

GIS AND DOMAIN NAMES: LET THERE BE NO CINDERELLAS IN IP!

By Latha R Nair¹

Introduction

The Report of the Second WIPO Internet Domain Name Process² (“the 2nd report”) released in September 2001 excluded geographical indications (“GIs”) from the purview of recognized prior rights in the domain name process. This article examines the current status of GIs in the domain name systems against the backdrop of the 2nd report and analyses whether the report still holds valid at a time when GIs have come to the forefront as an important and universally recognised intellectual property (IP) in their own right.

Context setting: Two rulings and one GI

On May 18, 2012, the National Internet Exchange of India (NIXI), the .IN dispute resolution body in India, rendered an arbitral decision³ in a domain name complaint filed by Comité Interprofessionnel du Vin de Champagne (CIVC) against the domain name <champagne.in> registered by an Indian entity, “India Portals”. CIVC is the French body in charge of protection of rights in the GI “Champagne”, a sparkling wine produced in the Champagne region of France. The decision was rendered under the .IN Dispute Resolution Policy⁴ (INDRP), closely modelled under the Uniform Dispute Resolution Policy (UDRP).

In the complaint, CIVC claimed that:

- the domain name <champagne.in> is identical to the registered GI ‘Champagne’;
- India Portals had no rights to or legitimate interests therein;
- the registration was in bad faith, which was evidenced by the 530 domains consisting of proprietary names and common words registered by India portals without any intent to use the same; and
- it ignored CIVC’s requests for transfer of the subject domain.

India Portals did not respond to the complaint. While at the time of the complaint, ‘Champagne’ was registered by CIVC as a GI in India in class 33 for ‘wine’ under the Geographical Indication of Goods (Registration & Protection) Act, 1999 (“the GI Act”), it did not have any certification or collective marks for the name Champagne in India. Apart from the registration under the GI Act, CIVC relied on 32 ccTLD domain registrations [though none for <.IN>] in respect of Champagne, numerous decisions upholding the rights in the name Champagne from around the world and in India, some of the successful cancellation or transfer orders in domain name complaints against unauthorised ccTLDs and materials

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² Please see link <https://www.wipo.int/amc/en/processes/process2/report/html/report.html>

³ Case No. INDRP/346 dated May 18, 2012 available on <https://www.registry.in/Policies/DisputeCaseDecisions>

⁴ <https://www.registry.in/IN%20Domain%20Name%20Dispute%20Resolution%20Policy%20%28INDRP%29>

reflecting the public perception in India of Champagne as a sparkling wine from Champagne, such as dictionary references and media articles and details of global protection of Champagne.

The arbitrator ordered a transfer of the impugned domain to CIVC as he found that CIVC had established all the three requirements under Section 4(a) of the INDRP [identical to para 4(a) of the UDRP]. Specifically, the arbitrator noted that while Para 6(ii) of INDRP [identical to para 4(b)(ii) of UDRP], infers bad faith of registrants who register domains to prevent *trademark / service mark* owners from reflecting these in corresponding domain names, it did not include GIs. Noting that CIVC did not have any trademarks or service marks in India and considering the legislative intent and looking beyond a literal interpretation of INDRP, the arbitrator held that a similar weightage as that is given for trademarks could be assigned to GIs. In arriving at the decision, the arbitrator noted that CIVC had established negative rights in the name Champagne by preventing third parties from registering marks that contain the said name. Noting that CIVC clearly established its rights in the GI Champagne, the arbitrator proceeded to treat CIVC's GI registration in India at par with a trademark registration and granted the transfer.

Interestingly, a year before this decision, on June 21, 2011, CIVC was handed over an adverse order by an arbitration panel of the WIPO Arbitration and Mediation Center, which followed the UDRP, wherein it declined to grant relief to CIVC in a complaint to transfer the domain <**champagne.co**>⁵. While the respondent, Steven Vickers, did not trade in Champagne or beverages of any kind, he operated an IT consultancy and computer sales business in London. CIVC based its complaint, among others, on claims of unregistered trademark rights in the "Champagne" name. In support of the same, CIVC filed similar evidence as that in the Indian case discussed above. Rejecting the complaint, the panel made the following observation:

The Panel has given careful consideration to the Complainant's bona fides in bringing the present Complaint. First, the Complainant and its advisers must surely have been aware of the need to establish trademark or service mark rights under paragraph 4(a)(i) of the Policy, and of the fact that attempts to amend the Policy to bring geographical indications within its ambit (a major area of focus in the Second Domain Name Process) had been unsuccessful. For a long time, and in many parts of the world, the Complainant has been at the forefront of battles over its intellectual property rights in the name "champagne", and it seems unlikely that it would not have appreciated the issue over the precise nature of its rights in that expression, and whether they could be said to be "trademark or service mark" rights. Yet the Complainant did not address the issue in any detail, instead electing to provide the Panel with apparently incomplete detail of its rights in "champagne" as a protected designation of origin, referring to favorable domain name decisions it had secured in other cases which turned out to have been decided on policy provisions which differed materially from

⁵ Case No. DCO2011-0026 dated June 21, 2011 Comité Interprofessionnel du vin de Champagne v. Steven Vickers

those of the UDRP, and arguing, without significant analysis, that it had trademark rights because it was entitled to sue in the UK under the law of passing off.

While the 2012 INDRP ruling followed the spirit of the law (and was certainly a pleasant surprise to the proponents of GI rights), the 2011 UDRP ruling followed the letter of the law.

Some rights are more equal than others?

GIs and trademarks are both brands that distinguish products in the marketplace and help consumers make informed decisions. While trademarks help consumers to identify the commercial origin of a product, GIs help to identify the geographical origin, which guarantees certain qualities, characteristics and reputation associated with such geographical origin. To that extent, they render similar functions. Yet, the fate of GIs at the hands of arbitral panels for domain names disputes around the world reminds us of the famous quote from George Orwell's novel, *Animal Farm*, namely, '*All animals are equal, but some animals are more equal than others*'.

The 2nd report, released in September 2001 referred to in the UDRP decision above was the result of a process that was initiated to consider, among others, the rights in GIs in the domain name process. The recommendations in the report were disappointing for bodies who held rights in GIs as well as proponents for the protection of GIs, because these excluded GIs from the domain name process for the following reasons:

- (a) There is not a ready and easy fit between the then existing rules for protection of GIs and the predatory and parasitic practices of the misuse of GIs in the Domain Name System;
- (b) The mere registration of a GI as a domain name by someone with no connection whatsoever with the geographical locality in question, however cheap and tawdry a practice, did not appear to be, on its own, a violation of existing international legal rules;
- (c) There are many circumstances in which a domain name registration, even though constituting a false or unauthorized use of a GI, may not constitute a violation of the existing international rules because there is no relationship between the domain name and goods;
- (d) Existing rules would offer only a partial solution to the problem of what is perceived to be the misuse of GIs in the domain name system;
- (e) There is a problem in respect of applicable laws because of the different systems that are used, at the national level, to protect GIs; and
- (f) The existing international legal framework for the protection of GIs was developed for, and applies to, trade in goods alone.

Considering that Article 22.2 of the World Trade Organisation's (WTO) Agreement on Trade related Aspects of Intellectual Property Rights (TRIPs Agreement) stipulates member states to only provide "legal means" for the protection of GIs without being prescriptive about such "legal means" and that the said article also stipulated that member states prevent any use of

a GI which constitutes acts of unfair competition, the last of the two reasons above, perhaps appear the most unconvincing and unjustified⁶.

It has been 18 years since the 2nd report was released. While it is rather late to do a post-mortem of the report now, it would be relevant to examine whether GIs faded into oblivion post the report or whether the policies and protection surrounding GIs thrived or whether GIs stood their ground; and if they have thrived and flourished over these years, whether we need to revisit the recommendations in respect of GIs in the 2nd report.

Where have GIs been since 2001?

Though the recommendations in the 2nd report were a major setback to right-holders of GIs and have been continuously criticised and debated all these years, the protection of GIs and the policies surrounding them have made remarkably steady progress in the last 18 years. Such progress is visible from various factors such as the number of countries that enacted laws to protect GIs, the advancement in the protection of GIs for goods other than wines and spirits, positioning of GIs as a brand in their own right by stakeholders and brand associations, the interest of brand associations and other organisations in the brand power of GIs, protection measures taken by African and Asian countries for their GIs, the adoption of the Geneva Act in 2015 and greater judicial recognition for GIs around the globe.

Increased GI protection around the world

The increase in the protection of GIs around the world is visible from the fact that many countries have enacted sui generis laws to protect GIs in the last two decades. The website of the Organisation for an International Network for Geographical Indications (oriGIn) has a detailed global chart depicting a total of 97 countries that protect GIs through various legal instruments along with the list of products that are protected, including the details of protection for such products in third countries⁷.

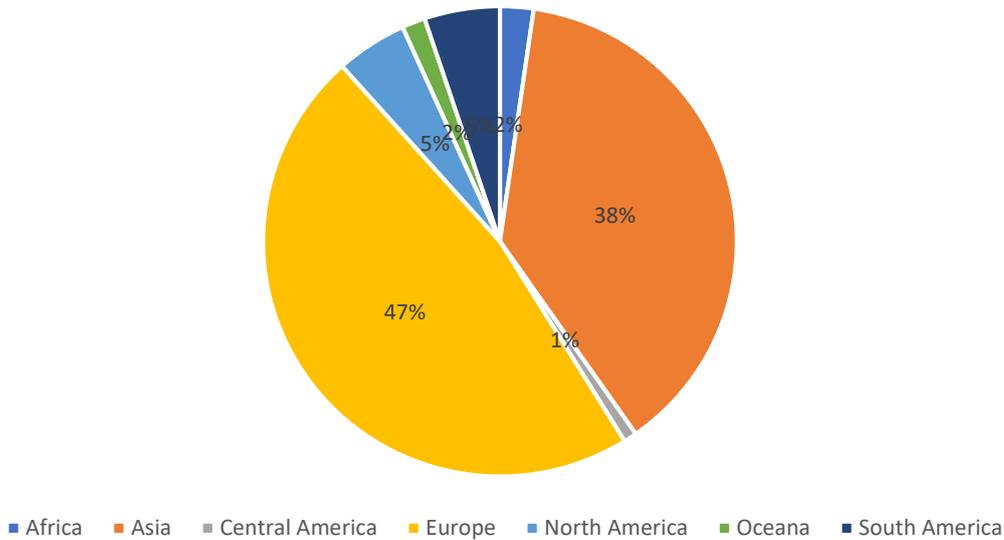
Depicted below is a figurative representation of the global spread of GIs compiled from the data available on oriGIn's website. As per the numbers available on the said website, there are a total of 8131 GIs around the world. While Europe holds 47% of this figure, Asia is featuring right behind with 38% share in the world's GIs listed therein. These figures dispel the notion that Europe is the only region that is interested in advancing the cause of protection GIs. In fact, the diversity of goods eligible for GI protection is better in Asian and African countries than in Europe, which mostly has GIs for wines, spirits, cheeses and meats.

⁶ In respect of geographical indications, Members shall provide the legal means for interested parties to prevent:

- (a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;
- (b) any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967).

⁷ <https://www.origin-gi.com/i-gi-origin-worldwide-gi-compilation-uk.html?filter=darjeeling&limit=100&cc=p>

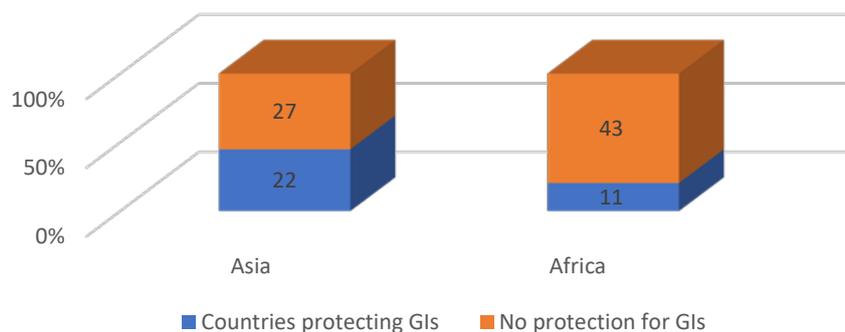
Compilation of worldwide GIs by oriGin - 8131



With the advent of the WTO and the TRIPs Agreement, the awareness of IP rights slowly expanded for many developing countries in Asia and Africa beyond trademarks, copyrights, designs and patents. For example, the website of the Indian GI Registry states that it has been organizing awareness programmes throughout India to promote registration of the Indian GIs with special focus on tea, coffee, spices, agriculture and horticulture products, handloom products, handicrafts, textiles, processed food items, dairy products, natural goods, spirits and wines⁸.

The interest evinced by many of the Asian and African countries in the protection of GIs is also evident from the number of countries from these regions that are protecting GIs. The two representative charts below depict the percentage of countries in these two regions that currently protect GIs through various legal instruments⁹.

Asian and African countries protecting GIs



⁸ Source: Annual report of the Indian Patent Office for the financial year 2017-18 which is available at http://www.ipindia.nic.in/writereaddata/Portal/IPOAnnualReport/1_110_1_Annual_Report_2017-18_English.pdf

⁹ Source of the data used in the chart is from oriGIn’s website

GIs beyond wines and spirits

While Article 22.2 of the TRIPs Agreement¹⁰ mandated members to provide legal means to protect all GIs against misleading uses, Article 23.1 thereof stipulates an “additional protection”¹¹ for GIs relating to wines and spirits, where it is not necessary to show that the unauthorised use of the relevant GI by a third party is misleading. This issue of preferential treatment to wines and spirits was controversial immediately after the WTO was established and it continues to be an eyesore in the TRIPs Agreement.

Though the fact that there is no obligation on a member of the WTO to enact laws to give this “additional protection” to GIs for goods other than wines and spirits continues to be agitated by the affected groups, this has not deterred many countries from enacting inclusive laws¹². This is indeed a very positive development and reflects the understanding and awareness of WTO members about the importance of GIs as an IP right and the need to protect it for the relevant stakeholders.

The European system currently protects GIs in respect of wines and spirits, cheeses and agricultural goods. One of the criticisms against the European system for GI protection has been that it never provided for GIs relating to non-agricultural goods. This led to a study and a public hearing in 2013 followed by a green paper in 2014¹³. The green paper discussed whether and how GIs for non-agricultural products could be protected in the EU. It was concluded by the green paper that:

- protected GIs strengthen consumer confidence in indications of origins;
- they provide greater legal certainty for consumers and businesses particularly when they are formulated as a European right; and
- registering them in a central register enables people to check at no great expense whether a GI is protected.

The fact that such a study was initiated in a region which is dominated by GIs for wines, spirits, cheeses and agricultural products is again sign in direction of the progress of GI protection around the world. If Europe were to enact laws to protect GIs for non-agricultural goods, it would further strengthen global GI protection from two perspectives. First, many European

¹⁰ Supra note 6

¹¹ Article 23: Additional Protection for Geographical Indications for Wines and Spirits: -

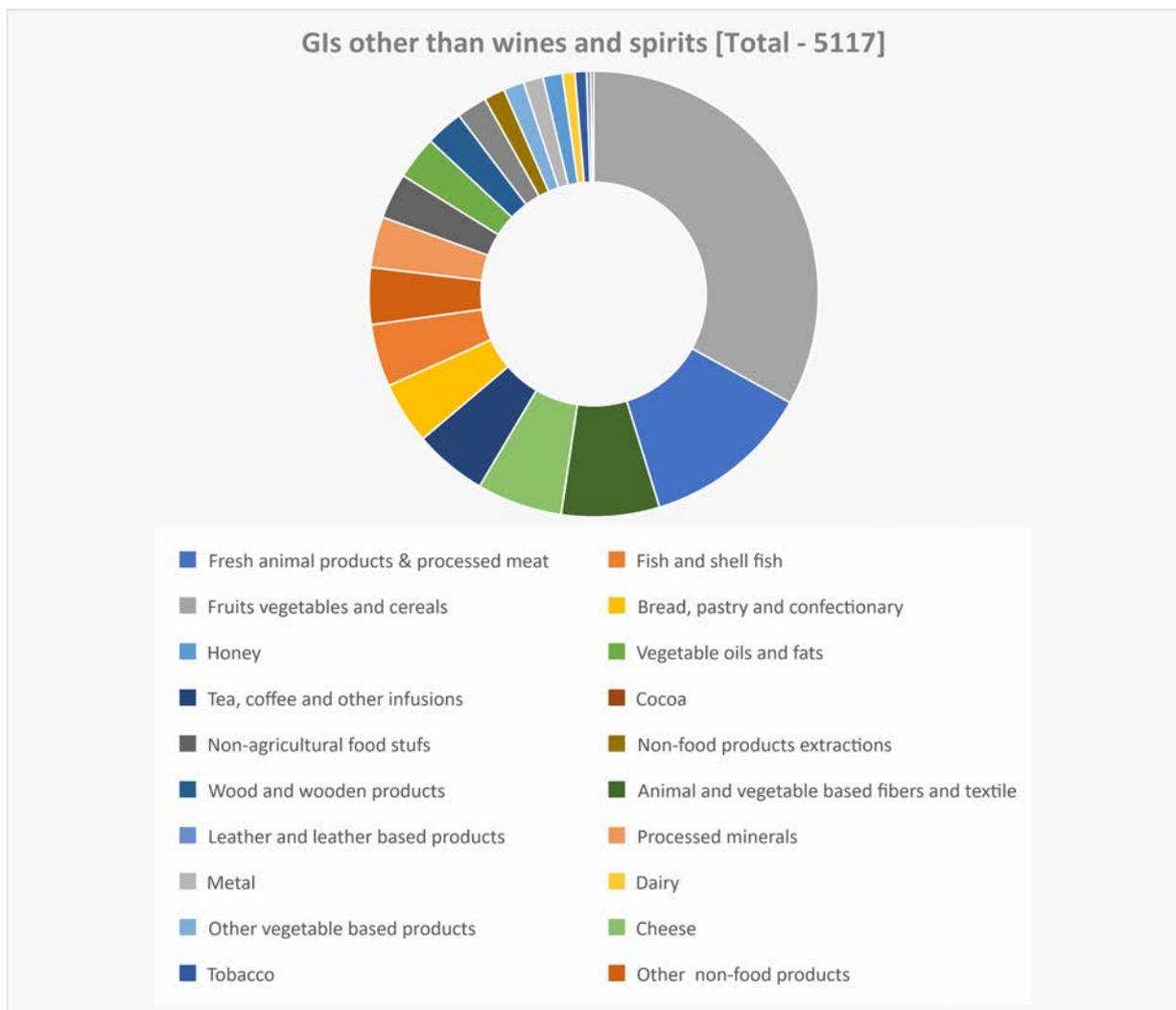
1. Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like.

¹² For example, Section 20(2) of the Indian Geographical Indications of Goods (Registration & Protection) Act, 1999 states: *“The Central Government may, if it thinks necessary so to do for providing additional protection to certain goods or classes of goods under sub-section (3), by notification in the Official Gazette, specify such goods or class or classes of goods, for the purposes of such protection”*. During the Free Trade Agreement negotiations between India and the European Union (which have since stalled), several European GIs were afforded higher level of protection under this section by the Indian government.

¹³ https://www.cep.eu/fileadmin/user_upload/cep.eu/Analysen/COM_2014_469_Schutz_geographischer_Angaben/cepPolicyBrief_COM_2014_469_Geographical_indication_protection.pdf

GIs for non-agricultural goods would get the same level of protection enjoyed currently by wines, spirits, cheeses and agricultural products in Europe. Secondly, this would enable several Asian and African countries to protect their GIs for non-agricultural goods in Europe, thereby, opening up avenues for the relevant communities of right holders to improve their social and economic conditions.

Below is a chart depicting the diversity of products that are protected as GIs around the world. The data used to create this chart is gleaned from the website of oriGIn.



Founding of oriGIn

oriGIn was founded in 2003. It calls itself to be a “truly global alliance of GIs” from a large variety of sectors and claims to represent around 500 associations of producers and other GI related institutions from 40 countries of the world. The goals of oriGIn are stated to strengthen the production of GIs at the national, regional and international level, raise

awareness on GIs and sustainable development and facilitate the exchange of experience among GI groups.

Since its inception, oriGIn is actively involved in policy and advocacy matters relating to GIs and has been regularly holding events for stakeholders of GIs around the world. It has also created a comprehensive global database of GIs, their mode protection in their home countries along with links to the respective statutes and details of any protection offered by third countries to such GIs¹⁴.

oriGIn has often collaborates with other brand bodies and organisations who have interest in GIs. Its efforts in the last 16 years have contributed in a meaningful way to bring GIs and their stakeholders from the margins to mainstream IP discussions.

Recognition of GIs by other organisations and brand associations

It is interesting to note that associations of brand owners such as the International Trademark Association (INTA) and MARQUES have included GIs in their activities over the years. These associations primarily consist of trademark owners. Significantly, two of the recognized legal instruments globally employed for the protection of GIs are certification marks and collective marks. Owners of certification marks and collective marks are members of such associations and several of these members are bodies that look after the interests of GIs.

INTA's mission statement says that it is a *global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property to foster consumer trust, economic growth, and innovation*¹⁵. INTA has a dedicated committee for GIs for about a decade or more. The GI Committee of INTA is stated to develop and advocate INTA's policies regarding the impact of GIs and their enforcement on trademark rights, monitor developments in treaties, legislation, and implementation in various jurisdictions, and completes, analyses and proposes policy recommendations to INTA's Board¹⁶. Over the years, INTA has had panels on GIs in many of its conferences including its annual meetings¹⁷. In 2015, INTA hosted a one-day conference in Rome titled, "The Geographical Names Conference", which was dedicated exclusively to GIs and geographical names and covered a range of topics. At the said conference, INTA launched its international online searchable guide on GIs, Certification Marks and Collective Marks, which is available for its members on its website¹⁸. The guide currently covers the details of these three legal concepts in over 20 jurisdictions and is intended to serve its users as a complete guide on the laws pertaining to the same.

MARQUES's mission statement *is to educate and promote the professional development of brand owners in the selection, management, protection and exploitation of their Trade Marks within a global economy; to create a forum for the free exchange of ideas and information and to provide an effective platform for the representation of their interests*. MARQUES has

¹⁴ See <https://www.origin-gi.com/i-gi-origin-worldwide-gi-compilation-uk.html>

¹⁵ <https://www.inta.org/Governance/Pages/StrategicPlan.aspx>

¹⁶ <https://www.inta.org/Committees/Pages/GeographicalIndicationsCommittee.aspx>

¹⁷ Source: www.inta.org

¹⁸ https://www.inta.org/INTABulletin/Pages/GI_Conference_Review_7101.aspx

a “Team” dedicated to GIs and its mission statement is, “to monitor and influence legislative and any other developments in the area of Geographical Indications and Designations of Origin and disseminate information about GIs within the Organisation”. The Team was regularly representing Marques at WIPO and was intensely involved in the preparation of the Geneva Act, by providing inputs and position papers for the EU trademark reform, especially on GIs and certification marks¹⁹.

The activities of organisations like INTA and MARQUES in the area of GIs are a testimony to the brand power of GIs and their importance in the branding world which is still dominated by trademarks.

Another organisation which has recognized the power of GIs as a tool for social and economic development is the Food and Agriculture Organisation (FAO) of the United Nations. FAO believes that origin-linked products can become the pivotal point of an origin-linked virtuous circle, through a territorial strategy of promotion, whose effects are reinforced over time²⁰. Since promotion and preservation of origin-based quality can contribute to rural development, food diversity and consumer choice, in 2007, FAO launched a programme on origin-linked quality in order to contribute to rural development by assisting member countries and stakeholders in the implementation of origin-based quality schemes, both at institutional and producer level that are tailored to individual economic, social and cultural contexts. Thereafter, it launched a guide in 2009 for promoting quality linked to geographical origin and sustainable GIs²¹. In 2018, FAO released another study on the economic impact of strengthening sustainable food systems through geographical indications²². In the said study, FAO states that the promotion of linkages between local producers, their local areas and their food products through GIs is recognized as a pathway to nutritious food systems and sustainable development for rural communities throughout the world.

FAOs interest in GIs demonstrates that GIs are not only powerful brands, but also agents of social and economic change.

Geneva Act, 2015

In May 2015, the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications was adopted under the auspices of WIPO. While the Lisbon Agreement applies only to appellations of origin, a special kind of GIs for products that have a particularly strong link with their place of origin, the Geneva Act extends that protection to all GIs covered by the TRIPS definition as well. This change accommodates the existing national or regional systems for the protection of distinctive designations in respect of origin-based quality products since the Act and the Regulations thereunder accommodate the different national/regional GI systems that exist around the world.

¹⁹ <http://ipkitten.blogspot.com/2015/05/a-transcendental-moment-for-very.html>

²⁰ <http://www.fao.org/in-action/quality-and-origin-program/en/>

²¹ <http://www.fao.org/3/i1760e/i1760e.pdf>

²² <http://www.fao.org/3/a-i8737en.pdf>

Contracting Parties to the Geneva Act must provide legal means to prevent the use of an internationally registered appellation of origin or GI:

- a. in respect of goods of the same kind as those to which the appellation of origin or the GI applies, not originating in the geographical area of origin or not complying with any other applicable requirements for using the appellation of origin or the GI; and
- b. in respect of goods that are not of the same kind, *or services*, if such use would indicate or suggest a connection between those goods or services and the beneficiaries of the appellation of origin or the GI, and would be likely to damage their interests, or, where applicable, because of the reputation of the appellation of origin or GI in the Contracting Party concerned, such use would be likely to impair or dilute in an unfair manner or take unfair advantage of, that reputation^[1].

This Act is a significant milestone in the debates surrounding GIs and their inclusion in the domain names systems for two reasons. First, because it recognizes the wider term “geographical indications” and has serious potential to put at rest the concerns raised in the 2nd report regarding lack of uniformity in the protection granted and the inability of the existing systems to fit in violations of GIs in the domain name world. Secondly, the Act recognizes that though GIs are in respect of goods, their use in respect of services could, in some circumstances, violate GI rights, including situations involving possible dilution of GI rights.

Time to tune the jarring notes

The discussions above only strengthen the argument that GIs are now hard to ignore. There is considerable evidence around the globe of the emergence of GIs as an IP right in their own stead. While GIs may be existing in a world that is quantitatively dominated by trademarks, qualitatively viewed, GIs are as powerful and prevalent a branding tool as trademarks are. Unlike trademarks that enrich corporations and private individuals, GIs have the power and potential to positively and expansively affect the development of communities.

In addition, as a collective IP right, GIs compliment several trademarks. Take the case of the trademarks used to trade in GIs such as Scotch Whisky, Champagne, Darjeeling tea and Basmati rice. We cannot overlook the fact that such use exists solely because the respective traders of such goods recognize and value the power of GIs to guarantee origin and quality to accentuate the power of their trademarks.

Also, it would be hard for the domain name system to ignore the increasing global protection of GIs irrespective of the different legal instruments employed for such protection. If the means used for such protection are legal, there is no justification in questioning the ends.

In world that is rapidly turning digital and online, if GIs continue to be kept out of the domain name system, it would result in aggravating the already mounting frustrations of producers

^[1] <https://www.wipo.int/export/sites/www/treaties/en/registration/lisbon/mainprovisions.pdf>

and right holders. Such differential treatment to GIs is incongruent in the face of the progress undergone by GIs since 2001. Besides undermining the livelihood of millions of stakeholders of such products, it would also dilute cultural and historic moorings of many GIs around the world. Unless GIs are let into the hall of the domain name system as an IP right that must be protected from misappropriation, they will never have a level playing ground. Future discussions and policy decisions concerning the inclusion of GIs in the dispute resolution policies of domain names system must, therefore, be truer, fairer and more inclusive.

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