

WIPO



SCT/10/6
ORIGINAL:English
DATE:April3,2003

E

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

STANDING COMMITTEE ON THE LAW OF TRADE MARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

Tenth Session
Geneva, April 28 to May 2, 2003

INTERNET DOMAIN NAMES AND GEOGRAPHICAL INDICATIONS

Document prepared by the Secretariat

1. At its Ninth Session from November 11 to 15, 2002 (document SCT/9/8, paragraph 5), the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) decided to:

“continued discussions on [the issue of Internet domain names and geographical indications] and requested the International Bureau to prepare a paper summarizing the state of the positions, drawing together work already done by the International Bureau and including the comments made by several delegations at the SCT.”

2. The present document constitutes the paper requested by the SCT and reflects the discussions held at WIPO on the issue at hand. The principal stages of those discussions are as follows:

- The first WIPO Internet Domain Name Process;
- The letter of request of certain Member States of June 28, 2000, initiating the Second WIPO Internet Domain Name Process;
- The Second WIPO Internet Domain Name Process;
- The decision of the Member States taken at their meeting from September 24 to October 3, 2001;

- The Special Sessions of the SCT held from November 29 to December 4, 2001, and from May 21 to 24, 2002; and
- The decision of the Member States taken at their meeting from September 23 to October 1, 2002.

The Final Report of the First WIPO Internet Domain Name Process

3. The possible need for the protection of geographical indications in the Domain Name System (DNS) was discussed in the final report of the first WIPO Internet Domain Name Process dated April 30, 1999. The issue was addressed in the context of proposed limitations to the scope of the Uniform Domain Name Dispute Resolution Policy (UDRP). The relevant passages read as follows:

“167. Thesecond limitation [of the UDRP] would define abusive registration by reference only to trademarks and servicemarks. Thus, registrations that violate trade names, geographical indications or personality rights would not be considered to fall within the definition of abusive registration for the purposes of the administrative procedure. Those in favor of this form of limitation pointed out that the violation of trademarks (and servicemarks) was the most common form of abuse and that the law with respect to trade names, geographical indications and personality rights is less evenly harmonized throughout the world, although international norms do exist requiring the protection of trade names¹ and geographical indications.²”

“168. We are persuaded by the wisdom of proceeding firmly but cautiously and of tackling, at the first stage, problems which all agree require resolution. It was a striking fact that in all the 17 consultation meetings held throughout the world in the course of the WIPO Process, all participants agreed that “cybersquatting” was wrong. It is in the interests of all, including the efficiency of economic relations, the avoidance of consumer confusion, the protection of consumers against fraud, the credibility of the domain names system and the protection of intellectual property rights, that the practice of deliberate abusive registrations of domain names be suppressed. There is evidence that this practice extends to the abuse of intellectual property rights other than trademarks and servicemarks,³ but we consider that it is premature to extend the notion of abusive registration beyond the violation of trademarks and servicemarks at this stage. After experience has been gained with the operation of the administrative procedure and time has allowed for an assessment of its efficacy and of the problems, if any, which remain outstanding, the question of extending the notion of abusive registration to other intellectual property rights can always be revisited.”

¹ See the Paris Convention for the Protection of Industrial Property and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement).

² *Ibid.*

³ See Comment of the *Fédération des syndicats de producteurs de Châteauneuf-du-Pape* (March 24, 1999 – RFC -3).

The letter of request of WIPO Member States of June 28, 2000

4. On June 28, 2000, WIPO received a letter of request from the Government of Australia as well as 19 Governments of its other Member States to initiate a second WIPO process to address certain intellectual property issues relating to Internet domain names that remained to be considered after the first WIPO Internet Domain Name Process. The signatories of the letter “envisage[d] that the scope of this study would explore the issues raised, in the domain namespace, *inter alia*, by bad faith, abusive, misleading or unfair use of [among other identifiers] geographical indications....” In response to this request, on July 10, 2000, WIPO commenced the Second WIPO Internet Domain Name Process.

The Final Report of the Second WIPO Internet Domain Name Process

Evidence of the Misuse of Geographical Indications in the DNS

5. The final report of the Second WIPO Internet Domain Name Process of September 3, 2001 summarizes the evidence of the misuse of geographical indications in the DNS, as follows:

“223. Illustrations of problems experienced in the DNS concerning geographical indications were submitted in response to WIPO 2RFC -2 by entities whose interests, or whose interests they represent, are most affected by the subject matter. These entities include the Office international de la vigne et du vin (OIV), an international intergovernmental organization, and the Institut national des appellations d’origine (INAO), a French governmental organization charged with the protection of appellations of origin and geographical indications for food and agricultural products.

“224. The OIV is an intergovernmental organization with a scientific and technical character, competent in the field of the vine and its derived products. It was created by the International Agreement for the Creation of the Office international du vin of November 29, 1924. The Organization has 45 Member States which, together, represent the vast majority of the world’s vine planting areas and of the world’s wine production and consumption. ⁴ Already within the framework of the first WIPO Process, the OIV had protested against the ‘appropriation and the reservation for private purposes of names that benefit from intellectual property protection’ and sought ‘a level of protection for geographical indications that is equal to that available for trademarks.’ ⁵ The OIV has reiterated its position in the Second WIPO Process and draws attention to a Resolution adopted by its Member States concerning the use of geographical indications on the Internet. This resolution, in its pertinent part, reads as follows:

⁴ More information on the *Office international de la vigne et du vin (OIV)* is available at www.oiv.int.

⁵ See Comment of *Office international de la vigne et du vin (OIV)* (RFC -3 of first WIPO Process - April 30, 1999).

‘...averylargenumberofInternetdomainnamesconsistofgeographical indicationsofrecognizedtraditionaldenominationsthatareregulatedbythe MemberStatesoftheOIVandhavebeencommunicatedtotheOIVbythem...

‘...amongthesedomainnames,thereareanumberwhichareparticularly confusingforInternetusersandconstitutecommercialpiracyoramisappropriationofnotoriety...certainregistrationsareofferedforsaletothe highestbidderorarelinkedtoinactive sites,evidencingbadfaith...’

“225. In addition to this Resolution, the OIV has submitted a study conducted by the Fédération des syndicats de producteurs de Châteauneuf du Pape (the Federation of Producers’ Associations of Châteauneuf du Pape) covering numerous domain names corresponding to claimed geographical indications and wine varieties. According to the OIV, this study establishes that “a large number of domain names have been registered which correspond to appellations of origin and geographical indications of wine-derived growing products, as well as wine varieties, without there being any relationship between the domain name registrants and the persons who hold rights in these distinctive signs.”⁶ A representative selection of domain names covered by this study, together with relevant registration data concerning these registrations, has been reproduced in Annex [1].⁷ Similar examples of claimed appellations of origin that have been registered as domain names have been presented by the INAO (see Annex [2]).⁸

“226. As a complement to the studies presented by the OIV and INAO, we have performed two similar exercises. The first relates to a number of examples of appellations of origin, including those for products other than wine, that have been registered by the International Bureau of WIPO under the Lisbon Agreement. The results are reproduced in Annex [3]. The second relates to a number of examples of other possible geographical indications and is reproduced in Annex [4].

“227. The comments received, in particular the studies submitted by the OIV and INAO, reveal the existence of practices concerning the registration of geographical indications as domain names, which are similar, if not identical, to those that were observed in relation to trademarks and service marks, and which ultimately led to the adoption of the UDRP. As described by OIV and INAO, those practices are the following:

⁶ “Une étude menée en 1999 a constaté le dépôt d’un grand nombre de noms de domaine (.com) qui correspondent aux noms d’appellations d’origines et d’indications géographiques de produits vitivinicoles et de noms de cépages sans que les dépositaires aient un lien quelconque avec les titulaires réels des droits liés à ces signes distinctifs.” in Comment of Office international de la vigne et du vin (OIV) (RFC -1 -August 14, 2000).

⁷ As the study was conducted in 1999, and as registration data often change, all information regarding the domain name holder as well as the website’s activity has been verified as at January 26, 2001, as reflected in the Annex.

⁸ See Comment of Institut national des appellations d’origine (INAO) (RFC-2 –January 31, 2001).

- “(1) The registration of a domain name corresponding to a claimed geographical indication primarily for the purpose of selling, renting or otherwise transferring the domain name to a third party at a premium.”⁹
- “(2) The use of a domain name corresponding to a claimed geographical indication in connection with a product which does not benefit from the geographical indication, thereby creating a likelihood of confusion as to the quality, other characteristics or reputation of the product.”
- “(3) The use of a domain name corresponding to a claimed geographical indication with a view to attracting Internet users to a website or other on-line location, the contents of which bears no relationship with the geographical indication.”¹⁰
- “(4) The registration of a domain name corresponding to a claimed geographical indication with a view to preventing others from registering the same name.”¹¹

“228. In light of these practices and their strong resemblance to those that have been observed previously in relation to trademarks and service marks, and taking into account the need to safeguard the interests of legitimate users of geographical indications in the DNS, as well as the interests of consumers, the Interim Report recommended that measures be adopted to protect geographical indications and indications of source in the open gTLDs, and proposed that these measures take the form of a broadening of the scope of the UDRP to cover the identifiers in question. The comments received on these preliminary recommendations are discussed in the next section of this Report.”

Analysis of Comments and Views Expressed in Response to the Interim Report

6. The final report summarizes the comments received on the above proposed protection for geographical indications as follows:

“229. In recognition of the significant divergence in view throughout the world on what is to be regarded as a protectable geographical indication, the Interim Report’s recommendations focused on attempting to curb only clear-cut cases of abuse of these identifiers, assuming that everyone might agree that manifestly bad faith behavior should be tolerated under no circumstances. The Interim Report proposed that this could be accomplished by broadening the scope of the UDRP to cover geographical indications and indications of source through a revision of the three-pronged test of

⁹ See Annex[2], INAO: *fitou.com*.

¹⁰ See Annex[1], ChâteauneufduPape: *bade.com, barsac.com, rhodes.net*; Annex IX, INAO: *bourgueil.com, corton.com, gigondas.com, vacqueyras.com*; Annex [3], Lisbon: *champagne.org, chinon.org, frascati.com*.

¹¹ See Annex[1], ChâteauneufduPape: *bourgogne.com, eiswein.com, lambrusco.com, medoc.com*; Annex[3], Lisbon: *armagnac.com, hoyo-de-monterrey.com, tequila.com*.

subparagraph 4(a) of the [UDRP] (“Applicable Disputes”). In view of the essentially collective nature of the rights represented by geographical indications and indications of source, the Interim Report also identified, discussed and proposed options for further reflection on the question of which persons or entities should be deemed to have standing to file a complaint under the proposed revised UDRP and which remedies (transfer or cancellation) should be available under the procedure.

“230. A review of the comments submitted in response to the recommendations formulated in the Interim Report reveals continuing disagreement regarding the principle of providing protection in the DNS for geographical indications and indications of source, as well as regarding the form which such protection should take. Several commentators are in favor of the specific proposals contained in the Interim Report.¹² Others, including some representing intellectual property interests,¹³ either oppose them, or, at best, consider them premature.¹⁴

¹² See Comment of France, *Institution des appellations d'origine* (INAO) (RFC-3-June 13, 2001), Comment of Hungary, Hungarian Patent Office (RFC-3-June 13, 2001), Comment of Switzerland, Swiss Federal Institute of Intellectual Property (RFC-3-June 15, 2001), Comment of United Kingdom, The Patent Office (RFC-3-June 1, 2001), Comment of European Commission (RFC-3-June 25, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC-3-June 7, 2001), Comment of Auckland District Law Society, Law & Technology Committee (RFC-3-June 22, 2001), Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-3-June 8, 2001), Comment of European Brands Association (AIM) (RFC-3-May 16, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC-3-June 18, 2001), Comment of International Chamber of Commerce (ICC) (RFC-3-June 18, 2001), Comment of Japan Network Information Center (JPNIC) (RFC-3-June 8, 2001), Comment of Nominet UK (RFC-3-June 14, 2001), Comment of UAE NIC (RFC-3-June 6, 2001), Comment of Elzaburu (Luis H. De Larramendi) (RFC-3-June 14, 2001). For similar views expressed in response to RFC-2, see also Comment of Government of Australia (RFC-2-January 23, 2001), Comment of Government of The Netherlands, Ministry of Transport, Public Works and Water Management (RFC-2-December 20, 2000), Comment of Republic of Moldova, State Agency on Industrial Property Protection (RFC-2-December 29, 2000); Comment of *Asociación Interamericana de la Propiedad Industrial* (ASIPI) (RFC-2-December 26, 2000); Comment of Brazilian Association of Intellectual Property (ABPI) (RFC-2-December 28, 2000), Comment of Association of European Trade Mark Owners (MARQUES) (RFC-2-December 22, 2000), Comment of ES-NIC (RFC-2-December 29, 2000), Comment of Verizon (RFC-2-December 26, 2000).

¹³ See Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC-3-June 14, 2001); see also (RFC-2-December 29, 2000) and Comment of International Trademark Association (INTA) (RFC-3-May 24, 2001).

¹⁴ See Comment of Canada, Government of Canada (RFC-3-July 5, 2001), Comment of Japan, Ministry of Economy, Trade and Industry (METI) (RFC-3-July 5, 2001), Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3-June 14, 2001), Comment of Association for Computing Machinery's Internet Governance Project, Electronic Privacy Information Center (RFC-3-June 15, 2001), Comment of EasyLink Services Corporation (RFC-3-January 1, 2001), Comment of International Trademark Association (INTA) (RFC-3-May 24, 2001), Comment of Icanchannel.de (RFC-3-June 15, 2001), Comment of Andy Eastman (RFC-3-June 16, 2001), Comment of Christine Haight Farley (RFC-3-June 11, 2001), Comment of Michael Froomkin (RFC-3-June 4, 2001). For similar views expressed in response to RFC-2, see also Comment of Tim Heffley, Z-Drive Computer

“231. Commentators who are in favor of the protection proposed in the Interim Report note that geographical indications have been the victims of abuse in the DNS and that there exist international norms protecting this class of identifiers. That being the case, they see no reason why geographical indications should be afforded less protection in the DNS than trade or service marks. Some of these commentators are of the view that protection should not be restricted to cases of bad faith abuse, but that an alternative dispute resolution procedure also should be available to resolve conflicts between parties each of which may have rights in the identifiers concerned, in light of the special nature of geographical indications representing collective, rather than individual, rights.¹⁵ The same commentators, as well as others, are of the opinion that an exclusion mechanism for geographical indications would be appropriate, or at least should be given further consideration, in light of ongoing negotiations in the framework of Article 23.4 of the TRIPS Agreement.¹⁶ If protection were to be provided through a revised UDRP, some commentators felt that panels with particular expertise in the subject matter would be needed, in view of its specialized nature and complexity. 17

“232. On the question of who should be deemed to have standing to file complaints under the proposed revised UDRP, the Interim Report presented three options for further consideration: (i) the persons or entities who have standing to enforce these rights in accordance with the law of the country of origin; (ii) governments only; or (iii) the persons or entities who are found to have standing based on the law determined to be applicable to that issue by the panel, in accordance with the ordinary rules of private international law. Most commentators were of the view that the second option would be overly restrictive and favored either the first or last option.¹⁸ As a solution to the standing problem, one commentator proposed that a complainant wishing to avail itself of the proposed revised UDRP could be required to produce a declaration by either the courts or the government of its jurisdiction confirming that it has standing to pursue the complaint in question.¹⁹ rsue

[Footnote continued from previous page]

Service (RFC -2– December 19, 2000), Comment of Christa Worley (RFC -2 December 19, 2000), Comment of Alexander Sv enssen (RFC -2– December 21, 2000).

¹⁵ See Comment of France, *Institut national des appellations d'origine* (INAO) (RFC-3–June 13, 2001).

¹⁶ See Comment of France, *Institut national des appellations d'origine* (INAO) (RFC-3–June 13, 2001) and Comment of European Commission (RFC -3– June 25, 2001).

¹⁷ See Comment of Elzaburu (Luis H. De Larramendi) (RFC -3– June 14, 2001).

¹⁸ See Comment of European Commission (RFC -3 –June 25, 2001), Comment of Hungary, Hungarian Patent Office (RFC -3 –June 13, 2001), Comment of United Kingdom, The Patent Office (RFC -3–June 1, 2001), Comment of American Intellectual Property Law Association (AIPLA) (RFC -3 –June 7, 2001), Comment of Auckland District Law Society, Law & Technology Committee (RFC -3– June 22, 2001), Comment of International Association for the Protection of Industrial Property (AIPPI) (RFC -3 –June 18, 2001).

¹⁹ See Comment of Elzaburu (Luis H. De Larramendi) (RFC -3– June 14, 2001).

“233. In light of the collective nature of the rights concerned, certain commentators proposed the creation of a new remedy for purposes of the proposed revised UDRP which would take the form of a “cancellation+exclusion”. Such a new remedy would serve a dual purpose. On the one hand, it would prevent a prevailing complainant from arrogating to itself a collective right, and, on the other, it would avoid cancelled domain names from being re-registered in bad faith (potentially by the same registrant).²⁰ Recognizing that multiple persons or entities may have a legitimate claim to the use of the same geographical indication or indication of source, certain commentators advocated the use of gateway systems and the creation of new chartered gTLDs to stimulate coexistence among these competing legitimate interests.²¹

“234. Commentators who oppose the introduction of protection for geographical indications in the DNS recognize that there exist uniform rules governing the subject matter, but believe that the level of harmonization achieved by those rules is insufficient to constitute an adequate basis for the protection proposed in the Interim Report. In particular, they highlight three specific areas where sufficient uniformity is lacking. First, they argue that the harmonized rules at issue (in particular the TRIPS Agreement) incorporate several qualifications and exceptions to the protection for geographical indications, striking a delicate balance of interests, which would be difficult, if not impossible, to reflect faithfully in the UDRP.²² Secondly, they state that the legal and administrative mechanisms giving effect at the national level to the internationally harmonized norms vary widely, ranging, as noted above, from *suigeneris* registration systems, certification or collective marks, the law on passing-off, unfair competition law and consumer protection legislation.²³ Thirdly, and perhaps most importantly, they claim that there exists no uniform view at the international level of what is to be deemed a protectable geographical indication, and that, consequently, terms which are protectable in some jurisdictions, are freely available in others.²⁴

“235. The commentators in question conclude that providing protection to geographical indications through the UDRP under this state of incomplete harmonization of the law is doomed to fail. They believe panels would be put in the awkward position of having to take decisions with insufficient guidance available to them, which would lead inevitably to the undesired creation of new law. For the same

²⁰ See Comment of Japan Network Information Center (JPNIC) (RFC -3-June 8, 2001).

²¹ See Comment of France, *Institut national des appellations d'origine* (INAO) (RFC-3-June 13, 2001).

²² See Comment of Christine Haight Farley (RFC -3-June 11, 2001).

²³ See Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3-June 14, 2001) and Comment of Christine Haight Farley (RFC -3-June 11, 2001).

²⁴ See Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3-June 14, 2001), Comment of *Fédération internationale des conseils en propriété industrielle* (FICPI) (RFC -3-June 14, 2001), Comment of International Trademark Association (INTA) (RFC -3-May 24, 2001), Comment of Christine Haight Farley (RFC-3-June 11, 2001).

reasons that are set out in this section of this Report concerning personal names, ²⁵ these commentators are of the view that this would jeopardize the UDRP's long-term viability as an effective dispute resolution system. This risk is considered particularly acute in the area of geographical indications because there has been, for many years now, continuing intense debate internationally between governments on the subject matter.

“236. Next to insufficient harmonization of the applicable norms, the same commentators advance also other reasons for their reluctance to protect geographical indications through a revision of the UDRP. Some argue that there is not enough evidence of widespread abuse to justify such additional protection. ²⁶ Others believe that the law governing the subject matter is so complex that it could not be enforced properly through simple mechanisms such as the UDRP, which is intended to deal with clear-cut cases not requiring extensive deliberation. ²⁷ Still others are of the view that none of the proposals formulated in the Interim Report for solving the standing problem are satisfactory. ²⁸”

Recommendation

7. Taking into account the evidence of abuse and the above comments on proposals formulated in the Interim Report, the final Report of the Second WIPO Internet Domain Name Process concludes as follows:

“237. This is a difficult area on which views are not only divided, but also ardently held. This alone is a cause for reflection about the desirability of introducing a modification dealing with this area to a consensus-based dispute-resolution procedure that is functioning inefficiently and cost effectively.

“238. It is undeniable that there is widespread evidence of the registration and use of geographical indications and other geographical source identifiers by persons who have no connection whatsoever with the locality to which the identifiers refer. These practices are misleading and harmful, first, the integrity of the naming systems in which those geographical identifiers operate and, secondly, the credibility and reliability of the DNS. The question for decision, however, is whether there is a solid and clear basis in existing international law which can be applied so as to prevent erosion of the integrity of geographical indications and enhance the credibility of the DNS.

²⁵ See paragraph 195, of the final Report of the Second WIPO Internet Domain Name Process.

²⁶ See Comment of Michael Fromkin (RFC-3–June 4, 2001).

²⁷ See Comment of Association for Computing Machinery's Internet Governance Project, Electronic Privacy Information Center (RFC-3–June 15, 2001), Comment of International Trademark Association (INTA) (RFC-3–May 24, 2001), Comment of Iannchannel.de (RFC-3–June 15, 2001).

²⁸ See Comment of United States of America, U.S. Patent and Trademark Office (USPTO) (RFC-3–June 14, 2001).

“239. We believe that there are two fundamental problems in endeavoring to apply the existing international legal framework to prevent the bad faith misuse of geographical indications in the DNS.

“240. The first problem is that the existing international legal framework for the prohibition of false and deceptive indications of geographical source and the protection of geographical indications was developed for, and applied to, trade in goods. The Paris Convention, the Madrid (Indications of Source) Agreement and the TRIPS Agreement all deal with the misuse of geographical identifiers in relation to goods. There is, thus, not a ready and easy fit between these rules and the predatory and parasitic practices of the misuse of geographical indications in the DNS. The mere registration of a geographical indication as a domain name by someone with no connection whatsoever with the geographical locality in question, however cheap and tawdry a practice, does not appear to be, on its own, a violation of existing international legal rules with respect to false indications of source and geographical indications. Such a registration may violate existing standards if it is associated with conduct relating to goods. For example, a domain name registration that is used in relation to an offer of sale of goods may be considered to be a “commercial communication” under Article 3bis of the Madrid (Indications of Source) Agreement. If the domain name registration is a geographical identifier and it is false or deceptive, it may, in these circumstances, be considered to violate the prohibition against the use of false indications set out in Article 3bis of the Madrid (Indications of Source) Agreement. Additionally, for example, one can imagine various hypothetical uses of domain name registrations with respect to goods which might be considered to constitute violations of the provisions on the protection of geographical indications in the TRIPS Agreement. However, there are many circumstances in which a domain name registration, even though constituting a false or unauthorized use of a geographical indication, may not constitute a violation of existing international rules because there is no relationship between the domain name and goods. Existing rules, therefore, would offer only a partial solution to the problem of what is perceived to be the misuse of geographical indications in the DNS.

“241. Secondly, there is a major problem in respect of applicable law because of the different systems that are used, at the national level, to protect geographical indications. For example, suppose that there is a geographical indication recognized and protected as such under the law of country A, but considered to be generic and descriptive under the law of country B. A resident carrying on business in country B registers, with a registrar based in country B, the geographical indication as a domain name and sells, from the website accessed through that domain name, goods that are available for purchase only by residents in country B. The person has no connection whatsoever with the locality covered by the geographical indication. What law applies to determine whether the registration and use of the domain name constitutes a violation of the protection of the geographical indication?

“242. The problem of applicable law highlights the lack of a multilateral system for the recognition of geographical indications. The hypothetical problem referred to in the previous paragraph would not arise if there were a multilaterally agreed list of geographical indications. If such a list existed and were accepted by both country A and country B in the example given, it is a simple matter to determine whether there exists a protectable geographical indication.

“243. We believe, therefore, that the existing international framework would provide only a partial answer to the perceived problems of false indications of source and geographical indications within the DNS. Furthermore, because of the need to resort to a choice of applicable law to resolve the question of the recognition of the existence of a geographical indication, very complicated questions would be involved in the application of the UDRP in this area. On these questions, international opinion is far from settled, as can be seen from the history of the negotiations with respect to a future Hague Convention on International Jurisdiction and Foreign Judgement in Civil and Commercial Matters.²⁹ These problems of applicable law could be avoided if a multilaterally agreed list of geographical indications were to be established.

“244. It is recommended that no modification be made to the UDRP, at this stage, to permit complaints to be made concerning the registration and use of domain names in violation of the prohibition against false indications of source or the rules relating to the protection of geographical indications.

“245. In making this recommendation, it is recognized that there is widespread dissatisfaction with the use of geographical indications as domain names by persons unconnected to the locality to which the geographical indications relate. We consider that, in order to deal with this problem, new law would need to be created in view of the inadequacy of existing law. The dissatisfaction that exists about certain practices in the DNS in this area is, we believe, best expressed in a will on the part of the international community to advance multilateral discussions on (i) the definition of the circumstances in which the registration and use of geographical indications as domain names should be proscribed; and (ii) the establishment of a multilaterally agreed list of geographical indications or other means of satisfactorily dealing with the interaction of differing systems and levels of protection at the national level and the mutual recognition of geographical indications within those systems.”

Decision of the Member States on the Final Report of the Second WIPO Internet Domain Name Process

8. At their meeting from September 24 to October 3, 2001, the Member States decided to subject the final report of the Second WIPO Internet Domain Name Process, including its recommendation on geographical indications, to a comprehensive analysis by the SCT which was to meet in two Special Sessions for this purpose (Document WO/GA/27/8, paragraph 33).

²⁹ See <http://www.hcch.net/e/workprog/jdgm.html>.

Special Sessions of the SCT

9. The Special Sessions of the SCT were held from November 29 to December 4, 2001, and from May 21 to 24, 2002. The minutes of these meetings reflect extensive discussion on the issue of geographical indications (see document SCT/S1/6, paragraphs 50 to 87; and document SCT/S2/8, paragraphs 211 to 229). Document WO/2002/01/03/GA/28/3 summarizes those discussions as follows:

“43. Discussions at the first Special Session reflected a division of views on the appropriateness of creating protection for geographical indications in the DNS. On the one hand, a group of countries noted that there exists a practice of abusing geographical indications in the DNS and was of the view that the international legal framework regarding geographical indications is sufficiently well developed to constitute a legal basis for establishing the protection in question. On the other hand, a group of countries believed that this legal framework is not sufficiently well developed and that subjecting geographical indications to the UDRP would lead panelists to develop undesired new law. Despite extensive discussions at the first Special Session, no progress was made in bridging this divergence of opinion. At the end of the first Special Session, the Chair consequently noted that “[v]iews on the question were divided. Whilst more delegations favored the modification of the UDRP to allow protection for geographical indications than those who opposed such a modification, no agreement had been reached. Accordingly, it was decided to continue discussions on the issue at the second Special Session to examine the many useful questions raised. Any delegation would be free to submit comments or papers for consideration before the second Special Session.

“44. At the second Special Session, delegations essentially reiterated their positions as reflected above. Those delegations in favor of protecting geographical indications in the DNS noted the urgency of the matter and requested that discussions continue in order to find a solution to the problems that are being encountered. Those that did not favor such protection stated that, while they agreed to continue discussing the matter, those discussions should focus first on a number of fundamental issues concerning geographical indications, before returning attention to their protection in the DNS. Finally, the Special Session:

- (i) Decided that it was not timely to take definitive decisions with respect to the protection of geographical indications in the Domain Name System.
- (ii) Noted that some delegations considered that the issue needed urgent attention, while others considered that a number of fundamental questions concerning the protection of geographical indications needed to be resolved before the question of their protection in the Domain Name System could be discussed.
- (iii) Recommend[ed] that the WIPO General Assembly revert this issue to the regular session of the SCT to decide how the issue of the protection of geographical indications in the Domain Name System be dealt with.

45. The Assemblies of the Member States of WIPO are invited to take a decision on the recommendation as contained in paragraph 44, above.”

Decision of the Member States on the Recommendations of the Special Session of _____ the SCT

10. At their meeting from September 23 to October 1, 2002, the Member States adopted the recommendation of the SCT with respect to geographical indications, it being understood that the SCT is to continue the discussions on this topic (document WO/GA/28/7, paragraph 78).

11. The SCT is invited to note the contents of this Document.

[Annex 1 follows]

ANNEX1

The Recognition Of Rights And The Use Of Names In The Internet Domain Name System ¹

Geographical Indication Claimed	Country	DomainName	DomainNameHolder	CountryofDomainName Holder	Activity²
Bade	Germany	bade.com	Mailbank.com, Inc .	UnitedStatesofAmerica	E-mailservice
Barsac	France	barsac.com	BarsacBrasserie	UnitedStatesofAmerica	GeneralInformation/Portal unrelatedtoBarsac
Bourgogne	France	bourgogne.com	BourgogneWebAssociates	UnitedStatesofAmerica	Servererror ³
Châteauneufdu Pape	France	chateauneuf-du-pape.com	JohnCrowley	UnitedStatesofAmerica	Informationonthecityof ChâteauneufduPape
Chenas	France	chenas.com	PaulTweed	CzechRepublic	Servererror ³
Chianti	Italy	chianti.com	DomainNameClearing Company	UnitedStatesofAmerica	Servererror ³

¹ Study submitted by the *Fédération des syndicats de producteurs de ChâteauneufduPape* on claimed geographical indications and wine varieties registered as domain names.

² As of January 26, 2001

³ Server error: "the server is aware that it has received a request that it is incapable of performing the request." Source: Hypertext Transfer Protocol --HTTP/1.1 --Draft Standard RFC 2616, The World Wide Web Consortium (W3C), <http://www.w3.org>

Geographical Indication Claimed	Country	DomainName	DomainNameHolder	CountryofDomainName Holder	Activity²
Chiroubles	France	chiroubles.com	FrédéricDufaud	France	Siteunderconstructionaimedat providinginformationonthe regionofBeaujolais(including informationonwinefrom Beaujolais)
Dolcetto	Italy	dolcetto.com	Dolcetto,Inc.	UnitedStatesofAmerica	WebsiteofDolcetto,Inc. (manufacturersofwine glassware)
Eiswein	Germany	eiswein.com	A.Ohanessian	Canada	Servererror ³
Fleurie	France	fleurie.com	SébastienSchmitt	France	Servererror ³
Gamay	France	gamay.com	JohnCrowley	UnitedStatesofAmerica	Servererror ³
Gewurztraminer	France	gewurztraminer.com	LittleWinery	Australia	Servererror ³
Irouleguy	France	irouleguy.com	PaulTweed	CzechRepublic	Servererror ³
Julienas	France	julienas.com	SébastienSchmitt	France	Servererror ³
Lambrusco	Italy	lambrusco.com	DomainNameClearing Company	UnitedStatesofAmerica	Servererror ³
Lirac	France	lirac.com	PaulTweed	CzechRepublic	Servererror ³
Medoc	France	medoc.com	JohnCrowley	UnitedStatesofAmerica	Servererror ³
Montalcino	Italy	montalcino.com	DomainNameClearing Company	UnitedStatesofAmerica	Servererror ³
Montepulciano	Italy	montepulciano.com	AlessandroBardelli	Italy	Siteunderconstruction
Montrachet	France	montrachet.com	MaikaMasuko	France	Siteunderconstruction
Ouzo	Greece	ouzo.com	Mailbank.com,Inc.	UnitedStatesofAmerica	E-mailservice

Geographical Indication Claimed	Country	DomainName	DomainNameHolder	CountryofDomainName Holder	Activity²
Primitivo	Italy	primitivo.com	BigSt,Inc.	UnitedStatesofAmerica	WebsiteofthePrimitivoWine Bar
Retsina	Greece	retsina.com	ArcticBlueEnterprises ,Ltd	Cyprus	Servererror ³
Rhodes	Greece	rhodes.net	Mailbank.com,Inc.	UnitedStatesofAmerica	E-mailservice
Rioja	Spain	rioja.com	AdrianLucas	Switzerland	Siteunderconstruction
Sangiovese	Italy	sangiovese.com	FreeRunTechnologies,Inc.	UnitedStatesofAmerica	WebsiteofDrinkwine.com
Sherry	Spain	sherry.com	ChapmanCapitalLLC	UnitedStatesofAmerica	Servererror ³
Sylvaner	France	sylvaner.com	JohnCrowley	UnitedStatesofAmerica	Servererror ³
Touraine	France	touraine.com	W3Systems,Inc.	UnitedStatesofAmerica	InformationonthecityofTours
Xeres	Spain	xeres.com	RyanShewchuk	UnitedStatesofAmerica	Nocontent

[Annex2follows]

ANNEX2

Examples Submitted by the *Institut national des appellations d'origine* (INAO) of Claimed Appellations of Origin Registered as Domain Names

Appellation of Origin Claimed	Product	Domain Name	Domain Name Holder	Country of Domain Name Holder	Activity¹
Alsace	Wine	alsace.com	Alsace Development Agency	United States of America	Website of Alsace Development Agency
Bourgueil	Wine	bourgueil.com	Coventry Investments Ltd.	United States of America	General Information/Portal unrelated to Bourgueil
Chablis	Wine	chablis.com	Chablis.com	Canada	Website related to wine
Chinon	Wine	chinon.com	Syndicat des Vins de Chinon	France	Website of Chinon Wine Growers
Corton	Wine	corton.com	Sébastien Schmitt	France	Domain Name Registration service
Fitou	Wine	fitou.com	Venster	Netherlands	fitou.com offered for sale
Gigondas	Wine	gigondas.com	Luc Castigli	France	General Information/Portal unrelated to Gigondas
Macon	Wine	macon.com	Knight Ridder.com	United States of America	Website of Macon.com
Madiran	Wine	madiran.com	Coffrini	France	Information on the city of Madiran

¹ As of January 26, 2001.

Appellation of Origin Claimed	Product	Domain Name	Domain Name Holder	Country of Domain Name Holder	Activity¹
Margaux	Wine	margaux.com	Château Margaux, Inc.	United States of America	Website of Café Margaux located in Florida and offering list of wines (including Margaux)
Moselle	Wine	moselle.com	Ocean Computing Systems	United States of America	Website of Ocean Computing Systems
Vacqueyras	Wine	vacqueyras.com	Orphée El Agamy	Egypt	Domain Name Registration service
Vouvray	Wine	vouvray.com	S.A. Vignoble du Château Moncontour	France	Website of Château Montoncour

[Annex 3 follows]

ANNEX3

Examples of Appellations of Origin Registered under the Lisbon Agreement Register and .domain Names

Appellation of Origin	Product	Country holding the Appellation of Origin	Domain Name	Domain Name Holder	Country of Domain Name Holder	Activity ¹
Ajaccio	Wine	France	ajaccio.org	Frigara	France	Information on Napoléon III
Alsace	Wine	France	alsace.com	Alsace Development Agency	United States of America	Website of Alsace Development Agency, Inc.
Anjou	Wine	France	anjou.com	ATD Electronique	France	Information on the province of Anjou
Armagnac	wine brandy	France	armagnac.com	Lord Plumleigh Imports	United States of America	Server error ²
Banyuls	wine	France	banyuls.net	Marina Walstrom	Sweden	Information on the city of Banyuls
Beaujolais-Villages	wine	France	beaujolais-villages.com	Patrice Mairot	France	Site under construction

¹ As of January 26, 2001.

² Server error: "the server is aware that it is unable to perform the request." Source: Hypertext Transfer Protocol RFC 2616, The World Wide Web Consortium (W3C), <http://www.w3.org> --HTTP/1.1 -Draft Standard

Appellation of Origin	Product	Country holding the Appellation of Origin	Domain Name	Domain Name Holder	Country of Domain Name Holder	Activity ¹
Beaune	wine	France	beaune.com	Axnet	France	Information on the sale of wines from Hospices de Beaune
Bergerac	wine	France	bergerac.com	Empire Media & Communications Hotel	Costa Rica	Website of the Hotel Le Bergerac located in San José, Costa Rica
Bohemia Glass	household glassware	Czech Republic	bohemia-glass.com	Externet World, Inc.	United States of America	Server error ²
Cahors	Wine	France	cahors.com	DX Communication	France	Server error ²
Champagne	Wine	France	champagne.org	Mailbank.com, Inc.	United States of America	E-mail service
Chinon	Wine	France	chinon.org	Namezero.com	United States of America	Website of Namezero
Cognac	wine brandy	France	cognac.net	Marcel Stenzel	United States of America	Site under construction
Corbières	Wine	France	corbieres.com	DNWeb	France	Server error ²
Cornas	Wine	France	cornas.com	Paul Tweed	Czech Republic	Server error ²
Frascati	Wine	Italy	frascati.com	Cristiano Colombi	Italy	General Information/Portal unrelated to Frascati
Habana	Tobacco	Cuba	habana.com	Siboney Systems	Spain	Information on the island of Cuba
Hoyo de Monterrey	Tobacco	Cuba	hoyo-de-monterrey.com	Romantik Hotel La Perla	Italy	Server error ²

Appellation of Origin	Product	Country holding the Appellation of Origin	Domain Name	Domain Name Holder	Country of Domain Name Holder	Activity ¹
Jaffa Jaffas	citrus fruits	Israel	jaffa.com	Elderaan Technologies Sendirian Berhad	Malaysia	General Information/Portal unrelated to Jaffa
Jurançon	Wine	France	jurançon.com	Exagri	France	Website of "Domaine of Cinquau" providing information on Jurançon wines
Les Baux de Provence	Wine	France	les-baux-de-provence.com	Gérard & Claire Allume	Canada	Information on the city of Baux de Provence
Meursault	Wine	France	meursault.net	Kalin Cellars	United States of America	General Information/Portal unrelated to Meursault
Muscadet	Wine	France	muscadet.com	New World Technology	France	Website related to sale of wines
Pilsner	Beer	Czech Republic	pilsner.com	Orbyt	Canada	Search Engine
Pommard	Wine	France	pommard.org	Kalin Cellars	United States of America	General Information/Portal unrelated to Pommard
Porto	Fortified wine	Portugal	porto.com	Cardinal Data Systems	United States of America	Server error ²
Sancerre	Wine	France	sancerre.org	Soft-Cie	France	Website related to sale of wines
Tequila	Brandy	Mexico	tequila.com	Structure Computers	United States of America	Server error ²

Appellationof Origin	Product	Countryholding theAppellation ofOrigin	DomainName	DomainName Holder	CountryofDomain NameHolder	Activity¹
Valpolicella	Wine	Italy	valpolicella.com	Domainname ClearingC ompany	UnitedStatesof America	Servererror ²
Volnay	Wine	France	volnay.org	KalinCellars	UnitedStatesof America	GeneralInformation/Portal unrelatedtoVolnay

[Annex4follows]

ANNEX4

Examples of Other Possible Geographical Indications Registered as Domain Names

Possible Geographical Indication	Country	DomainName	DomainNameHolder	Country of Domain NameHolder	Activity ¹
Barossa Valley	Australia	barossavalley.com	Tourism Northern Territory	Australia	Site under construction
Colchagua Valley	Chile	colchaguavalley.com	Small Potatoes	United States of America	Site under construction
Coronda	Argentina	coronda.com	Mario Koch	Germany	Server error ²
Cotnari	Romania	cotnari.com	Directway	France	General website/Portal related to Romania
Franschhoek	South Africa	franschhoek.com	Paris Le Cap	France	Information on Franschhoek
Irish Whiskey	Ireland	irish-whiskey.com	The Chesterfield Agency	United States of America	Server error ²
Korn	Germany	korn.com	J. K. Hullett	United States of America	Korn Issues Home Page
Maipo Valley	Chile	maipovalley.com	Small Potatoes	United States of America	Site under construction
Mendoza	Argentina	mendoza.com	EMEEfe Publicidad	Argentina	Site of Innovation Technology
Mezcal	Mexico	mezcal.com	Del Maguey, Ltd.	United States of America	Site of Del Maguey Company
Napa Valley	United States of America	napavalley.com	Free Run Technologies	United States of America	General website/Portal related to Napa Valley
Nemea	Greece	nemea.com	Soula Stesanopoulos	United States of America	Site under construction
Patagonia Lamb	Argentina	patagonialamb.com	Agro Business Inter	United States of America	Server error ²

¹ As of July 5, 2001.

² Server error: "the server is aware that it is unable to perform the request." Source: Hypertext Transfer Protocol HTTP/1.1 – Draft Standard RFC 2616, The World Wide Web Consortium (W3C), <http://www.w3.org>

Possible Geographical Indication	Country	DomainName	DomainNameHolder	CountryofDomain NameHolder	Activity ¹
Pisco	Peru	pisco.com	Pisco	UnitedStatesofAmerica	SiteofPisco
RapelValley	Chile	rapel.com	Goldnames,Inc.	UnitedStatesofAmerica	rapel.comofferedforsale
RealCalifornia Cheese	UnitedStates ofAmerica	californiacheese.com	Domains4Lease	AntiguaandBarbuda	Servererror ²
RogueValley	UnitedStates ofAmerica	roguevalley.com	HastingComputer Consulting	UnitedStatesofAmerica	Generalwebsite/Portal unrelatedtoRogueValley
Samos	Greece	samos.com	TakacAB	Sweden	Servererror ²
Stellenbosch	SouthAfrica	stellenbosch.com	MapxPTY	SouthAfrica	Servererror ²
YakimaValley	UnitedStates ofAmerica	yakima-valley.com	FutureNETInternet	UnitedStatesofAmerica	Siteunderconstruction
YarraValley	Australia	yarravalley.com	733tEnterprises	Australia	yarravalley.comofferedfor sale
WallaWallaValley	UnitedStates ofAmerica	wallawallavalley.com	AndrewLodmell	UnitedStatesofAmerica	Servererror ²

[EndofAnnex 4andofdocument]