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October 15, 2021 (amended to fix small issue with prior version)

VIA EMAIL ONLY

Dear ICANN Board and Mr. Botterman,

ICANN published a [letter](#) from Manal Ismail on behalf of the GAC dated October 7, 2021 (but published October 11, 2021) on its [correspondence](#) page which is highly misleading and incorrect.

On page 4, in response to a question related to concerns about "more expansive protections" than what is provided for by international treaties and national legislation, the GAC's flippant response was

merely:

The GAC, which represents governments, has for over 10 years provided consistent public policy-based advice concerning the protection of IGO identifiers in the DNS; such advice is based on national legislation and international agreements on intellectual property – which it is noted in the case of the Paris Convention, significantly precedes the advent of the DNS. The GAC does not accept the suggestion by ICANN that requested levels of IGO identifier protection would “provide more expansive protections to IGOs than what is provided for by international treaties and national legislation.

I was a member of the IGO PDP working group for over 4 years, and studied the issues carefully and deeply. IGOs routinely misstated and overstated their purported rights. One need only look at the [actual text of Article 6ter](#) to see this, in particular, 1(c) which states clearly:

No country of the Union shall be required to apply the provisions of subparagraph (b), above, to the prejudice of the owners of rights acquired in good faith before the entry into force, in that country, of this Convention. The countries of the Union shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is **not of such a nature as to suggest to the public that a connection exists between the organization concerned** and the armorial bearings, flags, emblems, abbreviations, and names, or **if such use or registration is probably not of**

such a nature as to mislead the public as to the existence of a connection between the user and the organization. (emphasis added)

The IGOs and the GAC repeatedly ignore those important limitations, which **explicitly** permit coexistence (and use by others) if they don't suggest a connection exists with the IGO, or are not of such a nature as to mislead the public.

In fact, former ICANN General Counsel Louis Touton made a similar point in a letter dated May 21, 2001:

<https://www.icann.org/resources/unthemed-pages/touton-letter-to-bank-for-international-settlements-2001-05-21-en>

[this was unearthed when another IGO policy proposal came to light in 2007, via https://circleid.com/posts/710118_short_domain_names_igo_udrp/ and the ensuing comments]

Many IGOs register their names/acronyms in the "Article 6ter" database maintained by WIPO, see:

<https://www.wipo.int/article6ter/en/>

which is used by national trademark offices to potentially block other terms from becoming registered, if they would be confusing. It's not an automatic block, as an identical or similar mark can be registered if it's not confusing.

e.g. "PAM" is in the Article 6ter database (and in the [ICANN reserved list](#)), for the World Food Programme. It can be seen as an 8900-series listing in the USPTO database:

https://tsdr.uspto.gov/#caseNumber=89000806&caseType=SERIAL_NO&searchType=statusSearch

(but it's not considered a registered TM -- it's just there to note the potential "blocking right")

But, there are numerous US registered TMs that were not blocked by that World Food Programme entry, see:

https://tsdr.uspto.gov/#caseNumber=72232915&caseType=SERIAL_NO&searchType=statusSearch [the cooking spray]

https://tsdr.uspto.gov/#caseNumber=85163866&caseType=SERIAL_NO&searchType=statusSearch [computer services for optometry]

etc.

Anyone can go to the "[Basic Word Mark Search](#)" at the USPTO website, and see for themselves that there are numerous live registered TMs that have been issued that are identical to Article 6ter entries (including many of the ones in the ICANN Reserved List, as many short acronyms have multiple uses by different organizations.

[for those unaccustomed to using the Basic Word Mark Search, make the search term "PAM" (without the quotes), and select "Singular" and "Live"; also keep the field as "Combined Word Mark and "All Search Terms" unchanged. After doing an initial search, change the [COMB] to [FM] in the "Refine Search" box, to make it:

Refine Search: (live)[LD] AND (pam)[FM]

and one can see that there are currently 18 results (some of which still have not been issued). Change the term "PAM" to "UN", and there are 36 results. [some of these are "stylized" or "figurative" TMs, but others are not, e.g. [US Registration #5646085](#) for athletic shirts, etc.]

You can check the other ICANN-reserved acronyms corresponding to IGO acronyms, and see the results for yourselves. You can further do an international search using other national TM databases, including a metasearch using the TMView tool [<https://www.tmdn.org/tmview/>]

(change "Contains" to "Is" for exact match searches on TMView) The US is not an anomaly -- other countries also allow for coexistence, as per the actual text of 1(c) of Article 6ter.

Extraordinary claims require extraordinary evidence, yet the GAC provides none. The provided counter-examples in this email (and in our working group) completely discredit and disprove their position. By adding those strings to a "reserved list", ICANN has already gone far beyond any protections recognized by treaty or law.

While the GAC and IGOs are entitled to their own opinions, they are not entitled to their own facts. They should cease from their continued attempts at misleading the ICANN community and its Board about the level of protections provided by international treaty and national legislation.

In fact, this situation has been going on for more than 20 years, as the Bank for International Settlements didn't want the dot-BIZ gTLD delegated, see their [letter of March 22, 2001](#).

You'll note that dot-BIZ has millions of registrations, and the term "BIZ" has numerous registrations around the world (348 exact matches, according to

[DotDB.com](#), most of which have nothing to do with the Bank for International Settlements).

We have wasted years on this matter, because the GAC and IGOs refuse to accept or acknowledge the demonstrable facts (as proven via numerous examples found in actual TM databases, like the examples above, and the actual text of Article 6ter of the Paris Convention).

They should not hold ICANN policymaking hostage when it's obvious that their positions and arguments are untenable.

I also would like to formally request an extension to the [current IGO report comment period](#) (I've already written to policy staff, but ~~my emails have not been acknowledged or responded to~~ **as of October 15, they have not agreed to change the deadline [Note: on October 14, when an earlier version of this letter was sent in plain text, I had not yet heard back from staff]**) so that the public can research the issues involved, as I've initially analyzed at [[my blog post of earlier this week](#)].

These are serious issues that negatively affect domain name registrants' rights, yet ICANN has failed to adequately involve affected parties, nor do adequate education on the topic. A 50 day extension (to match the length of another obscure comment period) would be appropriate, as would the addition of a "Reply Period" which is required under the ICANN Bylaws, as I've noted to the ICANN Complaints Office, and in my [blog post](#) [of April 26, 2021].

Thank you for your assistance.

Sincerely,

George Kirikos
President
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