive manifestation of multi-stakeholderism was accompanied by mutual back-slapping and bonhomie. We were all friends with the common goal of cyberspace stability, and we wanted the best result for the most.

Unfortunately, the willingness of parties to engage in respectful debate and reasoned argument dissipates all too rapidly when the focus turns to the more esoteric subject of geographical name protection.

Perhaps it is something to do with the recent rise of populism and its less savoury companion, nationalism. Were we naïve to expect anything else when sovereignty slouched out of the shadows to commandeer the ballot box in elections across 2016?

Whatever the reason, there is a need now more than ever for clarity in the creation of cyber-policy and the allocation of terms of geographic

significance. Heather's book looks at the hard questions relating to international law and geographic names on the internet. Her crisp analysis lays a trail you can follow even whilst the democratic and the demagogic tussle for control over such terms and identifiers.

Her conclusion is clear. Nation States cannot claim exclusive rights in geographical terms – at least not yet. She examines the issue from the perspective of custom and general principle, intellectual property protection, human rights, unfair competition and related commercial rights, international and soft law and more. The time may come when States seek to change international law because technology cannot be outside the law, but that is in the future.

Along the way, Heather considers the likelihood of a globally applicable solution emerging within ICANN that Nation States and intellectual property owners alike will accept. She also outlines factors which must be taken into account as the internet community lays the foundation for Round Two / Subsequent Procedures of the new gTLD program.

Echoing Saint Augustine 1500 years after his death, Kemal Ataturk said, 'Sovereignty is not given, it is taken'. This position holds true in the age of the internet. The Working Groups developing policy and practice wherever internet governance is debated – and indeed all of us interested in fairness and the rule of law – need to recognize this. Thanks to Heather and her meticulous research, we can at least start on the right track.

Nick Wood
Managing director of Com Laude & Valideus

Preface and Acknowledgements

The catalyst for the study documented in this book was the June 2008 decision of the Board of Directors of the Internet Corporation for Assigned Names and Numbers (ICANN) to commence a new round of expansion at the top-level of the internet Domain Name System. This book is the product of a doctoral thesis commenced at the University of Bern, Switzerland under the supervision of Professor Thomas Cottier, now Emeritus Professor of Law and Senior Research Fellow of the World Trade Institute at the University of Bern, and then Director of the World Trade Institute and Institute for European and International Economic Law. Professor Cottier's inestimable experience in intellectual property and trade law pushed me to new levels of understanding and enquiry, inspired me to draw connections where previously I had not even considered that these existed, and encouraged me to look beyond the microcosm of ICANN policy-making to the larger world in which it operates.

This study was additionally guided by Professor Dr Jürgen Bröhmer, then-Head of the School of Law at the University of New England, now Dean of the School of Law at Murdoch University and Visiting Professor at the Europa Institute, Saarbrücken University. Professor Bröhmer's early support encouraged me to turn mere wonderings about the legality of domain name policy into a doctoral study. His input and insight at so many stages along the journey have inspired me to question fundamental assumptions; he has thus contributed much to the rigour of this work, particularly as respects the role of human rights law in the protection of geographic names.

Thanks to Professor Cottier and Professor Bröhmer, I had the great pleasure of undertaking several months of research in residence at the Institute of European and International Economic Law at the University of Bern, Switzerland. I am particularly grateful to Dr Mira Burri, Dr Christian

Preface and Acknowledgements

Häberli, Dr Dannie Jost, Professor Marion Panizzon and Dr Susan Brown-Shafii for their support and interest in my work. I am also grateful to them for having introduced me to Dr Ueli Buri of the Swiss Federal Intellectual Property Institute and Professor Rolf Weber of the University of Zürich, who generously offered input in their respective areas of specialization and provided me with an opportunity to test my ideas. Further, the successful completion of this study also owes much to Wulfhard Stahl, Institute librarian, and the Institute staff, in particular Rosemarie Cöppicus and Gaby Hofer. It has been a pleasure to keep in touch with several of my fellow doctoral candidates and to be introduced to newly commencing candidates, all of whom I wish tremendous happiness and success in their future endeavours.

The first edition of this work was blessed with moral support from colleagues at the School of Law at the University of New England and the Thomas More Academy of Law at Australian Catholic University. The second edition has benefitted from the support of the Faculty of Law at the University of Tasmania, and particularly Dean Margaret Otlowski and Deputy Dean Rick Snell. LL.B. candidate Sophie Hey's research skills and attention to detail have contributed to the precision of citations and the expanded bibliography in this second edition.

For offering me the opportunity to revisit this work and produce a second edition, I am grateful to Wolters Kluwer and Professor P. Bernt Hugenholtz, General Editor of the Information Law Series. Miriam Weemhoff has cheerfully and patiently kept both the first and second editions on track. Certainly, without the support the first edition received from lawyers, academics, governments and new gTLD applicants around the world, this second edition would not have been contemplated.

Looking back over the ten years since I first became involved in the ICANN multi-stakeholder community, I am fascinated by the slow but steady transition of that organization into a more mature, more globally and legally aware policy-making body. So many within ICANN have contributed to the likewise slow but steady increase in my understanding of the DNS. We spend countless hours together on conference calls, in windowless conference rooms, on airplanes and in airports travelling to and from public meetings, to the point that each public meeting feels, in some way, like a family reunion. When I started my ICANN journey, there were no formal welcoming or induction structures as there are now, and finding my place was not easy. Most particularly, I have the Intellectual Property Constituency to thank. Representing the IPC on the GNSO Council alongside two incredibly talented lawyers, Brian Winterfeldt and Paul McGrady, has truly been an honour and a privilege. To my fellow Councilors and our outstanding ICANN support staff, here is my opportunity to resoundingly thank you for everything (and in particular your kind consideration of Australian Eastern Daylight Time when scheduling meetings).

Despite the tremendous distances between us, friends scattered across the globe have provided motivation and moral support throughout the life of this project, and often at exactly the moments I needed it most. With good humour, food and wine they have more than once pulled me back from the brink of ICANN overload.

What was said in the first edition is truer today; this journey could not have been sustained without the support of my family, immediate and extended. My husband, Jani Myöhänen, carries the heaviest burden, and does so with unfailing love, understanding, tolerance and companionship. He still makes all things seem possible.

Finally, I remain unable to articulate here the commitment that my parents, Teryle A and Mary Catharine Forrest, have made to their only child's education. This second edition is another milestone that is as much theirs as it is mine, and it is to them that I continue to dedicate this book.

Heather Ann Forrest, Dr. (Ius)

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There are many whom I wish to thank for their day-to-day encouragement, beginning with my former colleagues in the School of Law at the University of New England and my current colleagues in the Faculty of Law at Australian Catholic University. Despite the tremendous distances between us, friends scattered across the globe provided motivation and moral support, often at exactly the moments I needed it most. Anna Jondelius and Tim Eavis in particular have, without hesitation, rearranged their lives, holidays and home to support the European phases of this project.

This journey could not have been sustained without the support of my family, immediate and extended. My husband, Jani Myöhänen, has carried the heaviest burden but done so with unfailing understanding, tolerance and companionship; he makes all things seem possible.

Finally, I could not possibly hope to articulate here the commitment that my parents, Teryle A and Mary Catharine Forrest, have made to their only child's education. The achievement of this milestone is as much theirs as it is mine, and it is to them that I dedicate this book.

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