

Industry Seeks Policy Change To Strengthen Protection for GIs, Country Names Online

14/10/2016 BY ALEXANDRA NIGHTINGALE FOR INTELLECTUAL PROPERTY WATCH — [LEAVE A COMMENT](#)

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Calls for the international community to promote and strengthen the protection of geographical indications and country names on the internet were made at the first side event of the annual General Assemblies of the World Intellectual Property Organization that ended last week.

The Organization for an International Geographical Indications Network (oriGIn), a Geneva-based industry group, held a panel on 3 October to address the "Challenges for GIs and country names in the Internet domain names' environment."

Panellists shared their experiences of protecting their geographical indications (GIs) and country names online, and concerns relating to the loss of benefits and the risk to the reputation of one's country name or GI by owners of generic top level domains (gTLDs) appropriating their name.

OriGIn represents associations of producers and other GI-related institutions. OriGIn campaigns for the effective legal protection and enforcement of GIs and promotes GIs as a sustainable development tool for producers and communities, according to its website.

Few and Limited Mechanisms to Protect Country Names

Massimo Vittori, managing director of oriGIn, outlined challenges and said there are a few limited mechanisms and instruments to protect the intellectual property rights related to country names and GIs on the internet.

With the rapid expansion of domain names, a growing issue is companies which are the managers of gTLDs selling the second part of a domain name on a "first come, first served basis," which may conflict with the rights deriving from GIs, explained Vittori.

The responding possibilities to protect these IPRs in second-level domains are limited, and only trademarks are considered to hold legal title to access dispute resolution mechanisms in gTLDs (under the Uniform Dispute Resolution Procedures, UDRP).

Whilst the name of champagne is recognised and protected in most countries throughout the world, Charles Goemaere, director of commercial and legal affairs of the Comité Champagne, iterated that producers of champagne have been protecting their product for the last 180 years. Goemaere argued that the champagne GI is misused by providers of sparkling wines as well as non-champagne or even non-wine-related products and services on the internet.

There is a move towards developing case law, said Goemaere. However, he said there is huge gap between the action of misuse of registration and what is required to address these misuses.

"The reservation of a domain name requires five minutes and five dollars, while litigation by civil action in France or anywhere in the world lasts for more than one year and costs thirty to a hundred thousand dollars," he said.

Effective alternative dispute resolution to litigate against abusive use of domain names is being sought, where arbitration is relatively quick and inexpensive. According to Goemaere, proceedings have been tested and found to be satisfactory. However, ultimately the UDRP does not extend to GIs, which weakens the capacity for protection.

Other mechanisms and instruments such private agreements, for example with the "Donuts", an internet domain name registry, have been negotiated to protect GIs, said Goemaere.

Likewise, Simone Calzi, head of the Legal Department, Consorzio del Prosciutto di Parma, referred to monitoring services and the ability to register one's domain names. These are still subject to costs which are based on relevance, and can thus exceed affordability, explained Calzi.

Support and Action at International Level

Public policy in Jamaica stipulates that country names cannot be registered, unless the product originates from the country in question or has a direct link, highlighted Lilyclaire Bellamy, executive director of the Jamaican Intellectual Property Office (JIPO).



Jamaican flag

Thereupon, diplomatic channels in the first instance will be used to seek protection outside of Jamaican territory or else arbitration at WIPO sought. However, there are high costs involved in bringing a case to the WIPO arbitration and mediation centre.

Bellamy shared the experiences of the country's IP office upon the influx of both trademark applications and second-level domain applications conflicting with the name Jamaica, for example of Jamaican athletes. With specific respect to domain names, once registered, JIPO is unable to purchase them back as prices are usually exorbitant, said Bellamy.

Overall, in Bellamy's view domain name registration is a subset of a larger issue of country name protection and domain name registration is "a backdoor way of basically eroding the reputation that one has built up on your GI," which she said is neither good for international commerce nor trade. Support of the international community is greatly needed, Bellamy said.

Mathieu Weill, CEO of the Association Française pour le Nomme Internet en Coopération (AFNIC), an association which manages top-level domains for the French internet, outlined that registering domain names is easy and that setting up dispute resolution procedures on GIs is in fact simple. The principle of 'first come, first served' upon the registration of a domain name that applies to trademarks is still applicable, according to Weill.

During the Q&A, the audience and panelists discussed how the Internet Corporation for Assigned Names and Numbers (ICANN), the technical oversight body for the domain name system, and WIPO can play a greater role in the review of the UDRP and in the protection of GIs and country names in gTLDs.

From the different presentations, it emerged that:

- Protecting GIs and country names in generic top-level domains (gTLDs) is a challenging task in terms of time, resources and knowledge. Providing all IPR holders and beneficiaries with effective tools to fight the growing illegal use of geographical names as second level domains is therefore crucial (trademark owners have already the possibility to benefit from the UDRP)

- Country code top-level domains (ccTLDs) that recognise GIs, like trademarks and other IPRs, as a valid title to activate dispute resolution mechanisms, do it in a simple and effective way.

In the following months, oriGIn will continue to work towards the full recognition of GIs as a valid title to active the UDRP in gTLDs.

Alexandra Nightingale is a researcher at Intellectual Property Watch. She completed her Bachelors in Law at the University of Sussex and holds an LLM degree in International Law from the School of Oriental and African Studies in London. During her Masters, she developed a strong interest in Intellectual Property, particularly patents and the aspects relating to global health. Her research interests now also include geographical indications and trademarks.

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