

Proposal for a**REGULATION OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL****on geographical indication protection for craft and industrial products and amending Regulations (EU) 2017/1001 and (EU) 2019/1753 of the European Parliament and of the Council and Council Decision (EU) 2019/1754***Background and summary of the proposal*

Union law protects geographical indications (GIs) for agricultural products and foodstuffs, wines and spirit drinks. However, there is currently no EU-wide mechanism to protect the names of products such as Murano glass, Solingen cutlery, Donegal tweed, Halas lace or Gablonz jewellery. The proposal aims therefore at establishing a directly applicable GI protection for CI products (craft and industrial products) at Union level.

Comments

The Swedish Internet Foundation is an independent, private foundation that works for the positive development of the internet. We are responsible for the Swedish top-level domain .se and the operation of the top-level domain .nu, and our vision is that everyone in Sweden wants to, dares to and is able to use the internet.

Our comments are limited to the sections regarding domain names.

Establishment of a domain name information and alert system (article 31 and 61)

The European Intellectual Property Office (EUIPO) to establish a domain name information and alert system that should inform GI applicants about the availability of the GI as a domain name, and provide them on an optional basis with information once a conflicting domain name has been registered. Country code top level domain registries (ccTLDs) established in the EU should provide EUIPO with all information and data necessary to run this system: namely the information on the availability of the GI as a domain name and, as far as the alerts are concerned, the particulars of conflicting domain names, the dates of its application and registration. Data should be provided for both similar and identical domain names for protected GIs (Recital 26, Article 31).

Similar domain name alert system for already protected GIs and other trademarks under Regulation 2017/1001 should also be established by EUIPO (Recital 56, Article 61)

Comments from The Swedish Internet Foundation:

The proposed articles require ccTLDs to transfer data and information to the EUIPO on a regular basis. As stated in the impact assessment, this is the system in place for EUTM regarding the .eu top level domain.

There are certain technical possibilities to gain access to domain name information.

A zone file contains DNS information about a particular domain name, for example the names of the mailserver or webserver for the domain and, if applicable, their respective IP-addresses. The data in a zone holds the technical information required for the domain name to function. As such, a zone file does not contain any confidential information. The Swedish ccTLD publishes the zone files to the public and the zone files provided by The Swedish Internet Foundation contains information about all domains under the top-level domains .se and .nu that are delegated in the domain name system (DNS) and thus visible on the internet. The zone files are updated every hour and can be obtained from the nameserver zonedata.iis.se.

Via the WHOIS protocol, anyone can find information about a domain name. All non-personal data will be shown when searching for a domain name via WHOIS.

It is at this stage of the proposal unclear which technical solutions are required, but it is important to emphasize that any technical solutions must follow the technical standards and solutions that are already in place and used by ccTLDs.

There could be a potential conflict with technical compatibility, since different ccTLDs in EU may have their own technical systems in place.

Also, the proposal lacks the assessment of potential personal data treatment if such information needs to be provided to EUIPO or the GI applicant.

Protection of geographical indication rights in domain names (Recital 33, Articles 35 and 41)

Persons with a legitimate interest in a registered GI should be empowered to request for the revocation or the transfer of the domain name in case the conflicting domain name has been registered without rights or legitimate interest in the GI, following an appropriate alternative-dispute-resolution procedure or judicial procedure, or if it has been registered/is being used in bad faith.

Comments from The Swedish Internet Foundation:

The Swedish Internet Foundation, responsible for the domain name registry.se and .nu, has an alternative dispute resolution procedure (ADR) in place, which is mostly based on international rules for domain name disputes (UDRP). The same applies for most of the top-level domain registries in the EU.

ADR has been in place since 2003 and the UDRP was first adopted in 1999. For .se domain names, there are about 50-60 cases received each year. We have no official statistics regarding domain name cases in judicial procedures in court, but estimate this to approximately one case per year. We believe that the ADR procedure is a well-established and well-functioning system used by for example trademarks owners when there is a need to handle a domain name registration that corresponds to a registered trademark (or any other right according to the terms and conditions for .se).

More information about ADR can be found here

<https://internetstiftelsen.se/en/domains/dispute-resolution/dispute-resolution-for-se/>

More information about UDRP (the international system for domain name disputes) can be found here <https://www.icann.org/resources/pages/help/dndr/udrp-en>)

The ADR is compulsive for domain names holders, as the domain holder accepts the ADR when registering a domain name and accepting the terms and conditions. The same applies for most of the top-level domain registries in EU.

In order for a party petitioning for dispute resolution to achieve success, that party must show that three prerequisites are met:

- The applicant must have a right (e.g. a brand or company name) valid in Sweden.
- The domain holder shall have acted in bad faith when he/she registered or used the domain name.
- The domain holder shall also have no right or justified interest in the domain name.

We have no opposition regarding adding a registered GI as a right according to the first prerequisite. As for the other two prerequisites, the assessment will be made in accordance with the practice which has emerged from earlier domain name disputes.

It is important that the regulation does not require far-reaching changes to a procedure that already works both nationally and internationally. The solution for making it possible for a person with a legitimate interest in a registered GI to exercise its right in an alternative dispute resolution procedure, is to add the registered GI as a right on which an application can be based. For example the ADR for .se, it would be added in section 7.2.1 in the Terms and Conditions <https://internetstiftelsen.se/app/uploads/2021/10/se-terms-and-conditions-2021-11-01.pdf>.

Protection of geographical indication rights in domain names (Article 41)

ccTLDs established in the EU shall recognise GIs as rights that may prevent a domain name from being registered or used in bad faith.

Comments from The Swedish Internet Foundation:

The "first come, first serve" principle applies when allocating .se and .nu domain names – the first party to apply for an available domain name will be granted it with no prior testing. If one believes that someone else has registered a .se or a .nu domain to which they are entitled, one can appeal the allocation of the domain name retroactively. This is the principle that is applicable for almost all top-level domain registries within EU.

It is important that the GI as a right should be handled as other types of registered rights, such as trademarks, that is a right as a basis for an alternative dispute resolution

(or legal procedure in court). Otherwise GIs would be treated differently than the other registered rights, which cannot be prevented from being registered. Such conflicts should instead be handled in ADR (or as a legal procedure in court).

Orders to act against illegal content (article 55)

Competent authorities designated under the Regulation may issue orders to act against illegal content contravening with the offered GI protection under Article 8 of the Digital Services Act (where so provided by national law).

Comments from the Swedish Internet Foundation:

When requiring providers of intermediary services to act under Article 8 of the Digital Services Act (DSA), it is important that the reference in this suggested regulation is clear about reference to all steps necessary according to article 8 in DSA. Such order to act must follow all appropriate and necessary steps according to the article 8 in order to ensure proportionality.

General comments:

We also note that there is a similar suggested draft regulation regarding *geographical indications for wine, spirit drinks and agricultural products, and quality schemes for agricultural products*, in COM(2022) 134. It is important that legislation concerning the rights are the same, so the risk of different interpretations is reduced.

The Swedish Internet Foundation is hereby offering to assist in matters relating to domain names and dispute resolution regarding this proposed regulation.

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Stockholm den 12 maj 2022



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