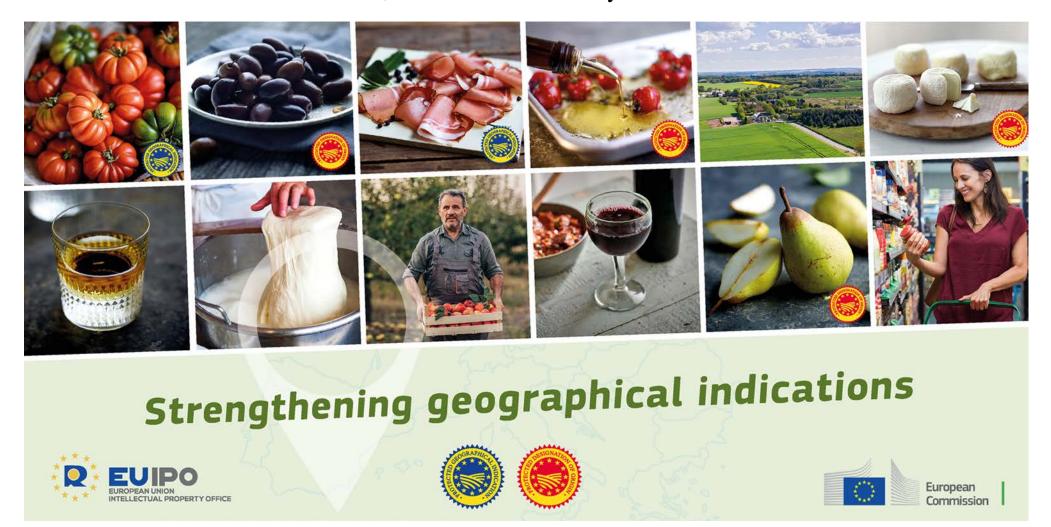
## Protection of Geographical Indications in the DNS (focus on gTLDs)

Irene Calboli, Texas A&M University School of Law



## 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 ...





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 <u>complainant must prove that each of these three elements are present</u>

## 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



#### COMPARATIVE CASE STUDY ON ALTERNATIVE RESOLUTION SYSTEMS FOR DOMAIN NAME DISPUTES



 $https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/observatory/documents/reports/2019\_Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_resolution\_systems/Comparative\_case\_study\_on\_alternative\_systems/Comparative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_study\_on\_alternative\_case\_s$ 

## 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

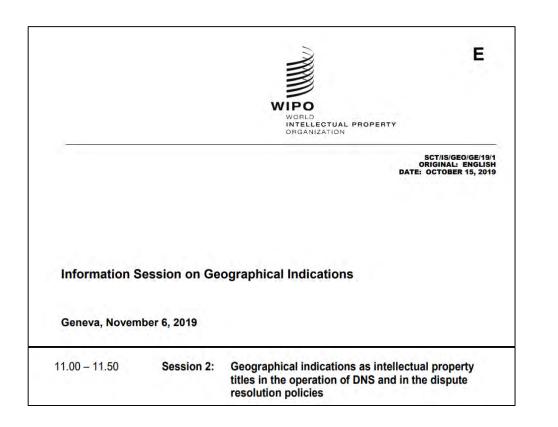
WIPO Case No. D2003-0474 Consorzio del Prosciutto di Parma v. Matthias Gasser, Hanslmeier Fleischwarenfabrik

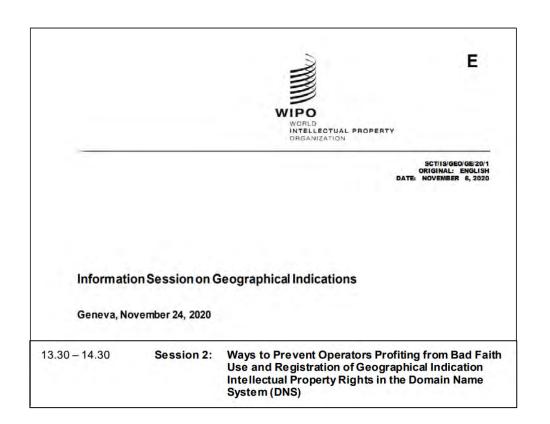


#### gorgonzola.best

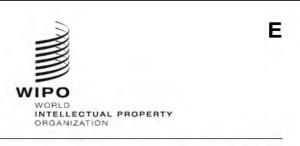
WIPO Case No. D2019-2848 Consorzio per la Tutela del Formaggio Gorgonzola v. WhoisGuard, Inc. / John Tattersall

## Multilateral Discussion





## Multilateral Discussion



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



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

## 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

Irene Calboli
Texas A&M University School of Law
Irene.Calboli@gmail.com