

# **Geographical Indications (GIs) in the Domain Name Space (DNS)**

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# Executive Summary

- **Definitions**
- **DNS before 2011**
- **DNS... and GIs... after 2011**
- **Some final considerations**

## Definitions

- **GIs: art. 21.1 of the WTO TRIPs Agreement (IPRs)**
- **DNS: root domain (dot), top-level domains (gTLDs & ccTLDs) after the dot, second level domains before the dot + subdomains and host names**

## DNS before 2011

- **Potential conflict with IPRs (second level):**  
“cybersquatting”
- **gTLDs: .aero, .asia, .biz, .cat, .com, .coop, .info, .jobs, .mobi, .museum, .name, .net, .org, .pro, .tel and travel + 76 ccTLDs**
- **“Ad hoc” dispute resolution mechanism: Uniform Domain Name Dispute Resolution Policy (UDRP)**

## **UDRP Rules: 3. The Complaint**

**(b) The complaint including any annexes shall be submitted in electronic form and shall:**

...

...

**(viii) Specify the trademark(s) or service mark(s) on which the complaint is based and, for each mark, describe the goods or services, if any, with which the mark is used**

## **UDRP Rules: 3. The Complaint**

**(ix) Describe, in accordance with the Policy, the grounds on which the complaint is made including, in particular,**

**(1) the manner in which the domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and**

**(2) why the Respondent (domain-name holder) should be considered as having no rights or legitimate interests in respect of the domain name(s) that is/are the subject of the complaint; and**

**(3) why the domain name(s) should be considered as having been registered and being used in bad faith**

## Some preliminary considerations

- **GIs as such not considered a valid legal title to activate UDRP: CIVC v. Steven Vickers (WIPO Case No. DCO2011-0026)**
- **Second WIPO Internet Domain Name Process did not recommend to include GIs under UDRP: legal certainty issues: international debate on GIs level of protection + how to prove the rights over a GI**
- **UDRP Rule 3: does not reproduce the “substantial” law of trademarks and service marks**

## DNS after 2011

- **New gTLDs: .wine, .food, .coffee, .organic, ... more than 1.000, all applying the UDRP**
- **TMCH: “marks protected by statute or treaty: ... these marks may include but are not limited to geographical indications and designations of origin”**



## DNS after 2011

- Specific safeguards for GIs in the “.wine” & “.vin” as part of a private agreement between Donuts and representatives of the wine industry
- ccTLDs (2018 WIPO survey) out of 86 ccTLDs dispute resolution policies analyzed, 14 mentions GIs + and 23 provide a general formulation, which seems not to exclude GIs (“all/other IPRs...” or “TMs, service marks and other distinctive signs...”) [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_39/sct\\_39\\_7.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_39/sct_39_7.pdf)

## GIs... after 2011: “Improved legal certainty”

- Some 150 countries provide “independent” laws on GIs, with a registry available online (oriGIn GIs Worldwide Compilation: <http://www.origin-gi.com/i-gi-origin-worldwide-gi-compilation-uk.html> )
- GIs factor of economic development
- Including GIs under the UDRP would not mean applying “substantial” GIs law

## Some final considerations

- **Legal certainty in the DNS is an issue**
- **Excluding GIs from the UDRP does not serve the interest of legal certainty in the DNS**
- **Encouraging precedents in gTLDs: TMCH & .wine/.vin strings**
- **ccTLDs that consider GIs a valid title to activate dispute resolution mechanisms implement such policy with no major problems**
- **No concrete obstacles to include GIs in the UDRP**

**Many thanks for your attention!**

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