

Preventing Bad Faith Use and Registration of Geographical Indications in the Domain Name System: Overview, Challenges, and Possible Solutions

Standing Committee of the Law of Trademarks
“Information Session on Geographical Indications”

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World Intellectual Property Organization

Continuing the Discussion



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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

Continuing the Discussion



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

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UPDATE ON TRADEMARK-RELATED ASPECTS OF THE DOMAIN NAME SYSTEM

Document prepared by the Secretariat



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)

Problems ...

- No general rules how to protect GIs against cybersquatting, “typosquatting” and other abusive registrations
 - Rules on DNS registered and used in bad faith
- Use and registration as domain names of GIs that are considered generic terms in one or more countries



- **Bad faith use** and **registration** of GIs as domain names

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



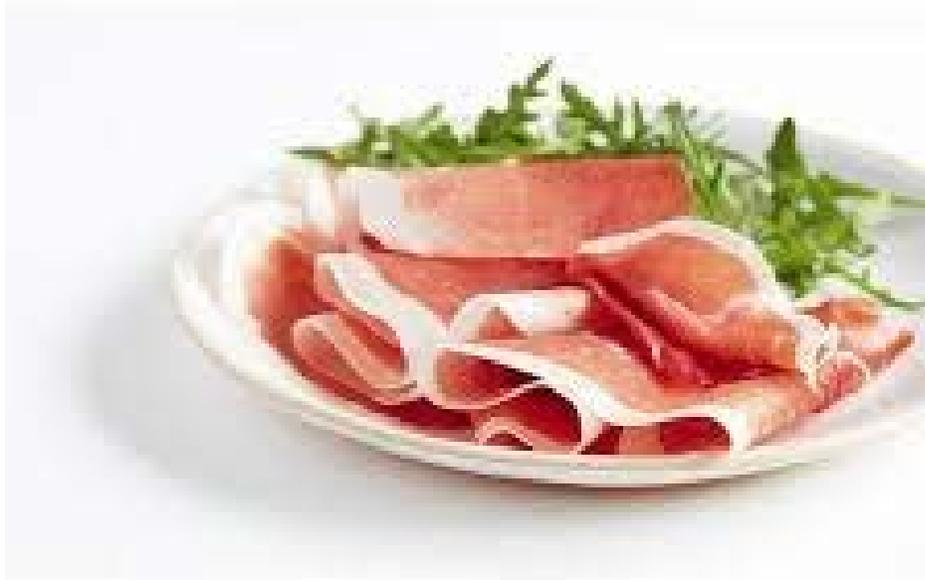
champagne.co

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

Results to Questionnaire II (2018)



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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 Bad Faith Registration and Use of GIs 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?



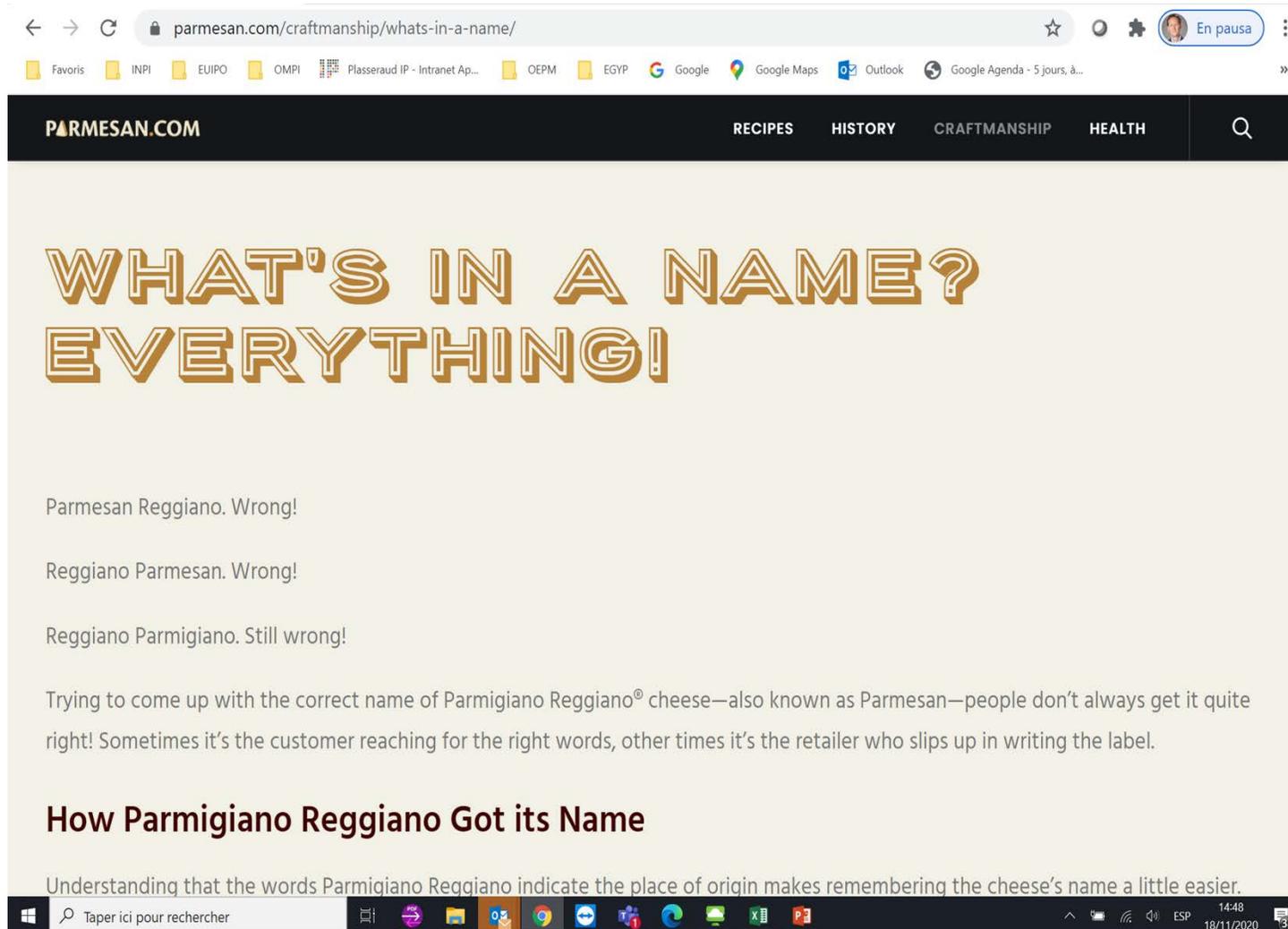
Possible solutions

The Limits of Private Initiatives



PARMIGIANO
REGGIANO





Practical “ex ante” measures



The Strength of Public Initiatives



GIs and cybersquatting: what real impact?

Reviewing the Legal Landscape

1/Extending all ccTLDs and gTLDs ADR proceedings to GIs;

- gTLDs: Assuring objective and fair functioning of UDRP

- ccTLDs to adapt their rules: cybersquatting or GI infringement



“In IP and UDRP we (should) trust”:

- **Territoriality**
- **Legitimate interest**
 - **Bad faith**



Ex. D2017-0554 GORGONZOLA.CLUB

2/ Encouraging introduction of repositories for GIs in those countries where they have a significant relevance;

- Either by means of pre-established lists of prohibited terms, or
- By conducting prior checks on GI databases before registering a DN.

3/ Extending the TMCH to GIs;

4/ Preventing potential GI abuse in the creation of new gTLDs;

5/ Enabling quick mechanisms for the disclosure of DN registrants.

Negotiations in Multilateral and Other Trade Agreements?

- Solution similar to the “.wine” & “.vin” agreements as part of a bilateral or multilateral agreements for additional and specific GIs?
- “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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