



Protecting GIs from Bad Faith Use in the Domain Name System (DNS)

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Contents

Introduction	3
I. Background	4
II. Basics of GI protection	5
A. Geographical Indications: origin, evolution, protection systems and differences between trademarks and GIs	5
1. What is a Geographical Indication?	5
2. Historical Evolution of Geographical Indications	5
a. The 1891 Madrid Agreement on Indications of Source	6
b. The Lisbon Agreement (1958)	6
c. The TRIPS Agreement (1994)	7
d. The Geneva Act of the Lisbon Agreement (2015)	7
3. Systems to Protect GIs	8
a. <i>Sui generis</i> system	8
b. Trademark Systems	8
II. Differences and Commonalities Between Trademarks and GIs	9
1. Cybersquatting and Protection for Trademarks in the DNS	12
2. Protection for GIs in the DNS	14
a. UDRP applicability to GIs	14
b. Some ccTLD Dispute Resolution Policies Include GIs	14
c. Judicial decisions and Litigation Results	15
d. Overview of EU Regulations on Geographical Indications and the DNS	16
European Union Regulation on Geographical Indications for Wine, Spirit Drinks, and Agricultural Products	16
Territoriality issues	17
Degree of GI Protections	17
Defenses to GI Infringement	18
Ownership of GIs	19
3. Applicability and Upcoming ICANN review of UDRP	19
Planned Review of the UDRP	19
GNSO's Role and Policy Development Process	19
III. Conclusion	20
IV. APPENDIX	21

Introduction

This concept paper outlines the background of the development of the Geographical Indications (GIs) protection system and the essentials of the Uniform Dispute Resolution Policy (UDRP) for domain names. It provides a historical view of the FGI framework through the WIPO Trade Related Aspect of Intellectual Property (TRIPS) agreement, and the differences and commonalities between trademarks and GIs, and an overview and Analysis of Current Laws on Trademarks and GIs in the DNS. Potential actions by INTA will be assessed in future work.

The issue of cybersquatting, where domain names identical or similar to trademarks are registered or used in bad faith to profit from the goodwill of those trademarks, is well-known to brand owners. In response, the Internet Corporation for Assigned Names and Numbers (ICANN) introduced the WIPO-designed Uniform Domain Name Dispute Resolution Policy (UDRP) in 1999¹. This mandatory dispute resolution procedure addresses bad faith use of trademarks in Generic Top-Level Domain (gTLD) names and has been widely utilized. The top two providers are Swiss based WIPO and US based Forum, with a total of 6 providers approved by ICANN. As of 2025, more than 136,000 complaints have been handled by WIPO alone (with a clear trend of continuing growth).²³ Many country code level domains (ccTLDs) have also adopted the UDRP. with a clear trend of continuing growth⁴⁵. Many country code level domains (ccTLDs) have also adopted the UDRP.

However, protection against the bad faith registration or use of domain names similar to GIs is minimal unless the GI is registered as a trademark. Unlike trademarks, the framework for GI protection is not as developed. Given recent developments in the European Union (EU) and ICANN's intention to review the UDRP, now is an opportune time to consider how GIs should receive protection under the UDRP or other processes.

Considering this disparity, the International Trademark Association (INTA) has formed a project team from its Geographical Indications and Internet Committees. This team's mission is to assess the scope of the problem, understand the current status of GIs in the DNS, and assess options responding to the need of a system to protect GIs.

¹ <https://www.icann.org/resources/pages/policy-2024-02-21-en>

⁴ <https://www.wipo.int/amc/en/domains/caseload.html>

⁵ "<https://www.wipo.int/amc/en/domains/statistics/cases.jsp>; <https://www.adrforum.com/domain-dispute/search-decisions>. WIPO and Forum together handle the majority of UDRP cases. Because there is no standardised reporting across the providers, identifying the total number of cases since the UDRP began is quite a manual exercise, which has not been undertaken for the purposes of this paper."

I. Background

The EU has recently passed two regulations concerning the protection of GIs, with one addressing craft and industrial products and the other wines, spirits, and agricultural products⁶. While the specific wording and applicability dates of the two regulations differ, both expand GI protection to include domain names, mandating that European ccTLDs equipped with alternative dispute resolution (ADR) procedures incorporate these protections. Notably, although the final regulations do not extend ADR requirements to gTLDs and the UDRP, the possibility was considered during the legislative process. This underscores the need for ongoing adjustments and evaluations to keep pace with the digital landscape, reinforcing the premise that these regulations are foundational rather than conclusive.

A survey by the Association of European Regions for Products of Origin (AREPO), involving experts and practitioners from French, Spanish, and Portuguese regions, revealed that 44% of GI producer groups feel inadequately protected against internet fraud with 75% of participants expressing concern⁷.

In the broader context of global commerce, the significance of GIs continues to grow. A 2020 study by the EU highlighted that GI status, on average, doubled the value of agricultural products, with GI products within the EU being valued at €75 billion in 2017⁸. This underscores the substantial economic benefits that GIs provide to local economies, enhancing the value of products and promoting regional development. With the rise of e-commerce and the digital economy, GIs are now more vulnerable to misuse and infringement online, which can mislead consumers and harm local economies. By establishing a clear framework for GIs in DNS, stakeholders can safeguard these valuable identifiers and ensure their appropriate use in the digital space.

INTA's 2019 Resolution⁹ on GIs already acknowledges their importance and supports their protection as an intellectual property right under national laws and international treaties. The resolution stipulates that conflicts between GIs and trademarks—including collective and certification marks—should be resolved based on the principle of "first in time, first in right." This principle is supported by the established legal concepts of territoriality, exclusivity, priority, and good faith.

⁶ Regulation (EU) 2023/2411 of the European Parliament and of the Council of 18 October 2023 on the protection of geographical indications for craft and industrial products and amending Regulations (EU) 2017/1001 and (EU) 2019/1753 (Text with EEA relevance)

Regulation (EU) 2024/1143 of the European Parliament and of the Council of 11 April 2024 on geographical indications for wine, spirit drinks and agricultural products, as well as traditional specialities guaranteed and optional quality terms for agricultural products, amending Regulations (EU) No 1308/2013, (EU) 2019/787 and (EU) 2019/1753 and repealing Regulation (EU) No 1151/2012

⁷ https://www.arepoquality.eu/wp-content/uploads/2023/03/protection-of-gis-on-the-internet_arepo-practical-guide_en.pdf

⁸ https://ec.europa.eu/commission/presscorner/detail/en/ip_20_683

⁹ <https://www.inta.org/wp-content/uploads/public-files/advocacy/board-resolutions/Protection-of-Geographical-Indications-11.2019.pdf>

Moreover, INTA asserts that regulatory systems for GIs should include effective and transparent mechanisms for application, amendment, and opposition and cancellation proceedings. It also specifies that governmental bodies, trade associations, individual traders with a legitimate interest in a GI or prior rights, and trademark owners should have the standing to oppose, amend, or cancel a GI registration. Importantly, the policy emphasizes that the use of geographical terms that have become generic should not be restricted by GI protection.

Additionally, an INTA Board Resolution dated May 16, 2023¹⁰ addressed the ongoing challenge of defining DNS Abuse, highlighting its significant threat to global enterprises, their business partners, and consumers. The resolution particularly noted the frequent involvement of misused brands, trademarks, and related IPRs. The resolution acknowledged that existing definitions of DNS Abuse were unclear across the private sector, government bodies, and academia and proposed a standard definition of DNS Abuse as follows: "DNS Abuse should be understood and defined as any activity that makes, or intends to make, use of domain names, the Domain Name System protocol, or any digital identifiers similar in form or function to domain names to carry out deceptive, malicious, or illegal activity." This definition aims to provide a clearer and more robust framework to tackle DNS Abuse effectively.

II. Basics of GI protection

A. Geographical Indications: origin, evolution, protection systems and differences between trademarks and GIs

1. What is a Geographical Indication?

GIs are signs which identify a product as originating in a territory, region, or locality where certain qualities, reputation or other characteristics of the goods are essentially attributable to their geographical origin¹¹. Typically, GIs are used for agricultural products, foodstuffs, wine and spirits, handicrafts, and industrial products.

2. Historical Evolution of Geographical Indications

The term "Geographical Indication," has evolved from its beginnings as a simple indication of source to the more sophisticated classification of Appellation of Origin (AO), Protected Designation of Origin (PDO), and Protected Geographical Indication (PGI) within the European Union and other countries. For the purposes of this document, GI will be used as an umbrella term to encompass PDO and PGI.

- a. The Paris Convention (1883) The concept of protecting geographical indications began with the Paris Convention for the Protection of Industrial Property in 1883. This convention concerned all aspects of IP and established basic principles

¹⁰ <https://www.inta.org/wp-content/uploads/public-files/advocacy/board-resolutions/INTA-Board-Resolution-on-Domain-Name-System-Abuse-May-2023.pdf>

¹¹ <https://www.inta.org/wp-content/uploads/public-files/advocacy/board-resolutions/Protection-of-Geographical-Indications-11.2019.pdf>

around IP protection, including geographical indications. However, it primarily addressed the unfair competition aspect, whereby as per Articles 10, 10bis and 10ter false indications of source on goods were prohibited¹².

Article 10ter (2) provides legal standings to federations and associations representing interested industrialists, producers, or merchants, to take action in the courts or before the administrative authorities, with a view to the repression of the acts referred to in [Articles 9, 10, and 10bis](#), in so far as the law of the country in which protection is claimed allows such action by federations and associations of that jurisdiction.

a. The 1891 Madrid Agreement on Indications of Source

The Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods was the first multilateral agreement to provide specific rules for the repression of false and deceptive indications of source.

According to Article 1(1) of the Madrid Agreement, any goods displaying a false or deceptive indication suggesting that the goods come from a member country, or a place within such a country, must be seized upon importation into any member country¹³. This Agreement builds on the principles set by the Paris Convention but goes further by not only addressing false indications of source but also deceptive ones. A deceptive indication could be the accurate name of the place of origin, yet it still misleads the buyer about the actual origin and quality of the product.

b. The Lisbon Agreement (1958)

The Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, established in 1958, provided a more focused framework specifically for appellations of origin, a subset of GIs. This agreement created an international system for the recognition and protection of appellations based on their geographical origin.

Article 2 of the Lisbon Agreement defines an AO as the geographical name of a country, region, or locality that designates a product originating from there, where the product's quality and characteristics are due primarily or exclusively to the geographic environment, including both natural and human factors.

Article 4 of this Agreement extends protection against any usurpation or imitation of the appellation, even if the true origin of the product is indicated, or if the appellation is used in translated form or accompanied by qualifiers such as "kind," "type," "make," "imitation," or similar terms.¹⁴

¹² See Articles [10, 10bis and 10ter of the Paris Convention for the Protection of Industrial Property \(1883\)](#)

¹³ See Article 1(1) of the [The Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods \(1891\)](#)

¹⁴ See Articles 2 and 4 of the [the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration \(1958\)](#)

c. The TRIPS Agreement (1994)

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), which came into effect in 1995, significantly expanded the scope of GI protection. It is the first multilateral treaty dealing with GIs, as such, and takes into consideration the existence of various systems set by Members States to protect GIs, thereby creating a definition that would allow members states to maintain their systems when implementing the treaty.

Article 22 defines GIs as indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation, or other characteristic of the good is essentially attributable to its geographical origin.

The same Provision outlines the basic level of protection that must be provided for GIs associated with any type of product, hence 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 10*bis* of the Paris Convention (1967).

The Article also tackles issues related to trademarks bearing GIs and provides legal standing for any interested party, following article 10*ter* of the Paris Convention.

Article 23 mandates a higher level of protection specifically for GIs that identify wines and spirits, elaborating additional regulations concerning their use in or as trademarks and calling for discussions on a multilateral system for the notification and registration of GIs for wines. Article 24 outlines specific exceptions, permitting the continued use of a GI for products not originating from the designated area, such as when a name has become generic.

TRIPS requires all World Trade Organization (WTO) members to provide a broad level of protection for GIs, notably enhancing protection standards worldwide and requiring members to protect GIs from misuse.

d. The Geneva Act of the Lisbon Agreement (2015)

The Geneva Act extends that protection to geographical indications alongside appellations of origin, to better consider existing national or regional systems for the protection of distinctive designations in respect of origin-based quality products. In addition, it introduces maximum flexibility with respect to how the protection standard of the Act may be implemented (i.e. through a *sui generis* appellation of origin or geographical indication system or through the trademark system).

3. Systems to Protect GIs

It is important to note that the TRIPS Agreement does not mandate a specific system for protecting GIs. However, most jurisdictions worldwide have chosen to protect GIs through independent systems (*sui generis*), whereas a smaller number of countries continue to rely solely on trademark registration (including certification and collective marks) for their protection.

a. *Sui generis* system

A *sui generis* system of GI protection is a specialized legal framework where GIs are recognized as an independent category of IP, and specific legislation is enacted to govern their protection. This approach acknowledges the unique qualities and reputation of products that arise specifically because of their place of production, encompassing both natural and human factors.

Key aspects of a *sui generis* system include:

- **Collective Ownership:** Rights to use a GI are typically held collectively by all producers adhering to predefined standards within a specific area, and the administration of the right resides either on a Government Agency or an Association commonly known as a regulatory Council.
- **Link to Geography:** It ensures that only goods produced in the designated region and meeting specific standards can use the protected geographical name.
- **Permanent Protection:** Protection under this system does not expire as long as the product qualities and geographic specificity are maintained.
- **Protection Scope:** The system is meant to protect the GIs from being misused, either by deceitful conduct or by conduct that exploits the GI's reputation.
- **Robust Enforcement:** Includes measures to prevent misuse both domestically and at borders, ensuring integrity and consumer trust in the GI products.

b. Trademark Systems

As mentioned above, in some countries GIs can be protected only under trademark law, typically as collective or certification marks:

- **Collective Marks** are used by members of a group to indicate membership, which may also indicate that the product possesses certain qualities.
- **Certification Marks** are used to indicate that certain products adhere to a set of standards (such as origin, material, mode of manufacture of goods, or performance of services) and are not limited to any membership.

Unlike individual trademarks that identify single companies, these marks can be used by multiple producers who meet the agreed-upon standards for using the mark. While the holder of a collective mark may also use it, the holder of a certification mark, under many laws, cannot; this holder is typically a certification agency tasked with certifying eligible products.

Both systems are vital for protecting the economic and cultural interests of regions, preserving traditional knowledge, and promoting local development through distinctive, high-quality products.

II. Differences and Commonalities Between Trademarks and GIs

The primary difference between trademarks and GIs lies in what they signify but not necessarily on all the matter they protect:

- **Trademarks** identify the goods or services of one source and distinguish them from those of other sources. They are private rights that can be owned by individuals or companies and can be sold or licensed.
- **Geographical Indications**, on the other hand, also identifies a product but not from one source to another, but from its qualities linked to a geographical origin. GIs are usually collective rights held by groups of producers or governments and cannot be sold or transferred, although the right to use a GI can be transferred.

GI registration through a *sui generis* system requires proof of origin and that the origin linked to the product has acquired a reputation, whereas trademark registration requires distinctiveness and use.

Both systems are meant to protect reputation and consumers.

Both systems forbid generic signs or terms from becoming trademarks or GIs.

However, both systems either acknowledge or are based on the rationale that intensive use of a sign or term creates a primary meaning in consumers' minds, also known as secondary meaning, thereby acquiring distinctiveness. It is unlikely that a sign acquires reputation without acquiring distinctiveness.

Therefore, while there are some differences as to the scope of protection of GIs and trademarks there are also commonalities:

- Trademarks can protect any sign or logo capable of distinguishing goods or services. GIs protect names of places, and exceptionally logos related to those places that are associated with specific goods or services.
- While Trademarks have potentially indefinite duration as long as the trademark is in use and its registration is renewed, GIs are protected so long the quality of the product, and its reputation remains. However, both systems provide for the extinction of the rights when the sign (TM or GI) has become generic.
- Both *sui generis* GI systems and trademark systems (including certification and collective marks) provide a set of criteria concerning the registration of names, third party opposition and length of protection. Following the request of protection by an association of producers or an independent certifier (in the case of certification marks) – usually through a document in which the relevant

geographical boundaries, production methods as well as the good's characteristics and the link between these elements are explained – and the approval by the competent authority, an exclusive right over the commercial use of the geographical name¹⁵ at issue may be granted.

To sum up, trademarks and GIs represent distinct categories of IPRs and rights holders sometimes have the discretion to choose the most appropriate system under which to protect their names in different jurisdictions—whether as a PGI or PDO (Using the sui generis system), a certification mark, or a collective mark, but in other cases they use the TRIPS flexibilities to protect the same right in different jurisdictions using the system offered by the corresponding country.

For example, Scotch Whisky is a PGI for a type of Spirit in the EU. Outside the EU, the protection mechanisms can vary, including protection as a certification mark or a collective mark, depending on the country's legal system and the agreements it holds with the EU. The following table shows how Scotch Whisky is protected by the EU system and by the US system, and the equivalencies of both systems:

EU Sui Generis System	US Certification mark system
Scotch Whisky	Scotch Whisky
PGI-GB-01854	US registration number 90108702
Applicant Department for the Environment, Food and Rural Affairs	Applicant The Scotch Whisky Association
Certification	
<p>The Scotch Whisky Association</p> <p>The Scotch Whisky Association is recognized by the UK Government as the trade association representing over 90% of the Scotch Whisky production and is specifically granted the right in Regulation 40 of The Scotch Whisky Regulations 2009 to apply for court orders to stop the sale of non-complying products to enforce provisions of those Regulations.</p> <p>The Scotch Whisky Association was established to protect Scotch Whisky worldwide, including the registration of Scotch Whisky as a Geographical Indication/collective mark/certification mark/appellation of origin in third countries. The Scotch Whisky</p>	

¹⁵ Not all geographical names are GIs, and not all GIs are AOs but all AOs are considered GIs. Additionally, not all certification or collective marks are GIs, but they can serve as such if they fall within the definitions described above.

<p>Association takes legal action to stop any spirits being sold as Scotch Whisky which do not comply with the requirements of The Scotch Whisky Regulations 2009.</p>	
<p>Conditions</p> <p>Method of production for Scotch Whisky</p> <p>The basic production method is set out in the definition of Scotch Whisky in Regulation 3(1) of the Scotch Whisky Regulations 2009 as follows:</p> <p>Definition of “Scotch Whisky”</p> <p>“Scotch Whisky” means a whisky produced in Scotland</p> <p>(a) that has been distilled at a distillery in Scotland from water and malted barley (to which only whole grains of other cereals may be added) all of which have been;</p> <p>(i) processed at that distillery into a mash; (ii) converted at that distillery into a fermentable substrate only by endogenous enzyme systems; and</p> <p>(iii) fermented at that distillery only by the addition of yeast;</p> <p>(b) that has been distilled at an alcoholic strength by volume of less than 94.8 per cent so that the distillate has an aroma and taste derived from the raw materials used in, and the method of, its production;</p> <p>(c) that has been matured only in oak casks of a capacity not exceeding 700 litres;</p> <p>(d) that has been matured only in Scotland; (e) that has been matured for a period of not less than three years;</p> <p>(f) that has been matured only in an excise warehouse or a permitted place;</p> <p>(g) that retains the colour, aroma and taste derived from the raw materials used in, and the method of, its production and maturation;</p> <p>(h) to which no substance has been added, or to which no substance has been added except;</p>	<p>Standards</p> <p>Method of production for Scotch Whisky</p> <p>The basic production method is set out in the definition of Scotch Whisky in Regulation 3(1) of the Scotch Whisky Regulations 2009 as follows:</p> <p>Definition of “Scotch Whisky”</p> <p>“Scotch Whisky” means a whisky produced in Scotland</p> <p>(a) that has been distilled at a distillery in Scotland from water and malted barley (to which only whole grains of other cereals may be added) all of which have been;</p> <p>(i) processed at that distillery into a mash; (ii) converted at that distillery into a fermentable substrate only by endogenous enzyme systems; and</p> <p>(iii) fermented at that distillery only by the addition of yeast;</p> <p>(b) that has been distilled at an alcoholic strength by volume of less than 94.8 per cent so that the distillate has an aroma and taste derived from the raw materials used in, and the method of, its production;</p> <p>(c) that has been matured only in oak casks of a capacity not exceeding 700 litres;</p> <p>(d) that has been matured only in Scotland; (e) that has been matured for a period of not less than three years;</p> <p>(f) that has been matured only in an excise warehouse or a permitted place;</p> <p>(g) that retains the colour, aroma and taste derived from the raw materials used in, and the method of, its production and maturation;</p> <p>(h) to which no substance has been added, or to which no substance has been added except;</p> <p>(i) water;</p> <p>(ii) plain caramel colouring; or</p> <p>(iii) water and plain caramel colouring</p>

(i) water; (ii) plain caramel colouring; or (iii) water and plain caramel colouring (i) that has a minimum alcoholic strength by volume of 40%. [OBJ]	(i) that has a minimum alcoholic strength by volume of 40% ¹⁶
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An example of a GI that has used three systems is CAFE DE COLOMBIA, an AO for coffee from Colombia¹⁷. It was protected as PDO in Colombia, it was protected as PGI in the EU and as a certification mark in the US (Colombian Coffee).

III Overview and Analysis of Current Laws on Trademarks and GIs in the DNS.

We compared the current tools trademark owners have to protect their trademarks from bad faith use in the DNS with the tools GI owners have. Our analysis follows.

1. Cybersquatting and Protection for Trademarks in the DNS

As mentioned above, it is well known that trademarks are vulnerable to misuse within the domain name system. Cybersquatters often register domain names that incorporate others' trademarks with the intent of profiting in bad faith from the established goodwill and recognition of those marks. Trademark owners have several options for addressing such infringements: they can choose to negotiate with cybersquatters, initiate litigation in court, or, when applicable, file a complaint under the UDRP or a similar dispute resolution procedure to contest the registration and usage of an infringing domain name.

Domain names at the second level are registered within top level domain (TLD) registries. TLDs may either be:

- Generic, or gTLDs, such as .com, .org, or .wine, which are overseen by ICANN and all subject to a uniform set of policies, including the UDRP dispute resolution procedure for dealing with IP-abusive domain names, or
- Country Code, or ccTLDs, such as .ca (Canada), .fr (France), or .in (India), which are sovereign properties, the policies for which are set by the individual registry or its national government or other oversight body. ccTLDs therefore are not subject to a uniform set of policies. Some ccTLDs have voluntarily adopted the UDRP, some operate their own dispute process, which may even be similar to the UDRP but with local differences, some have little or no process for addressing IP abuse.

¹⁶ See p. 55 of Scotch Whiskey Standards:
<https://tsdr.uspto.gov/documentviewer?caseId=sn90108702&docId=APP20200815100026&linkId=18#docIndex=17&page=1>

¹⁷ For a worldwide compilation of GIs, see <https://www.origin-gi.com/worldwide-gi-compilation/>.

Under Paragraph 4(a)(i) of the UDRP a complainant must demonstrate that the registrant's domain name is "identical or confusingly similar to a trademark or service mark in which the complainant has rights." Consequently, the UDRP is specifically applicable to disputes involving trademarks and service marks¹⁸.

Complainants under the UDRP submit their claims to approved dispute resolution service providers in expedited administrative proceedings. They must convincingly prove the following:

1. The challenged domain name is "identical or confusingly similar to a trademark or service mark in which the complainant has rights".
2. The domain name registrant has "no rights or legitimate interests in respect of the domain name"; and
3. The domain name "has been registered and is being used in bad faith."

Concerning the first element, the trademark or service mark in question can either be a registered or unregistered right. For an unregistered or common law mark, the complainant must demonstrate that the mark has acquired distinctiveness (secondary meaning) so that consumers associate it with the complainant's goods or services.

Besides the trademark owner, affiliates and exclusive trademark licensees may also have standing to bring a UDRP complaint. Generally, however, without explicit authorization from the trademark owner, non-exclusive licensees are not considered to have legal standing to file a UDRP.

It is also crucial to note that the UDRP generally cannot be used to challenge a domain name registered before the complainant acquired trademark rights, unless there are exceptional circumstances such as a planned business merger or name change that the domain registrant has attempted to exploit.

The UDRP acknowledges that there can be competing rights and interests in a term, even if that term is registered as a trademark in some jurisdictions and/or for certain goods and services. Not all uses of a term that is also a trademark within a domain name will meet the UDRP standard. This approach aligns with INTA's principle of "first in time, first in right." The burden of proof under the UDRP rests with the complainant, who must establish their case on the "balance of probabilities." When successful, the typical remedy is the transfer of the domain name to the complainant, although in a minority of cases, the domain name may be cancelled.

ICANN also oversees the Uniform Rapid Suspension (URS) procedure, a rights-protection mechanism for clear-cut cases of infringement in domain names, applicable to most gTLDs and some ccTLDs, but not to .com and .net domain names. Unlike the UDRP, the URS is faster and less costly but is limited to registered marks and requires the complainant to prove their claim by "clear and convincing evidence." The remedy in URS cases is the suspension of the domain, rather than transfer or cancellation,

¹⁸See Uniform Domain Name Dispute Resolution Policy at <https://www.icann.org/resources/pages/policy-2024-02-21-en>

allowing the domain to potentially re-enter the market—a situation not generally occurring under the UDRP.

2. Protection for GIs in the DNS

a. UDRP applicability to GIs

GI owners, much like trademark owners, encounter the challenge of their protected names being misused within the domain name system. Unlike trademarks, however, GIs are not directly protected under UDRP. Since GIs are separate IP rights and are not categorized as either trademarks or service marks under the UDRP framework, WIPO panels have consistently declined to extend UDRP protections to GIs, as demonstrated in the following cases: The basis for these refusals is that protected designations of origin or geographical indications do not constitute a “right” under Paragraph 4(a)(i). UDRP.

- **Regulatory Board of the Rioja Qualified Designation of Origin v. Domain Hostmaster**, WIPO Case No. D2018-0168
- **Consorzio Tutela Vini Emilia v. Leeuwerik**, WIPO Case No. D2017-1659
- **Comité Interprofessionnel du vin de Champagne v. Vickers**, WIPO Case No. DCO2011-0026,
- **Consejo Regulador del Cava v. Lucas**, WIPO Case No. D2008-1939
- **Consorzio per la Tutela dell’Asti v. Bennatto**, WIPO Case No. D2004-0350

In these instances, complainants were only deemed to have sufficient rights in GIs to initiate a UDRP claim when they also owned trademark rights in those designations.

Similarly, the language of the Uniform Rapid Suspension (URS) procedure confines the policy exclusively to trademarks and service marks. URS proceedings are initiated by filing a complaint that details the trademark rights and the alleged actions that justify relief for the trademark holder. The complaint must specifically outline the trademark/service marks upon which it is based.

Consequently, GI owners lack the procedural leverage that trademark owners possess under the UDRP to combat the bad faith registration and use of domain names that infringe upon their GIs.

This legal gap highlights the need for a tailored dispute resolution mechanism that addresses the unique properties and protection needs of GIs within the DNS.

b. Some ccTLD Dispute Resolution Policies Include GIs

Several ccTLDs recognize GI rights as a legal basis for complaints under their ADR systems. The WIPO Survey on the Existing State of Play of GIs, Country Names, and Other Geographical Terms in the Domain Name System provides a comprehensive overview of the various ccTLD policies as of 2018¹⁹.

¹⁹ See WIPO Survey at https://www.wipo.int/edocs/mdocs/sct/en/sct_39/sct_39_7.pdf

At an ICANN session²⁰ in September 2022, representatives from various ccTLDs discussed recent developments regarding the interplay between GIs and ccTLDs. WIPO's head of Internet Dispute Resolution highlighted that 13 out of 81 WIPO-administered ccTLDs offer ADR mechanisms that include provisions for GIs.

The project team reviewed several decisions under different ccTLD dispute resolution policies that could potentially impact GIs. In some jurisdictions, like the UK, the definition of rights within the ADR policy is broad enough to implicitly cover GIs. In others, like Belgium, Ireland, and Spain, GIs are explicitly mentioned within the dispute resolution policy.

In these ccTLDs, if complainants can demonstrate a GI right that the Panel/Expert deems acceptable under the relevant ccTLD ADR policy, the proceedings will typically follow the same course as they would for trademark rights. This means that if the complainant can also establish that the respondent has no legitimate rights or interests in the domain name, and that there is evidence of bad faith or abuse, the challenged domain name will generally be transferred. Examples include the *Fédération des Vins de Nantes v. Arthur G.*, Case No. FR-2017-01381 (muscadet.fr), *Comité Interprofessionnel du Vin de Champagne (CIVC) v. Richard Doyle*, Case No. DIE2007-0005 (champagne.ie), and *Comité Interprofessionnel du Vin de Champagne v. Steven Terence Jackson*, Case No. DRS 4479, on appeal (champagne.co.uk).

However, merely possessing a relevant GI right does not guarantee success; similarly to trademarks, the outcome depends on the respondent's legitimate rights and/or absence of bad faith or abusive intent. For instance, see *Consorzio Tutela Taleggio v. Gilberto Ramponi Rivelli*, Publinord s.r.l., Case No. DEU2020-0003 (taleggio.eu).

Therefore, while GI owners face challenges compared to trademark holders, especially in protecting their rights in gTLDs under the UDRP and URS where these systems do not apply to GIs, the inclusion of GIs in various ccTLD ADR policies shows that alternative dispute resolution mechanisms can effectively protect GIs in the DNS.

For a detailed examination of ccTLD policies and decisions pertinent to GIs, please **see Annex A for our full research.**

c. Judicial decisions and Litigation Results

In addition to examining ADR systems, the project team also explored judicial decisions related to GIs in the DNS. Many of these judicial opinions were provided by Clarivate/Darts IP, and we extend our gratitude for their support of this project.

GI owners can occasionally safeguard their rights within the DNS against bad faith domain name registrations by leveraging country-specific laws.

²⁰ See session details [at https://archive.icann.org/meetings/icann75/meetings/MKveKucGpemjYA9vJ.html](https://archive.icann.org/meetings/icann75/meetings/MKveKucGpemjYA9vJ.html)

For a comprehensive overview of all the judicial decisions we have analyzed, please refer [to Annex B](#) which summarizes findings from France, Spain, Italy, Portugal, and Germany.

While GI owners may have the option to use court systems in various countries to protect their rights in the DNS, pursuing litigation tends to be more costly and time-consuming compared to ADR mechanisms like the UDRP. These alternative mechanisms offer advantages such as bypassing jurisdictional debates and facilitating enforcement, as the transfer of the domain name can be executed without the cooperation of the registrant.

d. Overview of EU Regulations on Geographical Indications and the DNS

Protection of Craft and Industrial Products Geographical Indications in the European Union

As mentioned above, the EU has enacted Regulation 2023/2411, which specifically addresses GIs for Craft and Industrial Products (Non-Agri)²¹. This regulation, which officially entered into force on November 16, 2023, and will be applicable from December 1, 2025, aims to enhance the protection of GIs for craft and industrial products by extending its provisions to both offline and online environments, including domain names. Specifically, Article 40 of the Regulation ensures that EU GIs are protected against misuse, imitations, and unauthorized evocations, explicitly extending these protections to domain names. Furthermore, Recital 44 mandates that ccTLD registries within the EU that offer ADR procedures for domain disputes must also include GIs in these processes. These registries are empowered to revoke or transfer domain names in violation of GI protection, especially when registered in bad faith or without legitimate rights to the GI.

Additionally, Recital 45 and Article 72 of Regulation 2023/2411 propose the establishment of an information and alert system to monitor and combat the abusive use of craft and industrial GIs within the DNS, with a feasibility study due by June 2, 2026.

European Union Regulation on Geographical Indications for Wine, Spirit Drinks, and Agricultural Products

Regulation (EU) 2024/1143, adopted on March 26, 2024, consolidates the protection of wine, spirit drinks, and agricultural GIs under a unified system, effective from May 13, 2024²². This regulation emphasizes the extension of GI protections to all domain names accessible within the Union, as stated in Recital 33, irrespective of the registries' locations. It asserts that ADR systems of ccTLD registries across the Union must recognize GIs as a legitimate right, as highlighted in Recital 45. Recital 55 and Article 35.1 further strengthen enforcement measures by empowering national authorities to disable access to domain names that violate GI protections. Article 35.2 tasks the European Union Intellectual Property Office (EUIPO) with establishing a

²¹ See https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=OJ:L_202302411.

²² See <https://eur-lex.europa.eu/eli/reg/2024/1143/oj>

domain name information and alert system, enhancing the visibility and protection of GIs in the DNS.

Territoriality issues

The introduction of specific provisions for the protection of GIs within the DNS in the recent EU regulations addresses a critical need for consistency and clarity across the EU. Prior to these regulations, the landscape for GI protection in the DNS was marked by significant inconsistencies among member states. Some countries like Belgium, France, Ireland, Italy, Portugal, and Spain have explicitly incorporated GI protections into their ccTLD policies²³. Conversely, countries like Denmark and the UK have ccTLD policies that are either silent or ambiguous regarding GI protection²⁴ (however as mentioned above in the UK, the definition of rights within the ADR policy is broad enough to implicitly cover GIs). This disparity not only complicates the enforcement of GI rights but also poses challenges for producers seeking to protect their products against misuse and infringement online.

Degree of GI Protections

French, Italian, Portuguese, and Spanish courts and arbitral tribunals such as WIPO have ordered domain names to be transferred or cancelled on the basis of GIs alone.²⁵ This has included translations of GIs.²⁶ While adjudicators have often relied on ccTLD policies that specifically protect GIs against confusingly similar and bad-faith domain name registrations, such orders have also been made in adjudications governed by

²³ [Terms and conditions for .be domain name registrations](#), Art. 10(b)(1); AFNIC [Règlement des procédures alternatives de résolutions de litiges - SYRELI and PARL EXPERT](#), [AFNIC Practical user's guide to ADR](#) at 15; [IE Dispute Resolution Policy \(ieDRP\)](#); [Dispute resolution in the ccTLD.it - Regulations Version 2.1](#), Article 3.7 (2); [PT Domain Names Registration Rules 2021](#), Article 6.1; [Reglamento del procedimiento de resolución extrajudicial de conflictos para nombres de dominio bajo el código de país correspondiente a España \(".ES"\)](#); [.eu ADR Rules](#), para B(1)(b)(9).

²⁴ [Terms and conditions for .be domain name registrations](#), Art. 10(b)(1); AFNIC [Règlement des procédures alternatives de résolutions de litiges - SYRELI and PARL EXPERT](#), [AFNIC Practical user's guide to ADR](#) at 15; [IE Dispute Resolution Policy \(ieDRP\)](#); [Dispute resolution in the ccTLD.it - Regulations Version 2.1](#), Article 3.7 (2); [PT Domain Names Registration Rules 2021](#), Article 6.1; [Reglamento del procedimiento de resolución extrajudicial de conflictos para nombres de dominio bajo el código de país correspondiente a España \(".ES"\)](#); [.eu ADR Rules](#), para B(1)(b)(9).

²⁵ Decision by the Paris High Court on auchampagne.com dated 5 October 2007; Decision by the Paris high Court on chamalal.com and chamlal.net, dated 27 Jan 2009; Decision by the Paris High Court on champagne.ch, dated 9 April 2008; Decision by the Paris Court of Appeal on champagnes.be, dated 23 August 2006 and *Comité Interprofessionnel du Vin de Champagne v. Editions Lander*, Case No. DOM 44051; *Fédération des Vins de Nantes v. Arthur G.*, Case No. FR-2017-01381; Decision by the TFI of Paris on champ-pagne.com, dated 7 September 2001; Decision by the Paris High Court on leschampagne-s.com; Decision by the Paris Court of First Instance on piment-espelette.info; Decision by the Paris Court of First Instance on vin-de-champagne.com, dated 14 Dec 2005; Audiencia Provincial Civil de Madrid, 668/2020 (darts-398-283-N-es-2), 4 Feb 2022; Decision by the Provincial Court of Burgos on chuletondeavila.es and chuletondeavila.com.es, dated 28 March 2018; Tribunale Ordinario di Napoli, 6244/2013 (darts-559-832-K-it-2); Portuguese Court of Appeals, Lisbon, Supremo Tribunal De Justiça, 393/12.7YHLSB.L1.S1 (darts-894-711-H-pt-2); Portuguese Court of Appeals, Lisbon, Tribunal da Relação de Lisboa, 1/13.9 Y H LSB (darts-635-280-D-pt-4); *Comité Interprofessionnel du vin de Champagne v. Internet SARL*, Case No. DFR2005-0006; *Comité Interprofessionnel du Vin de Champagne (CIVC) v. Richard Doyle*, Case No. DIE2007-0005; *Consorzio Tutela Parmigiano Reggiano v. Famiglia Lusuardi Società Agricola S.S.*, Italian Disputes Resolution Center decision dated 25 March 2012; *Consorzio per la Tutela dell'Asti v. Augusto Tugnoli*, Italian Disputes Resolution Center decision dated 4 August 2003; *Consorzio per la Tutela dell'Asti v. Augusto Tugnoli*, Italian Disputes Resolution Center decision dated 7 November 2002;

²⁶ *Consorzio del Prosciutto di Parma v. Mario Staetter*, Case No. 44244;

policies that do not expressly refer to GIs.²⁷ At least one arbitrator, deciding a matter governed by the Indian Domain Name Dispute Resolution Policy, commented that GIs and trademarks may hold similar weight or importance.²⁸

In many cases, adjudicators in various jurisdictions have relied on GIs alongside other interests, such as trademarks, to order the transfer or deletion of domain names containing GIs.²⁹

Decisions by WIPO indicate that if not specifically asserted, GIs may not be considered, and that asserting a GI alongside other interests, such as trademarks, can also bolster a complainant's case.

Defenses to GI Infringement

The variation in policies also impacts the defences available against GI-based complaints. Jurisdictions vary significantly in how they handle defences based on good faith and legitimate interest.

For example, German courts have permitted the registration of domain names containing the GI "champagne," whereas the Paris Regional Court has rejected a defence based on a similar interest³⁰.

In one decision, WIPO permitted a registrant to rely on a legitimate interest in the region associated with the GI, even though the GI was also registered as a trademark. Conversely, the Paris Regional Court rejected a defence based on similar grounds. Additionally, an arbitration center in Portugal, operating under a ccTLD with robust GI protections, ruled that the geographic significance of the name "Colares" was not diminished by its generic, non-geographic meaning of "necklaces."³¹ It was held that this would be the case irrespective of the notoriety or prestige of the geographical name.

Good faith defenses provide another example. Some jurisdictions' ccTLD policies, such as those of Belgium and France, expressly provide that good faith domain name registrations operate as a defense to GI infringement or require complainants to demonstrate bad faith. Even where a jurisdiction's ccTLD policy does not address a registrant's intention, adjudicators such as WIPO have considered it. The threshold for bad faith or, at least, lack of good faith, appears to differ by jurisdiction. Belgian, French, and Italian arbitrations have held that respondents who registered domain names containing the GI "Prosciutto di Parma" or translations thereof, with a view to selling their domains, either did so in bad faith or could not rely on a good faith

²⁷ *Comité Interprofessionnel du vin de Champagne v. India Portals*, arbitration governed by the Indian Domain Name Dispute Resolution Policy (INDRP); *Comité Interprofessionnel du Vin de Champagne v. Steven Terence Jackson*, Case No. DRS 4479

²⁸ *Comité Interprofessionnel du vin de Champagne v. India Portals*, arbitration governed by the Indian Domain Name Dispute Resolution Policy (INDRP).

²⁹ *Consorzio del Prosciutto di Parma v. Madame D.*, Case No. FR-2018-01699

³⁰ Landgericht Hamburg, 312 O 426/06 (darts-093-177-A-de); Oberlandesgericht München, 29 U 5906/00 (darts-086-848-A-de)

³¹ *sociedade com domicilio na v. NIPC*, ARBITRARE decision dated 24 July 2012

defense.³² In contrast, a UK appeal panel upheld an arbitral decision that respondent who registered “parmaham.co.uk” and “parma-ham.co.uk” could rely on its legitimate belief that “Parma ham” was merely descriptive, even where the registration was made with a view to selling the domain name.³³

Ownership of GIs

Ownership issues further complicate the use of the existing UDRP procedure for GIs. Typically, a corporate body or association owns the registered right, which facilitates standing and the filing of a complaint. However, verifying such ownership can be challenging, especially in jurisdictions without a publicly accessible GI Register. If any system of protection against DNS abuse were to be offered to GIs, the plaintiff would have to submit an official title proving legal standing to the suit.

3. Applicability and Upcoming ICANN review of UDRP

As mentioned above the UDRP is currently mandatory only for gTLDs. While some ccTLDs have voluntarily adopted the UDRP, others like .uk operate under their own domain resolution policies (DRP), and some do not have any DRP mechanisms in place. As a result, not all TLDs would automatically fall under the scope of the UDRP if GIs were to be incorporated into its framework.

Planned Review of the UDRP

As referenced above, ICANN is scheduled to review the UDRP soon³⁴, with the Generic Names Supporting Organization (GNSO) Council having deferred the start date. This postponement is due to the ongoing work related to other rights protection mechanisms which has currently stretched the community and staff resources thin. There remains a possibility that the review could be further deferred if because the implementation of Phase 1 recommendations on Rights Protection Mechanisms (RPM) Review is also delayed.

During ICANN74 in The Hague, the Government Advisory Council (GAC) communicated that several of its governmental members expressed an interest in including the consideration of GIs during the UDRP review. This suggests a growing governmental interest in extending UDRP coverage to include protections for GIs.

GNSO's Role and Policy Development Process

The GNSO is the body responsible for managing policies that apply to gTLDs and would thus oversee any amendments to the UDRP. Policy development within the

³² *Consorzio del Prosciutto di Parma v. Mario Staetter*, Case No. 44244; *Consorzio del Prosciutto di Parma v. Madame D.*, Case No. FR-2018-01699; *Consorzio Prosciutto di Parma v. The Best Raffaello S.r.l.*, Italian Disputes Resolution Center decision dated 5 November 2001.

³³ *Consorzio del Prosciutto di Parma v. Vital Domains Limited*, Case No. DRS 00359

³⁴ As of the release of this Concept Paper, ICANN has not announced a definitive start date for UDRP Review which is covered under Phase II of ICANN's mandate for review of Rights Protection Mechanisms (RPMs). Phase I was completed more than 5 years ago.

GNSO follows a bottom-up, multistakeholder process that requires consensus among participants. This process involves representatives from a diverse range of perspectives, including various interests that may compete with one another. The success of reaching a consensus outcome is heavily dependent on the nature of these competing interests and the participants' willingness to compromise on certain issues to achieve desired outcomes on others.

WIPO and ICA REVIEW

WIPO and the Internet Commerce Association has issued their own joint review.³⁵ The results of the review do not specifically address the GI issue, nor does it allow for implementation of recommendations without ICANN oversight. It is hoped that this review will be treated as expert input during ICANN's formal review process.

III. Conclusion and Next Steps

This paper has explored the current landscape of GIs protection within the DNS and pinpointed limitations faced by GI owners, especially the inapplicability of the UDRP to GI disputes. This analysis emphasizes the critical differences between GIs and trademark. The recent legislative developments in the European Union and the forthcoming review of the UDRP by ICANN present a critical opportunity to address these challenges. INTA is well positioned to develop a clear and coherent position on GI protection in the DNS that aligns with both trademark and sui generis systems. By doing so, INTA can provide thought leadership in shaping a more robust system for protecting consumers from domain abuse.

³⁵ The report was released in April 2025 and is found at <https://www.wipo.int/export/sites/www/amc/en/docs/wipoicareportapril2025.pdf>

APPENDIX A

Protecting GIs from Bad Faith Use in the DNS

Table of Cases – ccTLD Arbitration Decisions

TLD	Domain name	Summary
.BE (Belgium)	GI protection referenced in ccTLD policy	<p><u>POLICY:</u></p> <p>Article 10b(1) of the Terms and conditions for .be domain name registrations ("the Policy") provides that: Within the scope of the alternative dispute resolution proceedings the third party ("complainant") has to assert and to prove, in compliance with the rules of procedure, that :</p> <p>i) the registrant's domain name is identical or confusingly similar to a trademark, a trade name, a registered name or a company name, <u>a geographical designation, a name of origin, a designation of source</u>, a personal name or name of a geographical entity in which the complainant has rights; and</p> <p>ii) the registrant has no rights or legitimate interests in the domain name; and</p> <p>iii) the registrant's domain name has been registered or is being used in bad faith.</p>
	champagnes.be	<p>Domain name transferred, case no. 44051 (decision retrieved from the Darts-IP database, reference: darts-091-889-A-fr).</p> <p style="text-align: center;">CEPANI DECISION Comité Interprofessionnel du Vin de Champagne v. Editions Lander Case No. DOM 44051</p> <p><u>SUMMARY/ANALYSIS</u></p> <p>The Complainant "Comité Interprofessionnel du Vin de Champagne" was an organization established under French law to defend the collective interests of all those involved in the production, distribution, processing and trading of the wines sold under the "Controlled Appellation of Origin" (CAO) "Champagne". In 2004, the Complainant filed a complaint with CEPANI against the Belgian company "Editions Lander" for the registration of the domain name <champagnes.be>.</p> <p>The Respondent "Editions Lander" registered the disputed domain name in December 2000. The domain name pointed to a website which was first designed for postcard publishing, then was modified to promote the Belgian village Champagne.</p> <p>The Complainant requested the transfer of the disputed domain name on the basis that it infringed the CAO "Champagne". The Respondent argued that the domain name was used in good faith to promote the Belgian village Champagne.</p>

		<p>The Panel found that the disputed domain name was confusingly similar to the CAO “Champagne” which was granted to a quality sparkling wine produced in a specific region of France and was protected in Belgium under the Regulation (EC) no. 1493/1999 of 17 May 1999. The Panel considered that the Respondent had no rights or legitimate interests in the disputed domain name as it was not mandated by the local authorities in charge of the Belgian village Champagne to promote it. The Panel found that the Respondent could not have been unaware of the existence of the CAO “Champagne” and that the disputed domain name was registered in bad faith.</p> <p><u>COMMENTS</u></p> <p>In this case, the transfer of the disputed domain name was ordered by the Panel thanks to the GI protection referenced in the Policy.</p>
	jambondeparme.be	<p>Domain name transferred, case no. 44244, decision unpublished (decision provided upon request by the Belgian Centre for Arbitration and Mediation https://www.cepani.be/be-domainname-what/#tab-6fc4b74639e56e5f9ef)</p> <p style="text-align: center;">CEPANI DECISION Consorzio del Prosciutto di Parma v. Mario Staetter Case No. 44244</p> <p><u>SUMMARY/ANALYSIS</u></p> <p>The Complainant “Consorzio del Prosciutto di Parma” was a company created in 1963 under the laws of Italy in order to protect and foster the reputation of Parma Ham on behalf of its 189 members. It asserted rights to the sign “Parma Ham” and to the protected designation of origin (PDO). It also owned two community trademark registrations for PARMA HAM and the domain name <prosciuttodiparma.com>.</p> <p>In September 2011, the Complainant filed a complaint with CEPANI against a person who had registered the domain name <jambondeparme.be> on 4 April 2011. The disputed domain name pointed to a parking page where it was offered for sale for 840 Euro.</p> <p>The Complainant requested the transfer of the disputed domain name on the basis that it was confusingly similar to its trademarks, that the Respondent was never authorized to use the sign “jambon de parme”, and that the Respondent’s primary purpose was to sell the domain name. The Respondent did not respond.</p> <p>Regarding the first element, the Panel found that the disputed domain name was not only an obvious translation of the Complainant’s PDO and trademark PARMA HAM but also an obvious translation of and a direct reference to the Complainant’s company name and website www.prosciuttodiparma.com, therefore it was confusingly similar to the signs in which the Complainant had rights. Under the second element, the Panel considered that the Complainant had established the absence of rights or legitimate interests on the part of the Respondent. Under the third element, the Panel was convinced that the Respondent’s primary intention in registering or using the disputed domain name was to monetize it by offering it for sale.</p>

		<p><u>COMMENTS</u></p> <p>In this case, the Panel ordered the transfer of the disputed domain name on the basis of a valid trademark as well as the GI.</p>
.DK (Denmark)	Reference in ccTLD policy is more generally to IPR	<p><u>POLICY: No express reference to GI</u></p> <p>The Complaints Board for Domain Names is an independent Complaints Board that can hear disputes between registrants and third parties concerning registration and use of domain names under the Danish .dk domain as well as complaints about decisions made by DIFO/Punktum dk (formerly DK Hostmaster) about compliance with the stipulated terms and conditions of business ("Terms and conditions for the right of use to a .dk domain name").</p> <ul style="list-style-type: none"> Paragraph 9.2 of Terms and conditions for the right of use to a .dk domain name makes reference to trademarks, but not to GIs, and provides that DK Hostmaster may suspend a domain name if the use creates a risk of confusion with "the Domain Name, name, logo, trademark, or other distinctive marks of another natural or legal person". Below are the applicable rules for the Complaints Board, which make no reference to trademarks nor GIs: <p>The 2014 Domain Names Act: Danish Act no. 164 of 26 February 2014 on Internet Domains (in Danish only) (S25 of the Act provides that "Registrants may not register and use domain names contrary to good domain name practice. Registrants may not register and maintain registrations of domain names solely for the purpose of resale or rental".)</p> <p>Regulations of the Complaints Board for Domain Names of 31 October 2018</p> <p>Rules of Procedure for the Complaints Board for Domain Names of 1 December 2017</p> <ul style="list-style-type: none"> General conditions for the assignment, registration and administration of domain names under the .dk top level domain (Version of 1 July 2006) makes reference to "a given designation" (unclear if this covers "designation of origin") in Section 12.2.2 which provides that: <p>If one of the applicants on the application form provides information to the effect that he or she has a special right (e.g. a right to a name or a trademark or a statutory exclusive right to use a given designation), DK Hostmaster will notify the other applicants for the domain name in question of this and of the identity of the person claiming this special right prior to the implementation of the procedure for several applicants given above.</p>
	champagne.dk	<p>No transfer, case no. 2018-0643 (https://www.domaeneklager.dk/sites/default/files/2019-03/2018-0643-R%20-%20champagne.dk_.pdf; darts-187-219-G-da-4)</p>

		<p>Complaints Board for Domain Names Biotinea GmbH v. Christian Trane Madsen J.nr.: 2018-0643</p> <p><u>SUMMARY/ANALYSIS</u></p> <p>The Plaintiff sought transfer of the domain <champagne.dk> from Mr Madsen on the basis that it had not been used since registration on 12th February 1997 and they claimed that it had been offered for sale. This was contrary to good domain practice as required by S25(1) of the Danish Domain Act. Biotinea wished to use the domain for an online store selling wines from Champagne.</p> <p>The Defendant maintained that he had a great interest in the Champagne region of France and was working on an encyclopedia about Champagne. He had not acted contrary to the Act and should retain the domain.</p> <p>The Board reasoned that when considering whether S25(1) had to be complied with it was necessary to carry out a balancing exercise between the interests of the parties to essentially consider whether the owner of the domain name had acted in good faith, both in registering the mark and subsequently. They concluded on doing this, that the Plaintiff's interests did not outweigh those of the Defendant and refused to transfer the domain.</p> <p><u>COMMENTS</u></p> <p>While Board observed that Champagne was well known in Denmark as a French wine producing region, the fact that it was a Geographical Indication was not a factor in reaching their decision. Indeed neither party argued that the fact that it was a Geographical Indication in Denmark was significant, and thus it had no bearing on the case.</p>
.ES (Spain)	GI protection referenced in ccTLD policy	<p><u>POLICY:</u></p> <p>Variation of UDRP:</p> <p>Reglamento del procedimiento de resolución extrajudicial de conflictos para nombres de dominio bajo el código de país correspondiente a España (".ES")</p> <p>Whereas the UDRP is limited to the protection of trademark rights, under the .ES Policy, a complainant must have "Initial Rights", which are defined under the .ES Policy as:</p> <ul style="list-style-type: none"> - Designations of entities validly registered in Spain, denominations or indications of origin, trade names, registered trademarks or other industrial property rights protected in Spain;

		<ul style="list-style-type: none"> - Civil names or “notorious” pseudonyms, which professionally identify, among others, intellectual creators, politicians and figures of entertainment or sport; - Official or generally recognizable names of public administrations and Spanish public bodies
	madeira.es	<p>No transfer, DES2010-0004 https://www.wipo.int/amc/en/domains/decisions/text/2010/des2010-0004.html)</p> <p>WIPO ADMINISTRATIVE PANEL DECISION</p> <p>Instituto do Vinho, do Bordado e do Artesanato da Madeira, IP (IVBAM) v. Ransol Systems, SL Case No. DES2010-0004</p> <p><u>SUMMARY/ANALYSIS</u></p> <p>The Claimant was the body responsible for the certification and control of Madeira wines and of the owner of the Community Trademark “Madeira”. It challenged the Respondent’s registration of <madeira.es> which it believed it intended to either sell to the Claimant or use it for their own benefit to the detriment of the Claimant.</p> <p>The Respondent did not answer the complaint beyond confirming their interest in the domain name.</p> <p>The Expert noted that the Claimant’s Community trademark pre-dated the registration of the domain name and that it was identical. The first of the requirements was met.</p> <p>However, the Expert ruled that the Claimant had failed to produce evidence to show bad faith on the part of the Respondent. There was no evidence that the Respondent had offered to sell the domain name at excessive cost. Beyond referring to its own website, the Claimant offered no evidence that their mark was well-known. Finally they offered no evidence as to how the domain name was being used to their detriment. It was used on a website relating to tourism on the island of Madeira and had no obvious connection with the goods sold under the Claimant’s mark.</p> <p>The claim was therefore dismissed.</p> <p><u>COMMENTS</u></p> <p>This case relates to a trademark rather than a Geographical Indication and so is not particularly relevant in this context. It does however show, like in many other cases of this type, that the Claimant’s failure to properly prepare their case and provide relevant evidence was their downfall.</p>
.EU (European Union)	GI protection referenced in ccTLD policy	<p><u>POLICY:</u></p> <p>Paragraph B(1)(b)(9) of the .eu ADR Rules (applicable as of 13 October 2022) provides that:</p>

		<p>The Complaint shall:</p> <p>(9) Specify the names in respect of which a right is recognised or established by the national law of a Member State and/or European Union law. For each such name, describe exactly the type of right(s) claimed, and specify the law(s), as well as the conditions under which the right is recognised and/or established (e.g. copyright, trademarks and geographical indications provided in national law or European Union law, and, insofar as they are protected under national law in the Member States where they are held: unregistered trademarks, trade names, business identifiers, company names, family names and distinctive titles of protected literary and artistic works)</p>
	taleggio.eu	<p>No transfer, DEU2020-0003 https://www.wipo.int/amc/en/domains/search/text.jsp?case=DEU2020-0003</p> <p>WIPO ADMINISTRATIVE PANEL DECISION</p> <p>Consorzio Tutela Taleggio v. Gilberto Ramponi Rivelli, Publinord s.r.l</p> <p>Caso No. DEU2020-0003</p> <p><u>SUMMARY/ANALYSIS</u></p> <p>The Complainant “Consorzio Tutela Taleggio” was established in Italy, dedicated to the protection, control and promotion of TALEGGIO cheese. It was the owner of the Protected Designation of Origin (PDO) TALEGGIO, recognized at Italian, EU and international level in 1988, 1996 and 2014 respectively. It also owned European and international trademarks for TALEGGIO (registered in 2011) and the domain names <taleggio.it>, <taleggio.com>, <taleggio.biz> and <taleggio.org>. The disputed domain name <taleggio.eu> was registered by the Respondent on 9 July 2007 and resolved to a website with information concerning Val Taleggio (the Taleggio Valley) as well as links to different kinds of web portals. The Complainant filed the complaint in Italian in 2020 and requested the transfer of the disputed domain name on the basis of its trademark and PDO TALEGGIO. The Respondent argued that the Complainant’s earlier rights, only limited to the domain name <taleggio.it> registered in 1997, were not sufficient to confer exclusive rights with regard to domain names having different extensions, and that the PDO was limited to prohibiting the production or sale of agricultural products covered by the PDO by a third party, both activities that the Respondent did not carry out.</p> <p>The Panel found that the Respondent’s website was dedicated mainly to the description of the geographical scope of the village called TALEGGIO and the homonymous valley, in the province of Bergamo, where by the Complainant’s own admission the famous cheese originated. The Panel considered that the Respondent had a legitimate interest in the disputed domain name by virtue of the descriptive use it was making in relation to the geographical location as well as the offer of services in good faith (which began before the Respondent became aware of the dispute). The Panel considered that the Respondent had registered and used the disputed domain name in good faith, within a service activity focused mainly on the creation of a portal dedicated to numerous Italian geographical locations, as well as other thematic portals related to different fields. The complaint was therefore dismissed.</p>

		<p><u>COMMENTS</u></p> <p>This case illustrates how a Panel dealt with a collision between the name of a geographical location and the corresponding PDO, also registered as a trademark. In summary, the Panel considered that the Respondent had a legitimate interest in the disputed domain name because the name, in addition to being a famous cheese, was also the name of an Italian place and the Respondent was making use of the domain name in the context of a bona fide offer of services, in a descriptive manner and not intended to target the Complainant's PDO and trademark, before having heard of the dispute, pursuant to Paragraph B(11)(e)(1) of the .eu ADR Rules.</p>
	zivania.eu	<p>Domain name transferred, CAC-ADREU-004419 (https://eu.adr.eu/decisions/detail?id=642a7b5efa098a1adc01b250)</p> <p style="text-align: center;">CZECH ARBITRATION COURT PANEL DECISION Wine Products Co v. Theodorus Onisiforou Case No. CAC-ADREU-004419</p> <p><u>SUMMARY/ANALYSIS</u></p> <p>Zivania is a GI for a grape marc spirit, produced in Cyprus. The Complainant had prior rights to the name "Zivania" as it was recognized as the owner of the trademark ZIVANIA. In addition, the Panel also found that it had rights from the provisions of Law No 61(I) / 2004 Cyprus in respect of the WINE PRODUCTS COUNCIL and the COUNCIL REGULATION (EEC) No. 1576/89 (Articles 1.4.f.3 AND 5 established exclusive rights for Member States producing spirits such as ZIVANIA in Cyprus). The Panel found that the Respondent had no rights or legitimate interests in the disputed domain name <zivania.eu>. The Panel considered that the Respondent, a Cypriot citizen, was likely to have knowledge of the Complainant's rights and had acted in bad faith. The domain name <zivania.eu> was therefore transferred to the Complainant.</p> <p><u>COMMENTS</u></p> <p>The transfer of the domain name was ordered not only on the basis of a valid trademark but also on the basis of the Complainant's wider rights.</p>
.FR (France)	GI protection referenced in ccTLD policy	<p><u>POLICY:</u></p> <p>Variation of UDRP: SYRELI and PARL EXPERT</p> <ul style="list-style-type: none"> • Pursuant to Articles L. 45-2 and L. 45-6 of the French Electronic Communications and Telecommunications Act ("CPCE"), a complainant must demonstrate that the disputed domain name: <ul style="list-style-type: none"> ○ is likely to disrupt public order or violate principles of morality, or infringe any rights protected by the French Constitution or by French law; or

		<ul style="list-style-type: none"> ○ is likely to infringe intellectual property rights or personality rights, unless the domain name holder has a legitimate interest in the disputed domain name and is acting in good faith; or ○ is identical or similar to the name of the French Republic, of a local authority or group of local authorities, of a local or national institution or public service, unless the domain name holder has a legitimate interest in the disputed domain name and is acting in good faith. <ul style="list-style-type: none"> ● Afnic Practical user's guide to ADR provides on Page 15 that: A complainant must demonstrate that it has standing (intérêt à agir) to file the complaint. The complainant has standing in particular if: <ul style="list-style-type: none"> ○ He holds an identical, almost identical or similar domain name(*) to that of the disputed domain name under another TLD ○ He holds an almost identical or similar domain name(*) to that of the disputed domain name under the same TLD ○ He holds a trademark(*), company name(*), family name or pseudonym, property title(*) (work, patent, drawing and model, etc.), an A.O.C./A.O.P. (controlled/protected designation of origin)(*) that is similar, identical or nearly identical to the disputed domain name ○ He can show proof of having been the holder of the domain name under dispute (registration invoice in his name, old extract from the Whois database, etc.) <p>* Irrespective of the date of creation or registration.</p>
	champagne-co.fr	<p>Domain name deleted, FR-2022-02678 (darts-150-398-N-fr; https://www.syreli.fr/decisions)</p> <p style="text-align: center;">AFNIC SYRELI PANEL DECISION Comité Interprofessionnel du vin de Champagne v. Monsieur S. Case No. FR-2018-01699</p> <p><u>SUMMARY/ANALYSIS</u></p> <p>The Complainant "Comité Interprofessionnel du Vin de Champagne" (CIVC) was the group of producers of the "Protected Designation of Origin" (PDO) called "Champagne". Its primary mission was to protect the PDO in France and abroad, and to defend the collective interests of all producers of "Champagne". It owned the domain name <champagne.fr> since 11 February 1999, as well as numerous other domain names under different extensions. In January 2022, the Complainant filed a complaint under AFNIC's SYRELI procedure against a person who had registered the domain name <champagne-co.fr> on 27 April 2020. The disputed domain name pointed to a site selling products comparable to "Champagne" and non-comparable products, such as spirits, glasses and accessories.</p>

		<p>The Complainant claimed that the disputed domain name infringed the PDO “Champagne” and its prior rights over the domain name <champagne.fr>. The Complainant requested the deletion of the disputed domain name. The Respondent did not respond.</p> <p>The Panel found that the disputed domain name was similar to the PDO “Champagne” and was operated by the Respondent through a company whose activity had no link to the wine-growing and winemaking environment covered by the PDO “Champagne”. Based on the evidence provided by the Complainant, the Panel considered that the registration of the disputed domain name, consisting of the PDO “Champagne” defended by the Complainant and used by the Respondent to offer for sale products covered by the PDO, was an unlawful misappropriation and weakening of the reputation of the PDO “Champagne”. The Panel considered that the Respondent could not have been unaware of the existence of the PDO and that the disputed domain name was likely to infringe the PDO, which was protected as a distinctive sign under French Intellectual Property Code and French Consumer Code.</p> <p><u>COMMENTS</u></p> <p>In this case, the Panel ordered the deletion of the disputed domain name on the basis of a prior domain name as well as the GI. The Panel referred to French case law and considered that a PDO as a distinctive sign could benefit from protection against infringements as long as the Complainant justified that: (i) it had rights to defend and manage the PDO; (ii) similarity between signs; and (iii) private use by the domain name holder depriving the rightful owner of the PDO of any legitimate use and/or use likely to misappropriate or weaken the reputation of the PDO.</p>
	prosciuttodiparma.fr	<p>Domain name transferred, FR-2018-01699 (darts-938-553-F-fr; https://www.syreli.fr/decisions)</p> <p>https://www.arepoquality.eu/wp-content/uploads/2023/03/protection-of-gis-on-the-internet_arepo-practical-guide_en-1.pdf PAGE 91</p> <p>https://syreli.fr/decisions/telecharger/25273</p> <p style="text-align: center;">AFNIC SYRELI PANEL DECISION Consortio del Prosciutto di Parma v. Madame D. Case No. FR-2018-01699</p> <p><u>SUMMARY/ANALYSIS</u></p> <p>The Complainant “Consortio del Prosciutto di Parma” was the official organization responsible for the protection, enhancement and promotion of the “Protected Designation of Origin” (PDO) called “Prosciutto di Parma”. It owned the European trademark “PROSCIUTTO DI PARMA” No. 001116458 (registered in 2000) and the domain names <prosciuttodiparma.com> (registered in 2004) and <prosciuttodiparma.it> (registered in 1998). In 2018, the Complainant filed a complaint via the SYRELI procedure of AFNIC against a person who had anonymously registered the domain name <prosciuttodiparma.fr> on 24 June 2018. The disputed domain name redirected to a parking page which contained hyperlinks referring to the Complainant’s business, such as “Italiano prosciutto”, “prosciutto ham”, “food prosciutto”, etc.</p>

		<p>The Complainant requested the transfer of the domain name on the basis that the domain name constituted an infringement of the PDO “Prosciutto di Parma” and created confusion among consumers as to the origin of the product. The Respondent did not respond.</p> <p>The Panel found that the disputed domain name was identical to the PDO “Prosciutto di Parma” defended by the Complainant as well as its earlier European trademark “PROSCIUTTO DI PARMA”, therefore it was likely to infringe the Complainant’s intellectual property rights. The Respondent lacked legitimate interests since it had never obtained any authorization from the Complainant to use its trademark, nor to explore the domain name under .fr extension. The Panel considered that the Registrant had registered the domain name in bad faith in order to take advantage of the reputation of the Complainant’s IP rights by creating a risk of confusion among consumers.</p> <p><u>COMMENTS</u> In this case, the transfer of the disputed domain name was recognized on the basis of a valid trademark as well as the eponymous GI.</p>
	muscadet.fr	<p>Domain name transferred, FR-2017-01381 (darts-285-620-E-fr; https://www.syreli.fr/decisions)</p> <p style="text-align: center;">AFNIC SYRELI PANEL DECISION Fédération des Vins de Nantes v. Arthur G. Case No. FR-2017-01381</p> <p><u>SUMMARY/ANALYSIS</u></p> <p>The Complainant “Fédération des Vins de Nantes” was an organization established under French law to defend the collective interests of all those involved in the production and marketing of the wines sold under the “Controlled Appellation of Origin” (CAO) called “Muscadet”. In 2017, the Complainant filed a complaint via AFNIC’s SYRELI procedure against the company “Arthur G.” for the registration of the domain name <muscadet.fr>.</p> <p>The Respondent “Arthur G.” operated in the fields of real estate, finance, consulting and investments and had registered the disputed domain name on 16 June 2006. The domain name redirected to a parking page. In response to the Complainant’s initial offer to buy the domain name for 500 euros, the Respondent proposed a price “between 5,000 and 6,000 euros”.</p> <p>The Complainant requested the transfer of the disputed domain name on the basis that the Respondent had registered the domain name in bad faith mainly with a view to selling it to the Complainant and had no legitimate right to hold the domain name. The Respondent did not respond.</p> <p>The Panel found that the disputed domain name was identical to the CAO “Muscadet” defended by the Complainant, therefore it was likely to infringe the Complainant’s intellectual property rights. The Respondent’s activity had no link to the wine-growing and winemaking environment covered by the CAO</p>

		<p>“Muscadet”. There was no evidence that the Respondent operated a website dedicated to the marketing of the “Muscadet” wines. The Respondent acknowledged the reputation and value of the CAO “Muscadet” by offering to sell the domain name to the Complainant at a price “equivalent to one year’s referencing”. The Panel considered that the Respondent could not have been unaware of the existence of the CAO and that the disputed domain name was likely to infringe the CAO.</p> <p><u>COMMENTS</u> In this case, the transfer of the disputed domain name was recognized on the sole basis of the eponymous GI.</p>
	champagnes.fr	<p>Domain name transferred, DFR 2005-0006 (darts-073-023-A-fr; https://www.wipo.int/amc/en/domains/decisions/html/2005/dfr2005-0006.html)</p> <p>https://www.arepoquality.eu/wp-content/uploads/2023/03/protection-of-gis-on-the-internet_arepo-practical-guide_en-1.pdf PAGE 93</p> <p style="text-align: center;">WIPO PARL PANEL DECISION Comité Interprofessionnel du vin de Champagne v. Internet SARL Case No. DFR2005-0006</p> <p><u>SUMMARY/ANALYSIS</u></p> <p>The Complainant “Comité Interprofessionnel du Vin de Champagne” (CIVC) was the group of producers of the “Protected Designation of Origin” (PDO) called “Champagne”. It had the particular mission of ensuring the protection of the collective interests of all the professionals involved in the production, development and marketing of Champagne wines covered by the famous DPO “Champagne”. In 2005, the Complainant filed a complaint against the company “Internet SARL” concerning the domain name <champagnes.fr>.</p> <p>The company “Internet SARL” stated that it operated in the field of design and publication of websites and registered the disputed domain name in December 2004 with the intention of creating a platform dedicated to the marketing of Champagne wines. However, the domain name was not in use.</p> <p>The Complainant requested the transfer of the domain name on the basis that the domain name constituted an infringement of the PDO “Champagne” and carried the risk of weakening the notoriety of the PDO.</p> <p>The Panel found that, given the collective character of the PDO, in order to guarantee the geographical provenance and quality linked to it, a PDO was for the benefit of all producers or merchants entitled to it. In this case, the PDO “Champagne” was for the benefit of all professionals involved in the production and marketing of Champagne wines. However, the Respondent’s activity was design and publication of websites, which had no link to the production or trading of Champagne, so it had no legitimate interest in using the “Champagne” PDO. The evidence provided by the Respondent was considered insufficient</p>

		<p>to prove its serious intention to use the domain name to promote all Champagne wines collectively as it only referred to one brand of champagne. Therefore, the Panel considered that the Respondent's registration and use of the disputed domain name harmed the collective interests of Champagne wine professionals.</p> <p><u>COMMENTS</u></p> <p>In this case, the WIPO Panel ruled in favor of the Complainant and ordered the transfer of the domain name, due to the infringement of the GI on the basis of French law applicable to the ".fr" domain. The Panel underlined that its decision was rendered in light of the collective character of the "Champagne" PDO which was not a matter of settling a dispute involving a private right, but a collective name.</p>
	darjeeling.fr, darjeeling.tm.fr	<p>No transfer, DFR2006-0003 https://www.wipo.int/amc/en/domains/decisions/html/2006/dfr2006-0003.html)</p> <p style="text-align: center;">WIPO PARL PANEL DECISION Tea Board, India v. Delta Lingerie Case No. DFR2006-0003</p> <p><u>SUMMARY/ANALYSIS</u></p> <p>The Complainant was an Indian public entity whose main activity was to promote tea produced in the region of Darjeeling, India. It owned an international trademark for the Darjeeling logo and a Community trademark for DARJEELING registered on 9 September 1988 and 31 March 2006 respectively, both in Class 30 for tea products. In 2006, the Complainant filed a complaint against the French company Delta Lingerie concerning the domain names <darjeeling.fr> and <darjeeling.tm.fr>, registered on 11 June 1997 and 3 July 2001 respectively.</p> <p>The Respondent was involved in the manufacturing and marketing of women's lingerie, corsetry and underwear. It used the brand name Darjeeling. It owned several French and Community trademarks for DARJEELING in Class 25 for clothing products, the earliest registered in 1994. The Complainant had filed various oppositions to the Respondent's trademark applications, but all of these oppositions had been rejected by the competent authorities on the grounds that the goods sold by both parties were not identical or similar so as to cause confusion in the mind of the consumers. The domain name <darjeeling.fr> pointed to a website selling women's lingerie but the domain name <darjeeling.tm.fr> was not in actual use.</p> <p>The Complainant requested the transfer of the disputed domain names on the basis that the domain names constituted an infringement of its IP rights and carried the risk of diluting the reputation and notoriety of its DARJEELING marks and logo.</p> <p>The WIPO Panel found that the disputed domain names <darjeeling.fr> and <darjeeling.tm.fr> were the exact reproduction of the Complainant's international and Community trademarks in DARJEELING protected in France for tea products in Class 30, but they were also the exact reproduction of the</p>

		<p>Respondent's commercial sign and its DARJEELING trademarks in Class 25 for clothing products. However, when it came to domain name registration, AFNIC applied the "first come, first served" rule. At the time when the Respondent registered the disputed domain names, the Complainant was not eligible to register a domain name in ".tm.fr" or ".fr" as it was not the owner of a French trademark or a company name or a trade name corresponding to the disputed domain names. The Panel also noted that the products sold on the website under the domain name <darjeeling.fr> were distinct and unrelated to the products sold by the Complainant, there was therefore no risk of confusion in the mind of the public. The Panel considered that the Respondent had registered and used the disputed domain names in good faith and did not infringe the Complainant's rights.</p> <p><u>COMMENTS</u> This case did not concern GIs. The transfer of the disputed domain names was rejected based on the valid trademarks owned by the Respondent who was first to register the disputed domain names.</p>
.IE (Ireland)	GI protection referenced in ccTLD policy	<p><u>POLICY:</u></p> <p>Variation of UDRP: .IE Dispute Resolution Policy (ieDRP)</p> <p>While the UDRP is limited to trademark rights, the ieDRP covers "Protected Identifiers", which are defined as trade and service marks, personal names (pseudonyms) in which the complainant has acquired a reputation in Ireland, and geographical indications.</p> <p>Whereas in the UDRP the jurisdiction(s) where the trademark is valid is not considered relevant to Panel assessment under the first element, under the ieDRP the complainant needs to prove that the disputed domain name is identical or confusingly similar to a Protected Identifier, protected in Ireland.</p> <p>Paragraph 1.3.3 of the ieDRP Policy defines "geographical indications" as: <u>Geographical indications</u> are, for the purposes of this Policy, indications which identify a good as originating in a territory or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin. A Complainant is deemed to have rights in a geographical indication for the purposes of the Policy, if it has standing to bring an action based on the alleged infringement of the geographical indication before the courts of Ireland.</p>
	champagne.ie	<p>Domain name transferred, DIE2007-0005 (darts-362-832-A-en-2; https://www.wipo.int/amc/en/domains/decisions/html/2007/die2007-0005.html)</p> <p>WIPO ADMINISTRATIVE PANEL DECISION</p> <p>Comité Interprofessionel du Vin de Champagne (CIVC) v. Richard Doyle</p>

		<p>Case No. DIE2007-0005</p> <p><u>SUMMARY/ANALYSIS</u></p> <p>1. The Panel noted that, as the Complainant had made out a prima facie case that the word “champagne” was protectable under the Irish law of passing off, the Complainant had succeeded in establishing that the designation of origin CHAMPAGNE was a Protected Identifier for the purposes of the ieDRP.</p> <p>2. The Respondent offered competing wines for sale and the Panel found that such use was fatal to the Respondent’s claim to have a legitimate interest in the domain name.</p> <p>3. Even if the Respondent registered the domain name in good faith, the Panel found that he subsequently used the domain name primarily for the purposes of selling or transferring the registration to the Complainant, given the offer for sale.</p> <p>The Panel therefore ordered that the domain name <champagne.ie> be transferred to the Complainant.</p> <p><u>COMMENTS</u></p> <p>In this case, the transfer of the disputed domain name was recognized on the sole basis of the eponymous GI.</p>
.IN (India)	Reference in ccTLD policy is more generally to IPR	<p><u>POLICY: No express reference to GI</u></p> <p><u>.IN Domain Name Dispute Resolution Policy</u>, Article 4 provides that:</p> <p>Any Person who considers that a registered domain name conflicts with his/her legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:</p> <p>(a) the Registrant's domain name is identical and/or confusingly similar to a Name, Trademark or Service Mark etc. in which the Complainant has rights; and</p> <p>(b) the Registrant has no rights or legitimate interests in respect of the domain name; and</p> <p>(c) the Registrant's domain name has been registered or is being used either in bad faith or for illegal/unlawful purpose.</p>
	champagne.in	<p>Domain name transferred (https://www.registry.in/s3-assets/Champagnein.pdf)</p> <p>INDRP DECISION Comité Interprofessionnel du vin de Champagne v. India Portals Decision of 8 May 2012</p> <p><u>SUMMARY/ANALYSIS</u></p>

		<p>The Complainant “Comité Interprofessionnel du Vin de Champagne” (CIVC) was a public service body created in France with the main objective to manage, promote and protect the interests of persons involved in the production of wines sold under the geographical indication “CHAMPAGNE” with powers to sue and be sued. It had the responsibility to manage and defend the rights in the geographical indication “CHAMPAGNE” in France and overseas. It owned geographical indications registered in various countries including India, containing the word “champagne”.</p> <p>In March 2012, CIVC filed a complaint against India Portals who had registered the domain name <champagne.in> in February 2005. The domain name only resolved to an error page.</p> <p>The Complainant claimed that the disputed domain name infringed its registered GI in “Champagne”. The Complainant requested the transfer of the disputed domain name. The Respondent did not respond.</p> <p>The Panel noted that the INDRP only made explicit reference to registered trademarks or service marks, and did not include geographical indications. Strictly speaking, the Complainant did not have a registered trademark or service mark, but owned the geographical indication “CHAMPAGNE” registered in various countries including India. However the Panel thought that, looking beyond the literal meaning or interpretation of the Policy, and based on the legislative intent, similar importance could be assigned to geographical indications. The Panel therefore found that the Complainant had established rights and interests in the word “Champagne”.</p> <p>The Panel found that the disputed domain name was similar to the GI “Champagne” in which the Complainant had established rights.</p> <p>The Panel found that the Respondent had not established that it was the holder of any registered trademark or service mark and therefore had no rights or legitimate interests in respect of disputed domain name.</p> <p>The Panel also found that the Respondent had registered the domain name in bad faith by registering various domain names without having any legitimate interest or right and without any intention of using them. The disputed domain name had not been used after its registration, which indicated that the Respondent was neither serious in using it nor it had any definite plan for using it.</p> <p>The Panel therefore ordered the disputed domain name to be transferred to the Complainant.</p> <p><u>COMMENTS</u> In this case, the Panel ordered the transfer of the disputed domain name on the basis of the registered GI “CHAMPAGNE”. Looking beyond the literal meaning or interpretation of the INDRP policy, the Panel considered that similar weightage or importance could be assigned to GIs as was attached to trademarks.</p>
.IT (Italy)	GI protection referenced in ccTLD policy	<p><u>POLICY:</u></p> <p>Arbitration and Variation of UDRP:</p>

		<p>Dispute resolution in the ccTLD.it - Regulations Version 2.1, Article 3.7 (2) provides that:</p> <p>The following circumstances, if demonstrated, will be considered proof of registration and use of the domain in mala fide:</p> <p>2) the circumstance that the domain name has been registered by the defendant to prevent the owner of the right to a name, trademark, <u>denomination (also geographic) or other distinctive sign recognized by national or European law</u> from using same name, denomination or other distinctive sign in a domain name corresponding to said and it is used for activities in competition with those of the petitioner or, for public organizations, judiciary or other state bodies, in such a way as to mislead the public searching for information regarding institutional activities;</p>
	parmigianoreggiano.it	<p>Domain name transferred, Decision of 25 May 2012, 307 (https://www.crdd.it/decisioni/parmigianoreggiano.htm)</p> <p>Italian Disputes Resolution Center Consorzio Tutela Parmigiano Reggiano v. Famiglia Lusuardi Società Agricola S.S.</p> <p><u>SUMMARY/ANALYSIS</u></p> <p>1. The judgement recognized that the applicant (the Parmigiano - Reggiano Cheese Consortium) had demonstrated that it was the holder of the sign 'Parmigiano Reggiano', being the owner of a "Protected Designation of Origin" (PDO).</p> <p>2. The home page at the domain name "parmigianoreggiano.it" contained the image of the well-known cheese and the indication "producers of milk destined exclusively for the production of Parmigiano – Reggiano since 1901".</p> <p>The presence of this indication could lead to the conclusion that there was no intention to divert customers, as any visitor of the domain name should be able to understand that the domain name led to the website of a company supplying milk used in the production of "Parmigiano Reggiano", without any confusion.</p> <p>However, there were still elements that made it possible to ascertain the Respondent's bad faith. First of all, the domain name corresponded to the famous distinctive sign and registered PDO, so it seemed logical that it could only have been registered to exploit the notoriety of the expression "Parmigiano Reggiano", which had long been protected according to EU GI rules. Furthermore, the indication on the home page of the domain name "parmigianoreggiano.it" appeared to have been inserted only recently, as verified personally by the appointed Expert.</p> <p>In the light of these observations, the Expert reassigned the domain name <parmigianoreggiano.it> to the Consorzio del Formaggio Parmigiano – Reggiano.</p>

		<p><u>COMMENTS</u></p> <p>1. Reference was also made to the judgment of the Court of Justice in Case C-132/05 of 16 February 2008 which recognized that the expression PARMIGIANO REGGIANO was undeniably well-known. The applicant Consortium was the body to which the competent authorities had assigned the functions of protection, promotion and enhancement of the interests relating to the 'Parmigiano Reggiano' PDO.</p> <p>2. The judgement makes general reference to "distinctive signs" in order to recognize the Complainant's ownership. Italy, like France, appears to favour an extension of the legal protection of geographical indications to domain names.</p>
	ilprosciuttodiparma.it, prosciuttodiparmadop.it	<p>Domain names transferred, Decision of 5 November 2001, 63 and 64 (https://www.crdd.it/decisioni/ilprosciuttodiparma.htm)</p> <p>Italian Disputes Resolution Center Consorzio Prosciutto di Parma v. The Best Raffaello S.r.l..</p> <p><u>SUMMARY/ANALYSIS:</u></p> <p>The Respondent was involved in the selection, promotion and recommendation of Italian food and wine products sold on its website. It had registered over 800 domain names, including generic denominations of food products and protected denominations and trademarks, including the two domains at issues: <ilprosciuttodiparma.it> and <prosciuttodiparmadop.it>. In response to an offer from the Parma Ham Consortium to buy the two domain names, the Respondent offered to sell them for 25 million Italian lira.</p> <p>The Expert found bad faith and ordered the transfer of the domain names on the basis that:</p> <ul style="list-style-type: none"> (i) there was confusion between the signs; (ii) the Respondent had registered at least 800 other domain names consisting of generic product names or protected registrations, showing that it registered this name in the knowledge that it was harming the rights of others; (iii) "prosciutto di parma" had achieved a certain notoriety through the Complainant's advertising. Both as a company name and as a collective brand, "Prosciutto di parma" had a particularly distinctive value and had acquired renown among the consumer public. <p><u>COMMENTS</u></p> <p>The transfer decision was based on a distinctive sign as opposed to a trademark.</p>
	spumanteasti.it	<p>Domain name transferred, Decision of 4 August 2003, 145 (https://www.crdd.it/decisioni/spumanteasti.htm)</p> <p>Italian Disputes Resolution Center</p>

Consorzio per la Tutela dell'Asti
v.
Augusto Tugnoli

SUMMARY/ANALYSIS:

The Complainant owned the Italian collective trademarks CONSORZIO PER LA TUTELA DELL'ASTI and CONSORZIO DELL'ASTI both covering class 33 and in particular "wines, sparkling wines". The Complainant had the task of protecting and guaranteeing the quality and origin of wines bearing the controlled and guaranteed designation of origin ASTI and MOSCATO D'ASTI.

The disputed domain name <spumanteasti.it> had been assigned to Mr. Augusto Tugnoli since 17 February 2000. The website at the domain name corresponded to a single page of a site under construction with links relating to different sectors.

The Expert reviewed the matter and found that:

- (1) The disputed domain name <spumanteasti.it> was identical to the name of one of the products with a controlled and guaranteed designation of origin, and which the Complainant had the task of protecting and guaranteeing. It was also similar to the collective brands owned by the Complainant.

The Complainant had a right to the name "spumante asti". Asti Spumate wine was one of the products to which the controlled and guaranteed designation of origin had been attributed. Therefore the word "Spumate" (translated as "sparkling wine") combined with the designation of origin "Asti" identified a product whose name constituted a distinctive sign of that product and not a generic term. As such, it was protected not only against any commercial use of a denomination for products that did not have the characteristics of the relevant production specifications, but also against any illicit use of the denomination of origin if the use of this denomination allowed the reputation of the protected name to be unduly exploited.

The disputed domain name could be confused with the distinctive sign of one of the products protected by the Complainant, as the domain name "spumanteasti" may cause confusion and result in users believing that the domain name referred to one of the wines with a controlled and guaranteed designation of origin protected by the Complainant.

- (2) The Respondent had no right or title in relation to the disputed domain name. The domain name was not used by the Respondent as there had been a single page announcing a site under construction for over three years.

		<p>(3) The disputed domain name was registered in bad faith given that, for example:</p> <ul style="list-style-type: none"> a. the Respondent, at the time of registering the domain, could not have been unaware of the existence of the Complainant and the object of its protection consisting of an Italian wine known throughout the world; b. the domain name was not used by the Respondent; c. all domain names registered by the Respondent appeared to resolve to the same identical "courtesy page", and it was not clear what hobby/recreational use the Respondent intended to make of the domain name, and why he had to register so many names to which he clearly had no title; d. the Respondent had registered other domain names in the .IT namespace corresponding to well-known brands. <p>In light of the above, the Expert ordered the transfer of the disputed domain name.</p> <p><u>COMMENTS</u></p> <p>1. The decision refers to "controlled and guaranteed designation of origin" and "collective trademark" or "collective brand" in order to recognize the Complainant's ownership. It shows a recognition of the legal protection of geographical indications in the context of domain names.</p> <p>2. Reference is also made to the decision of 7 November 2002 regarding the <astispumante.it> domain dispute between the same parties which recognized the well-known nature of the designation of origin "Asti" (see below).</p>
	astispumante.it	<p>Domain name transferred, Decision of 7 November 2002, 116 (darts-095-108-A-it-2; https://www.crdd.it/decisioni/astispumante.htm)</p> <p style="text-align: center;">Italian Disputes Resolution Center Consorzio per la Tutela dell'Asti v. Augusto Tugnoli</p> <p><u>SUMMARY/ANALYSIS:</u></p> <p>The disputed domain name <astispumante.it> had been assigned to Mr. Augusto Tugnoli since 17 February 2000. The website at the domain name corresponded to a single page of a site under construction with links relating to different sectors. The decision was very similar to the decision for <spumanteasti.it> examined above.</p> <p><u>COMMENTS</u></p>

		<p>The decision makes reference to “controlled and guaranteed designation of origin” and “collective trademark” in order to recognize the Complainant’s ownership. It shows a recognition of the legal protection of geographical indications in the context of domain names.</p>
.PT (Portugal)	GI protection referenced in ccTLD policy	<p><u>POLICY:</u></p> <p>ARBITRARE Arbitration Rules</p> <p>.PT Domain Names Registration Rules 2021, Article 6.1 provides that :</p> <p>Registration of a domain name is not admissible when it:</p> <ul style="list-style-type: none"> a) Corresponds to an already registered name within the same hierarchy; b) Manifestly corresponds to obscene language or words or expressions contrary to the law; c) Corresponds to <u>a protected Portuguese or European designation of origin or to a geographical indication</u> under the applicable law; d) Corresponds to a geographical name in accordance with and for the purposes provided for in article 7.
	colares.pt	<p>ARBITRARE, Judgment of 24 July 2012 (decision no.129), Portugal (https://www.arbitrare.pt/media/3413/decisions_37_download.pdf)</p> <p>https://www.arepoquality.eu/wp-content/uploads/2023/03/protection-of-gis-on-the-internet_arepo-practical-guide_en-1.pdf Page 93</p> <p style="text-align: center;">ARBITRARE sociedade com domicilio na v. NIPC</p> <p><u>SUMMARY/ANALYSIS:</u></p> <p>This case relates to provisions in the .PT registration rules which prohibit direct registration in .PT for names which have geographic scope. It appears that stricter rules apply in .PT than would apply in .COM.PT. The conclusion of the Arbitration panel was that where there is such geographic scope, this cannot be outweighed by the fact that the word may have other, non-geographic meanings. While the case was about a geographic name rather than a GI, there may be situations where a GI would fall within the scope of the relevant registration rule.</p> <p>The case was a challenge by the domain name registrant to a decision by the .PT registry to cancel the domain name registration. The registry assessment had been that the domain name had geographic scope under Article 9 (1)(f) Registration Rules, and thus could not be registered by the registrant</p>

		<p>(registration being limited to the competent administrative authority only). Colares is a town in the municipality of Sintra, Portugal.</p> <p>The registrant argued that the relevant article only related to names with a direct, immediate and unequivocal geographic nature, not being confused with names with a more common meaning and more common use, as was the case here since “colares” also means “necklaces”. The registry countered that the fact that there were other meanings did not eliminate the geographic character of the name.</p> <p>The arbitrator considered that restriction on registration of geographic names resulted from the need to combine domain names with industrial property rights, namely registered designations of origin or geographical indications, and align with WIPO best practice: the Second WIPO Internet Domain Name Process developed in 2001.</p> <p>The domain registration rules do not define a geographic name, and the panel had to consider whether any name would be covered, regardless of location in Portugal or abroad, and of its relevance in terms of public knowledge. Their conclusion was that:</p> <ul style="list-style-type: none"> • Geographic names covered by the restriction are, at least, those for which there is a competent administrative authority; • There should be no distinction of treatment between names which are only geographic and those which are also common words, as this would lead to discrimination for the latter; • Notoriety or prestige of the geographical name is not relevant; • Intention not to use to reference the geographic name did not outweigh the restriction that the name may only be registered by the competent authority. <p><u>COMMENTS</u> This case relates to a geographical name rather than a geographical indication, but there may be situations where a geographical indication would fall within the scope of the relevant rules.</p>
.UK (United Kingdom)	Reference in ccTLD policy is more generally to IPR	<p><u>POLICY: No express reference to GI</u></p> <p>Nominet UK's DRS Policy</p> <p>The DRS Policy requires Complainants to prove that they have “rights in respect of a name or mark which is identical or similar to the domain name”. Rights are defined as rights enforceable by the Complainant, whether under English law or otherwise.</p>
	champagne.co.uk	<p>Appeal: Overturned - Transfer (Case No. D00004479) https://secure.nominet.org.uk/drs/search-disputes.html (perform search by typing the Domain Name, then download the decision)</p> <p>Nominet UK Appeal Panel decision Comité Interprofessionnel du Vin de Champagne v. Steven Terence Jackson Case No. DRS 4479</p>

SUMMARY/ANALYSIS

The Complainant appealed the first instance decision dated 15 May 2007 rendered by an Expert who found that the Complainant had Rights in a name or mark that was identical or similar to the Domain Name; but that the Domain Name was not an Abusive Registration in the hands of the Respondent; accordingly the Complaint was dismissed. The three-member Appeal Panel overturned the decision of the original Expert and ordered the transfer of the Domain Name.

The Complainant claimed that it had exclusive rights to control the use of the name “champagne”, to protect and defend “champagne” as a controlled appellation of origin (CAO), which was used exclusively to refer to sparkling wines produced in the Champagne region of France, and that the Respondent was pre-empting those rights. The Complaint relied on its common law rights under the law of passing off in the name “champagne”.

The Appeal Panel recognized the Complaint’s Rights in the CHAMPAGNE name and considered that the Complainant, as a trade body to promote and defend those involved in the production and sale of champagne, as the representative of the champagne producers, merchants and bodies concerned with the regulation of the Champagne CAO and as custodian of the CHAMPAGNE name, had sufficient interest to bring the Complaint.

Regarding the elements of “Abusive Registration”, the Appeal Panel’s consensus view was that where a registrant registered or used a domain name so as to take advantage of “initial interest confusion”, which caused a user to visit a website expecting it to have some connection with a well-known name comprised in or constituting the Domain Name, he took unfair advantage of the Rights in the name.

The Appeal Panel considered that at least for the period when the Domain Name resolved to web pages comprising a number of commercial links to other websites, including the Respondent’s website selling car number plates, the Domain Name was used by the Respondent in a manner which took unfair advantage of the Complainant’s Rights.

The Appeal Panel believed that the Respondent was well aware that the term CHAMPAGNE was not just a name for any wine that had certain characteristics as far as method of manufacture and/or taste were concerned. He would also have known that the term referred exclusively to a limited set of producers of such wine in the Champagne region of France.

The Appeal Panel found that the Domain Name had been used by the Respondent in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights in the name CHAMPAGNE and that the Domain Name, in the hands of the Respondent, was therefore an Abusive Registration.

COMMENTS

The decision makes reference to the French concept “appellation d’origine contrôlée - AOC” in order to recognize the Complainant’s Rights in the CHAMPAGNE name.

	<p>parmaham.co.uk, parma-ham.co.uk</p>	<p>Appeal: Upheld - No Transfer (Case No. D00000359) https://secure.nominet.org.uk/drs/search-disputes.html (perform search by typing the Domain Name, then download the decision)</p> <p>Nominet UK Appeal Panel decision Consortio del Prosciutto di Parma v. Vital Domains Limited Case No. DRS 00359</p> <p><u>SUMMARY/ANALYSIS</u> The Complainant appealed the first instance decision dated 10 July 2002 rendered by an Expert who determined that the Domain Names did not constitute Abusive Registrations. The three-member Appeal Panel upheld the decision of the original Expert.</p> <p>The Appeal Panel recognized the Complainant's Rights on the basis of the combination of the PDO ("Prosciutto di Parma"), the community collective trademarks (word "Prosciutto di Parma" and device mark for "Parma" inside a crown) and UK certification trademarks (word "Prosciutto di Parma" and device mark for "Parma" inside a crown). The Appeal Panel considered those Rights identified were in respect of a name or mark (whether it be "Parma ham" as a translation of "Prosciutto di Parma" or the name or mark "Prosciutto di Parma" itself) which was similar to the Domain Names.</p> <p>Regarding the assessment of "Abusive Registration", the Appeal Panel found that at the time of registration, the Respondent genuinely and reasonably believed that the domain names were generic or descriptive terms and that it was neither aware of the existence of the Complainant nor its rights.</p> <p>The majority view of the Appeal Panel was that the Respondent, having fairly registered domain names it believed to be generic, was entitled to hold them with a view to selling them to someone it genuinely thought would be legitimately entitled to use the domain names. The fact that the Respondent redirected traffic to its domain name trading site was simply the mechanism whereby the domain names were "legitimately" offered for sale.</p> <p><u>COMMENTS</u> In this case, the Appeal Panel recognized the PDO status of "Prosciutto di Parma" but declined to recognize the Complainant's common law rights in view of the descriptive nature of the terms "Parma", "Parma ham" and "Prosciutto di Parma". In the majority opinion of the Appeal Panel, the UK public would consider "Parma ham" as an everyday descriptive term denoting "ham produced in the Parma region [of Italy]" and not a product originating from the Complainant or its members.</p>

- [WIPO SCT/39/7 Annex](#), “Survey of the Existing State of Play of Geographical Indications, Country Names, and Other Geographical Terms in the DNS”
- CENTR study on GIs and domain names (Council of European National Top-Level Domain Registries) ([Study on geographical indications and domain names \(Fieldfisher\)](#))
- AERPO Practical Guide, version of 2023 (Association of European Regions for Products of Origin) (https://www.arepoquality.eu/wp-content/uploads/2023/03/protection-of-gis-on-the-internet_arepo-practical-guide_en-1.pdf)

APPENDIX B

	Domain Name	GI/PDO/PDI	court & date	summary of decision	outcome
FRANCE	auchampagne.com	champagne	Paris High Court 5 Oct 2007	Citing Article L 115-6 of the Consumer Code and Article L 643-1 of the Rural Code, holding that a controlled designation of origin or any other mention evoking it cannot be used for any establishment or other product or service when this use is likely to misappropriate or weaken the appellation's reputation. Registrant operated a brasserie restaurant called LE CHAMPAGNE and uses the domain name auchampagne.com. Protection of designations of origin prohibits private appropriation. Defendant intended to appropriate the idea of prestige and refinement attached to the sign and use in domain name clearly results in weakening of reputation of appellation.	cancellation
	chamalal.com, chamalal.net	champagne	Paris High Court 27 Jan 2009	Non-alcoholic drink CHAMPALLAL, marketed as Muslim alternative to Champagne, violates Article L 643-1 of the Rural Code, domain names likely to divert and weaken the notoriety of the AOC Champagne	cancellation
	champagne.ch	champagne	Paris Regional Court 9 April 2008	Defendant sold aperitif biscuits under name "de CHAMPAGNE." Website is in French and mentions "recette de Champagne" with emphasis on "de Champagne." Defendant infringes Article L 643-1 of Rural Code with its domain name accessible in France, use of "champagne" in domain name "is of such a nature as to undermine the renown of the CHAMPAGNE AOC."	cancellation
	champagnes.be	champagne	Court of Appeal of Paris, 23 August 2006	Defendant's website sells the printing of postcards. Court notes that plaintiff CIVC does not have exclusive rights because of the collective nature of the name, but it is still able to bring this case. Court examines .be standards (Belgium) but states that .be element will not be considered in likelihood of confusion determination. Defendant clearly knew about the Champagne appellation of origin and existence of other champagne domain names does not rule out the unfairness of the defendant's use of this domain name.	transfer of domain name
	champ-pagne.com	champagne	TGI of Paris, 7 September 2001	"use of domain name for a pet fountain was misleading and likely to damage the image of PDO Champagne https://www.legalis.net/jurisprudences/tribunal-de-grande-instance-de-paris-3eme-chambre-2eme-section-jugement-du-7-septembre-2001-2/ "	transfer of domain name, damages
	lechampagne-s.com	champagne	Paris High Court	Defendant owned Brasserie Le Chamagne in Brittany - a restaurant. Term "champagne" appears on website multiple times. Use leads customer to have in mind the champagne product, which is a misuse of the CDO clearly resulting in a weakening of the appellation. (a longer summary was prepared by working group)	cancellation
	piment-espelette.info	PDO: Piment D'Espelette (Espelette pepper)	Paris Court of First Instance	Use of domain name for products not eligible for the PDO infringes PDO. Domain name registrant was authorized to use PDO but was only one of the producers so authorized. Registering this domain name constitutes a private use contrary to the principle of collective use of the PDO, which belongs to all the authorized producers of the region in question. Such a sign cannot be aggrandized by a single producer, whether PDO-compliant or not. Domain name likely to mislead consumers by stating it is a general information site related to the PDO. (a longer summary was prepared by working group)	cancellation, payment of 2000 euros
	vin-de-champagne.com	champagne	Court of First Instance of Paris, 14 Dec 2005	Defendant uses "Le Champagne" mark for wine cellar in Paris and sells wine through its website. Use is unlawful misappropriation of AOC	"striking off" ordered (cancellation?)

	Domain Name	GI/PDO/PDI	court & date	summary of decision	outcome
SPAIN	lachampanera.es	champagne	Audiencia Provincial Civil de Madrid, 668/2020 (darts-398-283-N-es-2), 4 Feb 2022	<p>"The lawsuit filed by the CHAMPAGNE indication of origin against the wedding, PR and lifestyle blog "LA CHAMPANERA" was initially dismissed. The Court found that there existed differences among the goods and services of the parties (namely, a wedding blog vs. the production of sparkling wines), and because the word "champanera" means "wine cooler" instead of making a direct reference to Champagne wines.</p> <p>This ruling was overturned in second instance. The appeal Court stated that the rules applicable for indications of origin are not the same as the ones applied for trade mark infringements, as per the European Court of Justice case law on Article 103.2.b) of Regulation 1308/2013. There is no need for similarity among the compared goods and services to establish an infringement of the protected indication of origin. In the case of indications of origin, the mere evocation of the protected sign which allows the consumer to establish a link would constitute an infringement.</p> <p>In the case at hand the link is evident and unavoidable, as the phrase "LA CHAMPANERA" includes the Spanish translation of the word CHAMPAGNE ("CHAMPÁN"), regardless of the different goods and services offered by the parties. The Court also points out that the defendant takes advantage of CHAMPAGNE's reputation for the promotion of their own services. Finally, and very relevantly, the Court reminds that indication of origin cannot be generic or descriptive within the EU."</p>	Cancellation of domain name and cease of use of the word "LA CHAMPANERA"
	chuletondeavila.es and chuletondeavila.com.es	PGI "CARNE DE ÁVILA"	PROVINCIAL COURT OF BURGOS, 28 March 2018	<p>"Domain names were a commercial use of the geographical term ""Ávila"" protected by the PGI ""Carne de Ávila"", taking advantage of the PGI's reputation and risking consumer confusion and damaging the PGI's image.</p> <p>https://www.wipo.int/wipolex/fr/text/579266"</p>	cancellation
	champanillo.es	champagne	JUDGEMENT 512/2022 In Barcelona, on the 18th of March in 2022	<p>Defendant uses CHAMPANILLO for bars and tapas restaurants, which is found to evoke PDO. It is prohibited to take unfair advantage of the reputation of a PDO by virtue of an association with it, which this use does. Use of domain name is infringement of PDO. (a longer summary was prepared by working group)</p>	unspecified but likely cancellation
ITALY	provolone-del-monaco.it and provolone-del-monaco.eu		Tribunale Ordinario di Napoli, 6244/2013 (darts-559-832-K-it-2)	<p>"The Court declares void the trademark of the defendant ""Provolone del Monaco"" registered in 2008, since it is identical to the earlier trademark of the claimant, registered in 2005, and because it was registered in bad faith, since the defendant was aware of the Consortium's intention to register a PDO. Any further use of the sign is prohibited, as well as the use of the domain name www.provolone-del-monaco since it contains the same name as the earlier trademark and refers to the same goods and services.</p> <p>NOTE: decision not relevant for our research, finding regarding domain name not related to GIs"</p>	order to stop using domain names
PORTUGAL	anonymised domain name	champagne	Portuguese Court of Appeals, Lisbon, Supremo Tribunal De Justiça, 393/12.7YHLSB. L1.S1 (darts-894-711-H-pt-2)	<p>The use of the expression "Campanherie" constitutes, among others, a hypothesis of unfair competition and the trivialization of the designation of origin "Champagne". Therefore, the Defendants are ordered to refrain from using the word "champanheria", champagne, or champagne as well as words or expressions derived or similar to that designation, such as: champgneria or champagnerie, xampanherie, etc... to identify establishments, namely hotels, restaurants or drinks sales, including ads, correspondence, or any other commercial documentation, on the internet or electronic mail.</p>	order to stop using domain name and email

	Domain Name	GI/PDO/PDI	court & date	summary of decision	outcome
PORTUGAL	champanheria.com.pt	champagne	Portuguese Court of Appeals, Lisbon, Tribunal da Relação de Lisboa, 1/13.9 Y H LSB (darts-635-280-D-pt-4)	Based on Portuguese jurisprudence, the designation of origin CHAMPAGNE enjoys high prestige in Portugal. The rule enshrined in article 312, 4 of the 2003 CPI, prohibits the use of a designation of origin or geographical indication with prestige in Portugal, whenever the use of the same could take undue advantage of the prestige of the previously registered designation of origin. Therefore, the expression "Champanheria" violates the protection enjoyed by the designation of origin CHAMPAGNE as it is likely to harm its prestige and distinctive character, by banalization or dilution, and its registration must be annulled under the terms of article 299, 1 paragraph a and article 239 paragraph h, all of the CPI 2003. Defendants are also ordered to refrain from using the word "champanheria", champagne, or champagne as well as words or expressions derived or similar to that designation, such as: champgneria or champagnerie, xampanherie, etc... to identify establishments, namely hotels, restaurants or drinks sales, including ads, correspondence, or any other commercial documentation, on the internet or electronic mail.	order to stop using domain name and email
GERMANY	champagner.de	champagne	Landgericht Hamburg, 312 O 426/06 (darts-093-177-A-de)	"Under the domain, search results for the term ""champagne"" can be found, e.g. wines, clothing, books. No exploitation of reputation or a transfer of reputation pursuant to Sec. 127 para. 3 Trademark Act, because the search results nowhere create the impression that the listed products are of comparable exclusivity as champagne. A claim for injunctive relief also does not follow from the German-French agreement on the protection of indications of source, indication of origin and other geographical designations, since there is no relevant impairment of the advertising value of the designation ""Champagner""; finally, no claim for release of the domain, because the plaintiff as an association of champagne manufacturers has no absolute right to ""Champagner""	domain name not transferred, no claim for release of domain name
	champagner.de	champagne	Oberlandesgericht München, 29 U 5906/00 (darts-086-848-A-de)	"No deliberate obstruction according to § 1 UWG (new: § 4 No. 4 UWG), because plaintiff (association of champagne producers) has no absolute right to ""Champagne"" and because everyone is entitled to use this geographical indication within the legal regulations; § 3 UWG is not applicable, because the public does not believe that (only) the plaintiff's umbrella association appears under the domain. § 127 para. 3 MarkenG (exploitation of reputation) is not applicable, because the defendant only informs about champagne and advertises for it, which is supposed to serve the distribution of the product and the promotion of the reputation of champagne; the image transfer typical for the exploitation of reputation is not present. § 826 BGB is therefore also ruled out. The German-French agreement, which contains champagne as a protected designation, does not apply because the advertising value of ""champagne"" is not impaired but promoted."	domain name not transferred, no claim for release of domain name



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