

Protection of Geographical Indications in the DNS (focus on gTLDs)

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Strengthening geographical indications



Premise ...

- Misuses, imitation, and evocation of Geographical Indications (GIs) are not adequately controlled in the Domain Names System (DNS) due to variations in protection nationwide and the non territorial nature of the Internet
- Existing challenges
 - An earlier GI right may not be a valid title to claim protection against a bad faith registration
 - Dispute resolution (e.g. UDRP) systems may only be available for request to address abusive registrations based on prior trademark rights
 - Private Agreements? Or Public Solutions?

Definitions

DNS

- root domain (dot), top-level domains (gTLDs& ccTLDs) after the dot, second level domains before the dot + subdomains and host names

DNS before 2011

- gTLDs: .aero, .asia, .biz, .cat, .com, .coop, .info, .jobs, .mobi, .museum, .name, .net, .org, .pro, .teland travel + 76 ccTLDs

DNS after 2011

- New gTLDs: .wine, .food, .coffee, .organic, etc. (all applying the UDRP)

Developments ...

— Trademark Clearinghouse
A mechanism for protecting intellectual property, the Clearinghouse will authenticate rights information, and support claims and sunrise services.

https://twitter.com/tmchinfo



Trademark Clearinghouse (TMCH)

487 Tweets

Follow

233 Following 1,213 Followers

Followed by World IP Review, PUJIP, and 3 others you follow

Tweets

Tweets & replies


Media

Likes



Trademark Clearinghouse (TMCH) @tmchinfo · Sep 18

Thank you @DomainIncite for this interesting article. As part of our continuous effort to improve our services, we are pleased to announce you the expansion of our ongoing notifications service to the .com TLD. 🗓️



Floodgates, open! Trademark Clearinghouse now sup...
The Trademark Clearinghouse has added .com to the roster of TLDs supported by its infringement ...
domainincite.com



Trademark Clearinghouse (TMCH) @tmchinfo · Aug 25

Last call for Sunrise registrations for .gay !

We kindly remind you that this is your last chance to take advantage of the priority registration in this TLD, before it opens to the general public.

trademark-clearinghouse.com/content/last-c...

Problems ...

- No general rules how to protect GIs against cybersquatting, “typosquatting” and other abusive registrations and use of GI names as DNs
- GIs are not recognized as IPRs Titles under International Dispute Resolution Systems
- Growing problems after the launch of the gTLDs in 2011?
- Bad Faith Use and Registration of GIs as domain names vs Use and Registration of GIs that are considered generic terms: Quo Vadis?

Uniform Domain-Name Dispute-Resolution Policy (UDRP)

Article 4.a Applicable Disputes

Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that

- (i) your domain name is **identical** or **confusingly similar** to a **trademark** or **service mark** in which the complainant has rights; and
- (ii) you have no **rights** or **legitimate interests** in respect of the domain name; and
- (iii) your domain name has been **registered** **and** is being **used** in **bad faith**.

In the administrative proceeding, the complainant must prove that each of these three elements are present

UDRP

Article 4.b Evidence of Registration and Use in Bad Faith

... the following circumstances, in particular but without limitation, ... shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

UDRP

Article 4.b Evidence of Registration and Use in Bad Faith

...

(iv) by using the domain name, you have **intentionally** attempted to **attract**, for **commercial gain**, Internet users to your web site or other on-line location, by creating a **likelihood of confusion** with the complainant's mark as to the source, sponsorship, affiliation, or **endorsement** of your web site or location or of a product or service on your web site or location

COMPARATIVE CASE STUDY ON
ALTERNATIVE RESOLUTION SYSTEMS
FOR DOMAIN NAME DISPUTES



GIs vs Trademarks as IPRs Title



champagne.co

WIPO Case No. DCO2011-0026
Champagne v. Vickers



rioja.com

WIPO Case No. D2018-0168
Rioja v. Domain Hostmaster



parmaham.com

WIPO Case No. D2000-0629

Consorzio del Prosciutto di Parma v. Domain Name
Clearing Company, LLC



parma-schinken.com

WIPO Case No. D2003-0474


Consorzio del Prosciutto di Parma v. Matthias
Gasser, Hanslmeier Fleischwarenfabrik




gorgonzola.best

WIPO Case No. D2019-2848
Consorzio per la Tutela del Formaggio Gorgonzola
v. WhoisGuard, Inc. / John Tattersall

Multilateral Discussion

 <p>WIPO WORLD INTELLECTUAL PROPERTY ORGANIZATION</p>		E
		<small>SCT/IS/GEO/GE/19/1 ORIGINAL: ENGLISH DATE: OCTOBER 15, 2019</small>
Information Session on Geographical Indications		
Geneva, November 6, 2019		
11.00 – 11.50	Session 2:	Geographical indications as intellectual property titles in the operation of DNS and in the dispute resolution policies

 <p>WIPO WORLD INTELLECTUAL PROPERTY ORGANIZATION</p>		E
		<small>SCT/IS/GEO/GE/20/1 ORIGINAL: ENGLISH DATE: NOVEMBER 6, 2020</small>
Information Session on Geographical Indications		
Geneva, November 24, 2020		
13.30 – 14.30	Session 2:	Ways to Prevent Operators Profiting from Bad Faith Use and Registration of Geographical Indication Intellectual Property Rights in the Domain Name System (DNS)

Multilateral Discussion



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SCT/40/6
ORIGINAL: ENGLISH
DATE: FEBRUARY 25, 2019

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

Fortieth Session
Geneva, November 12 to 16, 2018

COMPILATION OF THE REPLIES TO QUESTIONNAIRE II ON THE USE/MISUSE OF
GEOGRAPHICAL INDICATIONS, COUNTRY NAMES AND GEOGRAPHICAL TERMS
ON THE INTERNET AND IN THE DNS

Document prepared by the Secretariat



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SCT/43/4
ORIGINAL: ENGLISH
DATE: JANUARY 28, 2020

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

Forty-Third Session
Geneva, March 23 to 26, 2020

UPDATE ON TRADEMARK-RELATED ASPECTS OF THE DOMAIN NAME SYSTEM

Document prepared by the Secretariat

https://www.wipo.int/meetings/en/details.jsp?meeting_id=55468

Results to Questionnaire II (2018)

- How to best protect geographical terms from being improperly registered in the DNS?
- Should countries support for a mechanism similar to "Trademark Clearinghouse" (TMCH)² to prevent unauthorized delegation of GIs as gTLD?
- Under which conditions should the gTLDs process provide for the delegation of a geographical term (coinciding or not with a GI) as a Top-level domain?
- Existing rules and procedures to prevent or invalidate the registration and use as Top-level domains of GIs
- Existing rules and procedures to prevent or invalidate the registration and use of GIs as second-level domains in ccTLD?

Unresolved Problems related to the GI Registration and Use in the DNS

- GIs are not uniformly recognized as IPRs titles in DNS disputes
- Bad faith vs good faith registrations
- Absence of a general worldwide database for all GIs
- Generic terms
- Private vs Public Initiatives?



Private arrangement between the Donuts Registry, with regards to its new .win and .vin TLDs, and wine producers/organizations to “protect” GIs in the .win/.vin TLDs.

Negotiations in Multilateral and Other Trade Agreements?

- “In connection with each Party's system for the management of its country-code top level domain (ccTLD), appropriate remedies, such as revocation, cancellation, transfer, damages, or injunctive relief, shall be available, in cases where a person - not being the recognized holder of a geographical indication - registers or holds a second-level domain name that is identical or confusingly similar to the said geographical indication” (clause proposed by oriGIn and EFOW)

Thank You

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