

Effective protection of GIs in the Domain Name System: recent developments, best practices, legislative updates and case studies in the practice and in the work of the INTA Geographical Indications Committee



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Geneva, 5 October 2023

ICANN (Internet Corporation for Assigned Names and Numbers) is an American private law association.

It is responsible for creating domains in the DNS, and for allocating domain names according to rules common to all registries that will manage the domains created under the "ICANN Policy", or "UDRP".

- The issue of how geographic terms - including Geographic Indications (GIs) - are treated in the Domain Name System (DNS) has been an ongoing discussion inside and outside of ICANN.
- The issue of how GIs are treated as independent sui generis right and within the framework of the international trademark law has been an ongoing discussion inside and outside of WIPO.

Now, these 2 issues are converging into a discussion of whether **GIs should be included in the Uniform Dispute Resolution Policy (UDRP)** during the upcoming UDRP review at ICANN and as part of pending legislation in the EU.



Introduction



What is a domain name

Domain names are the most relevant “**commercial identifiers**” in the online environment. According to the World Intellectual Property Organization (WIPO), “domain names are the human-friendly forms of Internet addresses and are commonly used to find websites”.

They can consist of:

- a **second-level domain (SLD)**: a "root" domain generally corresponding to the name of a company, a registered trademark, or a geographical indication, preceding the top-level domain; and
- a **top-level domain (TLD)**: which includes two main types of extensions, one referring to the official geographical territory code of the website (Country Code Top-Level Domain, **ccTLDs**) and the generic extensions (Generic Top-Level Domain, **gTLDs**).

In 1984, the first available gTLDs included “.com”, “.edu”, “.gov”, “.mil”, “.net”, and “.org”.

In 1998, “.int” was added.

In 2000 applications from interested parties “.aero”, “.biz”, “.coop”, “.info”, “.museum”, and “.pro” were approved.

In 2003 were approved the sponsored gTLDs, “.asia”, “.cat”, “.jobs”, “.mobi”, “.tel”, and “.travel”.

In 2011 “.xxx” and “.post” were approved.



What is a domain name

Between 2012 and 2014 ICANN began a process to launch “**new**” gTLDs.

It included geographic names at the top-level only:

- **Two-character ASCII** (The American Standard Code for Information Interchange) letter-letter combinations
- **Country and Territory**
- **Capital cities, city names, sub-national names**
- **UNESCO regions and names appearing in the “Composition of macro geographical (continental) regions, geographical sub-regions, and selected economic and other groupings”**
- **Other geographic names such as geographic features** (rivers, mountains, valleys, lakes, etc.) and culturally significant terms related to geography.

GIs are exposed to misuse and counterfeiting through the DNS, since anyone can register a new domain name **without restriction**.



Rules governing domain names

- The main rule is that priority is given to the first person or entity who reserves the right (who requests the assignment of the domain name) on the basis of the principle “**First come first served**”, which become the holder of the name and acquired the exclusive right to use it for the duration of a contract with the registrar.
- The most effective first barrier for the GI industry is to reserve domain names containing the name of their GI with the most strategic extensions, since there is no obligation of use. **Yet, this is not practical since it is not possible to monopolize all domain names containing the name of the GI.**
- So, the other solution in case of misappropriation is the application of “**UDRP**” principles, providing elements for resolving disputes between domain name holders and holders of other intellectual property rights.



Uniform Domain-Name Dispute-Resolution Policy (UDRP)



UDRP and GIs

- The UDRP was adopted by ICANN in late 1999 to provide a solution to the challenges that traditional offline court-based legal proceedings faced in dealing with trademark-related domain name abuses.
- Today, it is used for all generic Top-Level Domains (gTLDs), and for many Country Code Top-Level Domains (ccTLDs).
- **Paragraph 4a** of the UDRP says that an administrative proceeding is started in the event that a third party (a **complainant**) asserts to the applicable Provider that:
 - i. the domain name is **identical or confusingly similar to a trademark or service mark** in which the Complainant has rights; and
 - ii. the subject who registered the domain name has **no rights or legitimate interests** in respect of the domain name; and
 - iii. the domain name has been **registered** and is being **used in bad faith**.



UDRP and GIs

- The complaint including any annexes shall be submitted in electronic form and shall
 - 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
 - describe, in accordance with the Policy, the grounds on which the complaint is made including:
 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**.



UDRP and GIs

- The procedure may result in a transfer of the domain name, a cancellation of the domain name or a dismissal of the action.
- Although GIs are recognized intellectual property rights the **UDRP does not consider them as a valid title as basis of a complaint**. Indeed, the UDRP is limited to the protection of trademark rights.
- Some alternative dispute resolution (ADR) systems may recognize GIs as a valid title in domain name disputes: ADR procedure for the European ccTLD “.eu”, the Czechia ccTLD “.cz”, for the Italian ccTLD “.it”. For example, the .eu ADR Rules protect all rights recognized or established by the national law of a Member State and/or European Union law, including GIs.



UDRP and GIs

- The problem is that all registrars responsible for gTLDs follow the ICANN's policy: *“Under the policy, most types of trademark-based domain name disputes must be resolved by agreement, court action, or arbitration, before a registrar will cancel, suspend, or transfer a domain name. Disputes alleged to arise from abusive registrations of domain names may be addressed by expedited administrative proceedings that the holder of trademark rights initiates by filing a complaint with an approved dispute-resolution service provider”*.
- **Therefore, GIs cannot be invoked under ICANN's UDRP.**
- However, if the rightful owner of a Geographical Indication **is able to demonstrate that its name is protected by a word trademark for goods and services** *“other than those that are described by or related to the geographical meaning of the term”* the owner can enforce his rights -> If a domain name infringes a GI, it could be revoked or transferred to the complainant in the UDRP proceeding, provided that an earlier trademark containing the geographical indication has been duly registered by the complainant.



INTA Geographical Indications Committee



What is INTA

- The International Trademark Association is a global association of brand owners and professionals (6500 organizations from 185 countries) dedicated to supporting trademarks and complementary intellectual property (IP) to foster consumer trust, economic growth, and innovation, as well as being committed to build a better society through brands. In the intervening 144 years, since the creation of INTA, much has changed in terms of the general IP landscape and the way that the world conducts commerce.
- One of the types of complementary IP that comes under INTA's mission are geographical indications of origin. In recognition of their growing importance, not just in their traditional European home but also elsewhere, especially in Asia and Latin America, the INTA Board passed a resolution in November 2019 on the Protection of Geographical Indications.



2019 Board Resolution

Through its resolution, INTA recognized GIs as a separate form of Intellectual Property and gave its support to their protection under national laws and international treaties and agreements, in line with Article 1(1) of TRIPS, subject to the existence of adequate safeguards to balance the rights of trademark owners. These safeguards include, for example, the recognition of earlier trademarks through the principle of “**first in time and first in right**” and transparent procedures to enable those with a legitimate interest to oppose or cancel a GI.



2019 Board Resolution

So, in the 2019 Board Resolution

- INTA **recognizes the importance of GIs** and advocates for protection of GIs as an intellectual property right *“the Association supports the protection of geographical indications under national laws and international treaties and agreements”*.
- INTA has declared that *“cybersquatting damages the growth of electronic commerce, results in consumer fraud and confusion as to the true source of products and services. It deprives legitimate trademark owners of substantial revenues and consumer goodwill”*.
- INTA believes that **GIs should be protected in the DNS** to the extent that they are also trademarks.



Cross Committee Project Team: GI in the DNS

- Since the misuse and copying of GIs is not currently protected in the DNS, INTA created a **Project Team, a cross-committee group from the GIs and Internet Committees**, to address the issues of protecting Geographic Indications in the Domain Name System.
- The decision to create “the Team” was taken in order to consider and propose approaches to protecting GIs that comport with INTA’s immediate and long-term policy objectives

Composition of the team:

- The Team consists of 8 representatives each from the GI and Internet Committees designated by the Committee Chairs
- The Team is Co-chaired by 1 representative from the GI Committee and 1 representative of the Internet Committee.



Cross Committee Project Team: GI in the DNS

Team Objectives

- Review INTA's current positions and formulate recommendations for responding to evolving policies and regulation in the area of GIs in the DNS.
- Function as a Rapid Response Team for calls for written and oral submissions.
- Examine how the UDRP is functioning within the ccTLD system and whether the outcomes are reasonable given INTA's historic positions on GIs (GIs should not be included in the UDRP unless they are registered as trademarks) and whether they should be adopted in more ccTLDs and at the top level.
- Prepare organizational talking points on GIs in the DNS.
- Prepare suggested model language for GIs in the UDRP.
- Prepare background papers and requests for Board Action, as necessary.



- Ahead of the EC GI regulations and the upcoming ICANN review of UDRP, INTA will develop an **official policy on GIs** to be able to respond to potential requests for comment regarding best practices for protection of GIs in the DNS and from ICANN regarding the UDRP.
- Any policy solutions to the issue of GI in the DNS need to meet certain criteria.
 - **Policies must effectively address abuse and be stringent enough to enable GI owners to stop bad faith use of their GIs in domain names.**
 - **Any protection of GIs in the DNS must be fair to both the GI owner and the domain name registrant.**
 - **A system to protect GIs in the DNS must be streamlined and efficient.**
- INTA would like to propose a harmonized solution for the variety of jurisdictions, making any individual process easier to use.
- Solutions must also recognize pre-existing trademark rights *“any regulation of geographical indications must have effective and transparent mechanisms for addressing: (i) applications for geographical indications, applications for amendments, and applications for cancellation; and (ii) effective opposition, cancellation, and notification procedures that recognize pre-existing trademark rights with which geographical indications might conflict or cause confusion.”* (2019 Board Resolution).



GIs in the DNS: the EU Proposals



EU Proposals

In March 2022, the EU Commission proposed **two regulations on GIs** (one on GIs for wine, spirit drinks, and agricultural products and the other for GIs for craft and industrial products) that contained provisions on registration of GIs in domain names.

Following that, ICANN is also planning to review the UDRP.

These EU proposals aim to **strengthen the GI protection** and intend to combat counterfeiting more effectively. For these purposes, the proposals want to **expand GI protection to domain names** by prohibiting the use of a domain name that has been registered “without rights or legitimate interest” in the geographical indication.

The Commission Proposal, EP Mandate, and Council Mandate all state in Recital 25:

“The relationship between internet domain names and protection of geographical indications should be clarified as regards the scope of the application of the remedy measures, the recognition of geographical indications in dispute resolution, and the fair use of domain names”.



EU Proposals

The Council mandate states that the alternative dispute resolution systems for EU country code top-level domains (ccTLDs) "*should acknowledge geographical indications as a right to be invoked during such disputes.*"

The EP mandate states:

*“The protection of established rights in the domain names industry at international level is essential to prevent the usurpation of the reputation of geographical indications due to the strong development of commerce on the internet. . . . The Commission should pay special attention to the need to include the protection of geographical indications rights at domain names level in bilateral trade particularly with Council Mandate Draft Agreement and other international trade negotiations, **and strengthen its mediation work with the bodies in charge of assigning domain names, and very particularly with Internet Corporation for Assigned Name and Numbers (ICANN), with the objective to include the GIs’ existing rights in the Uniform Domain Name Dispute Resolution Policy (UDRP)**”.*



EU Proposals / Alert System and INTA discussions

The draft regulations mandate in Recital 56 the establishment of a potential “**domain name information and Alert System**”, set up by EUIPO and .eu Registry (EURid), with the aim to inform GI applicants about the availability of the GI as a domain name and also monitor potentially unauthorized registration of domain names that contain a registered GI.

These alerts will allow producers to take appropriate action more quickly and effectively.

Yet, according to some positions arisen in the INTA “GI in the DNS” Project Team:

- **There is no European case with similar level of difficulty for GIs protection enforcement as the ones outside the EU domain name space** to justify the establishment of this system
- A protected GIs **cannot be automatically compared to domain names without further data processing and assumptions** -> undermines the whole purpose of expanding the GIs protection to domain names
- A fully automated process might deliver **too many false alerts**
- There is a **difficulty** with identifying protected GIs when it comes to **translate 24 EU languages**

For these reasons, it would be difficult to implement the proposed Alert System.



Examples of applicable case law

Generic Top-Level Domain, gTLDs



Case “champ-pagne.com”

- **TGI of Paris, Judgement of 7 September 2001, France**

In 2000, the Comité Interprofessionnel du Vin de Champagne (CIVC) filed a complaint against the company Saber Entreprises Incorporated for the fraudulent use of the domain name "champ-pagne.com" and for the marketing of a water for pets "Champ-pagne".

The Court ruled **in favor of the CIVC**, stating that the use of the domain name “champ-pagne.com” was misleading and likely to damage the image of the PDO “Champagne”.

The owner of the domain name was ordered to cease all use of the domain name and to pay damages to the CIVC. The Court also ordered the transfer of the domain name to the CIVC.



Consorzio per la Tutela del Formaggio Gorgonzola v. Rob Monster/DigitalTown, Inc. WIPO Case No. D2017-0253

- The **disputed domain name** <gorgonzola.city> is registered with Epik, Inc. (the “Registrar”).
- Factual background:
 - **The Complainant** was established in 1968 to control the use of the denomination of origin and trademark GORGONZOLA in relation to gorgonzola cheese. The Complainant is the holder of EUTM GORGONZOLA, registered in 2012.
 - **The Respondent** is a U.S. public company engaged in developing a platform to enable cities worldwide to provide access to local information, including restaurants, lodging and city services. The Respondent registered the Disputed Domain Name in 2017.



- Gorgonzola is a small town in Italy with little touristic attraction. While it is entirely possible that the choice of an American company to register the Disputed Domain Name <gorgonzola.city> might have been prompted by the famous GI GORGONZOLA, **no evidence has been given to support the assumption.**
- On the evidence, the **WIPO Panel** found that before notice of the dispute the Respondent had made use of the disputed domain name in connection with a **bona fide offering of services.**
- The panel concluded that the domain name was being used descriptively rather than to target the Consorzio's trademark, so **there was not even a need to look at the bad faith of the domain name registration.**



WIPO Case No. D2018-0168 –Rioja v. Domain Hostmaster

- Regulatory Board of “Rioja” (a GI) (Complainant) v. Domain Hostmaster.

Disputed domain name: rioja.com

- “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 stylized 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.



Case "gorgonzola.best"

- **WIPO Arbitration and Mediation Center, Judgment of 31 January 2020 (Decision No. D2019-2848)**

In 2019, Consorzio per la Tutela del Formaggio Gorgonzola DOP filed a complaint against the holder of the domain name "gorgonzola.best".

The Consorzio argued that the use of the name "Gorgonzola" in the domain name was misleading for consumers and infringed its trademarks and PDO.

According to art. 4(a) of UDRP, the three conditions needed to obtain the transfer of a disputed domain name are:

- i. the disputed domain name is identical or similar to its trademark,
- ii. the domain name has been registered and
- iii. used by the registrant without right or legitimate interest and in bad faith.

The requirement of similarity was accepted without difficulty.

The legitimate interest requirement was considered likely in view of "the popularity of the GORGONZOLA trademark and of the Italian cheese by the same name", that the registrant has attempted to capitalize on the reputation of the name.



Consorzio Tutela Taleggio v. Gilberto Ramponi Rivelli, Publinord s.r.l. WIPO Case No. D2020-0271

- The **disputed domain name** <taleggio.net> is registered with Tucows Inc. (the “Registrar”).
- Factual background
 - **The Complainant** holds that the GI TALEGGIO (i.e., PDO) is registered since 1996, as EU Trademark since 2010 and as International Registration No. 1066783 since 2011.
 - **The Respondent** is an Italian company operating with several thematic Internet portals, including a portal on Italian food, and a portal providing information about Italian cities and regions.
 - The disputed domain name was registered on July 15, 2004.
- The WIPO Panel found that the Complainant has **not satisfied the requirement of bad faith of the Uniform Domain Name Dispute Resolution Policy**. Therefore, the Complaint was denied.
- The argument of the respondent was found reasonable and not in contrast with the Policy: the Respondent denied its intent to attract Internet users to its website by creating a likelihood of confusion as to the source, sponsorship or affiliation with the Claimant’s products and services.



- The Respondent, in fact, claims that it registers DNs based on the names of Italian towns and tourist sites and then uses them to bring Internet users to informational portals.
- The Respondent has provided prima facie evidences
 - a. it registered numerous DNs similarly based on Italian place names and operates a relevant information portal on Italian towns and regions, and
 - b. there is no evidence that the advertising linked from the Respondent's website concerned the Complainant's competing products.
- The Panel refers to cases **Granarolo S.p.A. v. Publinord s.r.l. d/b/a Gilberto Ramponi Rivelli**, NAF Claim No. 653822 and **Superga Trademark S.A. v. Gilberto, Publinord S.r.l.**, (WIPO Case No. D2008-1890).
 - In both cases the Panel **denied the complaint**, finding it more plausible that the disputed domain name had been registered in connection with the Respondent's plans to use place names as domain names redirecting Internet traffic to its travel portal.



Case “champagne.co”

- **Comité Interprofessionnel du Vin de Champagne v Vickers (WIPO Case DCO2011-0026, June 21 2011)**

The Comité Interprofessionnel du Vin de Champagne (CIVC) has lost a complaint **filed under the UDRP**.

Respondent Steven Vickers operated an IT consultancy and computer sales business in London and did **not trade in champagne or beverages of any kind**. He registered the domain name ‘champagne.co’ in July 2010.

The term ‘**rights**’ under Paragraph 4(a)(i) of the UDRP refers to a **trademark or service mark** which can be registered or unregistered.

CIVC did not provide evidence of a registered CHAMPAGNE mark, but it tried to establish rights for the purpose of Paragraph 4(a)(i) by other means.

- It tried to rely on its rights in the term ‘champagne’ as an **appellation of origin** under French law and a **geographical identifier** under EU law. The panel said that such rights should remain outside the scope of the UDRP unless the complainant shows that: *it has rights in the term and that the term is being used as a trademark for goods or services other than those that are described by, or related to, the geographical meaning of the term (secondary meaning)*



- A sign to be a trademark must be capable of distinguishing the goods or services of an individual undertaking from those of other undertakings. A Geographical Indication such as 'Champagne' did not constitute a trademark, since it did not distinguish the wine of one champagne producer from the wine of another.
- The panel also rejected CIVC's argument that it had unregistered rights in a mark as a result of succeeding in passing-off actions before UK courts. **The WIPO Panel agreed CIVC clearly has rights in "champagne" as a GI under French law and EU law, but there was no finding that CIVC had unregistered trademark rights, as required by the UDRP.** The fact that CIVC had succeeded in having "champagne-related" domain names transferred to it under other administrative proceedings in relation to the domain names 'champagne.co.uk', 'champagne.ie', 'champagnes.fr' and 'champagnes.be' was irrelevant. **ADR procedures applicable to domain names registered under '.fr', '.be', '.co.uk' and '.ie' are different from the UDRP and grant protection to a wider variety of names.**
- The panel found that the sole fact of having the intention to rent, sell or otherwise transfer the domain name to a third party, as opposed to CIVC or one of its competitors, **did not amount to bad-faith registration and use for the purpose of the UDRP.**



The decision evidences how the **concept of 'rights' under Paragraph 4(a)(i) will be subject to close examination by panels.**

Many alternative dispute resolution procedures **applicable to ccTLDs** grant protection to a wide variety of names, such as personal names, company names or geographical identifiers.

The UDRP does not, and it is **limited to trade or service marks** for which there is greater harmonisation than for other types of rights. Trying to make other types of protected names fit into the UDRP will likely result in rejection of the complaint.

Source: <https://www.hoganlovells.com/en/publications/unsuccesful-harvest-for-champagne-producers-representative-body-under-udrp>



The .wine and .vin strings

The new standard gTLDs “.wine” and “.vin” are available for reservation by all and **without condition**.

Since no conditions are required for the registration of these new gTLDs with ICANN, anyone can be assigned the management of these extensions on a delegated basis with a "*first come, first served*" policy, which represents a real threat for geographical indications.

In 2012, Afiliac Limited, Donuts, Inc. and Famous Four Media Limited applied for the “.wine” and “.vin” gTLDs even if the company had no relationship with the wine sector = **threats to EU GIs**.

- ICANN’s Governmental Advisory Committee (GAC) gave its advice to the ICANN Board regarding the acceptance or refusal to said gTLDs.
- Donuts won the auctions for the .wine and .vin gTLDs, but its applications remained suspended due to objections from wine industry and EU stakeholders (concerned about the protection of “Champagne”, “Rioja” and “Napa Valley”) -> **after 3 years of negotiations a compromise was then reached by way of private agreement, providing changes to the .wine and .vin, resulting in a list of names reserved for holders of geographical wine indications.**

In 2016, “Prosecco”, “Champagne”, “Port”, “Sherry” were registered as second level domains in the .wine and/or .vin strings.



Conclusion

- Protected GIs are a particular category of IPRs and **should be considered a valid title** based on which a complaint can be filed for challenging the abusive use of GIs as domain names.
- The **lack of protection for Geographical Indications under UDRP**, which is limited only for trademarks' owners, **cause several risks both to European enterprises and consumers**. The former suffer economic damage from the abusive use of Geographical Indications as domain names; the latter will be confused in their purchases about quality and origin of products



Examples of applicable case law

Country Code Top-Level Domain (ccTLDs)



GIs: the response of national systems

As already said before, the alternative dispute resolution (ADR) system of some countries already recognizes a Geographical Indication as a valid title in domain name dispute.

But this was not an easy path, as we will see in the next slides...



Case “champagne.in”

In 2012, the *National Internet Exchange of India* (the .IN dispute resolution body) took a decision regard a compliant filed by the Comite Interprofessionnel du Vin de Champagne (CIVC) against the domain name «champagne.in» registered by an Indian entity.

CIVC claimed that:

- the domain name was identical to the registered GI
- the Indian entity had no rights or any legitimate interest
- the registration was in bad faith (no intent to use).

Champagne was already registered by CIVC in India as a GI in class 33 (for wine), under the GI Act of 1999.

The arbitrator ordered a transfer of the impugned domain to CIVC.



The arbitrator took this decision even if the INDRP, claiming the bad faith of registrants (when they register domains to prevent TM owners from reflecting these in corresponding domain names), doesn't include GIs.

He gave a **broader interpretation** of INDRP, saying that a similar protection should be given also to GIs -> it followed the spirit of the law.

The Indian case and the «champagne.co» case (see above) are similar cases because the respondent didn't have any legitimate interest and the evidences filed by the CIVC were similar, but in the Indian case the panel followed the spirit of the law, not the letter as did a year before in the champagne.co case by the arbitration panel of the WIPO Arbitration and Mediation Center, **following the UDRP**.



Consorzio Tutela Parmigiano Reggiano v. Famiglia Lusuardi Società Agricola S.S. – May 2012

The domain name in dispute: PARMIGIANOREGGIANO.IT and sees

- **Applicant:** Consorzio del Formaggio Parmigiano - Reggiano
- **Resistant:** the Lusuardi Family Società Agricola S.S. as the resistant

In the present case, there is no doubt that the Applicant has shown that **it is the holder of the expression 'Parmigiano Reggiano'**, being the holder of distinctive signs and confirming that it corresponds to a 'Protected Designation of Origin' (PDO).

The arbitrator notes that, prima facie, by typing in the domain name 'parmigianoreggiano.it' the image of the well-known cheese appears and the indication 'producers of milk intended exclusively for the production of Parmigiano - Reggiano since 1901'. Consequently, the presence of this indication would allow to reach the conclusion that there is no intent to divert customers, and the domain name would not appear to be used in bad faith.

On closer examination, however, the expert is able to identify unequivocally elements that allow to ascertain the bad faith of the Respondent.



First of all, **already at the time of registration**, **the domain name corresponded to the famous distinctive sign and DOP**, so it seems logical that it could have only been registered to **exploit the notoriety of the expression "Parmigiano Reggiano"**, which has long been protected by the rules on industrial property.

Furthermore, the **indication** on the home page that can be viewed through the domain name "parmigianoreggiano.it" **appears to have been inserted only recently**, as verified personally by the same expert, by carrying out research in the historical archives that can be consulted on *archive.org*.

Ultimately, the **domain name** that is the subject of this procedure **was in the past associated by the Consortium**, within its own website, **to the dairy "La Grande s.c.a.r.l. di Masone" and not to the Respondent**.

In the light of these observations, the expert can only reassign the domain name parmigianoreggiano.it to the Consorzio del Formaggio Parmigiano - Reggiano.



Case "Chuletón de Ávila"

- **Regional Court of Burgos**, Judgement of 28 March 2018 (decision no. 106/2018), Spain

In 2018, Consejo regulador de la IGP Carne de Ávila filed a lawsuit for trademark nullity and unfair competition against the companies "Gabinete de Estudios Ambientales Agronómicos Ingenieros S.L" and "Asociación Abulense de Empresarios de Hostelería" for the fraudulent use of the trademark "Chuletón de Ávila C.R." and the domain names "chuletondeavila.es" and "chuletondeavila.com.es" to market their own beef.

The *Consejo regulador* argued that the use of the trademark and domain names was an infringement of the PGI "Carne de Ávila".

The Court claimed in favor of the *Consejo regulador*, stating that the trademark and the domain names were a commercial use of the geographical term "Ávila" protected by the PGI "Carne de Ávila", taking advantage of the reputation of the PGI, creating confusion in the minds of consumers and damaging the image of the PGI.

The trademark was considered invalid, and the domain name cancelled.



Case "prosciuttodiparma.fr"

- **SYRELI** procedure of AFNIC, Decision of 29 November 2018 (request n°FR-2018-01699), France

In 2018, Consorzio del Prosciutto di Parma applied for the transfer of the domain name "prosciuttodiparma.fr", registered by a third party via the SYRELI procedure of AFNIC.

AFNIC is the Internet registry for .fr (France), .re (Ile de la Réunion), .pm (Saint-Pierre et Miquelon), .yt (Mayotte), .wf and .tf domain names.

The Consorzio claimed that the use of the domain name represented an infringement of the PDO "Prosciutto di Parma" and that it created confusion among consumers as to the origin of the product. The domain name led to a "parking" page with sponsored links whose names referred to the Consorzio's activity "FOOD PROSCIUTTO", "DOP PROSCIUTTO", etc.

AFNIC ruled **in favor of the Consorzio**, stating that the use of the domain name was misleading and likely to undermine the PDO and it ordered the transfer of the domain name to the Consorzio.



THANK YOU!

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