

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

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EXECUTIVE SUMMARY

- I. Geographical indications as intellectual property titles
- II. Geographical indications in the operation of DNS, especially after the launch of the new gTLDs in 2011
- III. UDRP and Geographical Indications
- IV. WIPO Case No. DCO2011-0026; WIPO Case No. D2018-0168
- V. .eu Regulation and Geographical Indications. CAC Case No. 04419
- VI. Conclusions

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)**



WTO building © WTO



Portugal signs the Geneva Act of the Lisbon Agreement, 2015. © WIPO. Photo: Emmanuel Berrod

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



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

- **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

.baby
.band
.bank
.bar
.barefoot
.bargains
.baseball
.basketball
.beauty
.beer
.berlin

Rights Protection Mechanisms (RPMs)

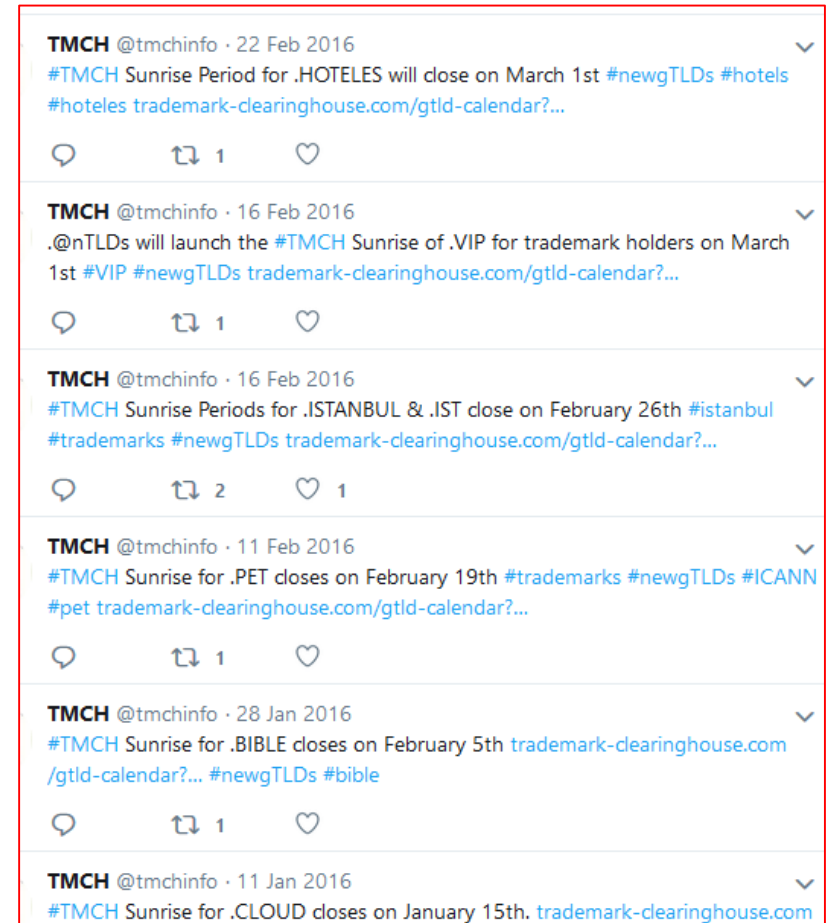
One is the **Trademark Clearinghouse (TMCH)**:
a centralized repository of authenticated trademark data

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.



WIPO offers UDRP arbitration services.
Photo: Emmanuel Berrod © WIPO.



Panelists at WIPO's UDRP 20th Anniversary Conference, 21.10.2019. Photo: Emmanuel Berrod © WIPO.

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**



Magiun de prune Topoloveni
GI, Romania



Cotnari
GI, Romania



Jihoceska niva,
GI, Czechia

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

Comité Interprofessionnel du vin de Champagne (CIVC) v. Steven Vickers. Disputed domain name: **champagne.co**. Complaint denied.

- 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”)



Champagne, GI, France

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.**



Rioja, GI, Spain

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**.



EU GI logo (PDO – protected designation of origin)

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



Ζιβανία / Τζιβανία / Ζιβάνα / Zivania, GI,
Cyprus

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



“Folk Wisdom to World Heritage”
Thai Silk GI, Thailand.
Photo: Violaine Martin. © WIPO.



Italy on Stage: “GIs, Traditions...Emotions”
Pasta di Gragnano GI, Italy
Photo: Violaine Martin. © WIPO.

Thank you for your attention!

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