

Policy Status Report: Uniform Domain Name Dispute Resolution Policy (UDRP)

oriGIn inputs

Introduction

oriGIn is the global alliance of Geographical Indications (GIs) groups and institutions (576 member organizations from 40 countries) dedicated to:

- i. campaigning for robust protection of GI in national laws and international treaties;
- ii. and promoting a model of managing value chains which is poised to respond to the emerging sustainability (economic, social and environmental) challenges.

Our concerns

In 2021, a record of 5,128 cases under the Uniform Domain Name Dispute Resolution Policy (UDRP) were filed under the WIPO Arbitration and Mediation Center (+22% from 2020).

Bad faith registrations of second level domain names in gTLDs (as well as in ccTLDs) affect also GIs. Such registrations consist of, or contain, GIs. There is “appetite” for using valuable and distinctive geographical names in the domain name environment. The attribution of new gTLDs in 2012 has increased the problem, in particular with respect to strings such as “.wine”, “.bio”, “.food”, “.pizza” and “.coffee”.

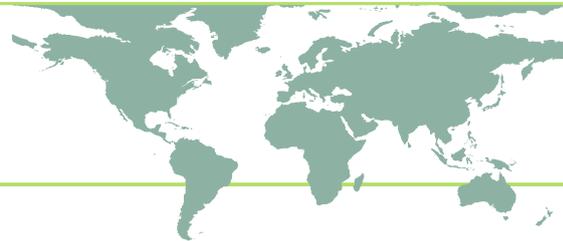
Our comments on the UDRP efficiency, fairness and capacity to address abuse

Does the UDRP provide trademark holders with a quick and cost-effective mechanism for resolving domain name disputes?

Yes. Among the remedies available to trademark holders to fight bad faith registrations, the UDRP has proved to be an effective administrative procedure.

Does the UDRP allow all relevant rights and interests of the parties to be considered and ensure procedural fairness for all concerned parties?

No. The UDRP is unfair as a curative mechanism to the extent that to activate its procedure, a party can rely exclusively on trademarks. The rights and interests of holders of another relevant category of Intellectual Property Rights (IPRs) which can be abused in the domain name environment – Geographical Indications (GIs) – are ignored by the UDRP.



GIs represent an internationally accepted category of IPRs, protected via the WTO TRIPs, the WIPO Lisbon Agreement and its Geneva Act, hundreds of bilateral agreements as well as national laws.

We estimate that at least 12,000 GIs are currently recognized in national jurisdictions, the large majority of which under independent systems of protection¹. GIs generate significant economic, social and environmental value for producers, transformers and distributors around the world (mainly small and medium sized enterprises, in the vast majority of cases small farmers).

Has the UDRP effectively addressed abusive registrations of domain names?

Several right holders rely exclusively on GIs (in other words, on geographical names protected under independent systems). Those rights and interests are excluded altogether from the UDRP.

Some right holders, on top of GIs, for practical reasons rely on trademarks as well. Their objective is to protect their geographical names in the few jurisdictions around the world where an independent system of protection is not available. For those rights and interests, the UDRP procedure has not always proved to be effective. Often in the case law, while protected via a trademark, for such geographical names there are additional burdens which makes it impossible to prove the exploitation of their reputation. Some examples of the discrimination faced by GIs, even when protected via trademarks, in the WIPO Arbitration and Mediation Center case law, are the following: Case No. D2021-0690, Case No. D2018-0168, Case No. D2017-0253 and Case No. D2017-0554.

Evolution since 1999

The UDRP is an ICANN policy that went into effect on 24 October 1999. Since then, the international landscape for GI has changed:

- a. As previously mentioned, the majority of jurisdictions around the world provide independent systems to protect GIs. Lists of protected rights, which clearly indicate the respective holders, are now available in all countries;
- b. Several ccTLDs expressly considered GIs valid titles to activate curative mechanisms and systems work in practice;
- c. The wine industry and Donuts reached a private agreement proving specific safeguards for GIs in the context of the attribution of the strings “.wine” & “.vin”;
- d. It became clear that extending the UDRP to GIs would not raise problems in terms of depth of protection, as the UDRP provides safeguards for legitimate uses of second level domain names.

¹ Some 9.000 of them have been already identified in the oriGIn GIs worldwide compilation: <https://www.origin-gi.com/worldwide-gi-compilation/>



Our proposal

In light of the above, oriGIn believes that, to make the UDRP fully compatible with the internationally accepted IPRs system, GIs should be considered as valid prior rights to activate the UDRP procedure.

One single and simple amendment to the UDRP (**point 4.a.i of the Policy**) is needed to achieve this:

The domain name is identical or confusingly similar to a trademark, ~~or~~ service mark or geographical indication in which the Complainant has rights;