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PATENT AND TRADEMARK OFFICE

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Geographical indications and the internet: Where are we now?

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April 1999

- WIPO Final Report on the First WIPO Domain Name Process
 - Internet Corporation for Assigned Names and Numbers (ICANN) implementation of Uniform Domain Name Dispute Resolution Policy (UDRP)
 - Certain issues outside scope of this process, including misuse of geographical indications

September 2001

- WIPO Final Report on the Second WIPO Domain Name Process
 - Existing international legal framework to protect GIs applies to trade in goods
 - Different systems used at the national level to protect GIs
- No modification to the UDRP at this time

2012 Applicant Guidebook

- The 2012 Applicant Guidebook (2012 AGB) provides a step-by-step procedure for new gTLD applicants.
 - Module 2 of 2012 AGB provides protection for certain categories of “geographic names.”
 - “Geographical indications” are not a category.
- 2012 AGB the basis for future rounds?

Rights Protection Mechanisms

- RPMs and dispute resolution procedures developed for New gTLD Program to mitigate risks to right holders in expansion
 - Trademark Clearinghouse (TMCH): repository for trademark data for sunrise and claims services
 - Uniform Rapid Suspension (URS): dispute procedure offering lower-cost, faster path, for clear-cut cases



Trademark Clearinghouse (TMCH)

- Four types of marks eligible for TMCH including “word marks protected by a statute or treaty”
 - TMCH: “These marks may include but are not limited to geographical indications and designations of origin.”
 - GIs, unless protected under a trademark system, are not marks and thus are not eligible for the TMCH.
 - ICANN community developed RPMS for trademarks and not for other types of IP.



January 2012 -October 2013

- Window opens for new generic top-level domains (new gTLDs)
- The first new gTLDs are delegated
 - From 22 original gTLDs to over 1,000 new gTLDs
 - Out of 1,930 total applications, 1,232 delegated (as of May 31, 2019)

January 2012 – fall 2015

- New gTLD applications include .wine, .vin
- Debate focused on whether existing gTLD safeguards were sufficient to address potential misuse of GIs for wine or whether additional safeguards were advisable.

January 2012 – fall 2015

- Governmental Advisory Committee (GAC): no consensus advice on safeguards
- ICANN consults French law professor: “[A] [GI] does not enjoy absolute or automatic protection against any use of an identical or similar name by a third party.”
- U.S. (and others): existing safeguards are sufficient to deal with misuse of GIs
- Donuts Inc. enters into private agreement with wine industry stakeholders



March 2014

- WIPO Standing Committee on Trademarks (SCT)
 - Some countries propose to expand the UDRP.
 - United States opposes the proposal:
 - UDRP set up to address cybersquatting of trademarks
 - GIs protected under a sui generis system are not trademarks
 - National GI systems do not scale to a system of international protection, unlike trademarks



November 2017 – November 2018

- WIPO Standing Committee on Trademarks (SCT) adopts Workplan on Geographical Indications and prepares a survey on current state of play
- Compilation of the Replies to Questionnaire on the National and Regional Systems that Can Provide a Certain Protection to Geographical Indications



December 2018

- Work Track 5 on Geographic Names at the Top Level – Supplemental Initiative Report of the New gTLD Subsequent Procedures Development Process (“WT5”)
- 2012 AGB basis for future rounds?
 - Some: urge “expansion” and want GIs included
 - Others: disagree; no overall common basis for protection of GIs



Where are we now?

- Second WIPO Domain Name Process findings re GIs still exist
- TMCH does not include GIs, by its terms, so no access to sunrise or claims services
- Not all SCT Members favor expansion of UDRP to include GIs
- Private agreement for .wine, .vin, but should we encourage private agreements and if so, for what purposes?
- ICANN Work Track 5 (WT5) unlikely to develop consensus around expansion beyond 2012 AGB, which does not include GIs
- How are consumers using the internet? By search engines? By new gTLDs?





Thank you!

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