GEOGRAPHICAL INDICATIONS AS INTELLECTUAL PROPERTY TITLES IN THE OPERATION OF DNS AND IN THE DISPUTE RESOLUTION POLICIES

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Delia Belciu
Partner, DB Law Office, Bucharest, Romania
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GEOPHICAL INDICATIONS AS INTELLECTUAL PROPERTY TITLES IN THE OPERATION OF DNS AND IN THE DISPUTE RESOLUTION POLICIES

I. Geographical indications as intellectual property titles

A. Paris Convention (1883) recognizes and protects appellations of origin against unfair competition

B. WTO TRIPs Agreement – Part II, Section 3 provides for Geographical indications as Intellectual Property Rights

C. National / regional legislation and multilateral agreements (Lisbon Agreement)

Article 22.1 TRIPS, Protection of Geographical Indications:

Geographical indications are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.
II. DNS, especially after the launch of the new gTLDs in 2011

- Domain names are a most relevant ‘business identifier’ for consumers
- Domain Names System (DNS) raises challenges for IPR
- Products protected under GIs:
  - closely connected to their place of production and
  - inform the consumers about the origin and authenticity of product.
- GIs support rural development and promote new job opportunities and in the same time strengthen consumer loyalty.
- GIs are exposed to misuse and counterfeiting and risks increasing
The Internet expansion is rapid:
- New gTLD Program started in June 2011
- First gTLDs (delegated in Internet’s Root Zone) in October 2013
- over 1200 more gTLDs delegated by January 2018.

Over half of the new gTLDs run with open registration policies:
- anyone can register a new domain name without restriction.
- brand owners needed to react and adapt strategies
- but, how about the organizations responsible for the protection of GIs?

A number of Rights Protection Mechanisms (RPMs) have appeared in relation to the New gTLDs
Rights Protection Mechanisms (RPMs)

One is the Trademark Clearinghouse (TMCH): a centralized repository of authenticated trademark data

**TMCH offers:**
- Sunrise Period Services
- The Trademark Claims service

**TMCH accepts and verifies:**
- registered trademarks,
- marks protected by statute or treaty [*may include GIs*]
- court validated marks,
- “any other marks that constitute IPRs”

Trademark Clearinghouse Twitter feed, announcing sunrise periods for .hoteles, .VIP, .istanbul, .ist, .pet, .bible, .cloud... © Trademark Clearinghouse
III. Uniform Domain-Name Dispute-Resolution Policy (UDRP) and Geographical Indications

• UDRP: an effective alternative to court litigation
• Currently, the UDRP is limited only for trademark owners
• The complainant must prove that each of the three elements of Article 4.a. of the UDRP are present
• Alternatives: other applicable ADRs (arbitration) or national/regional court proceedings.

Article 4.a UDRP
The Registrant must submit to administrative proceeding in the event that a Complainant asserts to the applicable Provider that:

(i) the Registrant domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) the Registrant has no rights or legitimate interests in respect of the domain name; and

(iii) the Registrant domain name has been registered and is being used in bad faith.
III. UDRP and Geographical Indications

• Currently, UDRP is limited to clear cases of:
  • bad-faith, abusive registration and
  • bad-faith, abusive use of domain names.

• Although GIs are recognized intellectual property rights, presently, **UDRP does not consider this IPR as a valid title.**

• **UDRP is applicable to disputes regarding to domain names registered:**
  • in generic Top-Level Domains (gTLDs) (.com, .biz, .net, etc.) and the New gTLDs (.beer, etc.)
  • several ccTLDs incorporate on a voluntary basis UDRP in the Registration Agreement, either directly or UDRP-based procedures.
III. UDRP and Geographical Indications

- **Romania case:**
  - .ro ccTLD registry adopted on a voluntary basis UDRP directly
  - **contract** for registration of .ro domain name requires registrant to ‘not infringe legal rights’ of other third parties.
  - But a **GI is not considered a valid title** in dispute resolution under UDRP.

- **Czechia case:**
  - alternative dispute resolution (ADR) system **recognizes a geographical indication as a valid title** in domain name dispute: ADR procedure in Czechia for ccTLD .cz

- Complainant has statutory purpose to defend, preserve, and promote interests those producing and marketing of sparkling wines sold under GI “Champagne”
- All producers in Champagne district (France) subscribe to CIVC
- CIVC has powers to sue and be sued, and represent producers
- CIVC: “Champagne” not a common name of a wine; distinctive only of wine produced in the Champagne region of France; word “Champagne” is regulated in EU as a GI (a “designation of origin”)

IV. WIPO Case No. DCO2011-0026 – Champagne v. Vickers
IV. WIPO Case No. DCO2011-0026 – Champagne v. Vickers continued

• Cited .be and .uk dispute resolutions which transferred champagne-related domain names to the CIVC.

• CIVC argued it holds unregistered trademark rights in a “CHAMPAGNE” mark.

• The WIPO Panel agreed CIVC clearly has rights in “champagne” as a GI under French law and EU law, but not an unregistered trademark right.

• The Panel found that a GI per se does not distinguish the wine of one Champagne producer from the wine of another, and so does not fulfill the fundamental function of a trademark of distinguishing the goods or services. Thus, the rights in a GI do not fall under the “Rights” provider of Paragraph 4(a)(i) of the UDRP

• CIVC’s Complaint was denied.
IV. WIPO Case No. D2018-0168 – Rioja v. Domain Hostmaster

Regulatory Board of “Rioja” (a GI) (Complainant) v. Domain Hostmaster. Disputed domain name: rioja.com. Complaint denied.

- “Rioja” is a “Qualified Designation of Origin”, a Spanish classification for GIs. Complainant is official body engaged in promotion and defence of “Rioja” GI.

- Complainant owns several trademarks comprising stylised word “Rioja” within a device, in class 33 for alcoholic beverages.

- Panel found the Complainant failed to establish the “bad faith” element of UDRP.

- Complaint denied.
V. <.eu> Regulation and Geographical Indications. CAC Case No. 04419

- EC Regulation 874/2004 laying down public policy rules of .eu TLD

  **Article 10:** ‘Prior rights’ shall be understood to include, inter alia, registered national and community trademarks, **geographical indications** or designations of origin...

  **Article 21:** domain name shall be subject to revocation, **where that name is identical or confusingly similar** to a name for which a right is recognised (e.g. in Article 10), **and** where it has been:

  (a) registered **without legitimate interest** in the name; **or**

  (b) registered **or** is being used in **bad faith**.
V. <.eu> Regulation and Geographical Indications. CAC Case No. 04419 continued

Wine Products Co. (Complainant) v. Th. Onisiforou (Respondent).
Domain name: **zivania.eu**. Domain transferred to Complainant

- The Complainant is a semi-governmental body with legal personality which can initiate and defend actions.
- Zivania is a GI for a grape marc spirit, produced in Cyprus
- Complainant had prior rights on the name 'Zivania' as it is the owner of the trademark Zivania
- Panel found the Respondent had **no right or legitimate interest**.
- Domain name **zivania.eu** was transferred to the Complainant
VI. Conclusions

1. Geographical indications should be considered to be included as valid titles based on which a complaint can be filed under the UDRP.

2. A unique database including:
   - all Geographical Indications protected worldwide (including GIs, PDOs, PGIs and AOs),
   - with a clear indication of the territorial scope of protection,
   - and of the organization in charge of that Geographical Indication,

should be considered to be created.
Thank you for your attention!

delia.belciu@db-law.ro; www.db-law.ro