



Intellectual Property Attorneys

WIPO's Information Session on Geographical Indications

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Intellectual Property Attorneys

GIs as IP titles in DNS and in Dispute Resolution Policies

Contents

Second Domain name report by WIPO - 2001

Were GIs protected prior to 2001?

Developments in GIs post 2001

What happens if GIs are not integrated into DNS

The 2nd Domain Name Report outdated?

Concluding remarks

WIPO's Second Domain Name Report 2001

“The first problem is that the existing international legal framework for the protection of geographical indications was developed for, and applies to, trade in 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”.

“.....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”.

“...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”.

Were GIs protected prior to 2001? Yes, Indeed!

Besides the international treaties, namely:

- The Paris Convention (162 member states at the time);
- The Madrid (Indications of Source) Agreement (33 member states at the time);
- The Lisbon Agreement (20 member States at the time); and
- The TRIPS Agreement (142 member states at the time)

Many countries had been protecting GIs through:

- National legislations;
- Regional treaties (EU and OAPI);
- Bilateral treaties (Switzerland)
- Passing-off actions;
- Certification / collective marks; and
- Consumer protection laws

Some countries that protected GIs prior to 2001



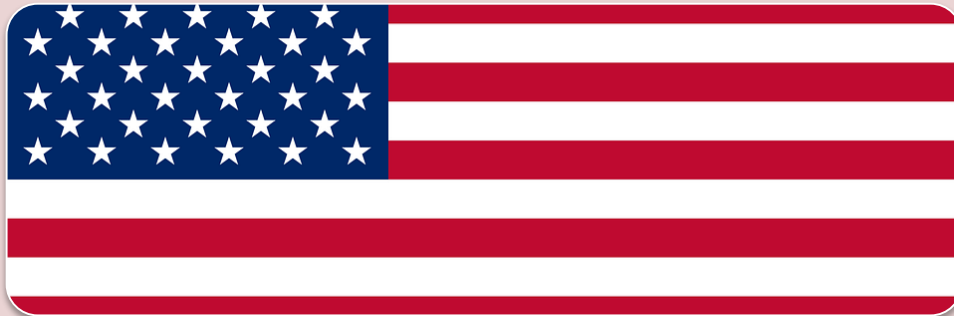
GIs protection through court actions prior to 2001



Several countries protected GIs through infringement of certification/ collective marks and/or passing-off actions



GIs protection through court actions prior to 2001



United States of America

- *City of Carlsbad et al v Kutnow et al* (1895)
- *Pillsbury-Washburn Flour Mills Co v Eagle* (1898)
- *California Fruit Cannery Association v Myer* (1899)
- *Roquefort v. William Faehndrich, Inc.* (1962)
- *Bureau National Interprofessionnel du Cognac v. Int'l Better Drinks Corp* (1988)
- *Institut National Des Appellations d'Origine v. Brown-Forman Corp.* (1998)



United Kingdom

- *J Bollinger & Ors v The Costa Brava Wine Co Ltd (The Spanish Champagne case)* [1961]
- *Argyllshire Weavers Ltd & Ors v A Macaulay (Tweeds) Ltd & Ors ("Harris Tweed" case)* [1964]
- *Vine Products Ltd & Ors v Mackenzie & Co Ltd & Ors (British Sherry case)* [1969]
- *Tattinger SA & Ors v Allbev Ltd & Anr (Elder Flower Champagne)* [1993]
- *Chocosuisse Union Des Fabricants Suisses de Chocolat & Anor v Cadbury Ltd* [1998]

GIs protection through court actions prior to 2001



India

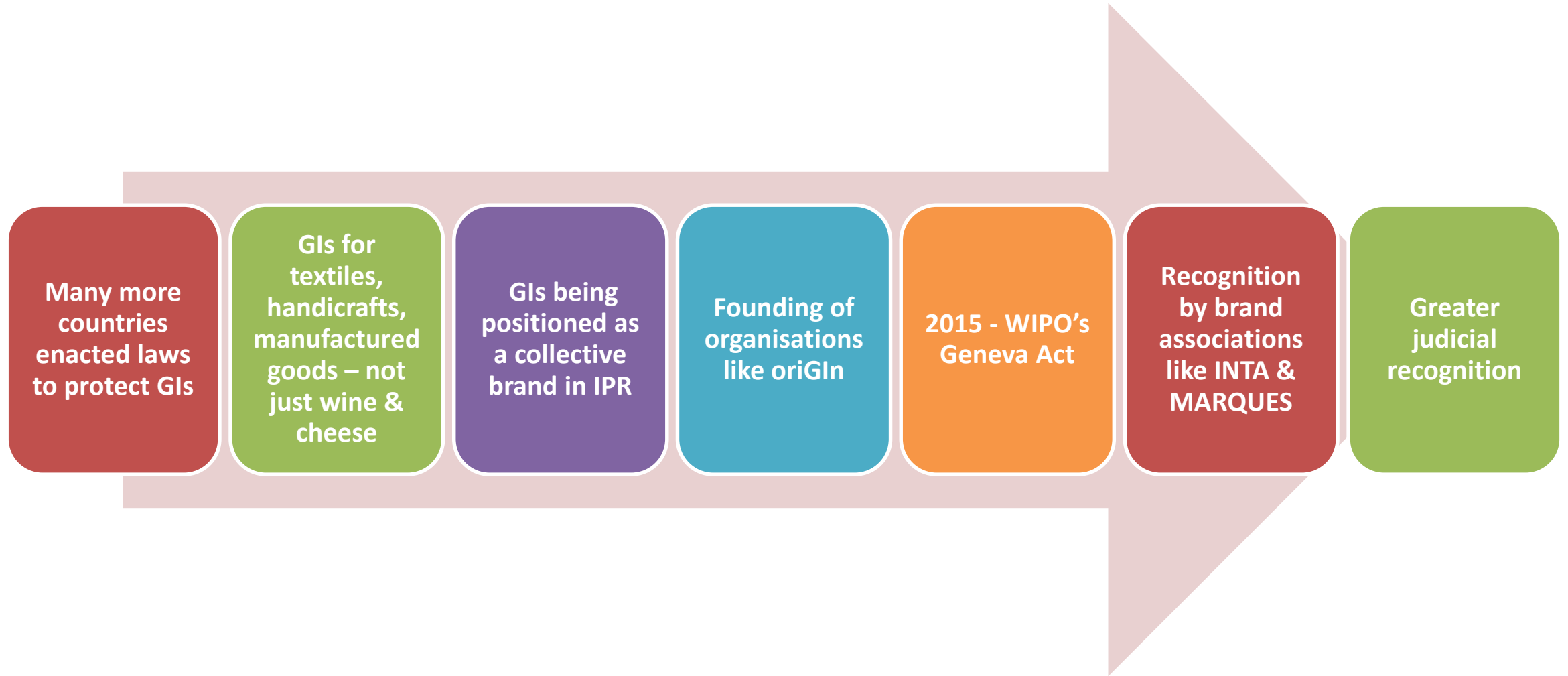
- Dyer Meakin Breweries v Scotch Whisky Association (1980)
- Scotch Whisky Association & Anor v Parvara Sahakar Shakar Karkhana Ltd (1992)
- Khoday Distilleries Ltd v Scotch Whisky Association & Anor (1999)



New Zealand

- Wineworths Group Ltd V Comité Interprofessionnelle du Vin de Champagne (New Zealand 1992)

GI Protection post 2001



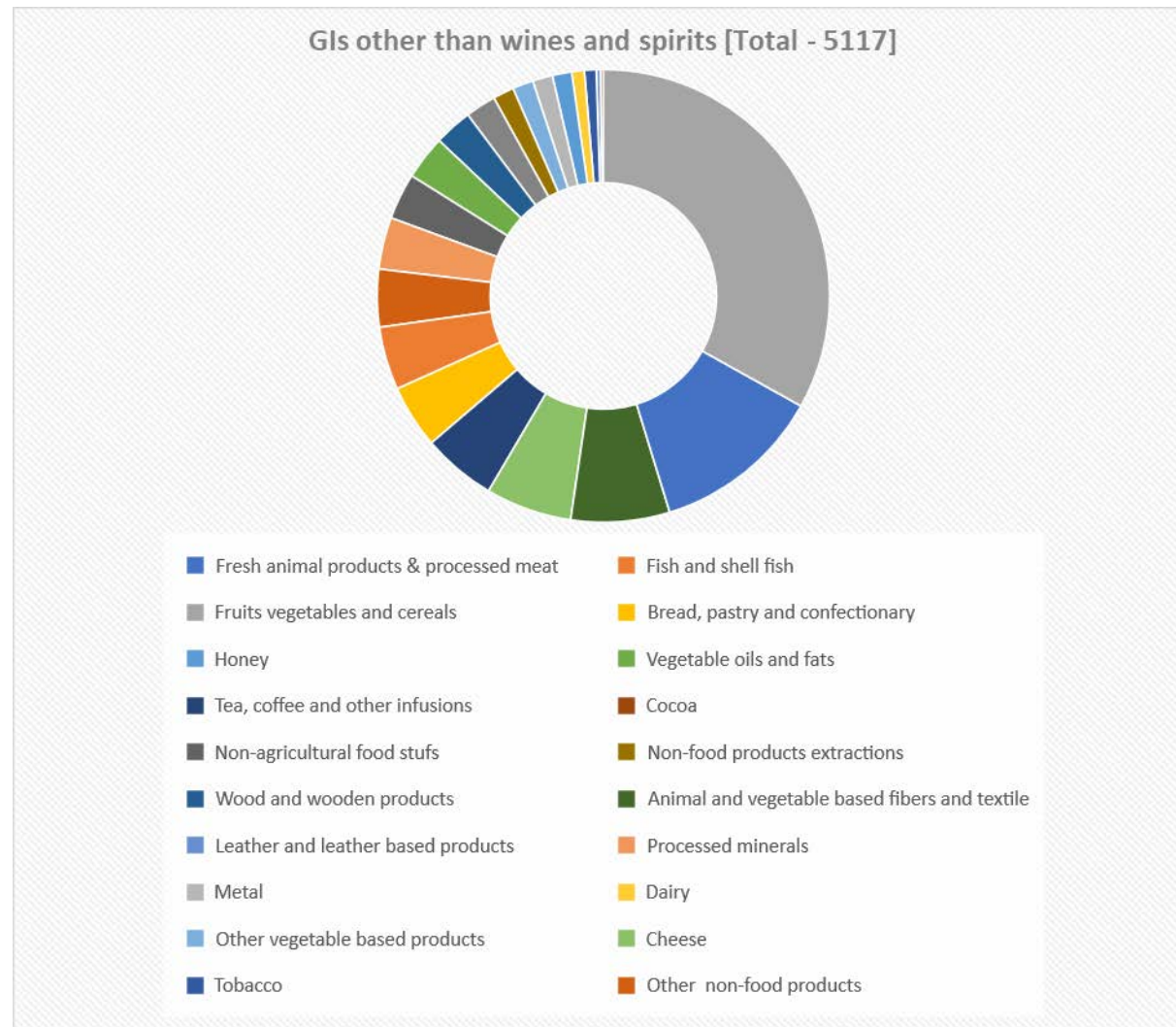
Some countries that enacted laws post 2001 to protect GIs



Other GI based developments post 2001

Not just wines and spirits!

EC green paper consultation and study on possible GI protection for non-agricultural products



Other GI based developments post 2001

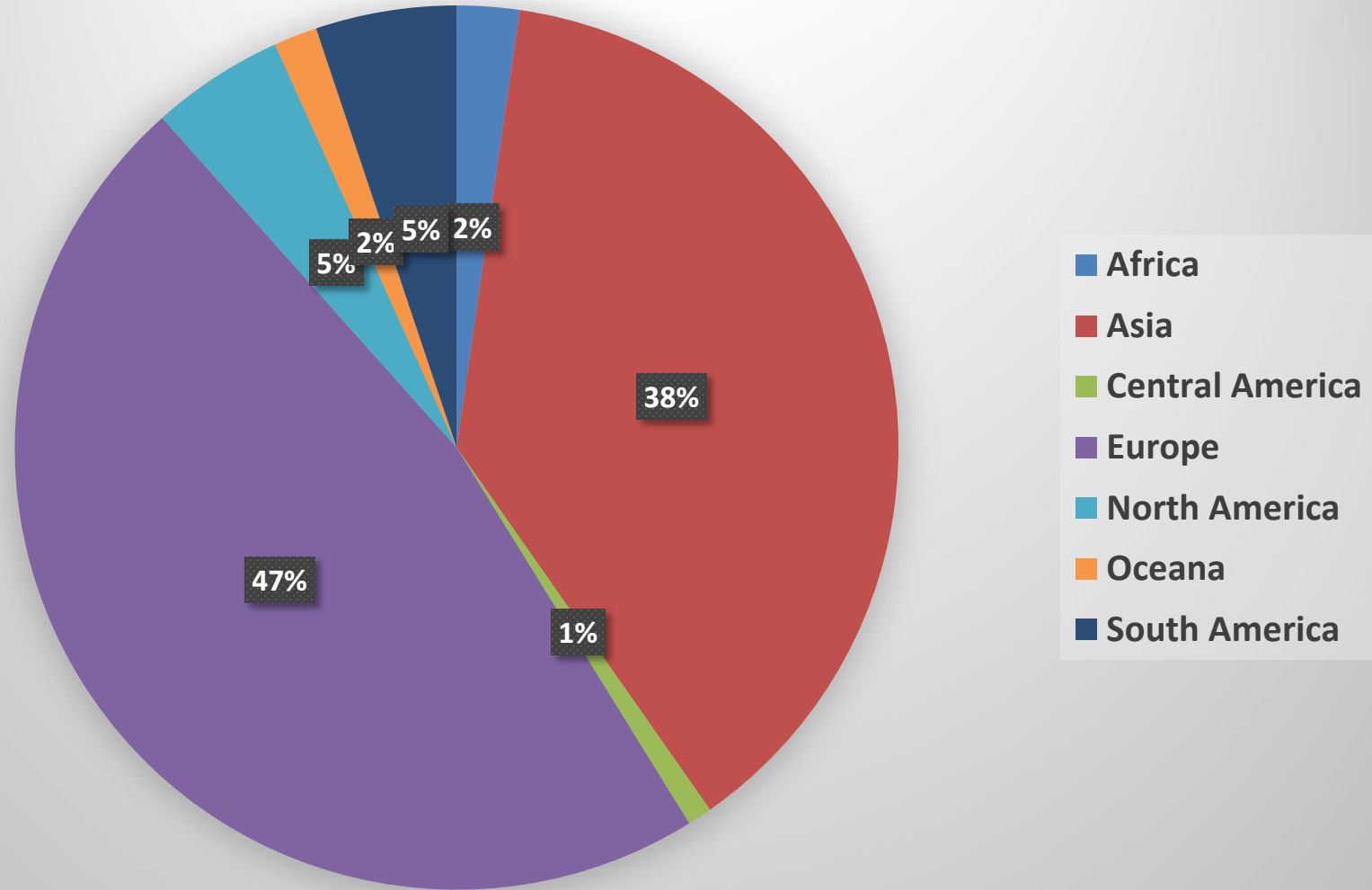
Establishment of oriGin in
2003

Advancing the cause of GIs

Represents about 500
associations of producers &
other GI-related institutions
from 40 countries.

The logo for oriGIn features the word "oriGIn" in a bold, lowercase sans-serif font. The letter "G" is significantly larger than the other letters and is contained within a solid green square. The letters "ori" and "In" are in black, while the "G" and its square are green.

Compilation of worldwide GIs by oriGin - 8131



Other GI based developments post 2001

Interest in GIs by other brand associations – confirms GI brand power

INTA, MARQUES & ECTA

Food & Agriculture Organisation (FAO) – GIs a tool for social & economic progress



The Geneva Act, 2015

Extends protection to all GIs covered by the TRIPs definition

Accommodates the existing 'legal means' for protection of GIs

Prevents use of a GI for a good in respect of a service under certain circumstances



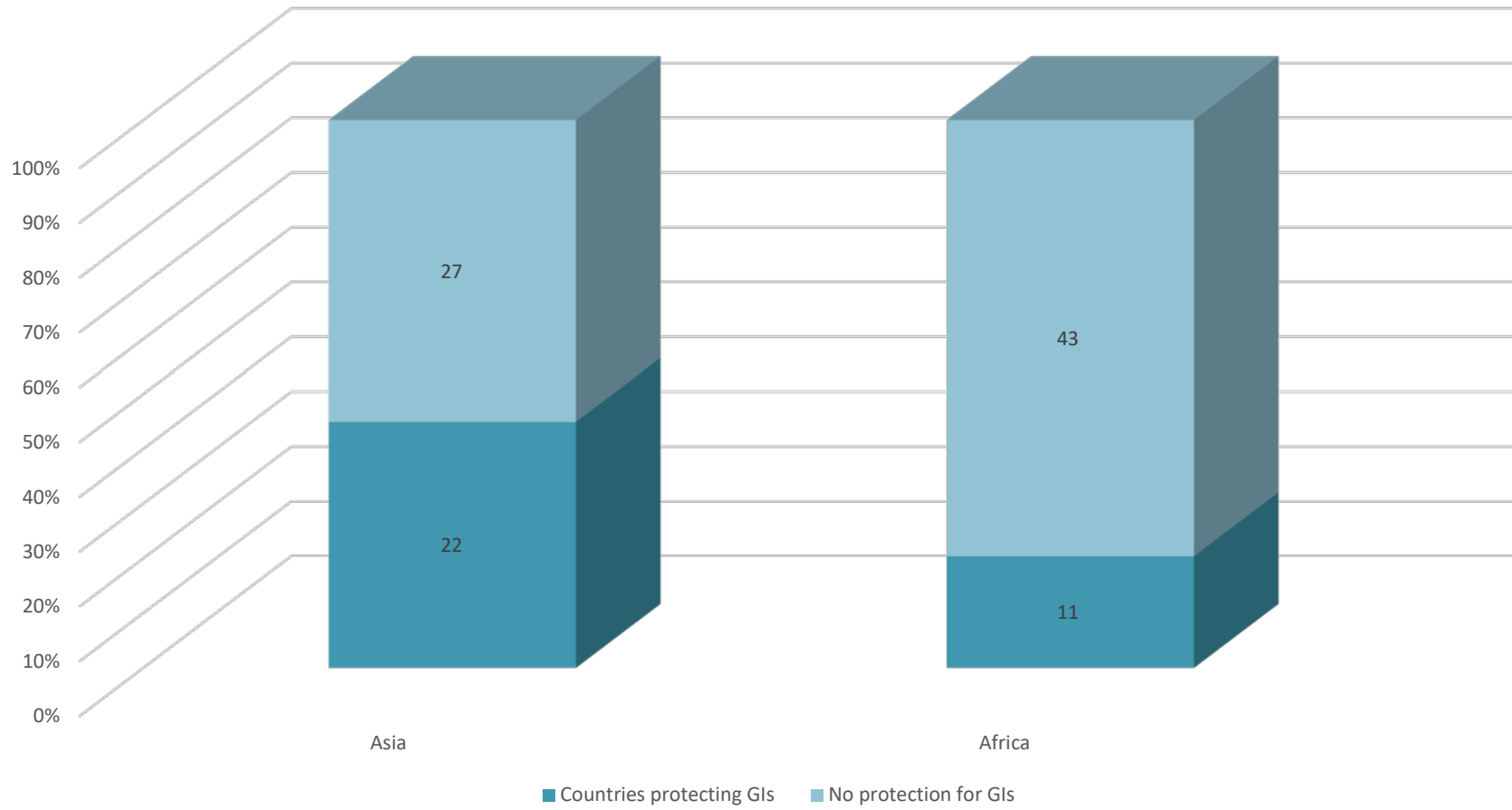
Interest by Asia and Africa in GIs

Many Asian countries fall in the silk road and spice route

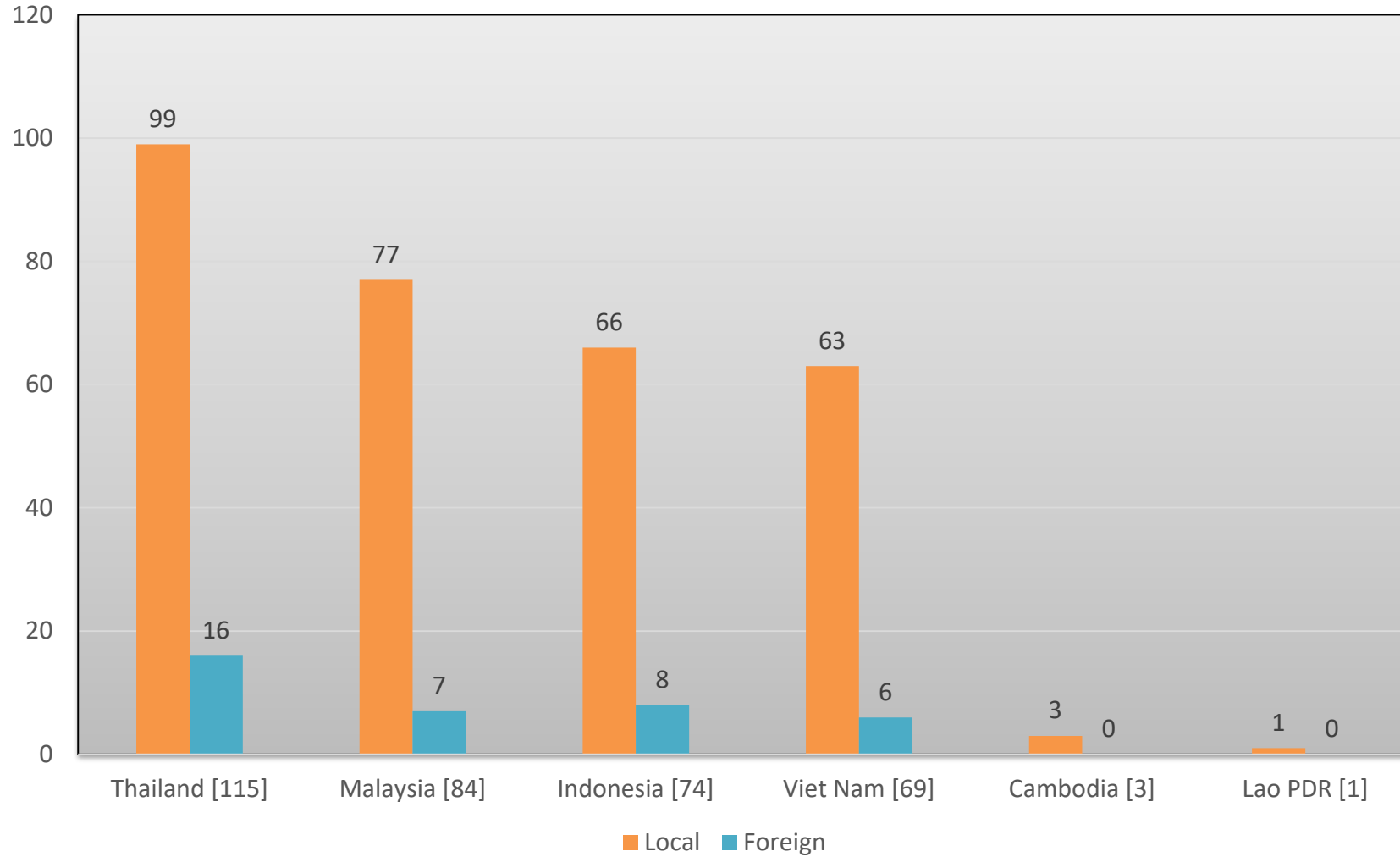
This historical connection is reflected in the GIs from these regions

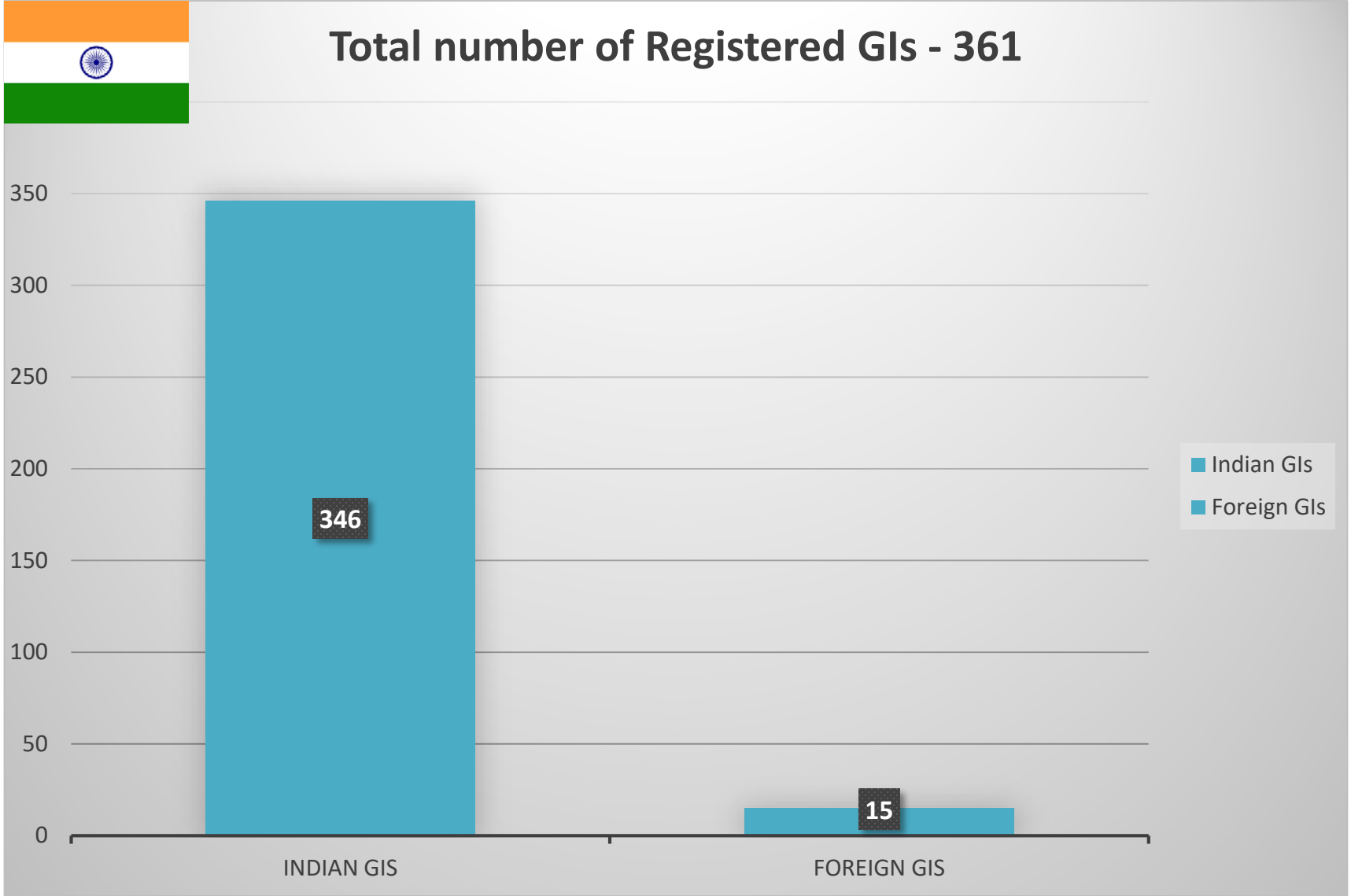


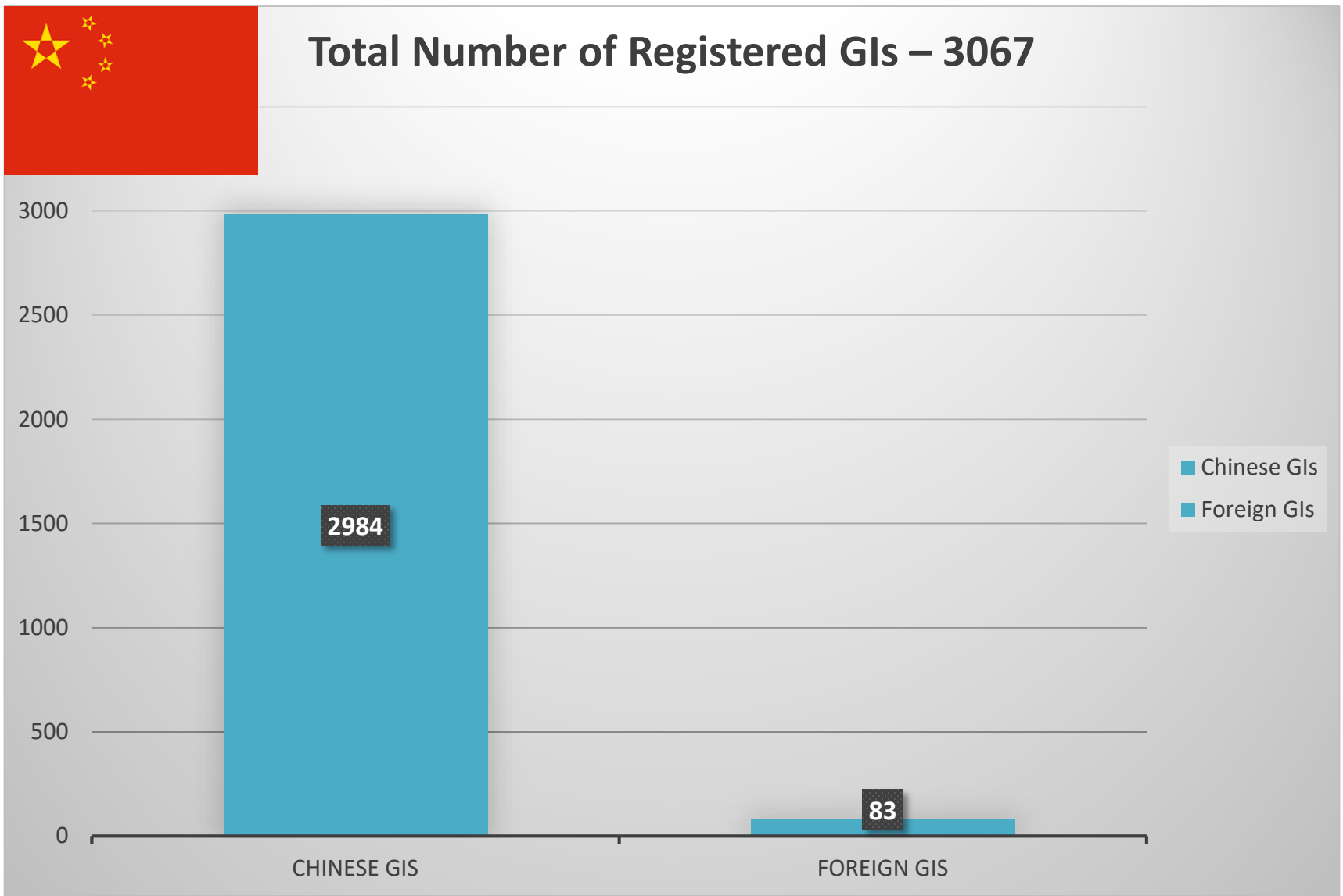
Asian and African countries protecting GIs



346 GI Registrations in the ASEAN region as of January 2019







What if GIs are not integrated into the DNS?

Much has happened post 2001; most importantly, GI protection regimes are now global.

GIs, as an IP right, have come to the forefront in the last 18 years; they are recognized for all kinds of goods and in some countries even for services

Number of right holders and nature of the right are important - unlike TMs, GIs are collective rights and enrich an entire community, economically and socially.

You cannot any longer wish away GIs while discussing IP – it would be simply unfair and untrue!

The 2nd Domain name report outdated?

2nd Domain Name report no longer fits global trends because:

- Overwhelming evidence of GI policy development across the world today
- Rise in use of specific GI legal instruments of protection, all seeking protection of IP rights of local producers
- True that the legal instruments of GI protection differ – but so long as the means are legal, the ends are justified and must be considered
- While GIs are protected mostly in respect of goods, many countries prevent dilution of GIs in contexts of use against similar or dissimilar services

The 2nd Domain name report outdated?

Many judicial precedents around the world holding that registration of a GI for services violate GI rights

- Basmati Bus (class 43)
- Champagnothèque (35, 41 & 43)
- Le Champagne Hotel (43)
- Darjeeling (16, 35, 41)



GI Protection in an inclusive world

With the new reality of global protection of GIs, the DNS policies in respect of GIs are incongruent and difficult to justify

GIs strengthen cultural and historic moorings across the world – E.g., GIs on the spice route and silk road

With the proliferation of online trade in the last decade, denial of a place for GIs in DNS is hugely disadvantageous to right holders and consumers

Besides it hampers many GI associations who are cash strapped to take on a legal fight

In a world that is advocating for more and more inclusiveness, keeping GIs still out of the DNS is indeed resulting in a jarring note

Ending on a positive note....

Champagne.in award by the National Internet Exchange of India (NIXI) May 2012 .

CIVC has a registered GI for Champagne in India, but no certification marks or trademarks.

CIVC came across a domain name, “Champagne.in” by the registrant, “India Portals”

Since the registrant never responded to a C&D notice, CIVC filed a complaint under INDRP (identical to UDRP) to transfer champagne.in

CIVC argued that India Portals was a cyber squatter who had registered nearly 530 generic words as domain names without any intention to use

Ending on a positive note....

Absent a response by India Portals, the arbitrator issued an ex-parte award holding that:

- **Bad faith under Para 6(ii) of INDRP [identical to para 4(b)(ii) of UDRP], is established from the Registrant's pattern of conduct**
- **While para 6(ii) does not include GIs, going by the legislative intent and avoiding a literal interpretation thereof, similar weightage must be given to GIs as that of trademarks**
- **CIVC has always opposed / addressed third party attempts in India to register trademarks with the name 'Champagne'**

Let there be no
Cinderellas in
intellectual
property...



'Cinderella' (1863) by Edward Burne-Jones, Museum of Fine Arts, Boston, US, Public Domain, <https://commons.wikimedia.org/w/index.php?curid=32045853>



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