



Intellectual Property Attorneys

GIs & Domain names: Darkness still or rays of hope?

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Contents

WIPO's Second Domain name report - 2001

Developments from 2001-2021

What is new in 2022?

The unfinished agenda

WIPO's 2nd Domain Name Report 2001

“The mere registration of a geographical indication as a domain name by someone with no connection whatsoever with the geographical locality in question, however cheap and tawdry a practice, does not appear to be, on its own, a violation of existing international legal rules”

“Existing rules, therefore, would offer only a partial solution to the problem of what is perceived to be the misuse of geographical indications in the DNS”.
“...there is a major problem in respect of applicable law because of the different systems that are used, at the national level, to protect geographical indications”.

2001-2021 - GIs emerged as a collective brand

International treaties, regional treaties, bilateral treaties and national legislations for GIs

Certification mark and collective mark protection for GIs by many countries

Several landmark judgements protecting GIs in common law as well as civil law countries including some developing countries like India

Enactment of GI laws by Asian and African countries

Recognition of products other than wines and spirits as GIs in Asia and Africa

Establishment of organizations like ORIGIN that represents GI stakeholders

Recognition of GIs by brand associations such as INTA and marques

Enactment of the Geneva Act

GIs facilitating social and economic change in communities and acting as a tool for achieving SDG

Overall global awareness of GIs in academic, legislative, judicial and policy platforms are at all time high by 2021

What is new in 2022?

2022/0089 (COD)

- Proposal for a REGULATION OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL on European Union geographical indications for wine, spirit drinks and agricultural products, and quality schemes for agricultural products, amending Regulations (EU) No 1308/2013, (EU) 2017/1001 and (EU) 2019/787 and repealing Regulation (EU) No 1151/2012 dated March 31, 2022

What is new in 2022?

Recital 18 says that protection of GIs should also apply to domain names

Recital 25 says that relationship between domain names and protection of GIs should be clarified in the context of application of remedy measures, recognition of GIs in dispute resolution, and fair use of domain names.

Recital 25 again says that persons with legitimate interest in GIs applied for registration prior to that of a domain name should be empowered to request for the revocation or the transfer of the domain name in case of conflict

What is new in 2022?

Article 27.1 - GIs are protected against:

- (i) any direct/ indirect commercial use for dissimilar goods if such use exploits or dilutes the GI's reputation;
- (ii) all incorrect usages evoking the GI or accompanied by expressions such as 'style', 'type'
- (iii) false and misleading usage on packaging; and
- (iv) any other misleading practice to create a false impression as to origin

Article 27.3

Article 27.1 also applies to a domain name containing or consisting of a registered GI

Article 33(3)(d)

Powers and responsibilities of a producer group includes the power to –

register an individual, collective or certification trade mark;

containing, as one of its prominent elements, a GI for the relevant product

to protect the GI in the domain name systems outside the EU

What is new in 2022?

Article 34.1 -Protection of geographical indication rights in domain names

- CCTLD registries in EU must revoke / transfer domain names to the relevant producer groups following ADR or court procedure, if such domain names were registered without rights or legitimate interests in the GI or are registered or used in bad faith and such use contravenes Article 27

What is new in 2022?

Article 34.2 -Protection of geographical indication rights in domain names

- CCTLD registries in the EU must ensure that any ADR procedure for domain names disputes recognise GIs as rights that may prevent a domain name from being registered or used in bad faith.

What is new in 2022?

Article 34.3 -Protection of geographical indication rights in domain names

- EC may adopt measures entrusting EUIPO to establish and manage a domain name information and alert system.
- Such a system would provide a GI applicant with information about the availability of the GI as a domain name including that about identical domain name registrations.
- Under such measures, CCTLDs in the EU would also be obliged to provide EUIPO with the relevant information and data

The unfinished agenda - how to rescue our Cinderella?

A WIPO SC proposal in 2014 to expand UDRP's scope to include GIs was opposed by the US on grounds that GIs protected under sui generis systems are not TMs and that national GI systems do not scale to a system of international protection like TMs

The lockdowns that ensued the pandemic has triggered enhanced online trading. The practices during lockdown has made online trading the preferred way

For a GI producer body, use of the GI as part of the domain name that resolves to a website lends credibility and authenticity to a customer

More than ever before, the denial of a place for GIs in DNS is hugely disadvantageous to right holders and consumers

It is important for producers, practitioners, academics and all GI lovers to start influencing the policy makers in their respective countries to support this process.

