



POLICY
PAPER

Strategies for Protection of Geographic Names including

Geographical Indications in the Domain Names System

ISHA SURI

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Isha Suri¹

1. Introduction and Scope

“Any implementation undertaken now should be based on an assumption of a much larger Internet.”²

Since the inception of the global Internet, it has transgressed legal borders. The Domain Name System (DNS) is central to the operation and accessibility of this global network.³ DNS administration and policy authority is further managed by the Internet Corporation for Assigned Names and Numbers (ICANN). Since its inception in 1998, ICANN has been charged with promoting competition in the registration of domain names while ensuring the security and stability of the DNS. In 2000 and 2003, ICANN conducted a limited expansion of gTLDs.

Thereafter, in 2005, ICANN's Generic Names Supporting Organization (GNSO) began a policy development process to consider the introduction of new gTLDs, based on the results of trial rounds conducted in 2000 and 2003.⁴ ICANN believed that expansion of the gTLD space would provide a platform for city, geographic, and internationalized domain names, among other things. It also posited that this type of change to the DNS would enhance consumer trust and choice and reinforce the global nature of the Internet.⁵

Subsequently, ICANN announced in June 2008 the commencement for expanding the top-level domains to various applicants. In a pamphlet published and distributed in 2009 in the New gTLD Program policy implementation process, ICANN projected ‘anything from hundreds to thousands’; the first new gTLD opened for general registration in 2014 which ultimately led to 1,930⁶ applicants with over 1200⁷ new gTLDs delegated.

With the expansion of new gTLDs, different stakeholder groups have voiced divergent views with respect to delegation of geographic names at the TLD. With the Government Advisory Committee at ICANN emphasising that new gTLDs should respect the sensitivities regarding

¹ The author would like to thank Srishti Sinha and Samuel Augustine for their research assistance during the writing of this paper.

² David D. Clark, MIT Laboratory for Computer Science, July 1982.

³ Forrest, Heather Ann, Protection of Geographic Names in International Law and Domain Name System, Kluwer Law International BV, 2017.

⁴ Statement of Fiona M. Alexander, Associate Administrator, Office of International Affairs (NTIA), available at: <https://www.govinfo.gov/content/pkg/CHRG-112shrg74251/html/CHRG-112shrg74251.htm>, (last accessed on June 29, 2021).

⁵ Ibid.

⁶ Ibid.

⁷ Domain Name Registration's Statistics, available at: <https://domainnamestat.com/statistics/overview>, (last accessed on June 29, 2021).

terms with national, cultural, geographic, and religious significance.⁸ The IPC on the other hand has been taking a contrary view to the GAC advice on the grounds that any objection to the use of a geographic term that is determined to be of either national, cultural, geographic, or religious significance to a particular country or region has no legal basis, whether under agreed principles of international law or national sovereignty.⁹ A lot of stakeholders, especially business owners have sought greater predictability while at large has advocated for safeguards to protect end users in the form of expanding the definition of Geographic Names to include the ISO-4217 list, having stronger protection mechanisms for non-capital city names, to name a few. Discourse around Geographical Indications, however, has been muted until recent past.

Along with the unprecedented numbers of applications came certain challenges. The addition of new gTLDs to the DNS created an additional burden for trademark holders by giving rise to the need to police not only the parameters of an ideal application for new gTLDs but also for all the second-level domain names that will be registered within each new top-level domain. Other than trademarks, the World Intellectual Property Organization (WIPO), the United Nation (UN) body that administers the major international treaties respecting intellectual property rights (IPRs), expressed a ‘problem of bad faith, abusive domain registration that violate IPRs other than trademarks or service marks’¹⁰. which directed towards geographical indications and other geographic identifiers

In the years since, disputes between governments asserting rights in geographic names and unauthorized registrants of geographic domain names have remained largely contentious with frequent back and forth. Recently, various divergent voices have reached a compromise in so far as the next round of gTLD applications is concerned. However, few issues remain ambiguous such as protections offered to Geographical Indications (GIs).

Through this paper, we will walk you through distinction between Geographic Names (geonames) and Geographic Indications. Thereafter, we will shed light on the treatment of both geonames and GIs in the DNS and the protection mechanisms in place for each of these. Chapter 4 of the paper will provide an Indian overview of the issue. Lastly the paper would end with policy recommendations based on our research and analyses. It is also important to note that the scope of this paper is largely limited to gTLDs, even though we do draw references from ccTLDs in other jurisdictions and as a by-product make references to treatment of GIs at the second level. But by and large our focus has been on gTLDs in so far as Geonames is concerned.

⁸ GAC Principles Regarding new gTLDs, Mar 2007, available at: <https://gac.icann.org/contentMigrated/gac-principles-regarding-new-gtlds>, (last accessed on Jun 29, 2021).

⁹ Joint Statements of Internet and Geographic Indications Committees on Geographic Names in the Domain Name System (DNS), ICANN Webinar on Geographic Names Subsequent Procedures Policy Development Working Group, Apr 25, 2017.

¹⁰ WIPO Internet Domain Name Process. <https://www.wipo.int/amc/en/processes/process1/report/finalreport.html>. Accessed June 02, 2021.

2. Geographic Names and Geographical Indications

The principle of ‘territoriality’ is usually referred to while deliberating policies in the realm of ‘geographical names’ or ‘geographical indications’ owing to their territorial nature. However, there is no international law that requires that a country have a name to be considered a ‘country’ or a ‘sovereign state’, and the agreed definitions setting out what is required to be considered a “country” make no mention of having a name.¹¹ According to established principles of International Law, countries do not have sovereign rights in their names because having a name is not a requirement of their sovereignty. Furthermore, laws are ‘territorial in nature’, implying that a country’s laws have effect only within a country’s borders and countries cannot dictate conduct outside their borders.¹² Therefore laws governing use of geographic names or property rights cease to have an effect beyond a country’s sovereign borders. This means that any national laws restricting the use of geographic names apply in that country only; they do not ordinarily apply to others outside of the country.¹³

While discussing ‘geographic names’ and ‘geographical indications’, it is important to understand that not all geographic names are geographical indications. Also, GIs are an internationally recognised intellectual property right,¹⁴ while geonames *per se* are not protected by any international law or treaty. Therefore, only a ‘geographical name’ which constitutes a geographical indication within the meaning of intellectual property law could be protected.¹⁵ It is important to note that GIs are a very small subset of Geographic Names.¹⁶ In the later parts of this paper, we will examine the treatment meted out to both Geographic Names and GIs.

2.1 Geographic Names and New gTLDs Subsequent Procedures

In 2017, ICANN initiated a separate Work Track, also known as the Work Track 5 as a sub-group within the New gTLD Subsequent Procedures Policy Development Process (PDP) Working Group (WG).¹⁷ The Work Track 5 focused solely on the issue of geographic names at the top level. The sub-group has completed deliberations and submitted its final report to the GNSO Council. The final report submitted by this group is part of the Final Report on new gTLD subsequent procedures submitted by the GNSO Council to the ICANN Board for its

¹¹ Dr Heather Ann Forrest, International Law On Geographic Names: Context For ICANN Policy-Making, GnsO Subsequent Procedures Pdp Webinar – Geographic Names, Apr 25, 2017, available at: <https://community.icann.org/download/attachments/64077479/Heather%20Forrest%20Legal%20Framework%20Paper.pdf?version=1&modificationDate=14927698900>, (last accessed on Jun 29, 2021).

¹² Ibid.

¹³ Ibid.

¹⁴ Article 22, TRIPS, available at: https://www.wto.org/english/docs_e/legal_e/27-trips_04b_e.htm, (last accessed on June 29, 2021).

¹⁵ Jerome Passa's Analysis - wine and vin, Mar 22, 2014, available at: <https://www.icann.org/resources/files/analysis-wine-vin-2014-03-22-en>, (last accessed on Jun 29, 2021).

¹⁶ Joint Statements of Internet and Geographic Indications Committees on Geographic Names in the Domain Name System (DNS), ICANN Webinar on Geographic Names Subsequent Procedures Policy Development Working Group, Apr 25, 2017.

¹⁷ Work Track 5: Geographic Names at the Top-Level, available at: <https://community.icann.org/display/NGSPP/Work+Track+5%3A+Geographic+Names+at+the+Top-Level>, (last accessed on June 28, 2021).

deliberation and future action.¹⁸ It is important to note that the Work Track 5 was constituted with the premise that if the WG failed to arrive at a consensus during its deliberations, then status-quo with respect to Geographic Names would be maintained. Essentially, this meant that Geographic Names would continue to be defined, treated, and protected similar to the 2012 round. Since the Working Group could not arrive at a consensus on various issues that were deliberated including but not limited to requirement of letter of support for non-capital city names, including categories of terms not included in the previous round such as names of rivers, mountains, non-ASCII geographic terms, geographic indications,¹⁹ and including currency codes (ISO-4217).²⁰

However, after extensive deliberations, the Work Track was unable to agree to recommendations that depart from the 2012 implementation, which it has considered the baseline throughout discussions between the WG. Consequently, it recommended updating the GNSO policy to be consistent with the 2012 Applicant Guidebook and largely maintaining the Applicant Guidebook provisions for subsequent procedures.²¹

2.2 Treatment of Geographic Names in the 2012 Round

During the 2012 application round, 66 applications designated themselves as geographic names applications (GeoTLDs).²² According to the Geographic Names Panel's review, six of these 66 self-designated applications did not fall within the criteria for a geographic name as per the AGB. These included the following: Vegas, Zulu, Ryukyu, Scot, Ist, FrI. Also, the panel identified 3 applications that did not self-identify as geographic names, however, as per the definition of AGB these strings were indeed 'geographic names', these included: Tata, Bar, Tui. Ultimately, 63 'strings' fell within the scope of geographic name out of which 56 had acceptable letter of support from relevant government authority. A total of 54 of these strings have been delegated.²³

¹⁸ Final Report on the new gTLD Subsequent Procedures Policy Development Process, Feb 1, 2021, ICANN, available at: <https://gns0.icann.org/sites/default/files/file/field-file-attach/final-report-newgtd-subsequent-procedures-pdp-02feb21-en.pdf>, (last accessed on June 28, 2021).

¹⁹ Supplemental Report on the new gTLD Subsequent Procedures Policy Development Process (Work Track 5 on Geographic Names at the Top Level), Dec 12, 2018, ICANN, available at: <https://gns0.icann.org/sites/default/files/file/field-file-attach/subsequent-procedures-geo-names-supp-initial-05dec18-en.pdf>, (last accessed on June 26, 2021)

²⁰ Work Track 5: Geographic Names at the Top-Level, available at: <https://community.icann.org/display/NGSPP/Work+Track+5%3A+Geographic+Names+at+the+Top+Level>, (last accessed on June 28, 2021). *Also see:* Supplemental Initial Report on the New gTLD Subsequent Procedures Policy Development Process, (Work Track 5 on Geographic Names at the Top Level), available at: <https://gns0.icann.org/en/issues/new-gtlds/subsequent-procedures-geo-names-supp-initial-05dec18-en.pdf>, (last accessed on June 28, 2021).

²¹ Ibid.

²² Michael Berkens, New gTLD's By The Numbers: 1930 Apps, 751 Apps In Conflict; Max Number of New gTLD's 1,409, June 13, 2012, available at: <https://www.thedomains.com/2012/06/13/new-gtlds-by-the-numbers-1930-apps-751-apps-in-conflict-max-number-of-new-gtlds-1409/>, (last accessed on June 27, 2021).

²³ Work Track 5 Final Report to the New gTLD SubPro PDP WG, Pg. 7-8, Oct 22, 2019, ICANN, available at: <https://www.icann.org/en/announcements/details/work-track-5-on-geographic-names-at-the-top-level--supplemental-initial-report-of-the-new-gtd-subsequent-procedures-policy-development-process-5-12-2018-en>, (last accessed on June 28, 2021).

In this section, we seek to discuss a few GeoTLD applications filed in the previous round and shed light on some of the issues that come up during examination and delegation of strings with Geographic Names. In the interest of brevity, we will not be discussing all the applications, however, due care has been exercised to select applications that bring out every nuance of the process. Furthermore, we are not limiting our analyses only to applications deemed to be Geographic Names as per the definition of the AGB (2012), alone since we want to highlight that some applications may not fall within the ‘definition’ but have witnessed resistance from communities or nations on account of cultural sensitivities associated with a particular string.

Largely, we will be discussing applications demonstrating at least one or more of the following issues: (i) GAC Early Warning, (ii) GAC Consensus Advice, (iii) Withdrawn, and (iv) Contractual obligations in the form of Public Interest Commitments or private settlement, among others. Thereafter, we will also take examples of some GeoTLDs being used by for commercial as well as administrative purposes to demonstrate the use of GeoTLDs.

i. GAC Early Warning: Though not a formal objection, GAC Early Warning is a notice from members of GAC that an application is seen as potentially sensitive or problematic by one of the governments.²⁴ A total of 18 GAC Early warnings were issued for concerns related to geographic nature of the string, these included .patagonia, .africa, zulu, 广州 (Chinese script for Guangzhou), and, 深圳 (Chinese script for Shenzhen), among others.²⁵ Out of all these GAC Early Warnings, the Geographic Names panel considered Roma, Africa, 广州 [Guangzhou], and 深圳 [Shenzhen] were considered by the Geographic Names Panel to fall within the criteria for a geographic name as per the AGB.²⁶ The Government of Switzerland also issued an Early Warning for a new gTLD application filed by .swiss on the grounds that the .swiss domain should be managed by the Swiss Confederation as a community based gTLD application for the benefit of all members of the Swiss community including private companies. Even though, .swiss is not a ‘geographic name’ when viewed strictly from the lens of definition of Geographic names in the AGB, the Government of Switzerland argued that new gTLDs should respect the sensitivities regarding terms with national, geographic, cultural and religious significance.²⁷ It also highlighted, that according to Swiss trademark protection legislation, the designation

²⁴ GAC Early Warning, ICANN, available at: <https://newgtlds.icann.org/en/applicants/gac-early-warning#:~:text=An%20Early%20Warning%20is%20a,in%20rejection%20of%20the%20application.>, (last accessed on June 27, 2021).

²⁵ GAC Early Warnings, Feb 19, 2019, available at: <https://gac.icann.org/activity/gac-early-warnings>, (last accessed on June 27, 2021).

²⁶ Work Track 5 Final Report to the New gTLD SubPro PDP WG, Pg. 7-8, Oct 22, 2019, ICANN, available at: <https://www.icann.org/en/announcements/details/work-track-5-on-geographic-names-at-the-top-level--supplemental-initial-report-of-the-new-gtld-subsequent-procedures-policy-development-process-5-12-2018-en>, (last accessed on June 28, 2021).

²⁷ GAC Early Warning – Submittal Swiss-CH-36248, <https://gac.icann.org/work-products/public/swiss-ch-36248-2012-11-20.pdf>, (last accessed on June 27, 2021).

‘Swiss’ denotes geographical origin in relation to goods or services. In 2015, ‘.Swiss’ was delegated as a community application with Swiss Confederation as the applicant.²⁸

- ii. GAC Consensus Advice:** During ICANN 47 meeting held in Durban, the GAC issued consensus advice on the application for .amazon and its related IDNs in Japanese and Chinese,²⁹ and the application of .thai which is a transliteration of Thailand’s IDN ccTLD.³⁰ In the case of ‘.thai’ the NGPC accepted GAC Consensus advice and stated that the application would not be approved and the applicant had the option of withdrawing as per the terms and conditions or appealing against this decision.³¹ The application was ultimately withdrawn. With regard to ‘amazon’, predominantly relying on the GAC’s consensus objection, the NGPC (ICANN’s New gTLD Program Committee) rejected Amazon’s (a globally well recognised e-commerce company) applications. It is also important to note that technically, “Amazon” did not fall under the definition of Geographic Names since it was not mentioned on the 3166-2 list.³² Thereafter, Amazon’s request for reconsideration was rejected by ICANN’s Board Governance Committee on August 22, 2014. Subsequently, Amazon filed a Notice of Independent Review with the International Centre for Dispute Resolution on March 1, 2016. The IRP declared that Amazon has established that ICANN’s Board, acting through the NGPC, acted in a manner inconsistent with ICANN’s Bylaws. Further, the GAC, as a constituent body of ICANN, failed to allow the applicant to submit any information to the GAC and thus deprived the applicant of the minimal degree of procedural fairness before issuance of its advice, as required by the Bylaws. Ultimately, in 2019 the Board approved processing of the .amazon applications according to the policies and procedures of the New gTLD Program. This also included publication of Public Interest Commitments (PICs) undertaken by Amazon Corporation to protect the culture and heritage of the Amazonia People.³³ The company also explicitly agreed to not apply for gTLDs with the names (or words) “Amazonas,” “Amazonia” and close variants thereof.³⁴ The amazon dispute also demonstrates how additional contractual obligations in the form of PICs may be employed to arrive at a mutually acceptable

²⁸ Application Details, available at: <https://gtldresult.icann.org/applicationstatus/applicationdetails/906>, (last accessed on June 27, 2021).

²⁹ GAC Communiqué – Durban, South Africa, July 18, 2013, ICANN, available at: <https://gac.icann.org/advice/communiqués/public/gac-47-durban-communique.pdf>, (last accessed on June 27, 2021).

³⁰ Michael Berkens, Organization That Run Thailand’s ccTLD (.Th) Objects To new the gTLD .Thai, August 18, 2012, available at: <https://www.thedomains.com/2012/08/18/organization-that-run-thailands-cctld-th-objects-to-new-the-gtld-thai/>, (last accessed on June 27, 2021).

³¹ ICANN Board New gTLD Program Committee Scorecard in response to GAC Durban Communiqué, Sept 10, 2013, ICANN, available at: <https://www.icann.org/en/system/files/files/resolutions-new-gtld-annex-1-10sep13-en.pdf>, (last accessed on June 27, 2021).

³² *AMAZON EU S.A.R.L. – Internet Corporation of Assigned Names and Numbers*, ICDR No. 01-16-0000-7056, July 10, 2017.

³³ ICANN Correspondence, April 17, 2019, available at: <https://www.icann.org/en/system/files/correspondence/huseman-to-chalaby-17apr19-en.pdf>, (last accessed on June 27, 2021).

³⁴ *AMAZON EU S.A.R.L. – Internet Corporation of Assigned Names and Numbers*, ICDR No. 01-16-0000-7056, July 10, 2017.

solution. Even though, in the case of .amazon, the Government of Brazil expressed its displeasure at ICANN Board's decision and stated that this decision undermined the rights of sovereign States.³⁵

iii. Withdrawn due to lack of predictability: An application that demonstrates lack of predictability and its deleterious impact on the applicant, is application for .tata. Tata Sons submitted an application for .tata in 2013, and the application was deemed to be a geographic name since Tata is a province in Morocco.³⁶ In order to comply with the non-objection certificate (NOC) requirement, the company submitted a letter from the Office of the Moroccan Industrial and Commercial Property (OMPIC) and Ministry of Industry, Trade, Investment and Digital Economy of the Kingdom of Morocco.³⁷ Consequently, the company passed the initial evaluation stage. However, the Moroccan Government later denied its support on the ground that it did not receive any formal communication from the authority in charge of the DNS policy and regulation or from any local authority from the Tata province in Morocco.³⁸ As a result, the application had to be re-evaluated, however, the company later withdrew its application ('did not proceed'). Through this case it is evident that lack of clarity on issues such as which authority is responsible for issuing an NOC can cause unnecessary delays and discourage bona fide applicants.

iv. Settlement between parties – wine/vin: While, amazon was an example of PICs being incorporated to help attain necessary approvals for delegation. In the case of .wine/vin, Donuts arrived at a private settlement with wine regions and European Union to settle this issue.³⁹ To give a brief background, an application for delegation of .wine was filed by three applicants,⁴⁰ and ultimately Donuts became the only applicant for .wine and .vin (for .vin Donuts was the only applicant) by prevailing in private auctions.⁴¹ The Government of France and Luxembourg filed a GAC Early Warning on the grounds that wine is a product

³⁵ ICANN Says Amazon Inc's Application for .AMAZON TLD Can Proceed Following 30 Days of Public Comment, Circle ID (online), available at: https://www.circleid.com/posts/20190520_icann_says_amazon_inc_application_for_dot_amazon_can_proceed/, (last accessed on June 27, 2021).

³⁶ Work Track 5 Final Report to the New gTLD SubPro PDP WG, Pg. 7-8, Oct 22, 2019, ICANN, available at: <https://www.icann.org/en/announcements/details/work-track-5-on-geographic-names-at-the-top-level--supplemental-initial-report-of-the-new-gtld-subsequent-procedures-policy-development-process-5-12-2018-en>, (last accessed on June 28, 2021).

³⁷ ICANN Correspondence, Feb 12, 2015, available at: <https://www.icann.org/en/system/files/correspondence/nage-to-atallah-12feb15-en.pdf>, (last accessed on June 27, 2021).

³⁸ Kevin Murphy, Tata's bid for .tata gTLD scuppered by Morocco, Dec 20, 2015, Domain Incite (online) available: <http://domainincite.com/19729-tatas-bid-for-tata-gtld-scuppered-by-morocco>, (last accessed on June 27, 2021).

³⁹ Kevin Murphy, Donuts makes private deal with wine-makers, Domain Incite (online), Jun 21, 2015, available at: <http://domainincite.com/18739-donuts-makes-private-deal-with-wine-makers>, (last accessed on June 27, 2021).

⁴⁰ Jean Guillon, A Financial Back-Up to Win .WINE?, Jul 29, 2014, available at: https://www.circleid.com/posts/20140729_a_financial_back_up_to_win_wine/, (last accessed on June 27, 2021).

⁴¹ Kevin Murphy, Donuts wins .wine auction, Nov 4, 2014, Domain Incite, available at: <http://domainincite.com/17620-donuts-wins-wine-auction>, (last accessed on June 27, 2021).

for which there are various geographical indications around the world and the applicant does not have the right to use the GI in question.⁴² The issue was discussed within GAC during ICANN 47, but GAC failed to reach a consensus advice.⁴³ Subsequently, the EU and wine regions had filed Cooperative Engagement Process objections with ICANN, saying that Donuts should be forced to protect “geographic indicators” such as Napa Valley and Champagne. Thereafter, Donuts negotiated a settlement with the complainants from the wine region and EU without undertaking any additional contractual obligations that could create potential compliance problems for the Registry.⁴⁴

2.3 Using GeoTLDs to establish digital identity

While the foregoing section elaborated on the various challenges faced by new gTLD applicants seeking to register a Geographic Name or a string that may have certain cultural sensitivities associated with it for people of a particular country, region, or ethnicity. And, because of such sensitivities these ‘strings’ have often faced contentions and hurdles, sometimes to the detriment of the string delegation. However, there are also examples of some Governments as well as private entities applying for certain GeoTLDs and making use of those TLDs for providing digital identities to cities and regions. Currently, an estimated 41 cities and 22 regions offer new domain names for citizens, businesses, and public authorities under a geographic TLD.⁴⁵ Operation model for various TLDs differs; for instance 34 geographic domain extensions are operated by organizations from the private sector and 26 by public authorities, meanwhile three GeoTLDs work as a public-private partnership.⁴⁶ These include but are not limited to .berlin, .tokyo, .sydney, .nyc, .alsace, .amsterdam, .paris, and .london, among others.⁴⁷ Some TLDs such as Barcelona and Istanbul have chosen an interesting manner of operation, their respective governments applied for two domain name extensions – one for exclusive use of the administration (.bcn) or (.ist) and other for private use or use by companies and the like (.barcelona and .istanbul).⁴⁸

⁴² Statement by Jerome Passa (IP Expert) submitted to ICANN, Mar 22, 2014, available at: <https://www.icann.org/en/system/files/files/analysis-wine-vin-22mar14-en.pdf>, (last accessed on June 27, 2021).

⁴³ GAC Communiqué – Durban, South Africa, July 18, 2013, ICANN, available at: <https://gac.icann.org/advice/communiques/public/gac-47-durban-communication.pdf>, (last accessed on June 27, 2021).

⁴⁴ Kevin Murphy, Donuts makes private deal with wine-makers, Domain Incite (online), Jun 21, 2015, available at: <http://domainincite.com/18739-donuts-makes-private-deal-with-wine-makers>, (last accessed on June 27, 2021).

⁴⁵ Dirk Krischenowski, GeoTLDs and Internet Governance, dotmagazine (online), 2017, available at: <https://www.dotmagazine.online/issues/who-rules-the-internet/claiming-and-protecting-virtual-namespace/GeoTLDs>, (last accessed on June 28, 2021).

⁴⁶ Ibid.

⁴⁷ Dirk Krischenowski, Mapping Virtual Space to the Geographical Environment, March 2017, available at: <https://www.dotmagazine.online/issues/who-rules-the-internet/claiming-and-protecting-virtual-namespace/GeoTLDs>, (last accessed on June 27, 2021).

⁴⁸ Dirk Krischenowski, GeoTLDs and Internet Governance, dotmagazine (online), 2017, available at: <https://www.dotmagazine.online/issues/who-rules-the-internet/claiming-and-protecting-virtual-namespace/GeoTLDs>, (last accessed on June 28, 2021).

3. Examining Extant Protection Mechanisms

During the drafting of the Applicant Guidebook, the GNSO council considered the following factors while formulation the process:

- whether to introduce new top-level domains and if the introduction should be restricted in some way;
- the criteria for ascertaining which strings are allowable including Geographic Names;
- the method for allocation of these strings; and
- the contractual terms between the registry and the ICANN.

In this section we will explore the procedure laid down in the AGB and its application during the 2012 round. Furthermore, we will also examine the rights protection mechanisms enshrined in ICANN's policy.

3.1 Procedure for protection as laid down by the Applicant Guidebook, 2012

The final version of the gTLD Applicant Guidebook (AGB) was published on 4th June 2012. The AGB outlines the process which must be followed by any applicant who wants to apply for a new gTLD string. In this section we take a closer look at the existing application procedure which is outlined in the AGB. According to the AGB finalized for the last round of gTLD applications, a Geographic Names Panel determined whether the applied for string is a geographic name requiring government support.

As per the AGB finalized by the GNSO Council in 2012 and used for the last application round, the following types of applied for strings were considered geographic names:

- i. Any string that is a representation, in any language, of the capital city name of any country or territory listed in the ISO 3166-1 standard.
- ii. A city name, where the applicant declares that it intends to use the gTLD for purposes associated with the city name.
- iii. Any string that is an exact match of a sub-national place name, such as a county, province, or state, listed in the ISO 3166-2 standard.
- iv. An application for a string listed as a UNESCO region,⁴⁹ or appearing on the “Composition of macro geographical (continental) regions, geographical sub-regions, and selected economic and other groupings” list.⁵⁰ If the applied for string appears on either one of these lists, then the applicant is required to submit documentation of support from at least 60% of the respective national governments in the region, and there cannot be more than one written statement of objection to the application from relevant governments in the region

⁴⁹ Available at: <http://www.unesco.org/new/en/unesco/worldwide/regions-and-countries/>, (last accessed on June 25, 2021).

⁵⁰ Available at: <https://unstats.un.org/unsd/methodology/m49/>, (last accessed on June 25, 2021).

and/or public authorities associated with the continent or the region. Furthermore, in cases where the 60% rule is applied, and there are common regions on both lists, the regional composition contained in the “Composition of macro geographical (continental) regions, geographical sub-regions, and selected economic and other groupings” takes precedence.⁵¹

Applications falling under any one of the aforementioned criteria are required to submit geographic names and must be accompanied by documentation of support or non-objection from the relevant governments or public authorities. Relevant public authorities for each string were ascertained by the Geographic Names Panel based on the inputs of the applicant, governments, and its own research and analysis. In cases where there was more than one relevant government or public authority for the applied-for gTLD string, the applicant was required to provide documentation of support or non-objection from all the relevant governments or public authorities.⁵²

The AGB also noted that city names are not universally protected and may pose challenges since they could also represent generic terms or brand names (such as Nokia) or in some cases city names may not be unique (for instance New Delhi in US⁵³ and New Delhi in India). Consequently, no established lists could be used as objective references to enable the evaluation process. Therefore, during the last round city names required document of support from relevant government or public authorities during the last round only if the applicant intended to use the string primarily for purposes associated with the city or if the city name is listed on official city documents. The AGB also clarified that city governments with concerns about strings that are duplicates, nicknames or close renderings of a city name should not rely on the evaluation process as the primary means of protecting their interests in a string. Rather, a government may elect to file a formal objection to an application that is opposed by the relevant community or may submit its own application for the string.⁵⁴

Furthermore, the following strings were considered to be country and territory names and were not available during the 2012 round:⁵⁵

- i. an alpha-3 code listed in the ISO 3166-1 standard.
- ii. a long-form name listed in the ISO 3166-1 standard, or a translation of the longform name in any language (such as Republic of India)
- iii. a short-form name listed in the ISO 3166-1 standard, or a translation of the short-form name in any language.⁵⁶

⁵¹ gTLD Applicant Guidebook, Jun 4, 2012, available at: <https://newgtlds.icann.org/en/applicants/agb>, (last accessed on June 28, 2021).

⁵² Ibid.

⁵³ See generally https://geonames.usgs.gov/apex/f?p=GNISPO:3:::NO::P3_FID:1747840, (last accessed on June 28, 2021).

⁵⁴ gTLD Applicant Guidebook, Jun 4, 2012, available at: <https://newgtlds.icann.org/en/applicants/agb>, (last accessed on June 28, 2021).

⁵⁵ Ibid.

⁵⁶ Ibid. See generally, Annex: Separable Country Names List.

- iv. a short- or long-form name association with a code that has been designated as “exceptionally reserved” by the ISO 3166 Maintenance Agency (such as UK⁵⁷)
- v. a separable component of a country name designated on the “Separable Country Names List,” or is a translation of a name appearing on the list, in any language.
- vi. a permutation or transposition of any of the names included in items (i) through (v). Permutations include removal of spaces, insertion of punctuation, and addition or removal of grammatical articles like “the.” A transposition is considered a change in the sequence of the long or short-form name, for example, “RepublicCzech” or “IslandsCayman.”
- vii. a name by which a country is commonly known, as demonstrated by evidence that the country is recognized by that name by an intergovernmental or treaty organization (such as EU).

Therefore, no applicant could apply for a string falling in any of the foregoing categories.

3.2 Existing Rights Protection Mechanism

The ICANN community developed several rights protection mechanisms (RPMs) and dispute resolutions procedures below to support a trusted marketplace.⁵⁸ These RPM s were developed mitigate potential risks to rights holders that could arise due to introduction of several new gTLDs in the DNS. These RPMs were specifically designed with a view to prevent rights of legitimate trademark owners. These RPMs have been designed to operate both pre-delegation (before a new gTLD is approved) and also post-delegation, i.e., after they become operational.⁵⁹ As such, the RPMs are available during various life cycles of a TLD. For instance, TLD launch processes include a Sunrise period and a Trademark Claims

period, supported by verified trademark rights information as recorded in the Trademark Clearinghouse (TMCH). Once these processes are completed and the TLD is in a steady state of operations in terms of domain name registration, rights holders have mechanisms such as the Uniform Domain Name Dispute Resolution Policy (UDRP), Uniform Rapid Suspension (URS), and PDDRP (Post Delegation Dispute Resolution Process). In this section, we will try to briefly describe these RPMs:

- i. **TMCH:** It is a centralized database of verified trademarks connected to every new Top-Level Domain (TLD) that is delegated. The insertion and verification of trademarks within the database of TMCH is made on a voluntary basis upon payment of a fee by the trademark

⁵⁷ Glossary for ISO 3166, available at: <https://www.iso.org/glossary-for-iso-3166.html>, (last accessed on June 28, 2021).

⁵⁸ Rights Protection Mechanisms (RPMs) & Dispute Resolutions Procedures (DRPs), ICANN, available at: <https://www.icann.org/resources/pages/rpm-drp-2017-10-04-en>, (last accessed on June 29, 2021).

⁵⁹ Rights Protection Mechanisms for New Top-Level Domains (TLDs), WIPO, available at: <https://www.wipo.int/amc/en/domains/rpm/#a>, (last accessed on June 29, 2021).

holders, subject to the renewal.⁶⁰ As such, the database is predominantly dedicated to trademarks, marks protected under statute or treaty and other marks that constitute intellectual property. For marks protected by statute or treaty, the relevant statute or treaty must be in effect at the time the mark is submitted to the Clearinghouse for inclusion. These marks may include but are not limited to geographical indications and designations of origin.⁶¹ However, the final report on the Review of All Rights Protection Mechanisms in all gTLDs Policy Development Process approved by the GNSO Council on Jan 21, 2021 recommends exclusion of GIs, protected designations of origin, among others from mandatory Sunrise and Trademark Claims RPMs unless they are also trademarks.⁶² This will further make existing RPMs only for trademark owners.

- ii. **UDRP:** Established in 1999, the Uniform Domain Name Dispute Resolution Policy (UDRP) was established to resolve disputes relating to the registration of domain names. However, GIs are beyond the scope of RPMs as will be described in greater detail during the subsequent parts of this paper.

Similarly, even URS and PDDRP provide protection to only trademark owners and as such it has been observed that despite being a well -recognised intellectual property right, GI owners are not treated at par with trademark owners in the DNS ecosystem.

3.3 Examining the Protections Afforded to GIs

Even though GIs are recognized as an Intellectual Property Right in the World Trade Organization's Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), they have not been afforded protection commensurate to that of trademarks in the Domain Name System (DNS). While GIs are legitimate intellectual property right, UDRP does not consider GI to be a valid legal title.⁶³ When this issue was discussed in Second WIPO Domain Name Process findings regarding GIs in 2001, following reasons were cited for not expanding the scope of UDRP to include protection for GIs:

⁶⁰ Compilation of a List of Questions Proposed by Members and Intergovernmental Intellectual Property Organizations with Observer Status on Topics Referred to in the Workplan on Geographical Indications, Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, Apr 2018, WIPO, available at: https://www.wipo.int/edocs/mdocs/sct/en/sct_39/sct_39_6_rev.pdf, (last accessed on June 29, 2021).

⁶¹ Trademark Clearinghouse Guidelines, available at: https://trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.0%20_1.pdf, (last accessed on June 29, 2021).

⁶² Phase 1 Final Report on the Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process, Nov 24, 2020, ICANN, available at: <https://gns0.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-proposed-24nov20-en.pdf>, (last accessed on Jun 29, 2021).

⁶³ Presentation by Delia Belciu, Geographical Indications as Intellectual Property Titles In The Operation Of DNS and in the Dispute Resolution Policies, Nov 6, 2019, WIPO, available at: https://www.wipo.int/edocs/mdocs/sct/en/sct_is_geo_ge_19/sct_is_geo_ge_19_p3.pdf, (last accessed on June 28, 2021).

- The International Legal framework was developed for the prohibition of false and deceptive indications of geographical source and the protection of geographical indications was developed for, and applies to, trade in goods.
- Lack of consistent laws, i.e., applicable law varies due to different systems being used to protect GIs. Thus, a situation may arise where Country A may protect a GI, but country B may consider that ‘string’ to be generic and descriptive. Secondly, there are challenges in respect of applicable law because of the different systems that are used to protect GIs at the national level. And 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. Thus, what may constitute as illegal behaviour in country A could well be legal in another country.⁶⁴

The Rights Protection Mechanisms developed by the ICANN Community are for trademarks and not for other types of IPs including GIs.⁶⁵ Furthermore, – GIs, unless protected under a trademark system, are not marks and thus are not eligible for the TMCH.⁶⁶ Therefore violations related to GIs are handled on a case-by-case basis.⁶⁷ As per the existing rules of the UDRP procedure, the only way a GI owner can win a case is by establishing a link between the GI and a registered trademark. Therefore, it becomes challenging for GI owners to protect their interests in the present rights protection ecosystem at ICANN.⁶⁸

The only means for an applicant to win a UDRP procedure regarding a geographical indication is to establish a link between the geographical indication and a registered trademark. However, it is very difficult to establish such a link and therefore to win a case within the context of an UDRP procedure. Practice by various ccTLD operators also vary. For instance Romania (.Ro) does not recognize GI as a valid title, meanwhile, Czech Republic and Netherlands⁶⁹ recognizes a geographical indication as a ‘valid title’ in a domain name dispute.⁷⁰ Also, Article

⁶⁴ Report of the Second WIPO Internet Domain Name Process, Sept 3, 2001, WIPO, available at: <https://www.wipo.int/amc/en/processes/process2/report/html/report.html#6>, (last accessed on June 28, 2021).

⁶⁵ Presentation by Susan Anthony, Geographical indications and the internet: Where are we now?, WIPO Worldwide Symposium on Geographical Indications, July, 2019, available at: https://www.wipo.int/edocs/mdocs/sct/en/wipo_geo_lis_19/wipo_geo_lis_19_x20.pdf, (last accessed on June 28, 2021).

⁶⁶ Ibid.

⁶⁷ How to defend the protection of geographical indications when allocating new gTLDs, Nov 29, 2016, Dreyfus, available at: <https://www.dreyfus.fr/en/2016/11/29/how-to-defend-the-protection-of-geographical-indications-when-allocating-new-gtlds/>, (last accessed on June 28, 2021).

⁶⁸ Ibid.

⁶⁹ Comparative Case Study on Alternative Resolution Systems for Domain Name Disputes, European Union Intellectual Property Office, 2018, available at: http://publications.europa.eu/resource/ellar/246c97e0-300f-11e9-8d04-01aa75ed71a1.0001.01/DOC_1, (last accessed on June 28, 2021).

⁷⁰ Presentation by Delia Belciu, Geographical Indications as Intellectual Property Titles In The Operation Of DNS and in the Dispute Resolution Policies, Nov 6, 2019, WIPO, available at: https://www.wipo.int/edocs/mdocs/sct/en/sct_is_geo_ge_19/sct_is_geo_ge_19_p3.pdf, (last accessed on June 28, 2021).

10 of EC Regulation n 874/2004⁷¹ laying down public policy rules of .eu TLD states: “‘Prior rights’ shall be understood to include, *inter alia*, registered national and community trademarks, **geographical indications** or designations of origin...” While Art 21⁷² of the Regulation clarifies that *domain name shall be subject to revocation where that name is identical or confusingly similar to a name for which a right is recognized (e.g., in Article 10), and where it has been:*

- (a) registered without legitimate interest in the name; or
- (b) registered or is being used in bad faith.⁷³

Some disputes to highlight the need for recognizing and protecting rights of GI owners in the DNS:

- i. **Champagne v. Vickers:**⁷⁴ Comité Interprofessionnel du vin de Champagne (CIVC) filed a case against Steven Vickers for use of champagne.co. With all producers of wine subscribing to CIVC in France, the complainant had the right to represent defend, preserve, and promote interests those producing, and marketing of sparkling wines sold under GI “Champagne”. CIVC also cited .be and .uk dispute resolutions wherein champagne related domain names were transferred to CIVC. However, the panel found that a GI per se does not distinguish the wine of one Champagne producer from the wine of another, and so does not fulfill the fundamental function of a trademark of distinguishing the goods or services. Thus, the rights in a GI do not fall under the “Rights” provider of Paragraph 4(a)(i) of the UDRP. Therefore, CIVC’s complaint was denied.⁷⁵
- ii. **Rioja v. Domain Hostmaster:**⁷⁶ “Rioja” is a “Qualified Designation of Origin”, a Spanish classification for GIs. Complaint was filed against the disputed domain name rioja.com. Complainant was official body engaged in promotion and defence of “Rioja” GI. Complainant also owned several trademarks comprising stylised word “Rioja” within a device, in class 33 for alcoholic beverages. However, panel found the Complainant failed to establish the “bad faith” element of UDRP. Hence, the complaint was denied.⁷⁷

⁷¹ COMMISSION REGULATION (EC) No 874/2004, Apr 28, 2004, available at: <https://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32004R0874&from=EN>, (last accessed on June 28, 2021).

⁷² Ibid.

⁷³ Ibid.

⁷⁴ WIPO Case No. DCO2011-0026

⁷⁵ Presentation by Delia Belciu, Geographical Indications as Intellectual Property Titles In The Operation Of DNS and in the Dispute Resolution Policies, Nov 6, 2019, WIPO, available at: https://www.wipo.int/edocs/mdocs/sct/en/sct_is_geo_ge_19/sct_is_geo_ge_19_p3.pdf, (last accessed on June 28, 2021).

⁷⁶ WIPO Case No. D2018-0168.

⁷⁷ Presentation by Delia Belciu, Geographical Indications as Intellectual Property Titles In The Operation Of DNS and in the Dispute Resolution Policies, Nov 6, 2019, WIPO, available at: https://www.wipo.int/edocs/mdocs/sct/en/sct_is_geo_ge_19/sct_is_geo_ge_19_p3.pdf, (last accessed on June 28, 2021).

Proposals to expand the scope of UDRP to also include GIs have been made by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications before the WIPO in 2014.⁷⁸ Among other things, the Standing Committee highlighted that the introduction of new gTLDs have enhanced the risk registration and use of domain names that violate intellectual property right. However, US opposed the proposal on the grounds that UDRP was envisaged to deal with cybersquatting of trademarks and GIs protected under a *sui generis* system are not trademarks. It also stated that national GI systems do not scale to a system of international protection unlike trademarks.⁷⁹ During Nov 2017 – 18, the WIPO Standing Committee on Trademarks (SCT) adopted a Workplan on Geographical Indications and prepared a survey on current state of play. But as of now, the 2001 findings of the Second WIPO Domain Name Process findings regarding GIs in 2001 still exist.⁸⁰

Some members of the Work Track 5 also proposed special protections for GIs in subsequent procedures on account of the following reasons:⁸¹

- This is a category with clear boundaries that can be documented, therefore increasing predictability.
- GIs play an important economic role in my regions and its protection has an impact on livelihoods of a lot of communities.
- GIs are generally protected by applicable local laws.

However, a lot of members were also opposed to the idea of additional protections for GIs due to reasons enumerated below:⁸²

- Since protection of GIs varies from country, it lacks clear boundaries.
- GIs lack a common basis for protection since there is no standard terminology or treaty for GIs
- Extent of protection granted to GIs under the local laws varies significantly.

⁷⁸ Proposal by the Delegations Of The Czech Republic, France, Germany, Hungary, Italy, Portugal, Republic Of Moldova, Spain And Switzerland, Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, 31st Session, March, 2014, available at:

https://www.wipo.int/edocs/mdocs/sct/en/sct_31/sct_31_8_rev_4.pdf, (last accessed on June 28, 2021).

⁷⁹ Presentation by Susan Anthony, Geographical indications and the internet: Where are we now?, WIPO Worldwide Symposium on Geographical Indications, July, 2019, available at: https://www.wipo.int/edocs/mdocs/sct/en/wipo_geo_lis_19/wipo_geo_lis_19_x20.pdf, (last accessed on June 28, 2021).

⁸⁰ Ibid.

⁸¹ Supplemental Report on the new gTLD Subsequent Procedures Policy Development Process (Work Track 5 on Geographic Names at the Top Level), Dec 12, 2018, ICANN, available at: <https://gns0.icann.org/sites/default/files/file/field-file-attach/subsequent-procedures-geo-names-supp-initial-05dec18-en.pdf>, (last accessed on June 26, 2021).

⁸² Ibid.

- The issue of GI is being discussed as an important trade issue and it is being discussed in many other fora because of which it has become a sensitive political issue. Therefore, Work Track 5 should be very cautious in seeking to address this issue.

Even though, the WG, sought responses on the issue of establishing specific protections for GIs during its Initial Report, it did not receive much support. Therefore, the Work Track 5 did not make any cogent recommendations on the same, nor was this issue discussed in detail during the Work Track 5 meetings and deliberations.⁸³

4. India

As has been elaborated in the foregoing sections, ICANN initiated a separate Work Track, known as the Work Track 5, under the new gTLDs subsequent procedures to examine protection of Geographic Names during any future expansion of gTLDs.⁸⁴ There was considerable discussion within the group on whether national governments have regarding the extent to which national and local legal and public policy protections of geographic terms should be used as a basis for granting rights to governments and other actors in the New gTLD Program. Work Track members also referred to Section 1.2 (a) of the ICANN Bylaws, which states: “In performing its Mission, ICANN must operate in a manner consistent with these Bylaws for the benefit of the Internet community as a whole, carrying out its activities in conformity with relevant principles of international law and **international conventions and applicable local law, through open and transparent processes** that enable competition and open entry in Internet related markets.”⁸⁵ From one perspective, the rights, and responsibilities of national and local governments with respect to geographic names are established in public policy and law instruments in different countries. If viewed from this lens, delegation of TLDs with geographic connotations has impacts within the applicable country, and a legal challenge based on national law would have an impact worldwide. In this view, ICANN is obligated to follow applicable national and local laws and policies that give governments rights and responsibilities over geographic names. One Work Track member cited GDPR as an example of a case where ICANN is making efforts to comply with local law.⁸⁶ Even though, the Work

⁸³ Supplemental Report on the new gTLD Subsequent Procedures Policy Development Process (Work Track 5 on Geographic Names at the Top Level), available at: https://docs.google.com/spreadsheets/d/1WKSC_pPBviCnbHxW171ZI4CzuhQXRCV1NR2ruagrxs/edit#gid=297053975, (last accessed on June 28, 2021).

⁸⁴ Work Track 5 on Geographic Names at the Top Level – Supplemental Initial Report of the New gTLD Subsequent Procedures Policy Development Process, Dec 5, 2018, ICANN.org, available at: <https://www.icann.org/en/announcements/details/work-track-5-on-geographic-names-at-the-top-level--supplemental-initial-report-of-the-new-gtld-subsequent-procedures-policy-development-process-5-12-2018-en>, (last accessed on June 26, 2021).

⁸⁵ Section 1.2, Bylaws For Internet Corporation For Assigned Names And Numbers (as amended Nov 28, 2019), available at: <https://www.icann.org/resources/pages/governance/bylaws-en/#article1>, (last accessed on June 26, 2021).

⁸⁶ Work Track 5 Working Document, July 10, 2018, available at: <https://community.icann.org/download/attachments/60490848/Work%20Track%205%20-%20Working%20Document%20-%202021%20August%202018.pdf?version=1&modificationDate=1534857207000&api=v2>, (last accessed on June 26, 2021)

Track 5 has submitted its final report and recommended no additional protections for Geographic Names in the next round of applications, this line of reasoning may have some merit. However, before we delve deeper into this, it is important to understand the laws making references to geographic names in India.

4.1 Relevant Indian Laws

Even though, India does not have a law which deals specifically with the issue of Geographic Names in the DNS, we do have some legislations that provide some guidance. The following section comprises a brief overview of laws or guidelines that may be pertinent to the discussion at hand:

i. Indian Domain Name Policy Framework: According to Para 3.4.6 .IN Internet Domain Name Policy Framework and Implementation following category of names are reserved.⁸⁷

- Constitutional Authorities
- States/Union Territories and Cities
- Specific names for Registry Use

Furthermore, the Indian Dispute Resolution Policy (INDRP) has been modelled closely along the lines of the UDRP by ICANN and it does not mention ‘geographic indications’ specifically.⁸⁸

ii. The Trademarks Act, 1999: As per Section 9 (1) of Trademarks Act, 1999, the absolute grounds for refusal of registration include:

(b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or services;

(c) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade.

*Shall not be registered: Provided that a trademark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trademark.*⁸⁹

⁸⁷ .IN Reserved Names, NIXI, December 22, 2004 (revised Feb 21, 2005), available at: https://www.registry.in/system/files/Reserved_Names_1.pdf, (last accessed on June 26, 2021).

⁸⁸ .IN Domain Name Dispute Resolution Policy (INDRP), September 16, 2020, available at: <https://www.registry.in/IN%20Domain%20Name%20Dispute%20Resolution%20Policy%20%28INDRP%29>, (last accessed on June 26, 2021).

⁸⁹ Section 9 (1) The Trademarks Act, 1999, available at: <https://indiankanoon.org/doc/520333/>, (last accessed on June 26, 2021).

iii. As such, The Geographical Indications of Goods (Registration and Protection) Act, 1999 only deals with ‘origin of goods’ and it may not be directly applicable to TLDs. Since the protection extends to and applies to ‘trade in goods’, there isn’t a specific remedy available for GI owners to protect their rights in the DNS.⁹⁰ Furthermore, Para 7 of the INDRP (which is identical to para 4(b)(ii) of UDRP) excludes GIs while inferring bad faith registration.⁹¹ However in 2012, the National Internet Exchange of India (NIXI) rendered an arbitral decision an Indian arbitration panel ordered transfer of the impugned domain name (champagne.in), even though the complainant did not have any certification or collective marks for the name Champagne in India.⁹² The said case will be discussed in greater detail in the subsequent section.

4.2 Dispute Resolution

In 2012, the Comité Interprofessionnel du Vin de Champagne (CIVC) filed a domain name complaint against the domain name <champagne.in>, registered by “India Portals”, an Indian entity. CIVC is the French body in charge of protection of rights in the GI “Champagne”, a sparkling wine produced in the Champagne region of France. CIVC is the French body in charge of protection of rights in the GI “Champagne”, a sparkling wine produced in the Champagne region of France.⁹³

In its complaint, CIVC alleged that:

- The domain name is identical to its registered Indian GI ‘champagne’;
- The impugned domain name is likely to confuse internet users into believing that ‘India Portals’ (the Respondent) has some nexus with CIVC (the Complainant);
- India Portals had no rights to or legitimate interests therein; and
- The registration lacks good faith: Even though India Portals registered the impugned domain name in 2005, it has shown no interest to use the same. Also, there is a continued pattern of bad faith registrations on the Respondent’s part, further demonstrated by the fact that India portals have nearly 530 domains consisting of proprietary names and common words without any intent to use the same.⁹⁴

⁹⁰ Latha R. Nair, Presentation by Ms. Latha Nair: GIs as IP Titles in DNS and in Dispute Resolution Policies, WIPO’s Information Session on Geographical Indications, available at: https://www.wipo.int/meetings/en/doc_details.jsp?doc_id=460072, (last accessed on June 26, 2021).

⁹¹ .IN Domain Name Dispute Resolution Policy (INDRP), September 16, 2020, available at: <https://www.registry.in/IN%20Domain%20Name%20Dispute%20Resolution%20Policy%20%28INDRP%29>, (last accessed on June 26, 2021).

⁹² Latha R. Nair, GIs And Domain Names: Let There Be No Cinderellas In Ip!, WIPO (2019), available at: https://www.wipo.int/edocs/mdocs/sct/en/sct_is_geo_ge_19/sct_is_geo_ge_19_p4-annex1.pdf, (last accessed on Jun 25, 2021).

⁹³ *Ibid.*

⁹⁴ Comité Interprofessionnel du Vin de Champagne (CIVC) - India Portals for “champagne.in”, INDRP, May 8, 2012, available at: <https://www.registry.in/Policies/DisputeCaseDecisions>, (last accessed on June 26, 2021).

Para 7 (ii) of the INDRP deals with bad faith registrations and infers bad faith registrations in cases where the registration has been done in order to “prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct”;⁹⁵. As such, it does not include within its ambit GI registrants. However, in the case of CIVC and India Portals, the arbitrator recorded the following reasons for his decision:

- Taking legislative intent into consideration and looking beyond literal interpretations, similar weightage as that is given for trademarks could be assigned to GIs.
- the complainant had legitimate interest in the disputed domain name by way of registered GI.
- if the website is uploaded by the Registrant, it is very likely that it would create confusion in the minds of the internet users and the Registrant would attract users by misrepresentation.
- CIVC had established negative rights and interests in the word ‘champagne’ by successfully opposing any trademark containing the word ‘champagne’ and consequently established its rights and interests in the disputed domain name.⁹⁶

This complaint was similar to the one filed by CIVC at the WIPO Arbitration and Mediation Centre in 2011. Following the UDRP, however, the WIPO interpreted the provision ‘literally’ owing to which the panel handed an adverse order against the complainant (as has been elaborated in the preceding section).

5. Conclusion and Recommendations

At the outset, it can be stated that ICANN has not treated Geographical indications at par with Trademarks even though both have international recognition under TRIPS. We also believe that work done by Work Track 5 needs to be commended and retaining status quo in so far as Geonames is concerned is a step in the right direction.

In this section we attempt to suggest policy recommendations based on our secondary research and stakeholder interactions. Through this paper we also wish to make certain cogent recommendations for the Indian stakeholders and therefore, the recommendations are split into two categories, one dealing specifically with policy gaps within the Indian ecosystem and the other focusing on ICANN and potential issues that the Indian delegation could raise with ICANN.

⁹⁵ Para 7(b), INDRP, available at: <https://www.registry.in/IN%20Domain%20Name%20Dispute%20Resolution%20Policy%20%28INDRP%29>, (last accessed on June 26, 2021).

⁹⁶ Comité Interprofessionel du Vin de Champagne (CIVC) - India Portals for “champagne.in”, INDRP, May 8, 2012, available at: <https://www.registry.in/Policies/DisputeCaseDecisions>, (last accessed on June 26, 2021).

1) Recommendations to fix gaps in the Indian Ecosystem

- i. **INDRP must recognise GI as a valid legal title:** INDRP has been closely modelled along the lines of the UDRP and therefore while inferring bad faith registration, it only considers ‘trademark’ to be a valid legal title. A lot of other ccTLD operators, though modelled along the lines of UDRP have recognised GI as a valid legal title during dispute resolution procedures. Examples include .eu, .cz and .nl. India should also amend its dispute resolution policy to protect the interests of GI owners in India. Furthermore, it can then take a position at ICANN to recognise rights of GI owners in its own RPMs
- ii. **Explore possibility of expanding the list of geographic names under .in policy** – In past India has advocated at ICANN that the definition of geographic names should be expanded to include strings having ‘cultural significance’.⁹⁷ However, India’s ccTLD policy does not have those names and during WT5 deliberations, it was suggested that since ccTLD policy is a sovereign right, countries are free to expand the list of geographic names. It was argued that if individual governments and regions are motivated to reserve geographical names, such preventative reservations should occur on the ccTLD level not the gTLD level.⁹⁸ Therefore, before arguing for expanding the list of geographic names at ICANN, we must create a repository of such names and create a requirement of support from the relevant public authority to bolster our argument at ICANN.
- iii. **Apply for GeoTLDs:** As has been elaborated in Section 2.3 of this paper, GeoTLDs can be used providing digital identities to cities and regions. Indian government should also apply for Indian geographic names along with their IDNs during the subsequent rounds. These can be used to promote tourism, create digital identities of the city. For instance, in Catalonia, the linguistically and culturally inspired .cat ending has been successful for more than 10 years.⁹⁹
- iv. **Domestic Capacity Building:** Indian stakeholder participation at ICANN has historically been lackadaisical. Therefore, there is a need to build a community of informed individuals that are able to put forth Indian stakeholder interests at various international fora. In the short term, the government must engage with domestic GI community and build awareness regarding the new gTLDs and its impact on their rights. Furthermore, keeping in mind that GIs provide livelihoods to marginalised

⁹⁷ Discussions related to Geographic Names of Countries and Territories at ICANN60, Nov 3, 2017, available at: <https://dig.watch/resources/discussions-related-geographic-names-countries-and-territories-icann60>, (last accessed on June 29, 2021).

⁹⁸ Comments by INTA on Work Track 5 Initial Report, Jan 22, 2018, available at: <https://mm.icann.org/pipermail/comments-geo-names-wt5-initial-05dec18/attachments/20190123/06820215/INTAWT5Comments1.22.19FINALSubmission-0001.pdf>, (last accessed on June 29, 2021).

⁹⁹ Dirk Krischenowski, GeoTLDs and Internet Governance, dotmagazine (online), 2017, available at: <https://www.dotmagazine.online/issues/who-rules-the-internet/claiming-and-protecting-virtual-namespaces/GeoTLDs>, (last accessed on June 28, 2021).

folks in the society, we must realise that application costs along with costs of running a registry may be too prohibitive. Thus, awareness campaigns regarding Applicant Support programs, community applications and the like must be initiated at the earliest. India is home to several GIs. As of March 2020, India had 361 registered GIs and 222 pending applications under the Geographical Indications of Goods (Registration & Protection) Act, 1999 (“the GI Act”). Among the registered ones, 57.9% belonged to “handicrafts”, and 30.2% belongs to the category, “agricultural” goods and it is imperative that we protect the rights of our domestic community.¹⁰⁰

- v. **Explore feasibility of expanding sunrise period and trademark claims to other forms of IP:** Even though, Para 3.4.7 of the .IN Policy Framework and Implementation mentions **Trademark owners, registered companies and owners of intellectual property** have a legitimate interest in protecting their brand. It also states that their rights would be protected through a ‘sunrise period’ of 90 days.¹⁰¹ However, the sunrise policy released by NIXI only mentions trademarks and service marks.¹⁰² It may be prudent to explore the option of expanding the scope of sunrise policy to include other intellectual property owners as well.

2) Positions India can take at ICANN

- i. **ICANN must recognise rights of GI owners:** Even though, GIs exist in a world that may be quantitatively dominated by trademark owners, GIs are an intellectual property in their own stead.¹⁰³ It is also worthwhile to note that GIs are an important brand protection tool for communities that come from marginalised sections of the society such as artisans, farmers, weavers to name a few. And, GIs have the wherewithal to have a positive impact on the development of these communities. In order to ensure that the rights of legitimate GI owners are not harmed through mala fide registration of domain names similar to or same as GIs, ICANN must take measures to protect geographical indications including expanding the scope of UDRP to afford protection to GIs as well. Furthermore, ICANN must also elaborate the scope of TMCH to ensure that GI owners have the option of registering under it. Considering the vibrant Indian GI community, India must look for ways to strengthen rights of GI owners within the ICANN Community. It should propose within GAC the initiation of an Expedited PDP that looks to protect the rights of GI

¹⁰⁰ Latha Nair, Should India Join the Geneva Act of the Lisbon Agreement, 2015?, Mar 12, 2020, available at: <https://spicyip.com/2020/03/should-india-join-the-geneva-act-of-the-lisbon-agreement-2015.html>, (last accessed June 29, 2021).

¹⁰¹ .IN Internet Domain Name – Policy Framework and Implementation, Oct 28, 2004, available at: <https://www.meity.gov.in/writereaddata/files/inpolicy.pdf>, (last accessed on Jun 29, 2021).

¹⁰² .IN Sunrise Rules, Dec 20, 2004, available at: https://www.registry.in/system/files/IN_Sunrise_Rules-20_Dec_2004_0.pdf, (last accessed Jun 29, 2021).

¹⁰³ Latha R. Nair, GIs And Domain Names: Let There Be No Cinderellas In Ip!, WIPO (2019), available at: https://www.wipo.int/edocs/mdocs/sct/en/sct_is_geo_ge_19/sct_is_geo_ge_19_p4-annex1.pdf, (last accessed on Jun 25, 2021).

owners before the next round of gTLDs applications. With internet becoming a necessity, the harm that mala fide registrations can cause to GI owners cannot be ignored.

- ii. **GAC notification tool:** Even though, GNSO Council has submitted the final report on new gTLDs subsequent procedures to the ICANN Board, India must support within GAC the need for a GAC notification tool as proposed by the ALAC in its minority statement so that GAC is aware of strings matching names with geographical meaning and relevant GAC members can take necessary steps, if needed.¹⁰⁴

¹⁰⁴ Final Report new gTLDs Subsequent Procedures, Feb 2, 2021, available at: <https://gns0.icann.org/sites/default/files/file/field-file-attach/final-report-newgtld-subsequent-procedures-pdp-02feb21-en.pdf>, (last accessed June 29, 2021).

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