

Strengthening geographical indications

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BACKGROUND PAPER

PANEL: GIS ON-LINE: PLATFORMS AND THE DNS

1. OBJECTIVES:

Producers holding the intangible asset of a geographical indication (GI) have a right to have it effectively protected both in the physical and in online markets.

The first of two areas where GIs are vulnerable is on sales **‘platforms’**. In an effectively global marketplace, product may – deliberately or inadvertently – be offered for sale under a GI which its producers are not entitled to use. The second area is the risk of allocation of a GI as a **‘domain names’** within the Domain Name System (DNS) to bad-faith operators who can use the website to unduly profit from the GI’s reputation or otherwise undermine the GI.

Misuses, imitations and evocation of GIs on the Platforms and in the DNS are difficult to enforce, in part due to the non-territorial nature of the web. This works to the detriment of both consumers (who buy a different product from the one they had intended) and producers (who lose sales and profit to bad-faith operators). Therefore, GI stakeholders have called for stronger action to protect GIs in the DNS, both in legal terms and in administrative practice.

2. CHALLENGES

2.1. Platforms

Most of the major global internet sales platforms have recognised GIs as legitimate rights concerning the marketing of product. Although an advertiser on a platform may inadvertently use a GI, an administratively simple system of ‘notice and take down’ is applied by the platforms.

The producer groups or national authorities send in a form highlighting the item for sale and proving that the GI is protected – and its protection excludes the designation of the product on the internet platform. Resolution is normally very fast (a few days) and the product is renamed or removed from sale.

The system does require vigilance by producer groups – and the producer group has to have the legal authority to be able to act to defend the GI.

2.2. Usurpations in the DNS

Domain names are allocated by a body or authority that owns or manages the top-level domain. In some cases, the top-level domain owner ensures that the second-level domains are allocated in respect of all intellectual property rights (IPR), including GIs. In these systems, as well as a check by the domain owner, the GI right holders are permitted to appeal against an allocation they consider infringes their GI.

However, in many – the majority of – cases, a ‘[universal](#)’ system of dispute resolution is applied, which only recognises prior trade mark rights. Holding a GI has even been rejected as a ground to challenge a domain allocation by the World Intellectual Property Organization (WIPO) which operates one of the global arbitration bodies.¹

To address these shortcomings, some managers of domains have extended protection to cover GIs whether through judicial redress or private agreements. Producers of GIs have even sought to use certification and collective trade marks to be able to defend their GIs. However, in many cases producer group of a GI finds they are not eligible for these kinds of trade mark protection.

3. QUESTIONS

- (1) How widespread is the problem of the sale of counterfeit goods bearing GI names via the internet’?
- (2) What types of enforcement actions or technical and awareness tools are needed by the relevant operators? (GI right holders, suppliers, online platforms, advertisers, payment services, domain name registrars/registries and public enforcement authorities.)
- (3) What steps are needed to ensure recognition of GIs as legitimate forms of IPR to qualify as prior rights in (a) domain name system, and (b) on platforms?
- (4) What kinds of risks to GI usurpation are there from the allocation of the new ‘generic top-level domains’? How many of these generic-top-level domains are being released and when?
- (5) In the EU and in national systems, are current legal and administrative rules sufficient to ensure GIs are respected in top-level domains?
- (6) In order to be fully entitled to take action to defend GIs in the DNS and on the platforms, do GI producer groups need special recognition or empowerment?

¹ Comité Interprofessionnel du vin de Champagne v. Steven Vickers, concerning allocation of ‘champagne.co’. [WIPO Case No. DCO2011-0026](#)