

# The protection of Geographical Indications on the Internet



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## AREPO PRACTICAL GUIDE VERSION OF 2023

Guide developed by AREPO, Association of European Regions for Products of Origin - with the participation of UTAD, Universidade de Trás-os-Montes e Alto Douro, for the Portuguese legal aspects - in the framework of the AGROSMARTglobal project, co-financed by the EU via the ERDF, European Regional Development Fund, in the framework of the Interreg Sudoe 2014-2020 programme



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## Abbreviations and acronyms

<b>AC</b>	Acta Constitucional
<b>ACDR</b>	Arab Center for Dispute Resolution
<b>ADNDRC</b>	Asian Domain Name Dispute Resolution Centre
<b>AFNIC</b>	Association Française pour le Nommage Internet en Coopération
<b>AGACAL</b>	Axencia Galega da Calidade Alimentaria
<b>AICA</b>	Agencia de Información y Control Alimentarios
<b>ALCCI</b>	Association de Lutte Contre le Commerce Illicite
<b>AREPO</b>	Association of European Regions for Products of Origin
<b>ASAE</b>	Autoridade de Segurança Alimentar e Económica
<b>BPI</b>	Boletim da Propriedade Industrial
<b>B2B</b>	Business to Business
<b>B2C</b>	Business to Consumer
<b>CAC</b>	Czech Arbitration Court
<b>ccTLD</b>	Country Code Top-Level Domain
<b>CIGI</b>	Craft and Industrial Geographical Indication
<b>CIIDRC</b>	Canadian International Internet Dispute Resolution Centre
<b>CIVC</b>	Comité Interprofessionnel du Vin de Champagne
<b>CJEU</b>	Court of Justice of the European Union
<b>CNAOC</b>	Confédération Nationale des Appellations d'Origine Contrôlée Viticoles
<b>CPI</b>	Intellectual Property Code
<b>CRDD</b>	Centro Risoluzione Dispute Domini
<b>CTT</b>	Correios, Telégrafos e Telefones
<b>C2C</b>	Customer to Customer
<b>DG AGRI</b>	Directorate-General for Agriculture and Rural Development
<b>DGCCRF</b>	Direction générale de la Concurrence, de la Consommation et de la Répression des Fraudes
<b>DGDDI</b>	Direction générale des Douanes et Droits indirects

<b>DNS</b>	Domain Name System
<b>DRS</b>	Dispute Resolution Service
<b>DSA</b>	Digital Services Act
<b>EC</b>	European Commission
<b>EFOW</b>	European Federation of Origin Wines
<b>EU</b>	European Union
<b>EUIPO</b>	European Union Intellectual Property Office
<b>EUTM</b>	European Union Trademark
<b>GDPR</b>	General Data Protection Regulation
<b>GeoTLD</b>	Geographic Top-Level Domain
<b>GI</b>	Geographical Indication
<b>GI.CE</b>	Geographical Indications Collaborative Examination
<b>GNSO</b>	Generic Names Supporting Organization
<b>gTLD</b>	Generic Top-Level Domain
<b>ICANN</b>	Internet Corporation for Assigned Names and Numbers
<b>ICQRF</b>	Ispettorato centrale repressione frodi
<b>INAO</b>	Institut National de l'Origine et de la Qualité
<b>INPI</b>	National Institute of Industrial Property
<b>INTA</b>	International Trademark Association
<b>IP</b>	Intellectual property
<b>IP</b>	Internet Protocol
<b>IPEP</b>	IP enforcement Portal
<b>IPR</b>	Intellectual Property Rights
<b>LCEN</b>	Loi pour la confiance dans l'économie numérique
<b>MDDE</b>	Marca do Dia Eletrónico
<b>MIPAAF</b>	Ministero delle politiche agricole alimentari e forestali
<b>MS</b>	Member State
<b>NAF</b>	National Arbitration Forum
<b>OECD</b>	Organisation for Economic Co-operation and Development

<b>OEPM</b>	Oficina Española de Patentes y Marcas
<b>PDO</b>	Protected Designation of Origin
<b>PGI</b>	Protected Geographical Indication
<b>RCD</b>	Registered Community designs
<b>RSS</b>	Really Simple Syndication
<b>SEO</b>	Search Engine Optimization
<b>SLD</b>	Second-Level Domain
<b>SME</b>	Small and medium-sized enterprises
<b>SUDOE</b>	South-West Europe
<b>TGI</b>	Tribunal de Grande Instance
<b>TLD</b>	Top-Level Domain
<b>TRIPS</b>	Agreement on Trade-Related Aspects of Intellectual Property Rights
<b>TSG</b>	Traditional Speciality Guaranteed
<b>UDRP</b>	Uniform Domain-Name Dispute-Resolution Policy
<b>UIBM</b>	Ufficio Italiano Brevetti e Marchi
<b>UNIFAB</b>	Union des Fabricants pour la protection internationale de la propriété intellectuelle
<b>URL</b>	Uniform Resource Locator
<b>URS</b>	Uniform Rapid Suspension
<b>UTAD</b>	Universidade de Trás-os-Montes e Alto Douro
<b>WIPO</b>	World Intellectual Property Organization
<b>WTO</b>	World Trade Organisation

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## Context and purpose of the guide

With the increasing globalisation of trade and the development of online commerce, the Internet is now asserting itself as a **major area of economic development** for all players in the agricultural world, and mastery of this area is essential to increase and perpetuate customer bases.

The Internet has become a new showcase, a new distribution system for agricultural and agri-food products, which requires companies to reorganise and acquire new technical skills.

Indeed, while the Internet brings many advantages to businesses in terms of visibility and commercial value, it is also a **new competitive space** within which **new conflicts** may arise, between professionals (producers and other operators) on the one hand, and between professionals and consumers on the other.

These conflicts remain ordinary in terms of the problems they raise, with violations generally involving competition law, consumer law or intellectual property law. They are nevertheless original in the channels they use and the responses they require from the professionals concerned.

These problems stem from unfair practices, such as domain name blocking, *cybersquatting*<sup>1</sup> or counterfeiting, but can also arise from competition between equally legitimate holders of prior rights.

Thus, the professional user of the Internet and holder of intellectual property rights<sup>2</sup>, or authorised to use them, must **be aware of the rights he or she enjoys** and consider the best measures to adopt in order to protect them.

The rightful proprietor must first of all be interested in **protecting the name** of the products concerned, but also in **protecting their image and reputation**.

This protection must be implemented upstream in order to prevent litigation, which is known as **"defensive" protection**, but it can also be implemented downstream of an established dispute, which is known as **"offensive" protection**.

A global approach is therefore essential, as Internet commerce adds a new dimension to the so-called "traditional" dimension of physical commerce: because of its immaterial nature, Internet commerce makes its control complex but does not replace the physical infrastructures (shops, warehouses, flow of goods, etc.). The professional must therefore control and **act on two fronts, one physical and the other immaterial**, the two often being intertwined.

Thus, in addition to traditional infringements such as the sale of counterfeit products or the unauthorised use of a name belonging to a third party on physical media, new methods of free riding using the so-called "immaterial" media of the Internet have appeared.

Products under Geographical Indications (GIs), and more particularly Protected Designations of Origin (PDOs) and Protected Geographical Indications (PGIs), play an important role in terms of exports for the countries of the European Union (EU) and are especially affected by these violations because of their **reputation and attractiveness, which are sparking growing interest among third parties**. However, there is currently no strong protection for GIs in terms of domain name allocation, and the very liberal approach proposed by ICANN (Internet Corporation for Assigned Names and Numbers), the American

<sup>1</sup> The practice of registering a domain name that corresponds to an already registered trademark in order to sell it back to the trademark owner.

<sup>2</sup> An intellectual property right holder is a natural or legal person, public or private, who has registered a distinctive sign with an institute in charge of intellectual property rights, such as a word or collective trademark.

corporation governing the allocation of domain names and numbers on the Internet, threatens the protection of GIs on the Internet, whose rights are not always upheld.

Thus, professionals who are legitimate holders of geographical indications must develop a **complete, prudent and exhaustive defence strategy**, in order to take advantage of the undeniable benefits of an Internet presence, while minimising the risks of infringements, which are often complex to contain.

AREPO, the Association of European Regions of Origin Products, has noted the lack, or even the absence, of clear and concrete information on the existing means of protecting GIs on the Internet and has therefore decided to draw up a **practical guide** in order to provide operational tools for the holders and legitimate users of geographical indications, in other words, GI producer groups and their members (producers).

This guide thus aims to provide **deciphered and clarified information** on how the Internet works in terms of intellectual property rights (IPR) and to present the **concrete steps that need to be taken** to effectively protect one's GI from infringement on the Internet.

This guide has been developed within the framework of the Interreg Sudoe [AGROSMARTglobal](#) project, which aims to strengthen the competitiveness, promotion and internationalisation of agri-food cooperatives and small and medium-sized enterprises (SMEs) in the rural areas of Sudoe (South-Western Europe, including Spain, Portugal and the French regions of Nouvelle-Aquitaine and Occitanie), on the digital market.

To carry out its work, AREPO called on experts and practitioners in intellectual property, specialised in French, Spanish and Portuguese regulations, i.e. the three countries covered by the project.

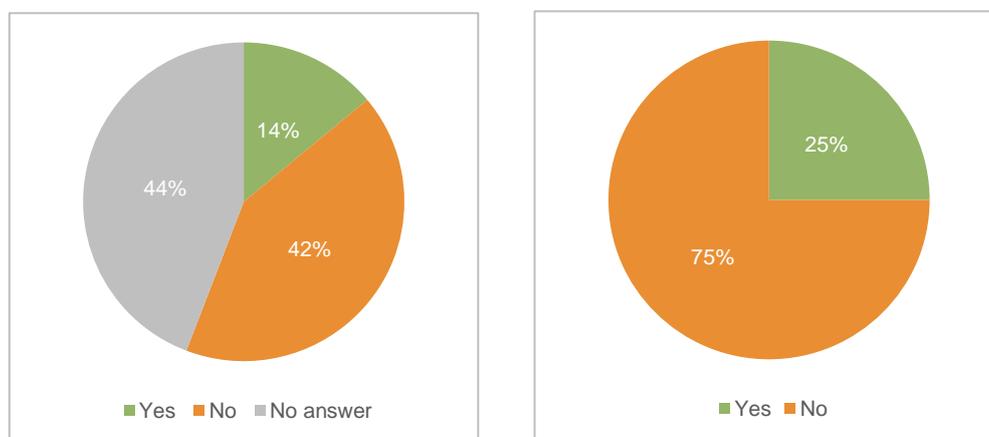


This guide focuses more specifically on the **procedures applicable to France**, with some **emphasis on the specific cases of Spain and Portugal**. It is nevertheless relevant to all GI producer groups in the EU, given the similarities in the approaches and procedures of European countries in this area.

In order to identify more precisely the issues and needs of the organisations concerned and to draw up the most relevant guide possible, AREPO also collected information from GI producer groups and agri-food cooperatives in the EU by means of a survey drawn up for this purpose (Annex 1), the results of which are set out in Annex 2.

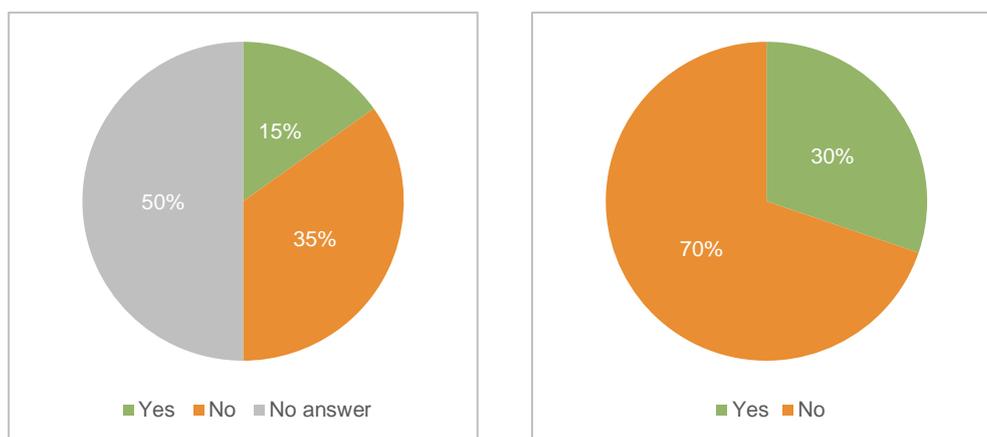
With a panel of 86 participants, mainly composed of French, Spanish, Portuguese and Italian GI producer groups, it appears that 44% of them consider that they are not sufficiently protected against Internet fraud (75% of participants after removing the non-response rate).

**FIG. 1:** Survey results: Would you say that your GI is sufficiently protected against fraud on the Internet? (AREPO, 2022)



It also shows that 38% of the participants think that they do not have enough knowledge about legal protection against Internet fraud (67% of participants after removing the non-response rate) and that 35% of them find it really difficult to collect clear information about the procedures to follow in case of infringement of a geographical indication on the Internet (70% of participants after removing the non-response rate).

**FIG. 2:** Survey results: Do you find it easy to access information on the legal procedures to follow in case of a GI violation on the Internet? (AREPO, 2022)



Finally, 57% of the participants in the survey are indeed interested in a practical guide detailing the main actions to be taken in the event of a GI infringement on the Internet (96% of participants after removing the non-response rate<sup>3</sup>).

<sup>3</sup> 41% non-response to this question.

## Part 1 | Internet: what are the challenges for GIs?

The Internet appears to be the **main vector of economic development today** for all the players in the agricultural world, and particularly in the GI sectors. It allows for easier networking and unparalleled exposure of agricultural and agri-food products of quality and origin. Thus, it is a real boost to the development of European quality systems, such as PDO or PGI<sup>4</sup>.

Nevertheless, the Internet is also a **place of exposure to new risks** that need to be properly identified in order to guard against them and avoid endangering GIs, their image and their reputation.

GI industry players must be aware of the need to protect this asset, especially on the Internet (chapter I.) and of the particularities resulting from the multiplicity of rights to be protected (chapter II.), but they must also consider their responsibilities on the Internet (chapter III.), and better understand the places within the Internet where this protection must be effective (chapter IV.).

The fight against Internet fraud is essential to protect the rights and interests of all GI industry players, but also those of consumers.

### I. Why protect GIs on the Internet?

GIs represent an increasingly attractive **marketing tool** at a time when consumers are placing greater importance on the guarantee of origin of the products they buy (paragraph A). This **image of quality** attached to GIs can nevertheless be coveted (par. B), which should lead the actors in the GI sector to be more vigilant on the Internet, because of the **weaknesses inherent** to this new trading space (par. C).

#### A. New marketing tools

The COVID-19 global pandemic has profoundly modified consumer habits, making the protection of GIs on the Internet a central issue in their development.

Consumers **are looking for quality products** whose origin is controlled and/or certified, "[...] if there is one trend that clearly seems to have emerged stronger from the crisis, it is the 'made in France' and proximity trend."<sup>5</sup> (FranceAgriMer, 2020) [1]. As such, GIs are "*intangible assets with interesting potential for product differentiation*" (WIPO, 2021) [2], and therefore rapidly expanding marketing tools.

Therefore, according to a DG AGRI study of 2021 (European Commission, 2021) [3], the value of European GI products reached €74.76 billion in 2017, an increase of 37% over the period 2010-2017, compared to the period 2005-2010.

GIs therefore provide an **economic advantage to producers** as, on average, the sale value of a GI product is twice as high as that of a product without certification. Furthermore, according to the above-mentioned study, France is the leading EU Member State in terms of the value of sales of its GI products, with a total of 26.9 billion euros, followed by Italy with a total of 15.8 billion euros<sup>6</sup>.

<sup>4</sup> We will group PDOs and PGIs under the common sign "GI".

<sup>5</sup> Quote translated from French

<sup>6</sup> 7.2 billion according to the study, but the exact amounts are not reported (European Commission, 2021) [3].

**FIG. 3:** Sales value by scheme in the EU between 2010 and 2017 (million EUR)  
(European Commission, 2021) [3]

	2010	2011	2012	2013	2014	2015	2016	2017
Wines	29 630	32 099	33 934	34 976	35 741	37 586	37 889	39 418
Agricultural products and foodstuffs	16 603	19 672	21 433	21 922	23 068	23 714	26 074	27 339
Spirit drinks	8 249	9 140	9 458	9 500	9 063	9 456	9 493	10 347
Aromatised wine products	31	36	35	32	37	39	39	43
<b>Total GIs (excluding TSGs)</b>	<b>54 513</b>	<b>59 357</b>	<b>62 852</b>	<b>64 215</b>	<b>66 151</b>	<b>69 483</b>	<b>71 592</b>	<b>74 759</b>
<b>Total (GI + TSGs)</b>	<b>54 513</b>	<b>60 946</b>	<b>64 861</b>	<b>66 431</b>	<b>67 909</b>	<b>70 794</b>	<b>73 495</b>	<b>77 148</b>

Furthermore, consumers are increasingly **buying online** and abandoning physical commerce, making the Internet a central marketplace. In this sense, nearly 9 out of 10 French people (BERTEAU, 2021) [4] and 7 out of 10 Spaniards (IAB Spain, 2020) [5] ordered a product on the Internet in 2020.

The combination of these two trends should lead the GI industry to question **the attractiveness of GIs and the vulnerability that may result from it on the Internet.**

For PGIs alone, infringements resulting from counterfeiting could be estimated at €2.3 billion in 2016 according to a report by the European Union Intellectual Property Office (EUIPO) (EUIPO, 2016) [6].

The table below shows the infringement rates and financial losses to EU consumers by product class. Infringement rates tend to be higher for spirits and for products sold in bulk, such as fruit and vegetables.

**FIG. 4:** Infringements by class of GI products in the EU (EUIPO, 2016) [6]

Class	Infringement rate	Infringing market (€ million)	Consumer loss value (€ million)	Consumer loss (%)
Wine	8.4%	2,182.0	1,349.0	5.3%
Spirits	12.7%	811.6	485.5	7.8%
Cheeses	10.6%	644.7	235.1	3.9%
Fresh meat and meat products	11.0%	402.3	141.3	4.0%
Beers	0.1%	1.2	0.4	0.02%
Fruit, vegetables and cereals	11.5%	94.0	23.3	2.9%
Other	10.0%	277.1	90.5	3.3%
<b>Total</b>	<b>9.0%</b>	<b>4,327.2</b>	<b>2,325.1</b>	<b>4.8%</b>

The Internet is the **main vector for counterfeiting today**, as noted in the *Counterfeiting Plan* of the DGDDI (Direction Générale des Douanes et Droits Indirects<sup>7</sup>): "Over the last few decades, the phenomenon of counterfeiting has expanded considerably, facilitated by the globalisation of trade and the exponential development of the Internet and e-commerce"<sup>8</sup> (DGDDI, 2021) [7] and this vulnerability is all the more important as **it concerns both rights holders**, who are often ill-equipped to combat counterfeiting, **and consumers**, who are often ill-informed and whose interest in quality and original products is nevertheless growing.

The table below shows the infringement rates and financial losses by EU Member State (MS).

FIG. 5: GI infringements by EU Member State (EUIPO, 2016) [6]

Member State	Infringement rate	Infringement value (€ millions)
BG	no infringements found	0
CY	no infringements found	0
EE	no infringements found	0
FI	no infringements found	0
LT	no infringements found	0
SK	no infringements found	0
CZ	2.1%	3.6
ES	5.7% <sup>9</sup>	266.1
SI	6.9%	9.0
DE	7.5%	598.2
IT	8.8%	682.4
BE	9.6%	88.0
PL	9.9%	27.8
FR	10.3%	1,572.8
HU	10.8%	50.7
EL	21.9%	234.5
LU	25.4%	23.0
<b>EU17</b>	<b>9.0 %</b>	<b>3,556</b>
Other MS (extrapolation)		770
<b>EU28: Estimation</b>	<b>9.0 %<sup>10</sup></b>	<b>4,326</b>

#### B. A reputation that attracts the interest of third parties

The **legitimacy of the protection of GIs** comes in particular from the **reputation they carry**. The existence of a reputation is one of prerequisites for obtaining registration<sup>11</sup>.

<sup>7</sup> In English: "French Directorate General of Customs and Excise"

<sup>8</sup> Quote translated from French

<sup>9</sup> Estimation of infringement from Spain for wine is only 0.4% compared to 14.4% for other GI products on the Spanish market. This has a significant influence on the overall Spanish figure because consumption of GI wine accounts for 61% of all GI product consumption in Spain (EUIPO, 2016) [6]

<sup>10</sup> The value for the 11 Member States for which inspection data is unavailable is estimated by applying the 9.0% infringement rate to their market value (EUIPO, 2016) [6]

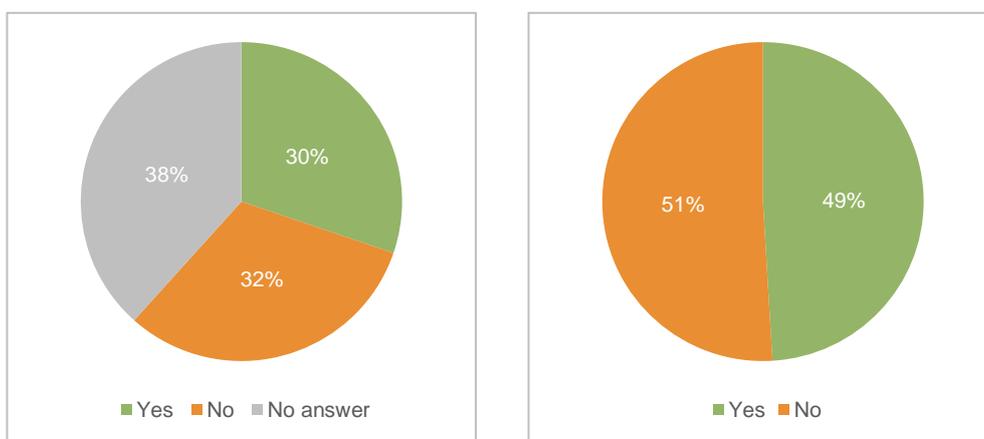
<sup>11</sup> Cf. article L. 721-2 of the CPI for CIGI; art. 5, §1, pt b of the EU Regulation 1151/2012 for agricultural and agri-food GIs; art. 93, §1, pt b of the EU Regulation 1308/2013 for wine GIs; art. 3, §4 of the EU Regulation 2019/787 for spirituous GIs

In this sense, the European courts, and in particular the Court of Justice, have consistently recalled that the primary function of geographical indications is to protect the producers of the products to which these protected names are reserved against misuse by their competitors: "[...] *insofar as those names are legally protected, they must satisfy the objectives of that protection, in particular the need to ensure [...] the safeguarding of the interests of the producers concerned against unfair competition [...]*"<sup>12</sup> (CJEU, Case 12-74, 1975) [8].

The system of geographical indications is therefore meant to **protect their beneficiaries** against misuse of these protected names by **third parties wishing to take advantage of the reputation they have acquired** (CJEU, Case C-108/01, 2003) [9]. However, this risk of usurpation is greatly increased on the Internet since the GI system, which is the very expression of the notion of "terroir", i.e. "[...] *a delimited geographical area in which a human community builds up, in the course of its history, a collective knowledge of production based on a system of interactions between a physical and biological environment and a set of human factors. Socio-technical itineraries are thus brought into play, reveal an originality, confer a typicality, and result in a reputation for a good originating from this geographical space*"<sup>13</sup> (CASABIANCA et al., 2006) [10], is confronted with a space where **delimitations and borders are abolished**, with products brought into contact with **multiple and varied consumers**, attracted by the subjective reputation of GIs without always mastering the objective characteristics or the certainty of its origin. These consumers are therefore likely to be deceived, or even to knowingly buy the counterfeit product out of convenience or opportunism.

As an illustration, almost 30% of the GI producer groups and agri-food cooperatives that responded to the AREPO survey have already faced fraud on their GI on the Internet, as you can see in the figure below (49% of participants after removing the non-response rate).

**FIG. 6:** Survey results: Have you ever faced fraud from your GI on the Internet? (AREPO, 2022)

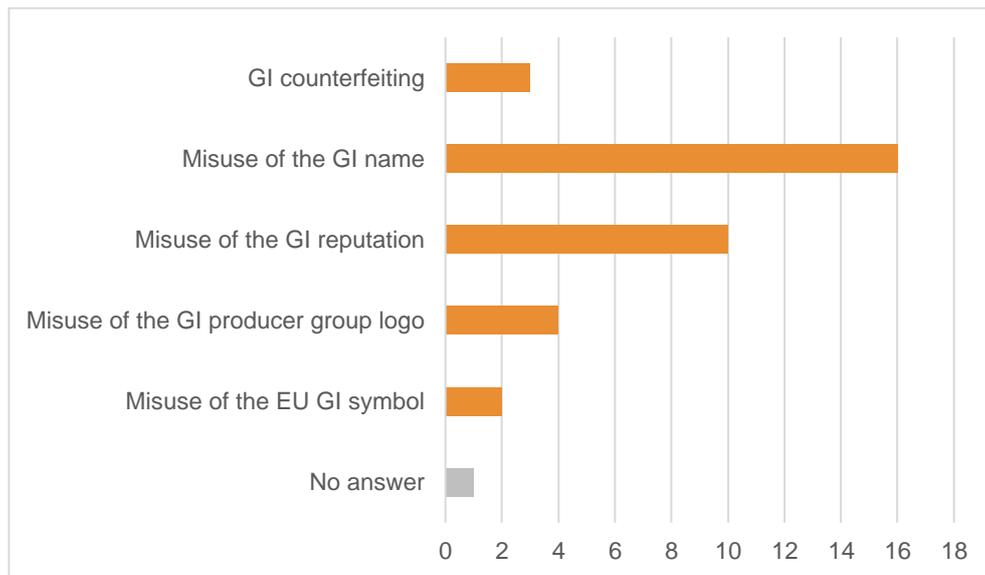


The majority of these frauds involved the usurpation of the GI name and the misuse of its reputation, as you can see in figure 7.

<sup>12</sup> Quote translated from French

<sup>13</sup> Quote translated from French

FIG. 7: Survey results: What kind of fraud was it? (AREPO, 2022)



Ultimately, illicit trade on the Internet is mainly explained by **the reputation of the products** offered for sale, **the prices charged**, **the limited knowledge of consumers** about the products sought and **how to identify them**, but it is also explained by a certain *"social tolerance to illicit trade"*<sup>14</sup> (UNIFAB, ALCCI, 2019) [11].

According to this view, the protection of GIs on the Internet, which refer to a positive idea of quality, typicality and tradition, is therefore indispensable and must be reinforced and controlled.

### C. The structural limits of the Internet

Online trade offers producers and consumers new opportunities and possibilities for buying and selling, regionally, nationally, and internationally.

Nevertheless, the Internet has become **one of the main channels for the sale of counterfeits**.

The sale of counterfeit GI products on the Internet is harmful and harms Internet platforms, legitimate rights holders and users and, most importantly, consumers.

This development of counterfeiting on the Internet is facilitated by the **many structural limitations of the network**.

<sup>14</sup> Quote translated from French

FIG. 8: The structural limits of the Internet (AREPO, 2022)



#### 1. The dynamism of counterfeiting on the Internet

The main challenge in protecting against online counterfeiting is that it is a **dynamic, constantly changing phenomenon that can adapt** to new business models.

Counterfeiters are so sophisticated (see the example of the fragmented distribution of a bottle of wine in paragraph 3 below), they can circumvent the protection strategies implemented against them (European Commission, 2013) [12].

#### 2. Anonymity of counterfeiters

The problem is further compounded by the fact that the Internet is a virtual space, where actors, stocks, and **counterfeit products can be completely untraceable and anonymous**.

A white paper, published on 13 May 2019 by the French associations "Union des fabricants pour la protection internationale de la propriété intellectuelle" (UNIFAB) and "Association de lutte contre le commerce illicite" (ALCCI), summarises the structural limitations that make it so easy to counterfeit on the Internet (UNIFAB, ALCCI, 2019) [11].

In particular, it notes that *"the Internet has become the distribution channel par excellence for illicit trade and in particular for counterfeit goods, due to its anonymity, its ability to operate across various jurisdictions, its ease of presenting sophisticated replicas of official online shops and, above all, its ability to reach large numbers of potential customers easily."*

*The rise of e-commerce platforms (eBay, PriceMinister, Alibaba, etc.) and social networks (Facebook, Twitter, Instagram, etc.) has enabled traffickers to considerably expand their field of operation.*

*Illegal online trade has two main characteristics:*

- ▷ *Selling to the public in violation of the law (ownership, taxation, compliance, contract) which has a competitive advantage (no taxes, purchase costs, manufacturing costs, copyright, standards...).*
- ▷ *An innovative entrepreneurial activity that takes advantage of the opportunities and vulnerabilities of the Internet.*

*According to a 2016 report by the OECD and EUIPO, 63% of counterfeit seizures were postal packages, many of which could be attributed to online sales and e-commerce.*"<sup>15</sup> (UNIFAB, ALCCI, 2019) [11].

Finally, as regards to domain names, since the entry into force in 2018 of the European GDPR reform (General Data Protection Regulation<sup>16</sup>), **the domain name directories** (in other words, the Whois<sup>17</sup>) **no longer publish the personal data of domain name holders**. In order to obtain this information, it is necessary to contact the "registries" directly, which can be time-consuming and costly.

Registries are entities that manage the allocation of domain names used on the Internet for specific geographical areas and make available and maintain Whois, such as:

- ▷ The [AFNIC](#) registry (Association Française pour le Nommage Internet en Coopération): French registry in charge of ".fr" domain names;
- ▷ The [Red.es](#) registry: Spanish registry in charge of ".es" domain names;
- ▷ The registry [Associação DNS.PT](#): Portuguese registry in charge of ".pt" domain names;
- ▷ The [NIC](#) registry: Italian registry in charge of ".it" domain names.

### 3. Fragmentation of violations

Another difficulty is the fragmentation of multiple small violations, which are difficult to trace.

While most transactions via internet platforms are perfectly legal, there are also illicit or fraudulent sellers specialising in counterfeit goods, who exploit the advantages of online trade to offer these products directly to consumers in the EU (European Commission, 2013) [12].

For example, there is an emergence of small resellers who obtain counterfeit goods at low prices and in small quantities and then offer them for sale on websites, without the original seller of the goods, or the goods themselves, necessarily being in the EU.

**These small order flows complicate customs controls.**

Similarly, it is not uncommon for websites to offer **both legal and illegal products for sale at the same time**, which makes detection even more complex.

Finally, the fragmentation of flows may also result from the fact that the products offered for sale on the Internet are not necessarily finished products. For example, in the case of wines and spirits, there are professional sites for materials and equipment needed for counterfeiting. For example, glassmakers in China offer empty bottles of major brands and/or French GIs on well-known platforms such as Alibaba or Amazon. At the same time, in Asia and Eastern Europe, production lines or bottling machines are for sale on the internet. Labels and even anti-counterfeiting technologies can also be found for these products. Artisanal content is then added to the bottles before marketing them on the internet, often to Asia or Eastern Europe (UNIFAB, ALCCI, 2019) [11].

<sup>15</sup> Quote translated from French

<sup>16</sup> Regulation (EU) 2016/679 of the European Parliament and of the Council of 27 April 2016

<sup>17</sup> WHOIS", a contraction of "who is", are directories of domain name owners that can be accessed by anyone using a simple Internet browser. They make it possible to find all the details declared by each domain name holder: surname, first name, postal address, e-mail address, telephone number, etc.

The **fragmented distribution** of these online components **makes their control even more complex**.

#### 4. Ephemeral nature

The **virtual nature of the Internet** goes hand in hand with the **sometimes ephemeral nature of its content**, which makes the detection of violations particularly difficult.

Thus, as the above-mentioned White Paper points out, many social networks have become fertile ground for the sale of counterfeit goods.

For example, the social network Instagram is said to have become a favourite tool for counterfeiters, due to the ephemeral publications it offers, in which the content disappears after 24 hours (MOREIRA, 2019) [13].

In addition to social networks, there is also the development of ephemeral sites, created directly by illicit producers for possible resellers, but also for consumers.

#### 5. Abolition of borders

The Internet has become the main distribution channel for counterfeit products, particularly through **online sales platforms**, allowing the **abolition of all borders**, to the detriment of controls and regulations.

This globalisation of the Internet is the main limitation to organising effective law enforcement.

Many websites are hosted abroad and use offshore payment methods.

For example, for wines, which are emblematic GI products, the OECD (Organisation for Economic Co-operation and Development) estimates the consumption of alcohol of illicit origin at 25% of global adult consumption (OECD, 2016) [14].

On the internet, the main risk areas for French wines and spirits are the following (UNIFAB, ALCCI, 2019) [11]:

1. China / Asia;
2. Russia / Eastern Europe;
3. Latin America / Caribbean;
4. Africa / Middle East.

This **complete delocalisation of the sources of infringing products raises issues with surveillance, control and sanction**, because even if the perpetrators are detected, it is still very difficult to sanction them, due to the territoriality of the GI right and the existence or not of a legal framework protecting GIs in the relevant territory (cf. chapter II, para. A below).

All of these limitations should lead GI industry players to consider which assets should be protected, particularly on the Internet, and what means should be implemented to ensure effective monitoring, greater reactivity, and also a pooling of prevention, regulation and repression actions.

## II. Multiple assets and rights to be protected for professionals

Beyond the inherent limits of the Internet, the difficulty for professionals also stems from the fact that a multiplicity of rights needs to be protected, starting with trademarks and GIs (paragraph A), but also logos (paragraph B), or the image and reputation of GIs and their producers (paragraph C).

## A. Trademarks and geographical indications

Before taking action, the rights holder should be aware that although the registration of any intellectual property right gives the owner a monopoly of use which enables him to prevent use by any unauthorised third party, this protection is limited.

The main difference between a trademark and a geographical indication is that **a trademark**, unless it is well-known or renowned<sup>18</sup>, **is subject to the "principle of speciality"**<sup>19</sup>.

The protection conferred by trademark law is thus limited to the types of goods (or services) covered by the trademark. Infringement of the trademark can therefore only result from the adoption by a competitor of an identical or similar sign<sup>20</sup>, covering identical or similar goods to those for which protection is claimed.

Similarly, the title will be limited to a **sphere of geographical protection, known as the "territoriality principle"**, referring to the territory in which the title has been registered. By way of illustration, the owner of a French trademark will not be able to oppose the registration of an identical trademark in Spain, even for similar goods or services, unless he has previously registered it in Spain or in the EU. Professionals are therefore strongly advised to identify the countries for which it seems necessary to protect their trademarks and to register them with the relevant trademark office.

EU GIs, on the other hand, are systematically recognised and **protected at national** and then **European level**. Some GIs may also be recognised by other countries under bilateral and multilateral agreements.

Counterfeiting on the Internet raises the question of this principle of territoriality: is the owner of a protected title in a given territory authorised to assert his right against anyone who, from a website outside his territory, carries out an unauthorised act of exploitation? The solution is set out in jurisprudence by examining the terms of the disputed offer on a case-by-case basis, in order to determine whether the disputed products are available in the territory in which the rights are effective.

Finally, unlike trademark protection, where registrations must be renewed and are subject to degeneration, **GI protection is perpetual**<sup>21</sup>.

In any case, beyond use, the proprietor of a GI or trademark may become aware of trademark applications by third parties which infringe his signs. In this case, it is always possible to take action by filing an opposition before the relevant trademark office (cf. part 2, chapter I, paragraph B).

## B. Logos

Logos are also assets that can frequently be appropriated on the Internet.

Because of its highly visual aspect, which attracts the consumer's attention, the logo is a very important asset in the physical world. It is also important on the Internet, where websites are real showcases in which the consumer's attention must be attracted by graphic and visual elements.

<sup>18</sup> Well-known or renowned trademarks are not subject to the principle of speciality because of their age and the reputation they have acquired over the years.

<sup>19</sup> The principle of speciality is a rule according to which a trademark is only protected for goods which are identical or similar to those indicated in the application for registration. Therefore, if a third party decides to apply for registration of a trademark which is identical or similar to an existing trademark, but the trademark covers a different type of goods, the proprietor of the existing trademark cannot oppose it.

<sup>20</sup> The sign represents the element protected by the trademark and can take different forms: verbal (e.g. GI names), figurative (e.g. logos), sound, etc.

<sup>21</sup> According to Article L. 643-1, paragraph 1, of the French Rural Code, a geographical indication can never be considered as generic and fall into the public domain, and the same applies to geographical indications protecting industrial and craft products under Article L. 721-8 of the IPC.

In the case of GIs, producer groups may wish to **use a common logo**, in order to mark their GI products with a **distinctive visual sign** directly **identifiable** by the consumer.

Protecting a logo on the Internet can, however, be more complex than protecting a name, because while infringements of a name are easily detected by a keyword system, it can be more complex to detect unauthorised uses of the graphic symbols that logos generally constitute.

However, it is advisable to protect oneself **by registering logos as collective or guarantee trademarks** (cf. Part 2, Chapter I, paragraph C).

FIG. 9: Examples of GI producer group logos (AREPO, 2022)

Logo of the PDO Beurre Charentes-Poitou <i>French butter</i>	Logo of the PDO Queixo Tetilla <i>Spanish cheese</i>	Logo of the PGI Maçã de Alcobaça <i>Portuguese apple</i>	Logo of the PDO Prosciutto di Parma <i>Italian ham</i>
			

### C. Image and reputation

In addition to the various signs referring to GI products, **the image and reputation** of these products must be taken into account as well.

*"Brand image [...] is the publicly perceived representation of a company, organisation or institution (and their services, products and trademarks).*

*The brand image is produced by the combination of a set of representations resulting from the relationships between two or more entities, each of which may simultaneously or alternatively perceive or wish to influence the other.*

*The representations conveyed or associated with the brand image are essentially "mental": even if they reach us via concrete media and/or supports that explicitly have the function of disseminating a constructed and deliberate message, their appropriation by each person is a matter of individual action, with all that it can be, i.e. subjective, unstable, selective, partial and simplifying, but also likely to be part of the exchange, to be accessible to reasoning, to leave room for influence, even manipulation"<sup>22</sup> (Wikipedia, 2022) [15].*

Any mention of a geographical indication on a product that is not covered and therefore does not comply with the provisions of the relevant specifications is likely **to weaken the reputation of the GI**. The usurped consumer who, through ignorance, consumes a counterfeit product, inevitably of inferior quality, may then lose interest in the true GI product and, in good faith, give "bad" publicity to the true GI even though the product that caused his dissatisfaction was illegal.

In short, in addition to attacks on signs, the Internet is also a place where attacks on the image of these signs happen, i.e. **on the consumer's perception of them**. These attacks are multiple and difficult to trace, which is why, in addition to the institutional players who lack the means to establish an effective common

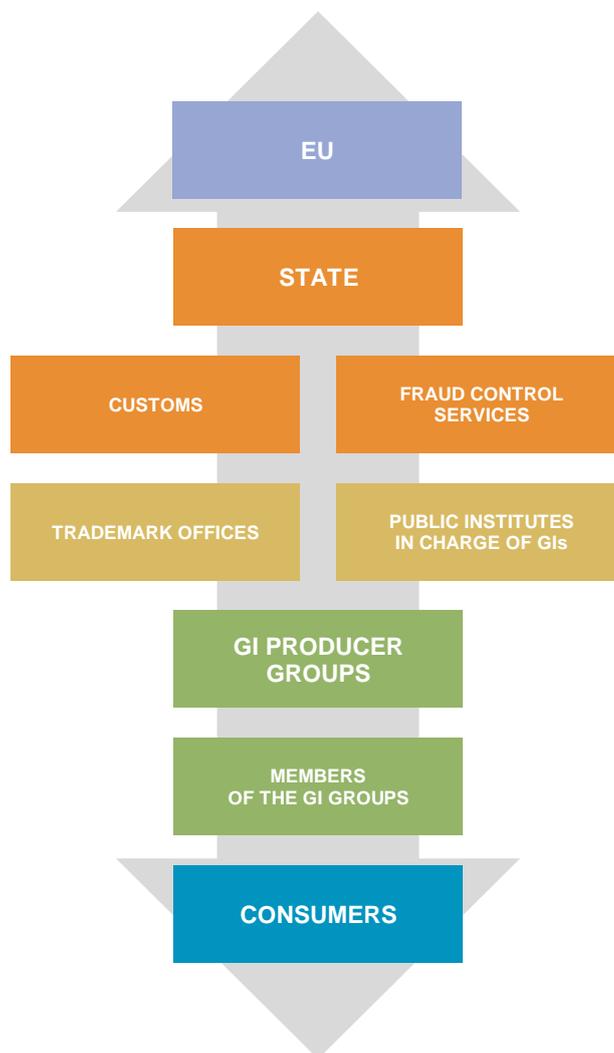
<sup>22</sup> Quote translated from French

strategy, **GI producer groups and their members, consumers and digital actors** must take responsibility.

### III. Actors with rights, but also duties

The weaknesses of the Internet and the multiplicity of rights to be protected are further compounded by the plurality of actors involved in the GI field.

FIG. 10: A plurality of actors involved in the protection of GIs on the Internet (AREPO, 2022)



In addition to institutional actors (paragraph A), professionals themselves must take responsibility, i.e. producer groups (paragraph B) and their members (paragraph C), but also consumers (paragraph D) and digital actors (paragraph E).

#### A. Institutional actors

Despite the **multiplicity of institutional actors** involved in the protection of geographical indications on the Internet, such as:

- ▶ The **European Union**, with, among other actions, its **proposal for reform of EU GIs**, one of whose measures is to support and strengthen the protection of GIs on the Internet (see part 2, chapter

V); and the **Digital Services Act (DSA)**, adopted by the European Parliament on 5 July 2022<sup>23</sup>, which aims to reduce the spread of illegal content and improve transparency between online platforms and their users (Service-public.fr, 2022) [16];

▷ **The State;**

▷ **Customs;**

▷ **Fraud control services** such as the DGCCRF (Direction générale de la Concurrence, de la Consommation et de la Répression des Fraudes<sup>24</sup>) in France, the AICA (Agencia de Información y Control Alimentarios<sup>25</sup>) in Spain, the ASAE (Autoridade de Segurança Alimentar e Económica<sup>26</sup>) in Portugal or the ICQRF (Ispettorato centrale repressione frodi<sup>27</sup>) in Italy;

▷ **Trademark offices** such as the INPI (Institut national de la propriété industrielle) in France, the OEPM (Oficina Española de Patentes y Marcas<sup>28</sup>) in Spain, the INPI (Instituto Nacional da Propriedade Industrial<sup>29</sup>) in Portugal, the UIBM (Ufficio Italiano Brevetti e Marchi<sup>30</sup>) in Italy, or the EUIPO at EU level;

▷ Or the **public institutes in charge of GIs** such as INAO (Institut national de l'origine et de la qualité) in France or AGACAL (Axencia Galega da Calidade Alimentaria<sup>31</sup>) in Galicia.

it is clear that not all Internet crime can be dealt with, as this would require far too many resources and almost instantaneous reaction from the state's law enforcement agencies (UNIFAB, ALCCI, 2019) [11].

In any case, the multiplication of uncoordinated and too fragmented initiatives does not allow for an effective strategic vision.

It is therefore up to the professionals themselves to take action.

## B. GI producer groups

Because of its function as "holder" of the GI, the producer group plays a leading role in defending it on the Internet.

The producer group, as will be shown throughout this guide, has a right to use the GI, but above all is **responsible for the day-to-day management and defence of the GI**, from the drafting of the specifications to the defence and promotion of the name.

Its missions are therefore central, and its actions must be comprehensive. This means acquiring the necessary knowledge and good practices as soon as the GI project is developed.

In this area, it is strongly advised to **keep all records of the financial efforts made** for the development of the project and its implementation (expenditure on consultancy services, audits, communication, etc.), in order to be able to justify economic damage in the event of infringement.

<sup>23</sup> The DSA amends the Directive of 8 June 2000 on electronic commerce (Directive 2000/31/EC)

<sup>24</sup> DGCCRF: Directorate-General for Competition, Consumer Affairs and Fraud Control

<sup>25</sup> AICA: Food Information and Control Agency [Spain].

<sup>26</sup> ASAE: Food and Economic Security Authority [Portugal]

<sup>27</sup> ICQRF: Central Inspectorate for Fraud Control [Italy]

<sup>28</sup> OEPM: Spanish Patent and Trademark Office [Spain]

<sup>29</sup> INPI: National Institute of Industrial Property [Portugal].

<sup>30</sup> UIBM: Italian Patent and Trademark Office [Italy]

<sup>31</sup> AGACAL: Galician Food Quality Agency [Spain].

Faced with the challenges raised by the Internet, it is important that the producer group adopts a cross-cutting approach, which will be detailed below, and which must involve real **pooling of efforts** with producers and **cooperation** and **information sharing** with the competent authorities.

### C. Members of GI producer groups

The members of producer groups, i.e. the producers who are members, also have an important role to play.

Indeed, if they have the right to use the geographical indication in order to enhance the value of their products, they must also bear its constraints and ensure its protection.

Their responsibility is similar to that of the group, they must **communicate and collaborate with the group** as soon as an infringement is identified.

They should also **value and promote the GI** and not just focus on their own brand or company. Simple reflexes, such as the integration of a page dedicated to the GI on their own website (see part 2, chap. III, para. C), make it possible to get the consumer to understand that, while there are brands and a variety of producers, there is first and foremost **a geographical indication that brings these producers together around a common project**.

In this respect, one of the fundamental points beyond scrupulous compliance with the provisions of the specifications, is the adoption and compliance with good practices (e.g. contribution to sustainable development or animal welfare), in order not to tarnish the image of the GI.

This proactive participation in the defence of the GI is an indispensable relay to other actors, whose responsibility and commitment are sometimes very limited, or difficult to activate.

### D. Consumers

Consumers also have a role to play.

Indeed, in addition to rights holders, consumers can also report online counterfeits directly to the platforms involved or by contacting the fraud control authorities in their country. However, they must be made aware of this, hence the essential role played by the **communication** and **education** of GI producer groups and their members to consumers.

To this end, the various actors in the GI sector are advised to **raise consumers' awareness on the risks of fraud**, to **encourage** them to **be vigilant** by obtaining proper information on the GI product before purchasing it online, and to **take action by reporting any frauds they identify** to the competent authorities.

Producer groups and their members must therefore be proactive in their communication to consumers, in order to educate them on counterfeiting and the practical means available to them to avoid falling prey to it, and thus help limit it.

### E. Digital actors

Finally, digital actors such as websites, marketplaces, e-commerce platforms, social networks and search engines also have a key role to play in tackling Internet fraud.

Most of these platforms offer **direct means for rights holders** to report an infringement or to request the blocking or removal of a page or a user/seller. However, it is sometimes very difficult to make effective use of these tools and to provide proof of the rights invoked, given the how little knowledge these platforms have about GIs; they only think in terms of trademarks. This is why it is also advisable for the

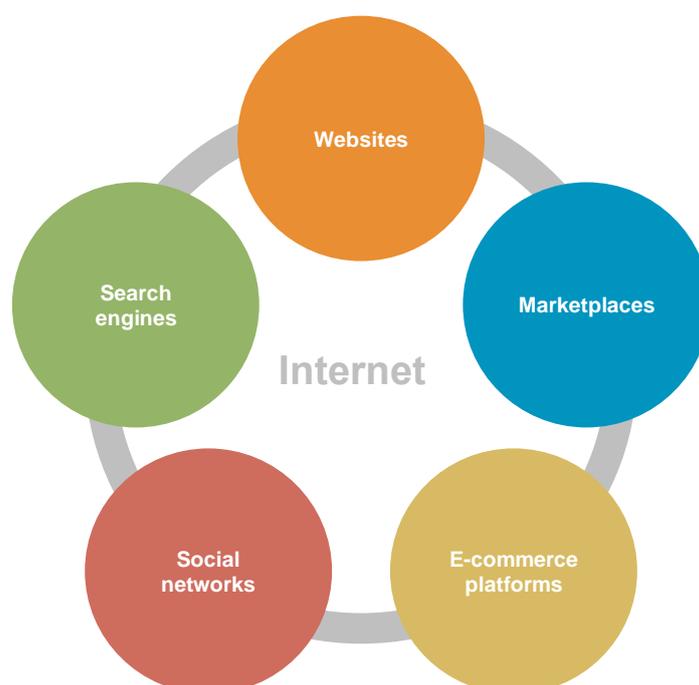
GI sector to **make these platforms aware** of the risks of fraud and to **invite them to collaborate** by reporting any fraud they observe to the competent authorities.

In addition, the responsibility and duties of these actors in relation to fraud may vary depending on the digital channel used.

#### IV. Multiple channels with specific issues

The final obstacle lies in the multiplicity of channels through which asset infringements can be identified, which constitutes a true "mille-feuille" of websites (para. A), marketplaces and e-commerce platforms (para. B), search engines (para. C) and social networks (para. D).

FIG. 11: The "mille-feuille" of Internet channels (AREPO, 2022)



##### A. Websites

Beyond the specific cases of marketplaces, e-commerce platforms, social networks or search engines discussed below, third party websites may contain multiple infringing elements.

In addition to **the domain name**, there are many other elements that can infringe the rights of a GI holder, such as:

- ▷ **The presentation of the website**, which can create confusion by using GI codes (logos, name, evocative terms or visuals, etc.);
- ▷ **The meta tags**<sup>32</sup>, which may contain the name of the GI component or evocative terms;
- ▷ **The products promoted on the website**, which can also cause confusion.

<sup>32</sup> A textual description of the content of a website that appears only in the source code of the site. They are used to transmit information to search engines for the proper referencing of the site, also known as SEO (Search Engine Optimization). A site is said to be well optimised or referenced if it is in the first positions of a search engine on the desired queries.

Once again, the main difficulty is to be able to identify these infringements on all the pages of a site, but also on the system of keywords present in the site's meta tags and allowing redirection to this site.

In addition to this, there are other technical difficulties such as **hosting the website abroad** or the **absence of legal notices**, which can sometimes make it very difficult to identify and contact the operator of the disputed site.

## B. Marketplaces and e-commerce platforms

Marketplaces and e-commerce platforms such as Amazon, Alibaba and eBay are probably **the most problematic channels**<sup>3334</sup>.

In addition to the difficulty of detecting contentious advertisements, it should be added, as indicated in the introduction, that consumers are increasingly buying via the Internet. Marketplaces and e-commerce platforms therefore centralise the majority of sales advertisements, and purchases.

The main difficulty for marketplaces is the **lack of verification of sellers** who may sell under false identities (INTA, 2021) [17].

In addition, **there may be multiple business relationships**, with multiple types of consumers or customers: B2B (Business to Business), B2C (Business to Consumer) or C2C (Consumer to Consumer).

Although most of these platforms offer **direct means for right holders to report an infringement** or request the blocking or removal of a page or a user/seller (cf. part 2, chapter III, paragraph B), it is sometimes difficult to make effective use of these tools and to provide proof of the rights invoked, given the unfamiliarity of these platforms with GIs, which only think in terms of trademarks. Platforms can thus be particularly reluctant to remove contentious ads (TESSIER et al., 2021) [18].

The other important difficulty is the **problem of the legal status of these platforms**.

Indeed, the current regime does not allow the courts, in the event of litigation, to determine with precision whether a marketplace should be qualified as a "publisher" or a "host", i.e. whether it should be responsible for what is published or not.

Often, marketplaces and many other intermediary providers on the Internet **are regarded as mere "hosts"**, a very advantageous status that relieves them of much of the responsibility for monitoring the products distributed on their site.

In France, the LCEN law<sup>35</sup> of 21 June 2004, which transposes the Directive 2000/31/EC on electronic commerce, defines the host as a simple technical intermediary.

As such, it benefits from an **attenuated liability regime**. Thus, Article 6-1-1 of the LCEN provides for the principle of the host's civil and criminal irresponsibility with regard to the content of hosted sites.

Its responsibility can only be invoked if it has been warned of the illicit content of a site, and did not promptly suspend its distribution.

<sup>33</sup> The Proposal for a Regulation of the European Parliament and of the Council on European Union geographical indications for wines, spirit drinks and agricultural products and on agricultural product quality schemes, amending Regulations (EU) No 1308/2013, (EU) 2017/1001 and (EU) 2019/787 and repealing Regulation (EU) No 1151/2012 of 31 March 2022 provides for an Article 43 on injunctions for online platforms.

<sup>34</sup> The Proposal for a Regulation of the European Parliament and of the Council on the protection of geographical indications for artisanal 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 of 13 April 2022, provides for an Article 55 on injunctions for online platforms.

<sup>35</sup> Law for Confidence in the Digital Economy

In this sense, in order to be able to activate the liability mechanism, the legitimate holder must notify the unlawful content to the host, giving him formal notice to remove it promptly (see Part 2, Chapter III, paragraph B for more information on the content of the notification). Then, only if the host does not promptly remove the contentious content, can it be held liable.

### C. Search engines

In addition to marketplaces and e-commerce platforms, search engines such as "Google", "Bing" or "Yahoo" also represent one of the major weaknesses of the protection system since they are the cause of the presence of illegal sales sites in the first search results.

Most search engines offer **direct means for rights holders to report an infringement** or to request a blocking or removal of a page or a user/seller (cf. part 2, chapter III, paragraph B). However, it is technically very complicated to fight this phenomenon for the following reasons (UNIFAB, ALCCI, 2019) [11]:

- ▶ The search engine has a **commercial interest in selling traffic** to a client, even an illicit one, who wants to be listed;
- ▶ Traffickers create **specific powerful tools** to obtain traffic;
- ▶ De-indexing ads **can be very expensive**;
- ▶ And only as a **temporary solution**.

For example, [Google Ads](#), formerly *Google AdWords*, which is Google's advertising network, allows advertisers to purchase ads or banners that will be displayed either on Google software, such as [Google Maps](#) or the Google [search engine](#), or on the [Google AdSense](#) user network. These ads will be targeted according to the browsing behaviour of the user.

### D. Social networks

In addition to websites, marketplaces, e-commerce platforms and search engines, social networks such as Facebook, Twitter and Instagram can also contain infringements.

It has been noted that these networks generally offer **online complaint procedures in the event of an infringement** (see Part 2, Chapter III, paragraph B), but it will first be necessary to locate the infringement in the networks' intricacies, and then the procedure will still have to be successful.

In theory, the network will process the request, and accounts with a username, or publishing any content that may mislead the consumer or infringe the rights of a third party, may then be modified, transferred or permanently deleted by the network in question.

But **there are many limitations to this process**:

- ▶ The claim will only have effect **in the territory in which the right is protected**;
- ▶ Often, the networks hide behind general terms and conditions indicating that they are not in a position to arbitrate disputes that would require too much analysis, and it is therefore **only in cases of clear infringement that the request will be processed**;
- ▶ This can be a never-ending battle, as deleting or blocking a profile does not prevent the **creation of new similar profiles** by the infringer.

The effectiveness of the protection on the networks must therefore be highly nuanced, and it is therefore up to the holder to be very vigilant, while being active on these networks in order to reserve profiles and other accounts, allowing a presence that will have to be coupled with a **surveillance strategy**.

## Part 2 | What strategies should be implemented?

The current state of GI protection on the Internet reveals structural weaknesses that complicate their practical protection, as **this new legal space is still under construction**.

Knowing this, producer groups and producers of products benefiting from a geographical indication must, while communicating with the authorities (in particular customs and fraud control services), build a real strategy for protecting GIs that is both defensive (chapter I) and offensive (chapter II), but also for protecting their image (chapter III). This task appears all the more complex as the jurisprudence relating to GIs, in particular their protection by domain name law, is still being built (chapter IV).

### I. A defensive protection strategy before the rights violation

In order to best protect one's GI on the Internet, it may be useful to adopt a three-pronged strategy based on **protection of the name** against domain name registration (para. A) and word trademark registration (para. B), **protection of the GI's own figurative elements** (para. C) and **proactive monitoring** of potential **infringements** (para. D).

#### A. Protection of the name constituting the GI: domain names

With regard to the protection of the name forming the GI, the most effective way to avoid fraudulent domain name registration by third parties is to register the domain names with strategic extensions oneself.

##### 1. What is a domain name?

Each website has an IP address<sup>36</sup> (unique number) which represents its "identity card".

However, IP addresses are complex to remember and do not distinguish between different website resources. Domain names were therefore created to **make access to websites more intuitive for users**: when a user enters a domain name in his or her search bar, a request is sent to a set of servers from the domain name system (DNS). The DNS then responds with the IP address of the website's hosting server, making it accessible.

The domain name is therefore the **main component of the address of a website** which, because of its intensive use, has become a distinctive sign for an economic operator, in the same way as the sign for a physical shop. This makes it possible to **identify a company or its products** and thus constitutes a sign that attracts customers.

The structure of a web address, apart from the protocol name "http", then ":" and "/" to make the address usable ("http://"), is generally composed as follows:

1. A technical prefix: "www" (world wide web) which means "Internet at the global level";
2. A **domain name**, consisting of:
  - A **second-level domain** (SLD): a "root" domain generally corresponding to the name of a company, a registered trademark, or a geographical indication. It precedes the top-level domain;
  - A **top-level domain** (TLD): it includes two main types of extensions: extensions referring to the official geographical territory code of the website, which are called ccTLDs (Country Code Top-Level Domain) and which are systematically composed of two letters (e.g. ".eu"; ".fr"; ".es"; ".pt";

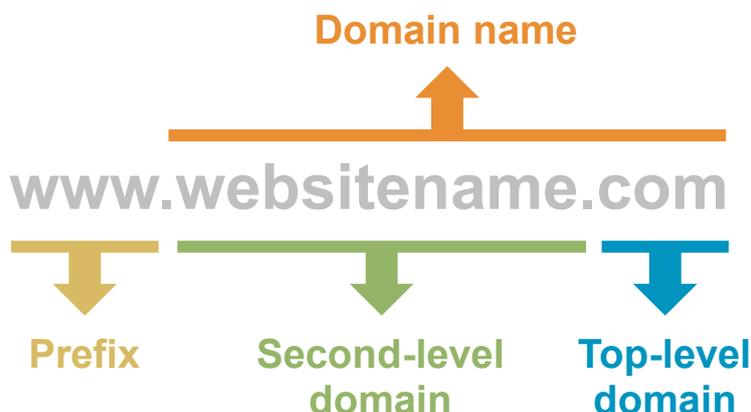
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<sup>36</sup> IP: Internet Protocol

".it"; etc.) and the so-called "generic" extensions, which are called gTLDs (Generic Top-Level Domain), which are characterised by a thematic field and which are systematically made up of three or more letters (e.g. ".com"; ".org"; ".net"; ".info"; etc.) The top-level domain is located immediately after the dot "." that follows the second-level domain.

The domain name is therefore made up of **several successive domains separated by a dot "."**.

FIG. 12: Structure of a web address (AREPO, 2022)



ICANN, an American private law association, is responsible for creating domains in the domain name system (or DNS), and for allocating domain names according to rules common to all registries that will manage the domains created under its aegis, known as the "ICANN Policy", or "UDRP" (Uniform Domain-Name Dispute-Resolution Policy).

Once the domains have been created, ICANN appoints legal entities called "**registries**" which will be responsible for the organisation, administration and management of the extension or domain and which will manage the allocation of domain names and make available and maintain the Whois:

- ▷ In **France**, the registry [AFNIC](#) is responsible for managing domain names with the country code ".fr";
- ▷ In **Spain**, the registry [Red.es](#) is in charge of managing domain names with the country code ".es";
- ▷ In **Portugal**, the registry [DNS.PT](#) is responsible for managing domain names with the country code ".pt";
- ▷ In **Italy**, the [NIC](#) registry is responsible for managing domain names with the country code ".it".

These registries select "registrars"<sup>37</sup> who will act as an interface between them and domain name applicants, registering domain names with the registries and collecting filing and renewal fees.

## 2. Rules governing domain names

The main rule, which follows the principle applicable to all intellectual property rights, is that **priority is given to the first person to reserve the right**<sup>38</sup>. The first person to reserve the right is the holder of the name, without any justification being required from the applicant for the domain name at the time of registration.

In addition, as mentioned above, ICANN has also adopted **guidelines or "UDRP" principles**, which provide elements for resolving disputes between domain name holders and holders of other intellectual

<sup>37</sup> In France, Article L. 45 of the French Post and Electronic Communications Code governs the procedures for appointing the organisations responsible for managing ".fr" domain names.

<sup>38</sup> French Post and Electronic Communications Code in Articles L. 45-1, 45-2 and R. 20-44-46.

property rights. Indeed, the principle of allocating the domain name to the first registrant **may conflict with the rights of a third party**.

There are also other rules laid down in "**naming charters**". These charters bring together the rules governing the use of a top-level domain (or "extension") and are created by the registries authorised to manage the domain in question. They include the essential elements of the guidelines regarding administrative, legal and technical aspects (AFNIC, 2020) [19].

With regard to ".fr" domain names, under the terms of Article 5.1. of the AFNIC Naming Charter, holders of a domain name in the ".fr" zone may be, "[...] *any natural person residing in the ".fr" zone and any legal entity having its registered office or principal place of business:*

- ▷ *on the territory of one of the member states of the European Union;*
- ▷ *on the territory of the following countries: Iceland, Liechtenstein, Norway, Switzerland"<sup>39</sup>. (AFNIC, 2020) [19]*

The applicant does not have the possibility to negotiate the registration contract proposed by the office, they have to respect the charter imposed on them and pay the fee requested from the registry.

The domain name is then reserved for the duration of its registration, which is renewable and subject to the payment of a fee.

At the time of registration, contacts for technical and administrative matters and billing should be provided<sup>40</sup>, which will then be included in the domain name database, the "Whois" database.

The **registration formalities are therefore not very restrictive**, and the registrar is not subject to an obligation to advise or to search for prior art<sup>41</sup>.

The sources presented above show that the choice of domain name is free, so it is possible to choose a descriptive domain name, which will be valid but difficult to protect against third parties who wish to reserve a similar domain name.

However, the freedom of choice is limited insofar as the domain name must not infringe public policy<sup>42</sup> and must comply with the syntax constraints<sup>43</sup>.

However, **registers do not check for prior art, nor is there an opposition procedure**, as in trademark law.

### 3. Reservation as an effective barrier

The most effective first barrier would therefore be for the GI industry to **reserve domain names containing the name of their GI** with the most strategic extensions.

As such, almost 44% of the participants in the AREPO survey would have registered at least one domain name containing the name of their GI in the DNS, as you can see in the figure below (81% of participants after removing the non-response rate).

The non-response rate, which still amounts to 45%, should not be dismissed, however, since it highlights the lack of mastery of the domain name issue by the players in the GI sector.

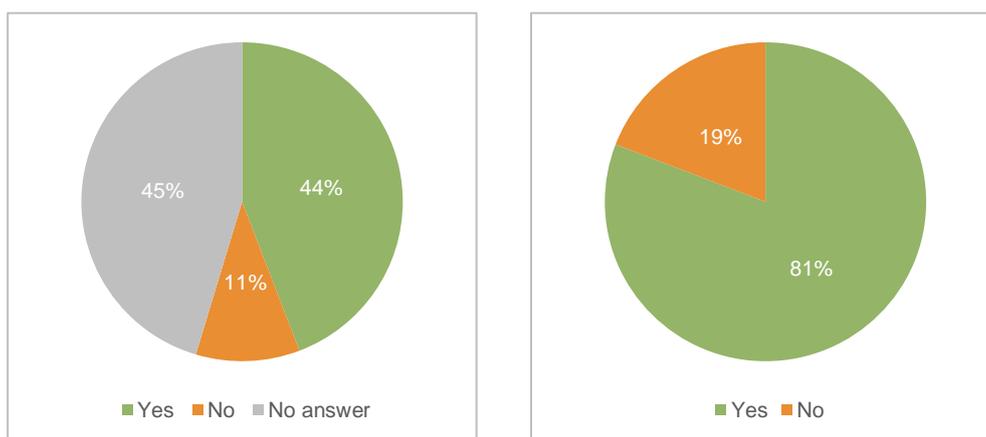
<sup>39</sup> Quote translated from French

<sup>40</sup> The provision of false information by the applicant will, in disputes with third parties, often be considered as an indication of bad faith and it is the contact who will be considered the holder of the domain name. The sanction may be the blocking and, if necessary, the deletion of the domain name.

<sup>41</sup> The 2020 AFNIC charter indicates in its article 4-3 a limited liability of the registrar.

<sup>42</sup> Article 45, 2°, (1) of the French Post and Electronic Communications Code and Article 2-4-26 of the AFNIC Charter.

<sup>43</sup> Article 2-2 of the AFNIC Charter.

**FIG. 13:** Survey results: Is your GI registered as a domain name in the DNS? (AREPO, 2022)

We wish to remind the reader that there is **no limit to the registration of domain names, nor is there any obligation of use**. In short, a producer group may reserve several domain names for its GI alone, solely for the purpose of preventing any malicious reservation by a third party. It is nevertheless advisable to redirect all registered domain names to the official website to improve its referencing and gain visibility.

This preventive registration therefore makes it possible to avoid or **limit the phenomenon of cybersquatting as much as possible**.

This technique of fraudulent registration of domain names by a third party consists in reserving a GI name without having any rights to that name, in order to:

- ▷ resell the domain name to the rightful owner of the right (trademark or GI) at a very high price;
- ▷ prevent the legitimate holder of the name from reserving it as a domain name and damage the image of the name;
- ▷ take advantage of the name's reputation, for example by redirecting the domain name to their own website to generate visits.

Even if *cybersquatting* is legally sanctioned (the limit being set by ICANN, which does not recognise GIs as anteriorities that can be used against a later identical or similar domain name), it is better to protect yourself **by registering your domain name under different strategic extensions in advance**.

However, it should be borne in mind that the reservation/registration of a domain name is only an exclusive right of use **granted for a defined period**.

In principle, this period may be renewable for a period of between one and ten years. It is therefore essential, before the expiry date of the domain name, to take the necessary steps to retain its use.

Without action on the part of the holder, the renewal is not carried out and **the domain name becomes free for reservation by potential cybersquatters**.

**FOCUS ON SPAIN**

In Spain, Judgment 67/2014 of 14 March 2014 of the Provincial Court of Granada (AC<sup>44</sup> 2014/646) states in its third-party law basis that *"We specified in our Judgment of 20 July 2012 (AC 2013, 772), citing the SAP of Barcelona (Section 15) of 25 May 2009, that "domain names are a system for identifying and locating computers connected to the Network (INTERNET). However, domain names, as the doctrine recognises, in addition to being able to define them technically as a computer address, are also legal distinctive signs insofar as they fulfil the function of distinguishing resources introduced on the Internet due to their different origin linking a subject with a website and the owner of the website with the content or activity proposed or developed on that website and, therefore, when the nature of the content or activity is commercial or professional fulfils essentially the function of trademarks and trade names, may generate conflicts between domain names and trademarks or trade names."*<sup>45</sup>.

In Spain, "[red.es](#)" is the national authority for the management of domain name registries under the country code ".es". The legislation applicable to domain names can be found on the website of "[red.es](#)" and can be accessed at the [following link](#).

Nevertheless, the best way to protect against infringements is to inform third parties of the consequences of an infringement.

In Spain, there are a multitude of structures that can be used as relays in the event of an infringement, in particular the competent administrative authorities in charge of protecting these distinctive signs, such as the national Ministry of Agriculture (accessible at the [following link](#)), or the regional ministries of agriculture, such as that of the Autonomous Community of Extremadura (accessible at the [following link](#)), the Autonomous Community of Catalunya (accessible at the [following link](#)) or the Autonomous Community of Castilla La Mancha (accessible at the [following link](#)), or the Spanish Trademark Office, the OEPM (accessible at the [following link](#)).

**FOCUS ON PORTUGAL**

In its decision of 26 February 2015, the Portuguese Supreme Court (case 1288/05.6TYLSB.L1.S1) concluded: *"The domain name [on the Internet], similarly to the trademark or the corporate name of a commercial company, assumes an inductive function, communicating information and suggestions about a certain product or service, for which reason the use of a domain name, correctly assigned from a technical point of view, may result in an infringement of industrial property law, particularly with regard to the rules of trademark protection and unfair competition"*<sup>46</sup>.

In Portugal, the association DNS.PT<sup>47</sup> is responsible for managing ".pt" domain names and selects the registrars that will act as an interface between the association and the applicants for a domain name, registering the domain names with the registrars and collecting the registration

<sup>44</sup> AC: Acta Constitucional (Spanish Constitutional Law)

<sup>45</sup> Quote translated from Spanish

<sup>46</sup> Quote translated from Portuguese

<sup>47</sup> Competent body according to Decree-Law 55/2013, of 17 April, to manage ".pt"

and renewal fees<sup>48</sup>.

Although the registrar is not subject to an advisory obligation or an obligation to search for prior art, the freedom to choose domain names is not unlimited.

In particular, Article 6/1/c) of the ".pt" Rules prohibits the registration of a domain name if it corresponds to a Portuguese or European geographical indication or to a geographical indication protected by law.

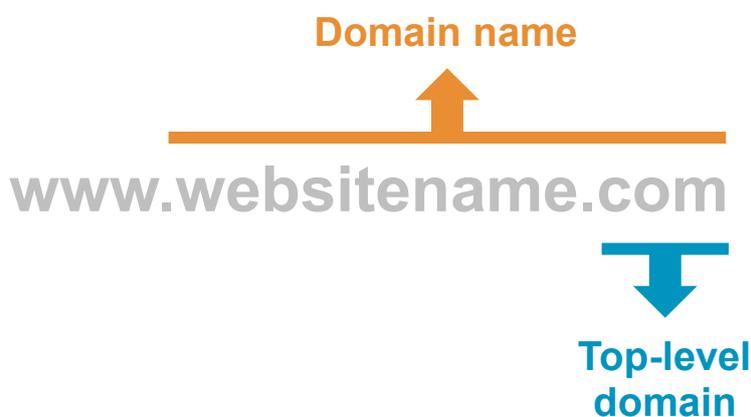
Similarly, Article 6/1/d) prohibits the registration of geographical names, defined in Article 7 as "any name, regardless of the language used, which coincides with the name of a country, parish, municipality or administrative region or with the name of a foreign city which, because of its relevance, is a matter of public knowledge". As an exception, Article 7/2 allows administrative authorities to register such domains.

#### 4. Terms, concepts and extensions to be protected as a domain name

As explained above, producer groups are strongly advised to register the name of their geographical indication in the domain name system under several extensions (top-level domains) in order to prevent potential fraud on the Internet as much as possible, but it is also advisable to look at the terms and concepts to be protected as second-level domains, beyond the exact name of the geographical indication.

##### ► The top-level domains

FIG. 14: The top-level domain in a web address (AREPO, 2022)



##### ► ccTLDs (Country Code Top-Level Domain)

Firstly, it is recommended that producer groups register the name of their geographical indication with the country extension associated with the protected geographical area of the GI. These extensions are called ccTLDs (Country Code Top-Level Domain).

Examples of domain names with:

- For France: this is the extension under the country code ".fr", managed by the [AFNIC](#) registry, e.g.: "champagne.fr" (PDO "[Champagne](#)", sparkling wine); "porcsdelasarthe.fr" (IGP "[Porc de la Sarthe](#)", pork); floc-de-gascogne.fr (PDO "[Floc de Gascogne](#)", liqueur wine); etc.;

<sup>48</sup> The general rules of the ".pt" domain name registry are available at the [following address](#)

- ▶ For Spain: this is the extension under the country code ".es", managed by the [Red.es](#) registry, e.g.: "quesomanchego.es" (PDO "[Queso Manchego](#)", cheese); "domontesdetoledo.es" (PDO "[Montes de Toledo](#)", olive oil); "patacadegalicia.es" (PGI "[Patata de Galicia / Pataca de Galicia](#)", potato); etc.;
- ▶ For Portugal: it is the extension under the country code ".pt", managed by the [DNS.PT](#) registry, e.g.: "ananasdosacores.pt" (PDO "[Ananás dos Açores/São Miguel](#)", pineapple); "perarocha.pt" (PDO "[Pêra Rocha do Oeste](#)", pear); "azeitedoalentejo.pt" (PDO "[Azeite do Alentejo Interior](#)", olive oil); and so on;
- ▶ For Italy: this is the extension under the country code ".it", managed by the [NIC](#) register, e.g.: "prosciuttodiparma.it" (PDO "[Prosciutto di Parma](#)", ham); "mortadelladipratoigp.it" (PGI "[Mortadella di Prato](#)", cold cuts); cintasenesedop.it (PDO "[Cinta Senese](#)", pork); etc.

While it is essential to register one's GI name with the associated country extension, it is also important to look at the countries where the product is marketed and where the risk of usurpation is high. For example, the group of producers of the PDO "Prosciutto di Parma" (Italian ham) has registered the domain name "prosciuttodiparma.uk", among others (the group has registered nearly 67 domain names for its geographical indication alone). ".uk" is the official ccTLD of the United Kingdom.

For the most renowned GIs, it is also recommended to register the GI name with the official EU ccTLD:

- ▶ For the European Union: ".eu", e.g.: "cerezadeljerte.eu" (PDO "[Cereza del Jerte](#)", cherry); "formaggiopiave.eu" (PDO "[Piave](#)", cheese); "prosciuttodiparma.eu" (PDO "[Prosciutto di Parma](#)", ham); etc.

N.B.: the ".tv" extension, which is the official ccTLD of the Tuvalu Islands, has been hijacked by the media, which now use this extension to refer to television. This extension has become so popular (notably because of the famous streaming platform "Twitch" which uses this extension in the URL<sup>49</sup> of its website) that some producer groups have registered their GI denomination with this extension, e.g.: "dovaldeorras.tv" (PDO "[Valdeorras](#)", Spanish wine).

According to the survey platform W3Techs (Web Technology Surveys), the 10 most popular "ccTLDs" in the world in November 2022 would be the following:

FIG. 15: Top 10 most popular ccTLDs in November 2022 (W3Techs, 2022) [20]

	TLD	Percentage	Meaning	Date	Type
1	.ru	4,0 %	Russia	1994	ccTLD
2	.de	2,1 %	Germany	1986	ccTLD
3	.uk	2,0 %	United Kingdom	1985	ccTLD
4	.au	1,7 %	Australia	1986	ccTLD
5	.in	1,6 %	India	1989	ccTLD
6	.ir	1,3 %	Iran	1994	ccTLD
7	.jp	1,2 %	Japan	1986	ccTLD

<sup>49</sup> URL: Uniform Resource Locator. The URL is the string of characters that make up a web address (e.g. "http://www.website.com").

8	.fr	1,2 %	France	1986	ccTLD
9	.ca	1,0 %	Canada	1987	ccTLD
10	.it	1,0 %	Italy	1987	ccTLD

The ccTLDs ".es" and ".pt" represent 0.5% and 0.1% of websites in 2022 respectively. The ".eu" ccTLD will represent 0.4% of websites in 2022. 250 ccTLDs are currently available on the market.

#### ► The original gTLDs (Generic Top-Level Domain)

It is also recommended that producer groups register the name of their GI with so-called "generic" extensions that have an international dimension and are particularly popular. These extensions are called gTLDs (Generic Top-Level Domain): ".com"; ".org"; ".net"; ".info"; etc.

Among the oldest gTLDs that appeared first in 1985 (".com"; ".org"; ".net"; ".edu"; ".gov"; ".int"; ".mil"; ".arpa"), then in the 2000s (".info"; ".pro"; ".coop"; ".aero"; ".biz"; ".museum"; ".name") and 2004 (".asia"; ".cat"; ".jobs"; ".mobi"; ".post"; ".tel"; ".travel") [21]The most popular domain names in the world would be the following according to the W3Techs survey platform:

FIG. 16: The 10 most popular original gTLDs in November 2022 (W3Techs, 2022) [20]

	TLD	Percentage	Meaning	Date	Type	Subtype
1	.com	51,1 %	Commercial	1985	gTLD	Standard
2	.org	4,4 %	Organization	1985	gTLD	Standard
3	.net	3,1 %	Network	1985	gTLD	Standard
4	.info	0,5 %	Information	2000	gTLD	Standard
5	.pro	0,1 %	Professional	2000	gTLD	Standard
6	.edu	0,1 %	Education	1985	gTLD	Community
7	.gov	< 0,1 %	Government	1985	gTLD	Community
8	.asia	< 0,1 %	Asia	2004	gTLD	Geographic
9	.cat	< 0,1 %	Catalunya	2004	gTLD	Geographic
10	.coop	< 0,1 %	Cooperatives	2000	gTLD	Community

As you can see in Figure 16 above, **the generic TLD ".com" is the most popular TLD in the world** and has been since its inception. It represents more than 51% of the top-level domains in 2022 according to the W3Techs survey platform (W3Techs, 2022) [20]. The ".com" extension is particularly used by American organisations, which have completely abandoned the ".us" ccTLD, which is not on the list of the ten most popular ccTLDs in 2022 (see Figure 15).

Examples of domain names with the original:

- ▷ ".com" extension, e.g.: "sauternes.com" (PDO "[Sauternes](#)", sweet wine); "lamanchawines.com" (PDO "[La Mancha](#)", wine); "dopoliterraalta.com" (PDO "[Aceite de Terra Alta / Oli de Terra Alta](#)", olive oil); "moulis.com" (PDO "[Moulis / Moulis-en-Médoc](#)", wine);

The ".org" extension comes next with 4.4% of users according to the W3Techs survey platform. This extension is generally used by non-profit organisations.

- ▷ ".org" extension, e.g.: "tartadesantiago.org" (PGI "[Tarta de Santiago](#)"); "cerezadeljerte.org" (PDO "[Cereza del Jerte](#)", cherry); "pomme-limousin.org" (PDO "[Pomme du Limousin](#)", apple); "piavecheese.org" (PDO "[Piave](#)", cheese); etc.

Other generic extensions, such as ".net" (which means "network" and is often used by organisations that have not succeeded in obtaining the ".com" extension), or ".info" (which means "information" and is generally dedicated to sites providing data of an informative nature), are also very popular generic extensions, e.g.: "prosciuttoveneto.net" (PDO "[Prosciutto Veneto Berico-Euganeo](#)", ham); "parmahams.info" (PDO "[Prosciutto di Parma](#)", ham); etc.

The ".asia" and ".cat" TLDs, on the other hand, were the first geographic TLDs (or geoTLDs) to appear before the launch of ICANN's call for applications in 2012. They differ from ccTLDs in that they refer to a geographical area but not to the official code of a country. The ".cat" extension refers to the autonomous community of Catalunya and many producer groups in the region have reserved the name of their GI with this extension, e.g.: "pomadegirona.cat" (PGI "[Poma de Girona](#)", apple); "dopoliterraalta.cat" (PDO "[Aceite de Terra Alta / Oli de Terra Alta](#)", olive oil); etc.

#### ▷ The new gTLDs (New Generic Top-Level Domain)

In 2012, ICANN launched a call for applications for the introduction of new generic extensions (gTLDs) into its domain name system, offering both opportunities and risks of *cybersquatting*.

Since the launch of this call for applications and until today, more than 1900 proposals have been identified and have given rise to **nearly 1300 new generic extensions** now available on the market (less than 25 extensions existed until then), according to the ICANN Statistical Program (ICANN, 2022) [22].

These new gTLDs are divided into four categories: 1. new standard gTLDs (non-restrictive), 2. new community gTLDs (restrictive), 3. new geographic gTLDs (restrictive) and 4. new branded gTLDs (restrictive) (ICANNWiki, 2021) [23].

#### ▷ The new standard gTLDs

The new standard gTLDs are available for reservation by all and without condition. They are now the most numerous.

These new gTLDs are intended for players who want their domain name to **reflect more accurately the content of their website**. They therefore mainly refer to generic terms and concepts, such as: ".photo"; ".consulting"; ".supply"; ".website"; ".business"; ".agency"; ".restaurant"; ".catering"; ".art"; ".bar"; ".club"; ".top"; etc.

These new standard gTLDs are added to the original list of standard gTLDs (".com"; ".net"; ".org"; ".info"; etc.).

While these new gTLDs make it easier for users to identify websites, they also open up **new possibilities for cybersquatting**. Indeed, these new gTLDs can also refer to types of food products such as ".wine" or ".vin"; ".coffee" or ".cafe"; ".beer"; ".vodka"; or ".organic" or ".bio"; etc. However, it turns out that no conditions are required for the registration of these new gTLDs with ICANN and that anyone can be assigned the management of these extensions on a delegated basis with a "first come, first served"

policy, which represents a **real threat for geographical indications**. The case of the ".wine" and ".vin" domains offers a good illustration.

#### The ".wine" and ".vin" extensions case:

The American company "Donuts Inc", created in 2010 specifically to invest in the purchase of top-level domains, was one of the first to apply for the registration of the ".wine" and ".vin" extensions in 2012 and obtained their management under delegation by ICANN, even though said company has no relationship with the wine sector.

However, this company, which was created solely with the aim of getting rich by exploiting domain names, practices a "highest bidder" policy, without any consideration for the legitimate holders of geographical indications. As a result, anyone with the means to outbid them could reserve, for example, the domain names "bordeaux.wine", "rioja.wine" or even "champagne.wine".

This situation obviously aroused the concern and anger of French and European wine producer groups. Negotiations were then launched between the winegrowers (with the help of the French federation CNAOC (Confédération Nationale des producteurs de vins et eaux de vie de vin à Appellations d'Origine Contrôlées), the EFOW (European Federation of Wine) and the French Secretary of State for the Digital Sector), and the company "Donuts Inc." about the conditions for the attribution of these extensions: *"Donuts discussed with us but did not want to negotiate the conditions for the attribution of the domain names. We are in fact asking that the second-level domain name be reserved for the structure managing the appellation or the interprofessional organisation"*<sup>50</sup>, explained Pascal Bobillier-Monnot, at that time director of the CNAOC (Silicon.fr, 2014) [24].

Finally, after three years of negotiations, a confidential agreement was reached, resulting in a list of names reserved for holders of geographical wine indications. However, this protection remains relative and incomplete.

The company "Donuts Inc" is now called "Identity Digital" and opened the extensions ".wine" and ".vin" to the general public in January 2016. A domain name reserved with one of these extensions now costs an average of €50.00 per year.

#### ▸ The new community gTLDs

New community gTLDs are available for reservation only under certain conditions. **They are intended for specific communities** wishing to operate their own registry. Thus, only organisations linked to these new gTLDs can reserve them.

These new community gTLDs refer to cultural communities, government organisations, associations or certain economic sectors, such as: ".bank"; ".finance"; ".catholic"; ".aarp"; etc.

These new community gTLDs are added to the original list of community gTLDs (".gov"; ".edu"; ".coop"; ".museum"; etc.).

#### ▸ New geographic gTLDs (or geoTLDs)

New geographic gTLDs are available for reservation only under certain conditions.

They differ from ccTLDs in that **they refer to a geographical area but not to the official code of a country**. More specifically, they can refer to a *"geographical, geopolitical, ethnic, social or cultural representation"* (ICANNWiki, 2021) [25], such as: ".paris"; ".alsace"; ".corsica"; ".madrid"; ".berlin"; ".eus" (Euskadi); ".gal" (Galicia); etc.

Prior to ICANN's 2012 call for applications, only the geoTLDs ".asia" (Asia) and ".cat" (Catalunya) were available for reservation.

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<sup>50</sup> Quote translated from French

Ultimately, anyone who wishes to include a place, town or region in their domain name can now do so. Producer groups are therefore advised to reserve the name of their GI with extensions referring to the geographical area of the GI, where appropriate, and to keep a regular watch on the new geoTLDs introduced by ICANN.

To see the list of geoTLDs currently on the market, [go here](#).

Regarding the registration of new geoTLDs, any applicant wishing to file an application with ICANN must submit "*documentation of support or non-objection from the relevant governments or public authorities*" according to the 2012 ICANN Applicant Guidebook (ICANN, 2012) [26].

This principle was called into question in 2018 when [ICANN consulted](#) on the possibility of allowing any actor to register a name referring to a geographical area as a TLD without the prior knowledge of the community or public authority concerned, which would have represented a major risk for geographical indications.

The report concludes, however, that "[...] *the Work Track was unable to agree to recommendations that depart from the 2012 implementation, which it has considered the baseline throughout deliberations. Therefore, it recommends updating the GNSO [Generic Names Supporting Organization] policy to be consistent with the 2012 Applicant Guidebook and largely maintaining the Applicant Guidebook provisions for subsequent procedures.*" (ICANNWiki, 2022) [27].

Nevertheless, it is important to remain vigilant regarding ICANN's liberal policy, which reasons only in terms of trademarks and lacks consideration for protected geographical names.

#### ► The new branded gTLDs

New branded gTLDs are available for reservation only under certain conditions.

They are dedicated to large companies and organisations **wishing to have their own brand name as a domain extension**, such as: ".amazon"; ".alibaba"; ".airbus"; ".apple"; ".android"; ".nike"; ".unicef"; ".snf"; etc.

According to the survey platform W3Techs, the 10 most popular "New gTLDs" in the world in November 2022 would be the following:

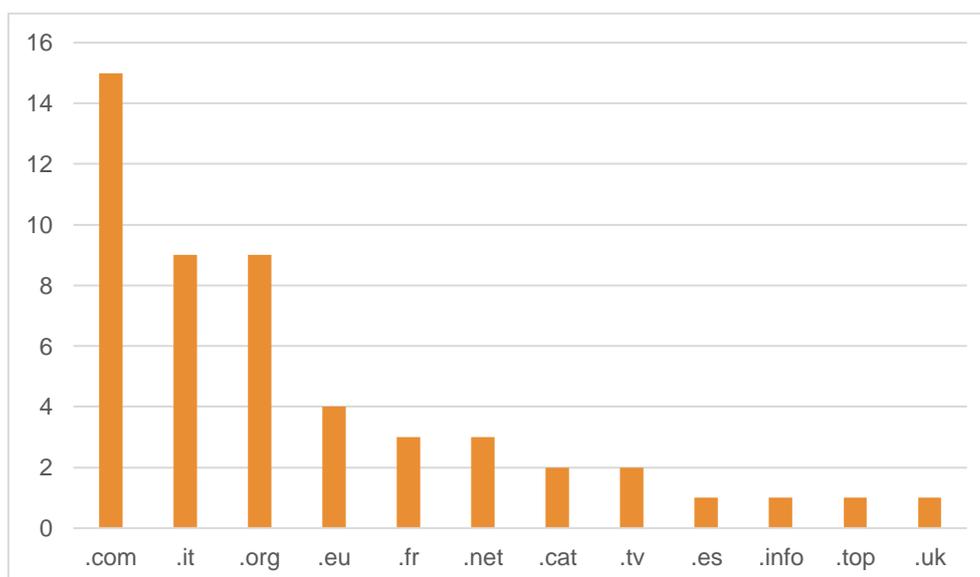
**FIG. 17:** The 10 most popular "New gTLD" extensions in November 2022 (W3Techs, 2022) [20]

	TLD	Percentage	Meaning	Date	Type	Subtype
1	.xyz	0,3 %	Alphabet	2014	New gTLD	Standard
2	.online	0,2 %	Online	2015	New gTLD	Standard
3	.shop	0,1 %	Shopping	2016	New gTLD	Standard
4	.app	0,1 %	Application	2015	New gTLD	Standard
5	.club	0,1 %	Club	2014	New gTLD	Standard
6	.top	0,1 %	Top	2014	New gTLD	Standard
7	.site	0,1 %	Website	2015	New gTLD	Standard
8	.store	0,1 %	Blind	2016	New gTLD	Standard

9	.live	0,1 %	Live	2015	New gTLD	Standard
10	.tech	0,1 %	Technology	2015	New gTLD	Standard

The figure below shows the domain extensions most registered by AREPO survey participants who answered this question:

FIG. 18: Survey results: Domain extensions registered by participating organisations (AREPO, 2022)



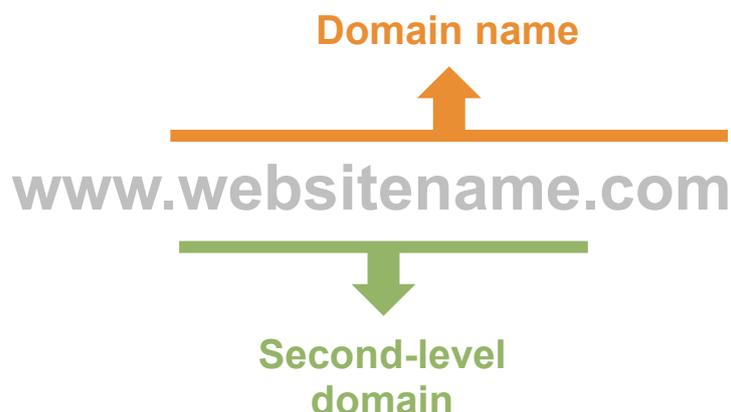
Of the 28 participating organisations that listed the domain name(s) containing the name of their GI:

- ▶ 15 have registered their GI name with the generic top-level domain (gTLD): ".com";
- ▶ 13 have registered their GI name with the country code top-level domain (ccTLD) associated with the country of the GI: ".it", ".fr" and ".es";
- ▶ 9 have registered their GI name with the generic top-level domain (gTLD): ".org";
- ▶ 4 have registered their GI name with the EU code top-level domain (ccTLD): ".eu";
- ▶ 3 have registered their GI name with the generic top-level domain (gTLD): ".net";
- ▶ 2 have registered their GI name with the geographic top-level domain (geoTLD): ".cat";
- ▶ 2 have registered their GI name with the country code top-level domain (ccTLD): ".tv";
- ▶ 1 registered its GI name with the generic top-level domain (gTLD): ".info";
- ▶ 1 registered its GI name with the new generic top-level domain (New gTLD): ".top";
- ▶ 1 registered its GI name with the country code top-level domain (ccTLD): ".uk".

N.B.: It should be noted that most of the participating organisations were unable to draw up an exhaustive list of their domain names, either because they were not aware of them or because it would have been too tedious. The above list therefore only includes the domain names mentioned in the survey and does not necessarily reflect reality.

## ► The second-level domains

FIG. 19: The second-level domain in a web address (AREPO, 2022)



The second-level domain usually refers to the organisation that reserves it.

- It is strongly recommended that producer groups start by **reserving the exact name of their GI** under several of the strategic extensions mentioned above.

Of the 51 domain names listed by AREPO survey participants, 32 were registered with the exact name of the GI, e.g.: "tartadesantiago.org" ("[Tarta de Santiago](#)"); "porcsdelasarde.fr" ("[Porc de la Sarthe](#)"); "prosciuttodiparma.com" ("[Prosciutto di Parma](#)"); "pomadegirona.cat" ("[Poma de Girona](#)"), etc.

- Another good practice may be to **reserve the name of the GI associated with the acronym "PDO" or "PGI"** in the language of the country of the GI, such as AOP/IGP for France or DOP/IGP for Spain, Portugal or Italy and/or in English (PDO/PGI).

Of the 51 domain names listed by AREPO survey participants, 10 were registered with the GI name associated with the PDO or PGI acronym in the language of the GI country, e.g.: "dopoliterraalta.cat" ("[Oli de Terra Alta](#)" DOP); "cintasenesedop.it" ("[Cinta Senese](#)" DOP); "dovaldeorras.tv" ("[Valdeorras](#)" DO); "mortadelladipratoigp.it" ("[Mortadella di Prato](#)" IGP), etc;

- Finally, it is also possible, for the most reputable GIs and therefore the most likely to suffer from *cybersquatting*, to **add the category of the GI** in the language of the associated country and/or in English.

Of the 51 domain names listed by AREPO survey participants, 9 were registered with the GI name associated with the GI category (in the language of the associated country or in English), e.g.: "lamanchawines" ("[La Mancha](#)" wine); "formaggiopiave.it" ("[Piave](#)" cheese); "piavecheese.eu" ("[Piave](#)" cheese); "riojawine" ("[Rioja](#)" wine), etc.

Ultimately, the more domain names producer groups reserve with the name of their GI, the more they prevent the risk of *cybersquatting*. It is now up to them to define which extensions could be the most strategic according to the geographical origin but also the reputation of the GI.

The annual cost of purchasing a domain name is generally between €10.00 and €50.00. The price varies, of course, depending on the registrars and the desired extensions. **The more popular the extension, the more expensive it is likely to be.**

## B. Protection of the name constituting the GI: word trademarks

The **right to geographical indications is recognised by the WTO** (World Trade Organisation) **TRIPS Agreement** (Agreement on Trade-Related Aspects of Intellectual Property Rights) which came into force on January 1, 1995 (WTO, 1994) [28]:

“Article 22

*Protection of Geographical Indications*

1. *Geographical indications are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.*
2. *In respect of geographical indications, Members shall provide the legal means for interested parties to prevent:*
  - (a) *the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;*
  - (b) *any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967).*
3. *A Member shall, ex officio if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public as to the true place of origin.*
4. *The protection under paragraphs 1, 2 and 3 shall be applicable against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.”* (WTO, 1994) [28]

Article 22 therefore sets out a standard level of GI protection for all products. Article 23 provides an increased level of protection for wines and spirits, and Article 24 sets out exceptions to protection related to, for example, "generic" terms and priority rights for prior trademarks (WTO, 1994) [28].

Geographical indications, however, **do not benefit from adequate protection in domain name dispute resolution** (ICANN Policy or UDRP), unlike trademarks.

However, all registrars responsible for generic top-level domains (gTLDs) follow ICANN's policy: “*Under the policy, most types of trademark-based domain name disputes must be resolved by agreement, court action, or arbitration, before a registrar will cancel, suspend, or transfer a domain name. Disputes alleged to arise from abusive registrations of domain names (for example, cybersquatting) may be addressed by expedited administrative proceedings that the holder of trademark rights initiates by filing a complaint with an approved dispute-resolution service provider.*” (OriGIn, 2016) [29].

Geographical indication law cannot therefore be invoked under ICANN's UDRP. However, if the rightful owner of a geographical indication is able to demonstrate that its name **is protected by a word trademark** for goods and services “*other than those that are described by or related to the geographical meaning of the term*” (OriGIn, 2016) [29], the owner can then enforce his rights.

Producer groups are therefore strongly encouraged to protect the name of their GI with a **collective** and/or **guarantee word trademark**.

### ► The collective trademark

The collective trademark is a trademark that can be used by any operator who complies with the rules of use drawn up by the holder of the registration, generally a group of producers.

Its function is to guarantee the origin of the products covered and to ensure a certain quality for the consumer (within the limits of the rules of use).

### ► The guarantee trademark (or certification)

Like the collective trademark, the guarantee (or certification) trademark must be accompanied by rules of use. It can be used by anyone who complies with the rules of use and is subject to a control system.

The rules for the use of the guarantee trademark are, however, more restrictive than those of the collective trademark in that they must not only guarantee the origin of the products, but also certain characteristics associated with them.

Operators using a guarantee trademark are subject to mandatory controls.

#### Procedures for filing a collective or guarantee trademark:

- ▶ **In France:** to file a collective or guarantee trademark, you must contact the French trademark office, INPI, [here](#). The fees for filing a collective or guarantee trademark in one class of goods with the INPI are €350.00 and €40.00 per additional class<sup>51</sup>;
- ▶ **In Spain:** to file a collective or guarantee trademark, you must contact the Spanish trademark office, OEPM, [here](#). The fees for filing a collective or guarantee trademark in one class of goods with the OEPM are €255.74 for an online filing and €300.87 for a paper filing and €165.67 per additional class for an online filing and €194.91 for a paper filing<sup>52</sup>;
- ▶ **In Portugal:** to file a collective or guarantee trademark, you must contact the Portuguese trademark office, INPI, [here](#). The fees for filing a collective or guarantee trademark in one class of goods with INPI are €129.08 for an online filing and €258.16 for a paper filing and €32.72 per additional class for an online filing and €65.44 for a paper filing<sup>53</sup>;
- ▶ **In Italy:** to file a collective or guarantee trademark, you must contact the Italian trademark office, UIBM, [here](#). The fees for filing a collective or guarantee trademark for one or more classes of goods with the UIBM are €337.00 plus €42.00 tax stamp for an online filing and €16.00 for a paper filing<sup>54</sup>;
- ▶ **In the European Union:** to file a collective or guarantee trademark, you need to contact the EUIPO trademark office, [here](#). The fees for filing a collective or guarantee trademark in one class of goods with the EUIPO are €1,500.00 for an online filing, and €1,800.00 for a paper filing, €50.00 for the second class and €150.00 for each additional class, regardless of the type of filing<sup>55</sup>;
- ▶ **At the international level:** to file an international application for a collective trademark or guarantee, one must go to the WIPO intellectual property portal "eMadrid", [available here](#). There are three types of fees to be paid upon filing: a basic fee, a complementary fee for each designated member country, and an additional fee for the fourth and higher classes of goods. To access the WIPO fee simulator, [go here](#).

<sup>51</sup> Rates 2020 recovered from the INPI website, to consult them, [go here](#)

<sup>52</sup> 2022 tariffs retrieved from the OEPM website, to consult them, [go here](#)

<sup>53</sup> Rates 2022 recovered from the INPI website, to consult them, [go here](#)

<sup>54</sup> Rates retrieved from the IUMB website (year not indicated), to consult them, [go here](#)

<sup>55</sup> Rates retrieved from the EUIPO website (year not indicated), to consult them, [go here](#)

The owner of a GI or trademark who becomes aware of trademark applications by third parties which infringe his signs can always take action:

- ▷ By filing an opposition before the relevant trademark office within two months of the publication of the application for Spanish and Portuguese trademarks and within three months for French, Italian and EU trademarks;
- ▷ By filing an action for revocation if the trademark was registered more than five years ago, is misleading or is not in genuine use, or for invalidity if the trademark is registered (on the basis of infringement of the GI).

To **oppose the registration of a trademark filed in a national territory**, such as:

- ▷ **France:** visit the [INPI website](#);
- ▷ **Spain:** visit the [OEPM website](#);
- ▷ **Portugal:** visit the [INPI website](#);
- ▷ **Italy:** visit the [IUMB website](#);

To oppose the registration of an EU trademark or an international trademark designating the EU: [visit the EUIPO website](#).

To oppose the registration of an international trademark: visit the [WIPO intellectual property portal "eMadrid"](#).



## FOCUS ON SPAIN

In Spain, once the word trademark is filed with the Trademark Office (OEPM), the Spanish administrative process established by the Trademark Law will apply.

During a first administrative proceeding, the existence of absolute prohibitions (Article 5.1.h) of the Trademark Law) and relative prohibitions (Article 6 of the Trademark Law) arising from third party opposition will be checked.

Article 19.4 of Spanish Law 17/2001 on Trademarks states that: "[...] *the Consejos Reguladores [producer groups] or the governing bodies of protected designations of origin or geographical indications may submit written observations to the Spanish Patent and Trademark Office within the time limit laid down in Article 2, underlining the prohibitions of Article 5, by virtue of which the registration of the trademark would be automatically refused. These bodies and associations shall not become parties to the proceedings, but their observations shall be notified to the trademark applicant and resolved in accordance with the provisions of Article 22.*"<sup>56</sup>.



## FOCUS ON PORTUGAL

In Portugal, once the word trademark is registered with the Trademark Office (INPI), it is published in the BPI<sup>57</sup>.

<sup>56</sup> Quote translated from Spanish

<sup>57</sup> BPI: Boletim da Propriedade Industrial (Portuguese Industrial Property Bulletin)

A two-month procedure for potential oppositions or observations by third parties then begins. Even in the absence of opposition, the INPI examines ex officio the existence of absolute and relative prohibitions (articles 231, 232 and 302 of the CPI<sup>58</sup>).

### C. Protection of logos: figurative or semi-figurative trademarks

The reservation of domain names and word trademarks only allows for the protection of the verbal element of the GI on the Internet, and not the figurative elements or logos that may be associated with it.

The Court of Justice of the European Union **has recently extended the concept of "evocation" of a GI to the use of non-verbal signs**, in response to the Queso Manchego PDO case (CJEU, Case C-614/17, 2019) [30] in which cheese labels of two companies that were not members of the producer group (Consejo Regulador de la DOP Queso Manchego) formed an unlawful evocation of the PDO. The Court of Justice of the EU held that it cannot be excluded that figurative signs are capable of directly reminding the consumer of the products benefiting from a registered name because of their conceptual proximity to such a name, and that the use of figurative signs evoking the geographical area to which the geographical indication is linked is likely to constitute an evocation of it.

However, this assessment is subjective, as the notion of evocation is based on consumer perception and cannot cover all logos used in connection with a GI.

In France, a logo also constitutes a protected work within the meaning of Article L. 112-2 - 8° of the Intellectual Property Code. Moreover, Article L. 111-1 of the Intellectual Property Code provides that the author of a logo enjoys an exclusive intangible property right over this work, by the sole fact of its creation, which is enforceable against all. However, protection is more uncertain in the absence of registration. In the event of a dispute, it will be necessary to be able to demonstrate that it is original in order for it to be protected, so a trademark registration is always to be preferred.

The solution remains for the producer group and its members to **protect their logos by means of collective and/or guarantee figurative or semi-figurative trademarks**.

The procedures are the same as for the filing of a word trademark, i.e. :

#### **Procedures for filing a collective or guarantee trademark:**

- ▷ **In France:** to file a collective or guarantee trademark, you must contact the French trademark office, INPI, [here](#). The fees for filing a collective or guarantee trademark in one class of goods with the INPI are €350.00 and €40.00 per additional class<sup>59</sup>;
- ▷ **In Spain:** to file a collective or guarantee trademark, you must contact the Spanish trademark office, OEPM, [here](#). The fees for filing a collective or guarantee trademark in one class of goods with the OEPM are €255.74 for an online filing and €300.87 for a paper filing and €165.67 per additional class for an online filing and €194.91 for a paper filing<sup>60</sup>;
- ▷ **In Portugal:** to file a collective or guarantee trademark, you must contact the Portuguese trademark office, INPI, [here](#). The fees for filing a collective or guarantee trademark in one class of goods with INPI are €129.08 for an online filing and €258.16 for a paper filing and €32.72 per additional class for an online filing and €65.44 for a paper filing<sup>61</sup>;

<sup>58</sup> CPI: Código da Propriedade Industrial (Portuguese Intellectual Property Code)

<sup>59</sup> Rates 2020 recovered from the INPI website, to consult them, [go here](#)

<sup>60</sup> 2022 tariffs retrieved from the OEPM website, to consult them, [go here](#)

<sup>61</sup> Rates 2022 recovered from the INPI website, to consult them, [go here](#)

- ▷ **In Italy:** to file a collective or guarantee trademark, you must contact the Italian trademark office, UIBM, [here](#). The fees for filing a collective or guarantee trademark for one or more classes of goods with the UIBM are €337.00 plus €42.00 tax stamp for an online filing and €16.00 for a paper filing<sup>62</sup>;
- ▷ **In the European Union:** to file a collective or guarantee trademark, you need to contact the EUIPO trademark office, [here](#). The fees for filing a collective or guarantee trademark in one class of goods with the EUIPO are €1,500.00 for an online filing, and €1,800.00 for a paper filing, €50.00 for the second class and €150.00 for each additional class, regardless of the type of filing<sup>63</sup>.
- ▷ **At the international level:** to file an international application for a collective trademark or guarantee, one must go to the WIPO intellectual property portal "eMadrid", [available here](#). There are three types of fees to be paid upon filing: a basic fee, a complementary fee for each designated member country, and an additional fee for the fourth and higher classes of goods. To access the WIPO fee simulator, [go here](#).

If the owner of a GI or trademark becomes aware of trademark applications by third parties which infringe his signs, he can always take action:

- ▷ By filing an opposition before the relevant trademark office within two months of the publication of the application for Spanish and Portuguese trademarks and within three months for French, Italian and EU trademarks;
- ▷ By filing an action for revocation, if the trademark was registered more than 5 years ago, is misleading or not in genuine use, or for invalidity if the trademark is registered (on the basis of infringement of the GI).

To **oppose the registration of a trademark filed in a national territory**, such as:

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- ▷ **Spain:** visit the [OEPM website](#);
- ▷ **Portugal:** visit the [INPI website](#);
- ▷ **Italy:** visit the [IUMB website](#);

To oppose the registration of an EU trademark or an international trademark designating the EU: [visit the EUIPO website](#).

To oppose the registration of an international trademark: visit the [WIPO intellectual property portal "eMadrid"](#).



## FOCUS ON SPAIN

In Spain, once the collective or guarantee trademark is filed with the Trademark Office (OEPM), the Spanish administrative process established by the Trademark Law will apply.

During a first administrative proceeding, the existence of absolute prohibitions (Article 5.1.h) of the Trademark Law) and relative prohibitions (Article 6 of the Trademark Law) arising from third party opposition will be checked.

Article 19.4 of the Spanish Trademark Law 17/2001 states that: "[...] *the Consejos Reguladores [producer groups] or the governing bodies of protected designations of origin or geographical indications may submit written observations to the Spanish Patent and Trademark Office, within*

<sup>62</sup> Rates retrieved from the IUMB website (year not indicated), to consult them, [go here](#)

<sup>63</sup> Rates retrieved from the EUIPO website (year not indicated), to consult them, [go here](#)

*the time limit laid down in Article 2, underlining the prohibitions of Article 5, by virtue of which the registration of the trademark would be automatically refused. These bodies and associations shall not become parties to the proceedings, but their observations shall be notified to the trademark applicant and resolved in accordance with the provisions of Article 22.*<sup>64</sup>



## FOCUS ON PORTUGAL

In Portugal, once the collective or guarantee trademark is filed with the Trademark Office (INPI), it is published in the BPI.

A two-month procedure for potential oppositions or observations by third parties then begins. Even in the absence of opposition, the INPI examines ex officio the existence of absolute and relative prohibitions (Articles 231, 232 and 302 of the IPC).

In any case, regardless of the chosen protection mode to complement and reinforce GI protection on the Internet, groups and their producers as well as all stakeholders involved in the marketing of GI products should put in place **proactive monitoring and surveillance of potential online violations**.

### D. Monitoring and surveillance of potential violations

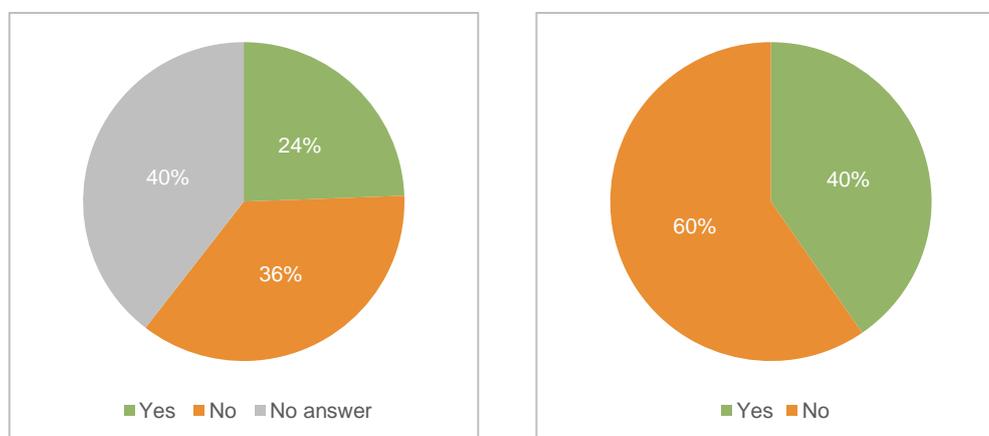
Monitoring and surveillance of potential violations must be carried out on two levels: **on the Internet, but also in the physical world**.

Indeed, as mentioned in the introduction, while GI infringement can occur on the Internet, it is still a physical flow of illicit goods in most cases.

It is therefore necessary to **act on the virtual sales offer and the material flow**.

36% of the organisations participating in the AREPO survey regularly monitor their GIs for potential fraud on the Internet (60% after removing the non-response rate) and 62% of them call on specific expertise to carry out the monitoring (cf. Figure 20).

**FIG. 20:** Survey results: Does your organisation have regular monitoring of potential Internet fraud on your GI? (AREPO, 2022)



<sup>64</sup> Quote translated from Spanish

## 1. Private monitoring tools and providers

In the case of Internet offerings, many private providers now offer highly effective monitoring services to detect violations and to obtain the removal of infringing ads.

► **Search engines**

Producer groups can start by exploiting the tools provided by search engines to monitor content posted on the Internet via a keyword system.

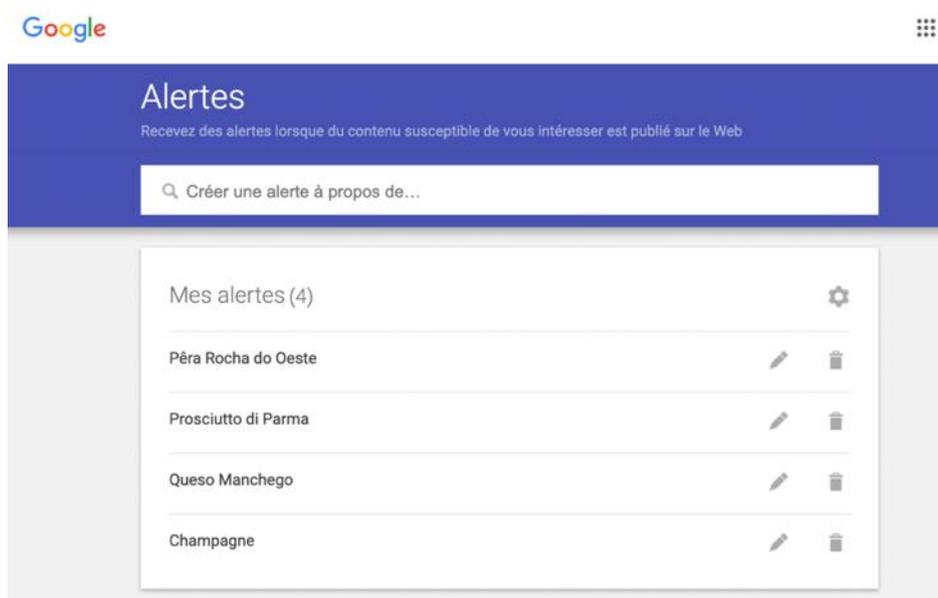
Of particular interest is Google's search engine, which in 2022 still has a 91.90% market share (for comparison, Bing has only 2.88%, followed by Yahoo with 1.51%) (Agorapulse, 2022) [31].

The best-known monitoring tool is therefore, for good reason, that of Google, with "[Google Alerts](#)". This tool allows the user to receive notifications and alerts by e-mail as soon as a keyword registered by the holder appears in the results of the Google search engine.

To create an alert, go to the [following address](#) and:

- ▷ Enter the desired keywords (e.g. the name of your GI);
- ▷ Determine the frequency of sending (when the case arises, once a day, etc.);
- ▷ Choose the type of results you want (news, blog, web, videos, etc.);
- ▷ Choose the languages and location of the results;
- ▷ Indicate the number of results desired;
- ▷ Enter your e-mail address<sup>65</sup>;
- ▷ Validate by clicking on the "create alert" button.

FIG. 21: Screenshot of the Google Alerts tool



This service is provided free of charge by Google. It allows producer groups to **carry out some of the monitoring at a lower cost**.

<sup>65</sup> It is also possible to receive alerts in RSS (Really Simple Syndication).

However, this monitoring tool has limitations in that it was not created with the aim of identifying fraud and only monitors a limited number of resources, excluding, in particular, the analysis of mentions of keywords contained in social networks, which today constitute a large share of the information circulating on the Internet.

### ► Private monitoring platforms

Private monitoring platforms are powerful and effective tools in the fight against cybercrime. They are specialised in **monitoring the assets** of professionals on the Internet (geographical indications, word trademarks, figurative trademarks, domain names, etc.).

There are two types of monitoring platforms, those specialised in **monitoring trademark databases** (e.g. Corsearch, Compumark/Clarivate, etc.) and those specialised in **monitoring Internet channels** through keywords, images and logos (e.g. EBRAND).

Monitoring platforms operate specifically against *cybersquatting*, counterfeiting, and any other form of infringement on the Internet with a tailored service. Once an infringement is identified, it is communicated to the owner who can decide to take action himself or to call on the monitoring provider to try to have it removed.

However, this tailor-made tool can represent significant costs for producer groups, especially if monitoring is to be carried out regularly. Costs can vary from several hundred euros for a simple audit to several thousand euros per year for a complete and regular monitoring.

Some monitoring platforms are used to working with GI producer groups, such as:

► **Corsearch**: accessible at the [following link](#)

This monitoring platform offers **monitoring of trademark databases** and is actively working on the integration of PDO and PGI databases.

Corsearch offers worldwide coverage with search and monitoring of word and figurative trademarks, proprietary names and company names in nearly **189 trademark databases**.

It also offers a service dedicated to domain names (search, filing, management, monitoring and recovery of domain names).

► **CompuMark/Clarivate**: accessible at the [following link](#)

This monitoring platform also offers the **monitoring of trademark databases**.

Compumark offers global coverage with search and monitoring of word and figurative trademarks, proprietary names, social network usernames, company names, and domain names with monitoring in over 250 countries and territories, including emerging markets, through **186 trademark databases**.

It is recommended to use a law firm or consultancy to get in contact with this platform.

► **EBRAND**: accessible at the [following link](#)

This platform offers to **quickly detect all infringements** of geographical indications, trademarks, products or corporate identity **on a large majority of Internet channels**, such as websites, e-commerce sites, marketplaces, social networks, or the darkweb. Detection is based on images, logos and keywords and covers all existing languages, alphabets and countries. It also offers monitoring of domain name registries.

It can detect copyright infringement, counterfeiting, illegal sales, parallel markets, cybersquatting, and all forms of online infringement.

Prior to any action, the EBRAND platform offers to carry out an audit at a cost of approximately €500.00 per channel, in order to:

- ▷ assess infringements on the desired channels (producer groups may decide to monitor all or some of the Internet channels simultaneously or consecutively);
- ▷ build a detection and suppression strategy in conjunction with the producer group's law firm or IP consultancy;
- ▷ define a budget and an intervention schedule.

These audits can also be a tool in their own right for producer groups that do not have the financial resources to set up full and regular monitoring. Infringements identified during the audits are communicated to the client, who may decide to take action himself or to call on a law firm or consultancy firm specialising in intellectual property.

When the infringement is detected by the monitoring service provider, the latter may, at the client's request, proceed with a request for deletion and possibly the sending of a letter of formal notice, but will not be able to take legal action. At that point, it will be appropriate to hand over to a law firm specialising in intellectual property.

### ► Intellectual property law firms

Lawyers are partners who can be indispensable for producer groups because they have a **monopoly on representation before the judicial courts** and are therefore the relay for the rights holders in the event of infringement.

They can also represent them before specialised offices and institutes, or rely on their network of colleagues abroad in case of infringement in other countries.

If the first letters from the holder or the providers have not had any effect, a lawyer can take over:

- ▷ His first step will be to write a lawyer's letter to the reluctant third party, which may have the effect of increasing the pressure;
- ▷ He will then be able to propose the most appropriate procedural strategy to address the violation;
- ▷ He may also propose that an amicable solution be found through negotiation.

These services can generate significant costs for producer groups. It should therefore be noted that lawyers are subject to a code of ethics requiring them to submit a fee agreement prior to any intervention, enabling the client to have a precise idea of the fees and their calculation. Producer groups must therefore demand **that an estimate be drawn up before any intervention**.

## 2. Monitoring tools of intellectual property offices

Trademark offices may also offer databases with trademark monitoring systems for an existing geographical indication or trademark. This monitoring is limited to trademark filings but can complement other available monitoring approaches.

### ► At national level

National trademark offices usually have databases that are accessible to all and **alert systems that allow for competitive monitoring**. Producer groups are advised to check with their national trademark office to know if an alert system has been set up.

Here is an example with the French Trademark Office.

For French trademarks, the INPI offers an alert system accessible on its website on the "[DATA INPI](#)" page.

This system allows producer groups to create three types of alerts:

- ▷ Trademark, patent, design or company monitoring alerts;
- ▷ Multi-bases alerts on a keyword;
- ▷ Single-base alerts on specific criteria that allow you to monitor new publications of trademarks, patents, designs and companies for competitive monitoring.

The procedure for creating an alert with the INPI is as follows:

- ▷ Go to the "DATA INPI" page at the [following address](#);
- ▷ Create or log into the personal space;
- ▷ Click on the "Create an alert" button;
- ▷ Name the alert;
- ▷ Choose the type of alert (between the three options mentioned above);
- ▷ Create alert (up to ten alerts) (INPI, 2022) [32].

For more information on INPI's alert creation procedure, you can watch their video "tutorial" at the following link (INPI, 2022) [33].

FIG. 22: Screenshot of the INPI's "DATA INPI" database

INPI.fr

REPUBLIQUE FRANÇAISE | inpi

ESPACE OPENDATA | OBSERVATOIRE | RESSOURCES | CONNEXION

## Bienvenue sur DATA INPI

Je cherche dans les bases Entreprises, Marques, Brevets et Dessins et modèles

Nom, déposant, SIREN...

RECHERCHER

» Recherche avancée

Pour les entreprises : données issues des greffes des tribunaux à compétence commerciale centralisées dans le Registre national du commerce et des sociétés (RNCS)

### ► At the European level

There are three main tools that can help producer groups monitor fraud on their GIs and trademarks at the European level: [GI|view](#), [TM|view](#) and the [EUTM alert system](#) (EU trademark).

- ▷ **TM|view**: available at [the following address](#)

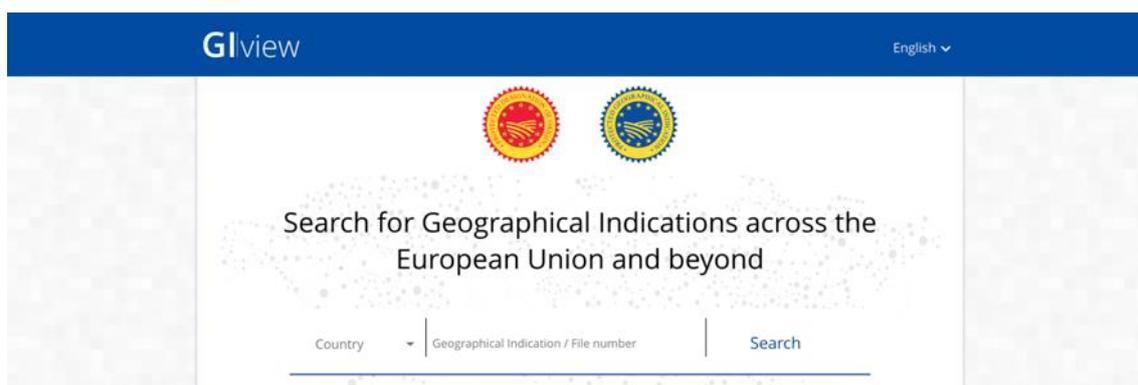
FIG. 23: Screenshot of the EUIPO trademark database "TM|view"



TM|view is the **EU's trademark database**. It contains the databases of trademark applications and registered trademarks of all national intellectual property offices in the EU, the EUIPO and many partner national offices outside the EU.

► **GI|view**: available at [the following address](#)

FIG. 24: Screenshot of the EUIPO GI database "GI|view"



GI|view is the **EU's geographical indications database**. It is the most interesting tool for monitoring GI fraud. It combines three features:

1. It contains the **official data of all agricultural and agri-food GIs** protected at EU level. This includes not only European GIs registered directly in the EU, but also third country GIs protected at EU level through bilateral and multilateral agreements, as well as all EU GIs protected abroad through such agreements;
2. It includes **extensive data**, such as contact details for producer groups and GI control bodies, maps, product photographs, product description, geographical area, sustainability statement, etc.
3. Finally, it provides a **direct link to enforcement authorities** through the EUIPO Observatory or **IPEP, IP Enforcement Portal**. IPEP is a free, secure platform for real-time information exchange between right holders and enforcement authorities. IPEP is mainly used for border measures, but it allows a national authority or producer group to communicate directly with law enforcement authorities. Police and customs officials in Member States can also view product information and details, making it easier for them to identify counterfeits and take action. The IPEP is available at the [following address](#).

FIG. 25: Screenshot of the EUIPO Trademark Observatory (or IPEP)



### ▷ EUTM Alert System

Since 2019, the EU Trademark Alert System (or EUTM Alert System) allows EU trademark owners and applicants to **take proactive measures to monitor their intellectual property rights**. This alert system is accessible on the [eSearch plus](#) database.

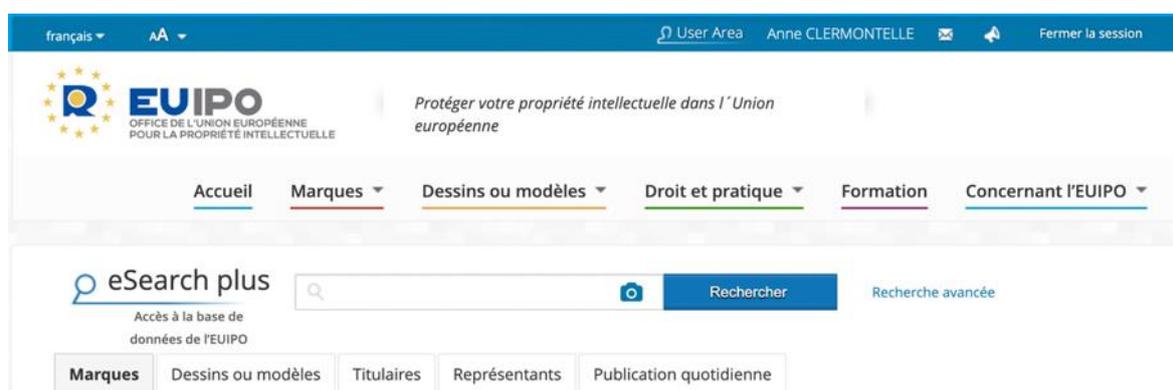
The EUTM alert system allows producer groups to create two types of alerts:

- ▷ EU Trademark (UETM) or Registered Community Design (RCD) monitoring alerts (change of status; renewal deadline; change of holder/representative; expiry of opposition period; identical “.eu“ domain registration);
- ▷ Watch alerts: these are based on criteria selected by the user (e.g. trademark name and/or product category) and will be triggered if another trademark or Community design matches these same criteria.

The procedure for creating an alert at the EUIPO is as follows:

- ▷ Go to the "eSearch plus" page at the [following address](#);
- ▷ Go to "User area" and create a personal area or log in;
- ▷ Click on the "Alerts" button and then "Create a new alert";
- ▷ Select "TIN/EMC Alerts";
- ▷ Select the relevant category (trademarks; designs; owners; representatives);
- ▷ Select the desired criteria;
- ▷ Then "Define an alert" (EUIPO, n.d.) [34].

FIG. 26: Screenshot of the EUIPO eSearch plus database



Furthermore, users are now directly informed of the availability of their trademark as a “.eu“ domain name as soon as they complete their e-filing, so that they can choose to register the domain name immediately before the publication of their European trademark application. More information is available at the [following address](#).

► **At the international level**

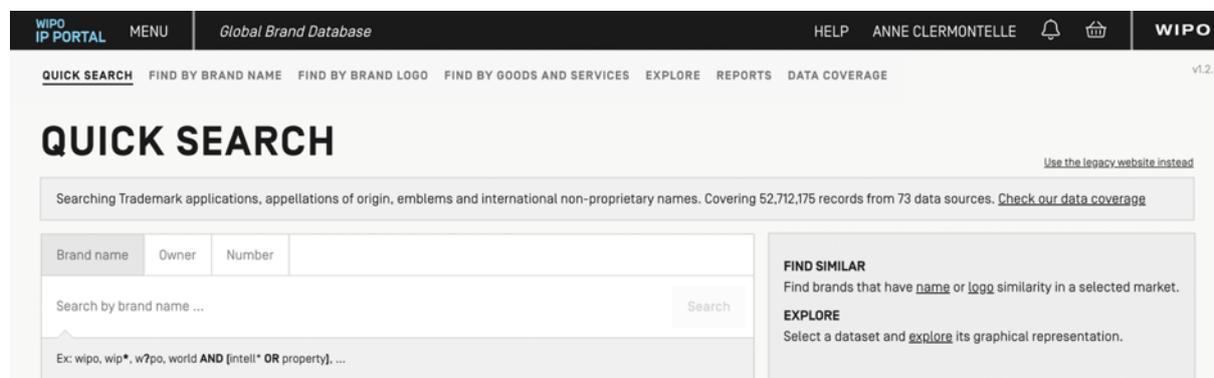
WIPO's new database or "**Global Brand Database**", whose new interface was launched on 15 November 2022, allows producer groups to determine whether a similar or identical trademark already exists in a database of nearly 73 national and international intellectual property offices (WIPO, 2022) [35]. The WIPO database does not, however, offer an alert system, so regular monitoring is required:

- ▶ International trademarks registered by WIPO;
- ▶ National and regional trademarks shared by national and regional trademark offices;
- ▶ Geographical indications;
- ▶ Logos of brands or geographical indications.

The **procedure for monitoring at WIPO** is as follows:

- ▶ Go to the new database at the [following address](#);
- ▶ For a quick search, enter the name, owner or number of the trademark;
- ▶ For an advanced search on word trademarks, go to "Find brands that have name similarity in a selected market" (right-hand column) by clicking on "name";
- ▶ For an advanced search on logos, go to "Find brands that have logo similarity in a selected market" (right-hand column) by clicking on "logo".

FIG. 27: Screenshot of the new WIPO "World Trademark Database"



### 3. Customs surveillance

Customs is a national public authority responsible for the **control of people and goods entering and leaving the country** in question.

In terms of monitoring the flow of counterfeit goods, customs surveillance is a particularly effective tool available to the rights holder through the **filing of applications for action**.

The application for action is the necessary precondition for detention of suspected infringing goods by customs.

In the case of GIs, this application must therefore be filed by the GI producer group and will help to draw the attention of customs to suspicious products in order to facilitate their interception.

The submission of an application for action is free of charge and must be renewed every year, by written request.

In France, this application consists of two forms:

- ▷ an application for action based on Regulation (EU) 608/2013 to set up a third-party border control;
- ▷ an application for action based on the intellectual property code allowing for the monitoring of goods already cleared through customs, in circulation on the national territory.

These two types of application are complementary.

This very effective tool **must absolutely be supported by the GI producer group and its members**, who must provide as much information as possible when submitting the application, but also throughout its period of validity, in order to enable customs to be as effective as possible in their monitoring.

An incomplete application will be ignored by Customs officers who will not have the tools to stop genuine counterfeit goods. Indeed, stopping genuine goods for lack of information is a waste of time and money for Customs, but also for legitimate holders or users.

The information to be provided mainly concerns **the means of identifying genuine products from counterfeit products**.

They must be supplemented by a constant exchange of information, during which the producer group must be rigorous, in order to inform customs as soon as it becomes aware of a contentious use or a counterfeiter.

#### Procedures for submitting an application for action:

- ▷ **In France:** to file an application for action with the French customs, [go here](#);
- ▷ **In Spain:** to file an application for action with the Spanish customs, [go here](#);
- ▷ **In Portugal:** to file an application for action with the Portuguese customs, [go here](#);
- ▷ **In Italy:** to file an application for action with the Italian customs, [go here](#).



#### FOCUS ON SPAIN

The application for action also consists of two forms:

- ▷ an application for action based on Regulation (EU) 608/2013 to set up a third-party border control;
- ▷ a request based on the Spanish Trademark Law 17/2001, of December 7, 2001 (Article 41.1<sup>o</sup> of the Trademark Law), and if necessary, a request for precautionary measures on the basis of Article 727.9<sup>a</sup> of the Spanish Civil Procedure Law.



#### FOCUS ON PORTUGAL

The application for action also consists of two forms:

- ▷ an application for action based on Regulation (EU) 608/2013 to set up a third-party border control;

- ▷ a request based on Article 312.º of the Código da Propriedade Industrial.

#### 4. Reporting to fraud control authorities

In case of infringement, it is also possible to **alert the fraud control authorities** in your country, in parallel.

For example, in France, the Directorate-General for Competition, Consumer Affairs and Fraud Control (DGCCRF) is responsible for ensuring the proper functioning of tangible and intangible markets for the benefit of consumers and businesses.

This administration aims to safeguard respect and fairness of competition, the economic protection of consumers and the safety and conformity of consumer products and services, including Internet channels.

It therefore has a role to play in informing consumers and ensuring **compliance with rules applicable to quality systems** such as geographical indications.

In the event of a report, the DGCCRF may intervene by deciding to monitor or control a company and, if necessary, impose administrative fines.

#### **Procedures for reporting fraud to the fraud control authorities:**

- ▷ **In France:** to report a fraud to the DGCCRF, [go here](#);
- ▷ **In Spain:** to report a fraud to the AICA, [go here](#);
- ▷ **In Portugal:** to report a fraud to the ASAE, [go here](#);
- ▷ **In Italy:** to report a fraud to the ICQRF, [go here](#).

## II. An offensive protection strategy after the rights violation

Once an infringement has been identified, it is essential for producer groups and their members to promptly **save evidence of the infringement**.

Indeed, as noted in Part 1 of the guide, one of the main limitations of the Internet is its **ephemeral nature**.

The system of proof in French law is set out in Article 9 of the Code of Civil Procedure, which states that *"It is incumbent on each party to prove, in accordance with the law, the facts necessary for the success of its claim"*<sup>66</sup> (Légifrance, 2004) [36].

A person who wishes to claim an infringement of a GI must therefore be able to prove the infringement, but also try to stop it as soon as possible.

This response should take the form, if possible, of a bailiff's report and evidence gathering (Chapter A) and a letter of formal notice (Chapter B), before leading to the judicial and extrajudicial actions of the disputes (Chapters C and D).

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<sup>66</sup> Quote translated from French

## A. Bailiff's report and evidence gathering of the violation

As soon as the infringement is noted, and even before contacting the bailiff, it is essential to take **screenshots<sup>67</sup>, dated, in ".pdf" format** of the Internet pages where the infringements appear and to **save the URLs** of the web addresses in question.

This will provide a basis of proof, should the disputed elements disappear before the report.

Next, it is advisable to **contact a bailiff** to have an urgent Internet report drawn up. The average cost of a statement of facts varies according to the number of pages to observe, but it can be between €150.00 excluding VAT and €600.00 excluding VAT for the biggest statements of facts<sup>68</sup>.

For France, it may be useful to use a bailiff from the capital, as the location of the report may, in the event of subsequent legal action, give jurisdiction to the courts in the capital, which are generally the most aware of GI issues.

The bailiff's report on the Internet meets a twofold imperative, namely a legal security imperative for the safeguarding of evidence, as it makes it possible to determine when, where and how the operations took place, and a technical imperative, which is to know whether the screen capture really represents the Internet page as it existed at the time (DOROL, 2019) [37].

The rules of validity for Internet statements of facts are extremely strict, but bailiffs are well versed in these standards, which are mainly based on case law, and **thus guarantee the incontestability of the evidence**.

In France, this is a "[...] *body of obligations and recommendations derived from case law and augmented by the Afnor NF Z67-147 standard*"<sup>69</sup>(DOROL et al., 2019) [38] whose main objective is the creation of a blank framework of findings, in order to give material findings an indisputable neutrality. In order to respect this framework, the bailiff must therefore "[...] *apply himself to respecting the praetorian canons of the prerequisites of the internet report, namely: identification of the equipment used for the reports, configuration of the network connection to the internet, establishment of a report environment cleansed of all previous browsing, and setting the location of the reports*"<sup>70</sup> (DOROL et al., 2019) [38].

It should be noted that if the content has disappeared before the report, it is still possible for the bailiff to carry out a **report on the disputed page on an archiving website**. "*The purpose of this type of sites is to preserve a memory of Internet pages in that they constitute an intangible heritage. Several services offer access to archived Internet pages: Internet Memory, Pandora, Archives.org... The latter website offers free access to the Wayback Machine, which allows users to consult archived versions of a web page through time*"<sup>71</sup> (DOROL, 2019) [37]. Indeed, if even though it has been reluctant in the past, the Paris Court of Appeal made a turnaround on 5 July 2019<sup>72</sup>, finally accepting this type of evidence. This allows the plaintiff to get the archives of a page that has been modified or deleted verified by a bailiff.

It is also possible, prior to any trial, to make judicial requests for the collection of evidence or for expert opinions<sup>73</sup>.

<sup>67</sup> To take a screenshot: 1. on a PC, press and hold the three keys "Windows" + "Shift" + "S" simultaneously, 2. on a Mac, press and hold the three keys "Shift" + "Command" + "3" simultaneously.

<sup>68</sup> Rates based on French bailiff's reports

<sup>69</sup> Quote translated from French

<sup>70</sup> Quote translated from French

<sup>71</sup> Quote translated from French

<sup>72</sup> CA Paris, 5 July 2019, n° 17/03974, M. AX c/ SAS Groupe conseil et gestion.

<sup>73</sup> Seizure for trademark or GI infringement (Articles L.716-1 et seq. and Articles L.722-1 et seq. of the French Intellectual Property Code), pre-trial investigation (Article 145 of the French Code of Civil Procedure), judicial expertise (Article 263 of the French Code of Civil Procedure)

Once the evidence has been saved, the holder can send a **letter of formal notice** to the person(s) responsible for the infringements.



### FOCUS ON SPAIN

In Spain, it is possible to request the establishment of a Notarial Deed certifying the date and place (web page) where the name or logo of the geographical indication has been reproduced. These public documents are probative in a judicial process, as established by articles 299.1.2<sup>o</sup> and 317.2<sup>o</sup> of the Spanish Law of Civil Procedure, which states that the authentic documents are "Documents authorised by a notary in accordance with the law".

It is an effective and efficient means of proof, although it has a slightly higher cost due to the involvement of a notary.



### FOCUS ON PORTUGAL

In Portugal, the system of proof in law is set out in Article 342 of the Código Civil, which states that "*the person who invokes a right has the burden of proving the facts on which the right is based*". Therefore, the person who wishes to invoke an infringement of a GI must be prepared to provide proof of that infringement.

In Portugal, this may take the form of a statement of facts drawn up by a notary, in particular by certifying screenshots taken directly by him. Article 4/2/e) of the "Estatuto do Notariado" ("Statute of the Notary") confers this competence on the notary.

It should be added that it is possible to obtain, even before the start of a legal action, judicial measures for the collection and preservation of evidence, under Articles 339 to 341 of the Código da Propriedade Industrial. These measures may take the form of seizure of objects or documents in the possession of the infringer or even of third parties, or judicial orders for the holder to deliver them to the court. If the infringement has a commercial nature, these measures may concern banking, financial or accounting documents.

#### B. Letter of formal notice

The letter of formal notice is a legal act which must comply with a certain formalism in order to be effective and valid.

In the event of an infringement of a GI, **the purpose of the formal notice is to instruct the addressee to cease the infringement**, or risk a penalty.

It must therefore contain a challenge, a deadline for compliance, and a threat of sanction in case of non-compliance.

- ▷ In regards to the interpellation, Article 1139 of the French Civil Code states that the terms of the formal notice must give "**sufficient interpellation**". This means that the demand must be clearly identified, precise and firm, or risk nullity;

- ▷ In regards to the deadline, it must be mentioned in the letter. This is the period of time left to the addressee to comply. It is customary to give the addressee **a period of fifteen days**;
- ▷ The letter must also contain **the threat of a sanction**, i.e. the use of legal means in the event of non-performance. In this respect, the terms of the formal notice must not be conceived in an abusively comminatory manner (akin to intimidation), at the risk of constituting an abuse of rights.

In addition to the content of the letter, its notification must also comply with a number of rules.

In this sense, preference should be given to forms of communication that will make it possible to prove, if necessary, the sending and receipt of the letter of formal notice, i.e. **an email with a read receipt, coupled with a registered letter with a return receipt**.

If there is no response, it is recommended that one or more reminders be made.

If silence persists, it is recommended that service be done by a bailiff, as this may increase the pressure on the recipient to act.

Finally, the letter must not omit **to invite the addressee to an amicable resolution of the dispute**. In France, since April 1, 2015<sup>74</sup>, it is necessary to justify an attempt at amicable resolution of the dispute in order to be able to refer the matter to a judge.



A **template letter of formal notice** that can be reused by all producer groups or holders of European geographical indications is available in **Annex 3** of this guide.



## FOCUS ON SPAIN

In Spain, the letter of formal notice ("carta de reclamación extrajudicial") must meet certain conditions to be valid, similar to those in France.

The purpose of the letter of formal notice is to extra-judicially challenge the addressee to stop the infringement, or else face legal consequences such as a criminal complaint, a claim for compensation or other binding measures.

It must therefore also contain a legal basis for the request, a challenge, a 15-day deadline for compliance, and a threat of sanctions in case of non-compliance.

Preference should be given to forms of communication that will enable proof to be provided, if necessary, of the sending and receipt of the letter of formal notice, i.e. an e-mail with a read receipt, coupled with a registered letter with a return receipt.

In Spain, there is also a sending mechanism called "Burofax", available at the following address, which makes it possible to prove the sending, receipt and content of a letter of formal notice and to make this evidence legally valid.

If there is no response, it is recommended that a reminder be sent.

<sup>74</sup> Decree No. 2015-282 of 11 March 2015.



## FOCUS ON PORTUGAL

In Portugal, the letter of formal notice ("carta de interpelação") does not have a "canonical" model, but it must meet certain conditions to be valid, similar to those in France.

The purpose of the letter of formal notice is to instruct the addressee to stop the infringement, or else face legal consequences such as a criminal complaint, a claim for compensation or other binding measures.

It must therefore also contain a warning, a fifteen-day deadline for compliance, and a threat of sanctions in case of non-compliance.

Preference should be given to forms of communication that will make it possible to prove, if necessary, the sending and receipt of the letter of formal notice, i.e. an e-mail with a read receipt, possibly backed up by a "day" certification with the MDDE (Marca do Dia Eletrónico<sup>75</sup>) mechanism through the Portuguese post office, CTT (Correios, Telégrafos e Telefones<sup>76</sup>), or simply by sending it by cc: to another address of the sender or a trusted third party.) The e-mail must be accompanied by a registered letter with acknowledgement of receipt.

If there is no response, it is recommended that a reminder be sent.

If silence persists, it is recommended to use a "notificação avulsa" ("single notification"), according to Article 256<sup>o</sup> of the Código de Processo Civil, carried out by enforcement agents or by judicial officers, which may increase the pressure on the recipient.

### C. Domain name dispute resolution

Domain name disputes have grown in line with the increasing interest in them. It can be resolved either judicially (para. 1) or extra-judicially (para. 2).

#### 1. Judicial settlement of disputes

Judicial dispute resolution occurs when the parties involved in a dispute use **the court system to settle their dispute**. This involves taking the case to court, where a judge or arbitrator will make a decision based on the presented evidence and the applicable laws.

A distinction should be made between disputes between domain names and other private rights such as trademarks or geographical indications, and disputes between domain names and other signs, such as trade names, local authority names, patronymic names or other domain names.

#### ► Disputes between domain name and another private right

Regarding the conflict between domain names and other proprietary rights, the regime of legal action will be the same for trademarks and geographical indications, **that of "infringement action"**.

Trademark owners, whether well-known or not, collective or not, can resort to legal action to resolve disputes arising from the confrontation between a domain name and a trademark. In France, the applicable texts are articles L. 713-2, L. 713-3 and L. 713-5 of the Intellectual Property Code, as well as

<sup>75</sup> In English: "Electronic Day Mark".

<sup>76</sup> In English: "Post, Telegraphs and Telephones"

article 1241 of the Civil Code when the trademark is included in a domain name, without being used as a trademark (Légifrance, 1992) [39].

The same applies to holders of geographical indications, who can also take legal action in the event of infringement. In France, the applicable texts are Articles L. 722-1 and following of the Intellectual Property Code (Légifrance, 1992) [39].

The major difference between the two regimes is that trademarks (except for well-known or renowned trademarks) are subject to a principle of speciality<sup>77</sup>, which is not the case for geographical indications.

In the case of the use of a well-known or reputed trademark or **geographical indication** in a domain name, **the judges do not examine the content of the website to decide whether the trademark or GI is infringed.**

Trademarks and GIs are protected outside the principle of speciality if their use for goods or services that are not similar to those designated in the registration is likely to prejudice the latter or if such use constitutes an unjustified exploitation of the latter. The use of the sign, even partially, is sufficient.

The situation may also be reversed in the case of trademarks, since **a domain name may constitute prior art that may impede the filing of a trademark<sup>78</sup>.**

### ► Disputes between the domain name and another distinctive sign

As regards other distinctive signs (trade name, sign, company name, etc.), the legal basis will be that of common law civil liability on the basis of Article 1241 of the Civil Code because there is no property right (Légifrance, 2004) [36].

When the courts are called upon to rule on disputes between domain names and trade names, between domain name holders and company names and other domain names, this will be a case of **parasitism or unfair competition**, and it will be necessary to demonstrate harm and a risk of confusion.

In this sense, it is necessary to demonstrate the distinctiveness of the terms claimed, and the identity of the activities that could lead to confusion between the companies.

## 2. Alternative Dispute Resolution

On the other hand, alternative dispute resolution occurs when the parties involved in a dispute choose to **resolve their conflict without going through the court system**. This can be done through direct negotiation, mediation or arbitration. In these cases, a neutral third party works with the parties to help them reach a mutually acceptable agreement that ends the dispute.

Out-of-court proceedings are divided into international and national proceedings.

### ► International extrajudicial proceedings

The particularity of proceedings at the supranational level is that **only trademarks can be invoked**.

Indeed, ICANN has two types of out-of-court procedures, the UDRP procedure (Uniform domain-name dispute-resolution policy) and the URS procedure (Uniform rapid suspension system). Both procedures are designed to resolve disputes between trademark holders and domain name holders in generic top-level domains (e.g. ".com", ".org", etc.).

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<sup>77</sup> As a reminder, the principle of speciality is a rule according to which a trademark is only protected for goods which are identical or similar to those indicated in the application for registration. Therefore, if a third party decides to file an application for a trademark which is identical or similar to an existing trademark, but the trademark covers a different type of goods, the proprietor of the existing trademark cannot oppose it.

<sup>78</sup> Article L711-3 4° of the Intellectual Property Code.

## ▷ The UDRP procedure

Article 4.a. of the UDRP (Uniform domain-name dispute-resolution policy) states that:

*"You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that*

*(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and*

*(ii) you have no rights or legitimate interests in respect of the domain name; and*

*(iii) your domain name has been registered and is being used in bad faith."* (ICANN, 1999) [40].

This procedure is therefore **limited to conflicts between trademark and domain name holders** to the exclusion of all others.

This procedure is fast and inexpensive and allows for alternative dispute resolution. It applies regardless of where the domain name is registered, regardless of the nationality of the complainant, and is governed by the UDRP.

This is an administrative procedure which does not interfere with the conduct of a parallel judicial proceeding, and a different judicial decision will be binding on the register.

The procedure may result in a transfer of the domain name, a cancellation of the domain name or a dismissal of the action<sup>79</sup>. No appeal is provided for, and dissatisfied parties must initiate new proceedings before their national courts.

The UDRP procedure is conducted by the [WIPO Arbitration and Mediation Center](#) for claimants from the European Union<sup>80</sup>.

The experts in charge of the procedure will assess **cumulatively the risk of confusion between the signs, the absence of legitimate interest of the reserving party<sup>81</sup> as well as their good faith<sup>82</sup>**.

The procedure is online only and provides a "standard" complaint to applicants. It is available on the WIPO website at the [following page](#).

Within 5 to 15 days of the complaint being lodged, it is declared admissible or not by the experts. This is a so-called "contradictory" procedure, i.e. *"no party may be judged without having been heard or called"*<sup>83</sup> (Article 14 of the French New Code of Civil Procedure). Thus, if the complaint is deemed admissible, the defendant is contacted by the experts and will also have the opportunity to submit his or her reasoned response online. The absence of a response presumes bad faith or lack of interest on the part of the respondent and will result in the transfer of the domain name.

A decision is given **within two months** from the date of receipt of the complaint.

For more information on ICANN's UDRP process, please [visit the following address](#).

<sup>79</sup> The claim for damages is excluded.

<sup>80</sup> Six centres are authorised to receive UDRP complaints: the WIPO Arbitration and Mediation Centre; the Czech Arbitration Court for Internet Disputes or '[CAC](#)'; the National Arbitration Forum or '[NAF](#)'; the Asian Domain Name Dispute Resolution Centre or '[ADNDRC](#)'; the Arab Centre for Domain Name Dispute Resolution or '[ACDR](#)'; and the Canadian International Internet Dispute Resolution Centre or '[CIIDRC](#)' (ICANN, 2012) [56].

<sup>81</sup> The applicant must prove that the respondent has no legitimate interest in the name it uses. Since it is difficult to provide negative evidence (evidence that asserts the exclusion or non-existence of something), the respondent must himself demonstrate the existence of such an interest. If he fails to do so, the applicant is deemed to have satisfied paragraph 4, a, ii.

<sup>82</sup> It is always a matter of misappropriating a third party's trademark for personal gain, or for the purpose of being harmful to the third-party owner of the sign.

<sup>83</sup> Quote translated from French

### ▷ The URS procedure

The URS procedure (Uniform rapid suspension system) was set up to **manage problems between domain name applicants in the new generic extensions** (new gTLDs such as ".wine", ".bio", etc.).

The elements of the application are largely the same as those of the UDRP procedure, with the difference that the applicant must provide proof of use of the trademark he is claiming. It also differs in its effects, since the URS procedure aims to suspend the domain name for the remainder of its registration period, with the possibility for the applicant to extend the suspension period by a further year, whereas the UDRP procedure aims to transfer or cancel the disputed domain name.

The special feature of this procedure is that the registry is **obliged to suspend the domain name as soon as it receives notification of the complaint**, even before it is processed. A URS decision can be appealed to the same centre<sup>84</sup>.

The [Czech Arbitration Court](#) (CAC), based in Prague, is competent to handle disputes over “.eu“ domain names.

For more information on ICANN's URS process, please [visit the following address](#).

### ► National out-of-court procedures

In the case of France, AFNIC has set up a specific dispute resolution procedure for people who have reserved an address in ".fr" (France), ".re" (Reunion Island), ".yt" (Mayotte), ".wf" (Wallis and Futuna), ".tf" (French Southern Territories) or ".pm" (Saint Pierre and Miquelon). This procedure is called **the SYRELI procedure**, and allows a decision to be taken on the transmission, blocking or deletion of the domain name **within two months** of the request. For the duration of the procedure, the domain name is "frozen".

Currently, the procedural fees are €250.00 excl. tax per domain name.

The scope of this procedure is broader than the UDRP procedure as it is not limited to trademark and domain name disputes, but **can be applied to all intellectual property rights, including geographical indications**, and also to personality and local authority rights if the domain name holder does not justify a legitimate interest and acts in bad faith.

Finally, as with the UDRP procedure, legal proceedings may also be initiated by the parties, which will suspend the AFNIC procedure.



### FOCUS ON SPAIN

In Spain, infringements of domain names infringing a geographical indication can be prosecuted on the basis of Regulation (EU) 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality systems for agricultural products and foodstuffs, with the aim of obtaining their closure and/or deletion from the Internet.

It is also worth mentioning the following Spanish regulation for infringements of geographical indications, regardless of where they occur:

<sup>84</sup> Three arbitration centres are currently competent for the URS procedure: the Italian Arbitration Centre "[MFSD Srl](#)"; the Asian Domain Name Dispute Resolution Centre or "[ADNDRC](#)"; and the National Arbitration Forum or "[NAF](#)" (ICANN, 2014) [57].

- ▷ [Law 6/2015](#) of 12 May 2015 on designations of origin and protected geographical indications of supra-autonomous territorial scope (see Article 13 on protection);
- ▷ [Law 17/2001](#) of 7 December 2001 on Trademarks, against trademarks and other distinctive signs registered and liable to infringe geographical indications (cf. Articles 5(1)(g) and 5(1)(h) listing the absolute prohibitions on registration);
- ▷ [Law 3/1991](#) of 10 January 1991 on Unfair Competition (cf. Articles 5, 6, 7 and 12);
- ▷ Rules of procedure for out-of-court settlement of disputes relating to ".es" domain names, available at the [following address](#) (see Article 2 on applicable prior rights).



## FOCUS ON PORTUGAL

In Portugal, the "Supremo Tribunal de Justiça" (Supreme Court of Justice) stated in its decision of 8 March 2022 that "*the criteria of Article 238 of the current Industrial Property Code must be applied, albeit with adaptations, to cases in which there is a risk of confusion between a trademark and a domain name*"<sup>85</sup>. In this case, the court granted domain names protection equivalent to that of trademarks, although they still depend on unfair competition.

As regards the conflict between domain names and other proprietary rights, the regime of legal action will be the same for trademarks, logos and geographical indications, namely that of infringement action.

The applicable texts are articles 249 to 251, 293, and 337 to 358 of the Código da Propriedade Industrial.

The same applies to holders of geographical indications, who may also take legal action in the event of infringement, on the basis of Articles 306 and 337 to 358 of the "Código da Propriedade Industrial" (Industrial Property Code).

A domain name may also, under certain conditions, constitute prior art that may hinder the filing of a trademark<sup>86</sup>.

When the courts are called upon to rule on disputes between domain names and trade names, between domain name holders and company names or other domain names, this will be a case of parasitism or unfair competition and it will be necessary to demonstrate harm and a risk of confusion. In this sense, it is necessary to demonstrate the distinctive nature of the terms claimed, and the identity of the activities that could lead to confusion between the companies.

The Portuguese domain name office "DNS.PT" has set up a dispute resolution system for people who have obtained a ".pt" address, which allows them to obtain a decision to transfer, block or delete the domain name. The arbitration procedure takes place at the "ARBITRARE" centre, created in 2009.

At present, the procedural fees amount to €270.00 for each part of the procedure.

<sup>85</sup> Quote translated from Portuguese

<sup>86</sup> On the basis of Article 232/2/a) of the Código da Propriedade Industrial. If the later sign is a "logótipo", the holder of the priority domain name, in order to oppose the registration, must rely on Article 289/1/h), invoking the risk of unfair competition.

#### D. Dispute resolution for other private rights

Whether it is a word trademark, a figurative trademark or a geographical indication, their use by an unauthorised third party may be sanctioned **by an action for infringement and unfair competition**.

In all cases, two principles govern the action: on the one hand, protection of the intangible asset that is the intellectual property right and all related investments, and on the other hand, consumer protection.

This question is all the more important as counterfeiting today goes far beyond the realm of physical sales and is developing massively on the Internet.

In France, the applicable texts give the owner the possibility of taking legal action against any exploitation of the sign to which he has not previously consented.

Article L. 716-4 of the IPC defines trademark infringement in the following terms: "*Infringement of the trademark owner's rights constitutes an infringement that engages the civil liability of its author. Infringement of the rights attached to the trademark constitutes violation of the prohibitions provided for in Articles L. 713-2, L. 713-3-3 and the second paragraph of Article L. 713-4*"<sup>87</sup> (Légifrance, 1992) [39].

Similarly, according to Article L. 722-1 of the CPI: "*Any infringement of a geographical indication in violation of the protection granted to it by European Union law or national legislation shall constitute an infringement for which the perpetrator shall be liable.*"<sup>88</sup> (Légifrance, 1992) [39].

The concept of infringement refers to all infringements of the owner's right, whether they are reproductions or simply imitations of the sign.

Infringement must be proven before it can be punished. The rights holder, who is the plaintiff in the action, must **take all the necessary steps to establish the facts allegedly constituting an infringement** prohibited by the texts.

On the one hand, in addition to the traditional **bailiff's report from the website** selling the contentious products<sup>89</sup>, the holder can use a specific method of proof known as "**seizure forgery**"<sup>90</sup>.

On the other hand, he may also set up **customs surveillance** aimed at combating the introduction into France and the EU of goods bearing counterfeit signs from abroad (cf. Part 2, Chapter I, para. D).

The discovery of acts of infringement leads to the possibility of legal action by the owner. The latter is dual, since acts of infringement constitute both a criminal offence<sup>91</sup> and a civil offence. The related actions may therefore be brought before the criminal courts or the civil courts.

Although the criminal route has certain advantages, it is rarely used in practice, and victims of counterfeiting usually prefer the civil route.

In any case, **the infringement is time-barred after three years**, the starting point of the limitation period being the commission of the infringement. However, infringement is considered a continuing offence, i.e. the limitation period will only start to run from the last act of infringement committed (as long as the use continues, the offence persists).

<sup>87</sup> Quote translated from French

<sup>88</sup> Quote translated from French

<sup>89</sup> L. 716-4-7, paragraph 1, of the CPI, "infringement may be proven by any means".

<sup>90</sup> L. 716-7 of the IPC also provides: To this end, any person having standing to bring an infringement action is entitled to have carried out in any place and by any bailiff, assisted by experts appointed by the plaintiff, by virtue of an order issued on request by the competent civil court, either the detailed description, with or without taking samples, or the actual seizure of the allegedly infringing goods or services as well as any document relating thereto.

<sup>91</sup> Article L. 431-2 of the Consumer Code, for example, lists the offences relating to appellations of origin and geographical indications

The civil action for infringement is subject to the provisions of Article L. 716-4-5 of the IPC, which also provides for another obstacle, defined as "foreclosure by tolerance", according to which this text declares inadmissible "[...] any action for infringement of a later registered trademark the use of which has been tolerated for five years, unless its filing was made in bad faith"<sup>92</sup> (Légifrance, 1992) [39]. However, the inadmissibility is limited to the goods or services for which the use has been tolerated.

In France, where the possibilities of action are still open, the holder can thus bring his action either before the correctional court<sup>93</sup> or before the judicial court (formerly the tribunal de grande instance)<sup>94</sup>.

Determining the territorially competent court is another important aspect of acts committed on the Internet. It appears that the case law decisions rendered on this point continue to hesitate, retaining two possibilities for establishing the jurisdiction of French courts: the first is satisfied with the accessibility of the litigious pages from French territory, sometimes associated with the destination of the litigious advertisement or the availability in France of the litigious products, the second requires the existence of a sufficient, substantial or significant link between the alleged facts and French territory.

In the case of geographical indications, civil action can also only be brought before a court with territorial jurisdiction and exclusive competence in the matter<sup>95</sup>.

It is also possible to combine the infringement action with an unfair competition action, in the event of two unlawful acts causing separate damage<sup>96</sup>.

In all cases, where the matter is urgent, it should be referred to a judge in summary proceedings.

At the end of the civil proceedings, in addition to the possible cancellation of their trademark, if they have registered a litigious trademark, the person responsible for an infringement of a geographical indication or a trademark is ordered **to prohibit the use of the unlawful sign**, as well as **to pay damages**<sup>97</sup>; they may also be forced **to transfer the litigious sign to the victim**.



## FOCUS ON SPAIN

The Spanish judicial procedure authorised by the Civil Procedure Act 1/2002 to resolve conflicts is the so-called "Ordinary Procedure" (Title II, Article 249.14°).

This ordinary procedure includes the following judicial steps in the first instance:

- a. Submission of a judicial application;
- b. Receipt and consideration of the challenge on request (if any);
- c. Pre-hearing for lawyers;
- d. Oral proceedings;
- e. Judgement.

The intervention of a lawyer ("procurador" in Spanish) is recommended to represent the parties

<sup>92</sup> Quote translated from French

<sup>93</sup> Court designated by Article 381 of the Code of Criminal Procedure to judge offences.

<sup>94</sup> Jurisdiction designated to judge civil actions relating to trademarks: the courts of Bordeaux, Lille, Lyon, Marseille, Nanterre, Nancy, Paris, Rennes, Strasbourg, Fort-de-France.

<sup>95</sup> Code de l'Organisation Judiciaire, Article D. 211-6-1 and Article L. 722-8 of the CPI.

<sup>96</sup> It is therefore necessary to establish facts distinct from those sanctioned on the basis of infringement.

<sup>97</sup> Article L. 722-6 of the IPC states that in order to determine damages, the court shall take into account separately:  
1° The negative economic consequences of the infringement, including the loss of profit and loss suffered by the injured party;

in the Court, to maintain contact with the Court, to ensure the transmission of documents between the parties and to conduct the process.

In Spain a state tax must be paid by legal entities for the exercise of jurisdiction (in case of filing a lawsuit).

If the amount of the procedure is less than 2000 euros, legal entities are exempted from paying it. If the amount exceeds 2000 euros, the following are exempted:

- ▷ Legal entities entitled to free legal aid;
- ▷ The Attorney General's Office;
- ▷ The General Courts and Legislative Assemblies of the Autonomous Communities;
- ▷ The general administration of the State and any local administration or entity dependent on it (Sevitia, 2020) [41].

The form to be completed to pay this tax is the "[M 696](#)" form available at the [following address](#). The tax for an ordinary trial is €300.00 with a 10% discount for an online declaration.

The Courts of Justice appointed by virtue of their specialisation to resolve disputes initiated exclusively in the field of intellectual property (trademarks) in Spain are the following Commercial Courts:

- ▷ Andalusia: Commercial Court nº 1 in Grenada.
- ▷ Catalunya: Commercial Courts nº 2, 6, 8 and 9 in Barcelona (trademarks).
- ▷ Madrid: Commercial Courts nº 7, 8, 9, 10 in Madrid.
- ▷ Comunidad Valenciana: Commercial Courts nº 1 and 3 (trademarks) in Valencia.
- ▷ Galicia: Commercial Courts nº 1 and 2 in La Coruña.
- ▷ Islas Canarias: Commercial Courts nº 1 and 2 in Las Palmas.
- ▷ Euskadi: Commercial Court nº 2 in Bilbao.

Legal action against domain names infringing geographical indications can be taken on the following basis:

- ▷ the European Geographical Indications Regulation (EU Regulation 1151/2012);
- ▷ the Spanish Trademarks Act 17/2001 (absolute prohibitions on registration). Even to avoid a trademark registration on the basis of an absolute prohibition of Article 5.1.h), or to attack a trademark already registered (absolute nullity);
- ▷ Spanish Law 3/1991 on unfair competition (acts of deception, confusion, abusive use of the reputation of others).

It should be noted that Article 45 of the Trademark Law on the "Prescription of Actions", applicable in case of starting legal proceedings against a registered trademark, states that "*Civil actions derived from the violation of trademark rights expire after five years, starting from the day they could be exercised*"<sup>98</sup> (Agencia Estatal Boletín Oficial del Estad, 2001) [42].

However, in case of application of the absolute prohibitions of Article 5.1.h) of the Spanish Trademarks (Protection of PDO/PGI) Act 17/2001 against registered trademarks, Article 51.2 considers that "*The action for absolute invalidity of a registered trademark is not subject to any statute of limitations*."

In case of invalidity of a registered trademark (basic right of an internet domain) infringing a

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<sup>98</sup> Quote translated from Spanish

geographical indication, Article 51.1 of the Spanish Trademark Law 17/2001 states that:

*"The registration of the trademark may be declared invalid by means of an application filed with the Spanish Patent and Trademark Office or by means of a counterclaim in a trademark infringement action:*

- a. *Where it contravenes the provisions of Article 5 of this Law.*
- b. *Where the applicant has acted in bad faith in filing the trademark application.*

In the case of the initiation of civil proceedings, the following points should be taken into account:

1. The Spanish Law of Civil Procedure allows for the initiation of proceedings in parallel with the main proceedings to request precautionary measures. Specifically, article 727.9<sup>a</sup> states: *"In accordance with the provisions of the preceding article, the following precautionary measures, among others, may be agreed upon: (...) 9<sup>a</sup> The temporary deposit of copies of works or objects deemed to have been made in violation of intellectual and industrial property rules, as well as the deposit of the material used for their manufacture.*
2. The complaint must be directed against the infringing entity and the specific holder/owner of the domain name, even when the latter is a third party or a temporary holder. Access to "whois" service providers is a key to determining the identity and legal status of future defendants.
3. The complaint should not be limited to a declaration of infringement or an action to stop the marketing of infringing goods via the domain name (if applicable) but should specifically request the cancellation (or transfer to the rightful owner) of the domain names.
4. The complaint must include a request for a court order against the domain name registry and/or registrar to cancel or transfer (if applicable) the infringing domain names.
5. Legal action can be taken against acts committed through domains (marketing of misleading or counterfeit goods) and/or the unlawful registration and use of the domain name containing the GI term.
6. If brought against a domain name on its own terms, the offending domain can be "attacked":
  - 6.1. As a violation of GI protected terms;
  - 6.2. As a means for other acts of unfair competition based mainly, but not only, on the benefit of reputation and acts of deception.
7. The plaintiff must specifically request the cancellation (or transfer) of the infringing domain names and the court must file an order addressed to the relevant domain name registrar. Merely requesting to cease or refrain from marketing products via the domain is not sufficient to prevent future infringement.
8. Active monitoring and opposition to the possible registration of terms as intellectual property rights, domains or other commercial uses are taken into account by the courts in upholding a plea.



## FOCUS ON PORTUGAL

In Portugal, the owner has the right to take legal action against any exploitation of the sign to which he has not previously consented (Articles 249 and 306 of the IPC).

The trademark owner may even oppose preparatory acts, such as the production or sale of labels,

packaging or security or authentication devices (Article 250 IPC).

Infringements of geographical indications and other distinctive signs may constitute both a criminal offence<sup>99</sup> and a civil offence. Consequently, the corresponding actions can be brought before the criminal courts or before the civil courts.

This type of offence is subject to a five-year statute of limitations, the starting point of which is the commission of the offence (Article 118/1/b) of the Criminal Code).

However, depending on the situation, infringement may be considered as a continuous infringement, in which case the statute of limitations will only start to run from the last act of infringement committed (as long as the same act continues).

The civil action for infringement is subject to the provisions of Article 261 of the IPC, which also provides for another obstacle, defined as foreclosure by acquiescence, according to which the owner of a registered trademark cannot oppose the use of a later trademark whose use has been tolerated for five years, unless its registration was made in bad faith. However, this foreclosure is limited to the goods or services for which use has been tolerated.

Depending on the domain, the holder can either bring his action before the criminal court or before the Intellectual Property Court (exclusive jurisdiction for civil actions in Intellectual Property matters, cf. article 111.<sup>o</sup> of Lei n<sup>o</sup> 62/2013, of 26/08). This court, sitting in Lisbon, is a specialised court, covering not only Industrial and Intellectual Property disputes, but also those concerning Internet domain names.

Crimes remain outside of its jurisdiction, they are exclusively within the jurisdiction of the courts of general jurisdiction.

It is also possible to combine the infringement action with the unfair competition action, in the event of two unlawful acts causing separate damage<sup>100</sup>.

At the end of the civil proceedings, in addition to the possible cancellation of his trademark, if he has filed a litigious trademark, the person responsible for an infringement of a geographical indication or a trademark is prohibited the use of the unlawful sign and to pay damages.

Article 347 of the IPC states that in order to determine damages, the court shall take into account separately:

1. The negative economic consequences of counterfeiting, including loss of profit and loss to the injured party;
2. The moral damage caused to the injured party;
3. And the profits made by the counterfeiter, including the savings in intellectual, material and promotional investments that the counterfeiter has made from the counterfeit.

In addition, judges may prohibit, including under penalty, the use of an unlawful name or sign, or impose its transfer to the victim (Article 348.<sup>o</sup> of the IPC).

In case of urgency, the holder may refer the matter to the judge of summary proceedings (Articles 345 and 346 of the IPC).

Portuguese civil court procedure is regulated by the "Código de Processo Civil" (Code of Civil Procedure), whose ordinary procedure includes the following judicial stages in the first instance:

<sup>99</sup> Articles 320 (trademarks) and 324 (geographical indications), providing for penalties of up to 3 years imprisonment. As regards wine geographical indications, Decree-Law No. 213/2004 of 23 August 2004 provides for more severe penalties of up to 4 years.

<sup>100</sup> Actions based exclusively on unfair competition must be brought before the courts of generic jurisdiction, of the place of domicile of the defendant (Article 85 of the Código de Processo Civil).

- a. Submission of a judicial application;
- b. Receipt and consideration of the challenge on request (if any);
- c. Pre-hearing for lawyers;
- d. Final hearing;
- e. Judgement.

The criminal procedure is regulated by the Código de Processo Penal (Code of Criminal Procedure) and is normally carried out by the Procurador da República (Public Prosecutor) of the Ministério Público (Public Ministry), with the assistance of private parties, which is optional.

The fees to be paid in civil proceedings depend on the value of the claim (including the compensation claimed) according to the "Regulamento das Custas Processuais" (Regulation on Procedural Costs). A simulation is available on the government website at the [following page](#).

The criminal procedure is free of charge (except for the constitution as an assistant, which is subject to a fee of €102.00).

### III. Practical advice in case of image or reputation violation

In addition to domain names and acts of counterfeiting and unfair competition, there may be other cases of indirect infringement of intellectual property rights on the Internet.

The multiplication of interactive spaces leads to a **multiplication of the risks of infringement of the image of intellectual property rights** and the products they cover.

Online forums, blogs, social networks, platforms for sharing audiovisual content, classified ads and websites are all new spaces of expression where it can be difficult to assert one's rights.

In this respect, the protection of geographical indications is understood at two levels.

It is important, first of all, to make the best use of this new tool to protect the intellectual capital of owners by building a strong image (paragraph A), and secondly, to defend distinctive signs and their image against attacks by competitors and dishonest consumers (paragraph B), while adopting good practices (paragraph C).

#### A. Building your image on the Internet

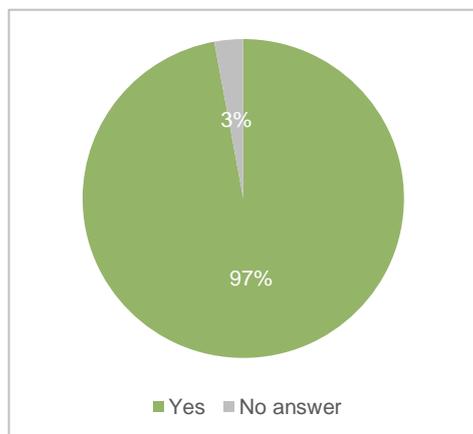
The Internet and social networks should not be approached solely from the perspective of the risk of intellectual property infringement.

They should also and above all be seen as **opportunities for right holders** to increase awareness of their GIs on the one hand, and to disseminate counterfeit awareness messages to consumers on the other.

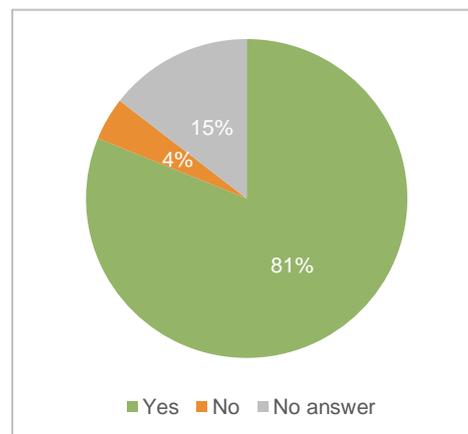
Nowadays, the awareness of a geographical indication is mainly achieved through promotion and advertising by the holders on the Internet.

In this respect, 97% of the organisations participating in the AREPO survey consider it profitable to promote their quality products on the Internet (cf. figure n°28), and 81% consider the geographical indications system as a powerful marketing tool (cf. figure n°29).

**FIG. 28:** Survey results: Do you consider it beneficial to promote your products under EU quality schemes on the Internet? (AREPO, 2022)

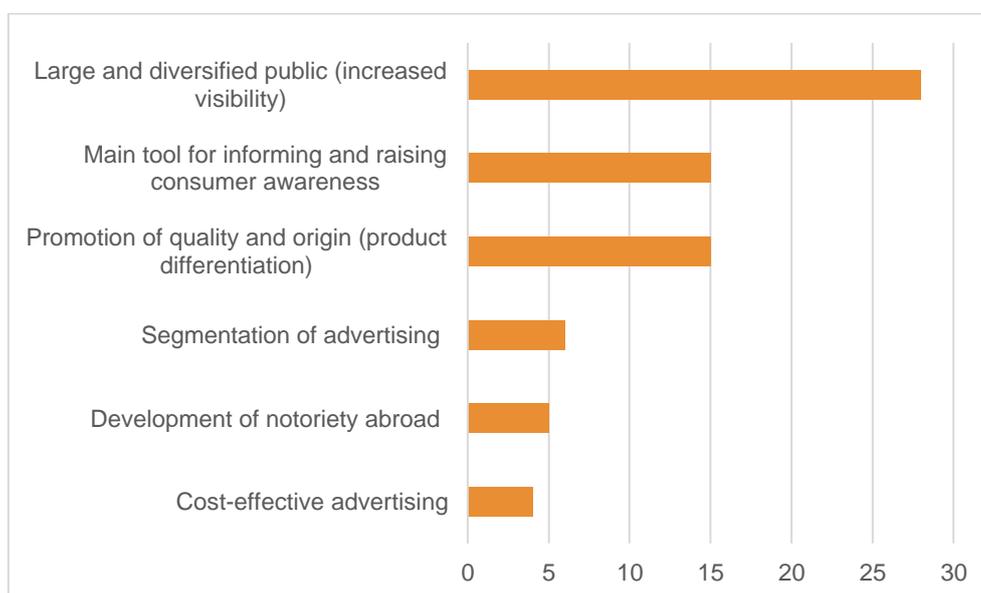


**FIG. 29:** Survey results: Do you consider the GI quality scheme to be a powerful digital marketing tool? (AREPO, 2022)



Indeed, according to these organisations, the Internet is now the **main information and consumer awareness tool for increasing the visibility of quality products** by reaching a large and diverse audience. It also allows advertising to be segmented to reach the target consumer category more easily and at lower cost. Finally, it allows the development of the reputation of the geographical indication beyond the borders of its geographical area thanks, in particular, to e-commerce (cf. figure n°30).

**FIG. 30:** Survey results: Why is it worthwhile to promote your products under EU quality schemes on the Internet? (AREPO, 2022)



Moreover, in the event of litigation, a strong presence on the Internet will make it **easier to justify a loss** and to obtain greater damages. Thus, the market share occupied by the sign, the intensity of its exploitation on the Internet, the importance of the investments will all be elements that will attest to the attachment of the consumer to the distinctive signs in question.

In addition to easing the burden of proof, the high visibility offered by the Internet can also be **a tool for communication and raising awareness against the unauthorised use of distinctive signs**, particularly through social networks.

Social networks can indeed be a means of sharing information on infringing products, allowing the owner to control his own communication.

## B. Identified risks and possible actions

There can be many different types of infringement on the Internet: the distinctive sign can be used in figurative elements, graphic charters using the GI's colour codes, images or even logos on a web page. It can also be directly implicated in the name of a website or a web page, in the URL of a web address (infringement of domain names), in disparaging remarks, or in the sale of counterfeit goods.

An owner who is the victim of an Internet infringement has a number of measures at his disposal to defend himself.

The first step is to **contact the platform where the infringement is located** to try to resolve the infringement amicably.

### ▷ For marketplaces and e-commerce platforms

Most of these platforms offer direct means for right holders to report an infringement or request a blocking or removal of a page or a user/seller, such as:

- ▷ Amazon: [go here](#) to access the complaints procedure;
- ▷ Alibaba: [go here](#) to access the complaints procedure;
- ▷ AliExpress: [go here](#) to access the complaints procedure;
- ▷ eBay: [go here](#) to access the complaints procedure;
- ▷ Rakuten: [go here](#) to access the complaints procedure.

However, it appears difficult to use these tools effectively and to provide proof of the rights invoked, as these platforms are not very familiar with GIs – they only think in terms of trademarks. Platforms can thus be very reluctant in removing contentious ads (TESSIER et al., 2021) [18].

### ▷ For search engines

Most search engines offer direct means for right holders to report an infringement or request a block or removal of a page or user/seller, such as:

- ▷ Google: [go here](#) to access the complaints procedure;
- ▷ Bing: [go here](#) to access the complaints procedure;
- ▷ Yahoo: [go here](#) to access the complaints procedure.

However, combating these breaches is complicated for the following reasons (UNIFAB, ALCCI, 2019) [11]:

- ▷ The search engine has a **commercial interest in selling traffic** to a client, even an illicit one, who wants to be listed;
- ▷ Traffickers create **specific powerful tools** to obtain traffic;
- ▷ Dereferencing ads **can be very expensive**;
- ▷ And only as a **temporary solution**.

▷ For social networks:

Social networks generally offer online complaint procedures in case of infringement, such as:

- ▷ Facebook: [go here](#) to access the complaints procedure;
- ▷ Instagram: [go here](#) to access the complaints procedure;
- ▷ Twitter: [go here](#) to access the complaints procedure;
- ▷ TikTok: [go here](#) to access the complaints procedure;
- ▷ YouTube: [go here](#) to access the complaints procedure;
- ▷ Pinterest: [go here](#) to access the complaints procedure.

The owner will have to fill in the dedicated online form, stating his identity and contact details, as well as the prior intellectual property rights, and the reasons for his claim.

In theory, the network concerned will process the request, and accounts with a username, or publishing any content that could mislead the consumer or infringe the rights of a third party, may then be **modified, transferred or permanently deleted by the network in question**.

If the platforms are indeed recalcitrant, then registrants can **take legal action**.

In France, reference should be made to Articles L. 716-4 et seq. of the Intellectual Property Code for counterfeiting, as already mentioned, or to Article 1241 of the Civil Code for cases of denigration and economic parasitism. It may also be possible to act on the basis of identity theft (protected by Article 226-4-1 of the Criminal Code), which benefits both legal entities and individuals.

However, owners should think twice before taking infringement action because, although they have many means at their disposal to defend themselves, it is sometimes better to not act **to avoid the effects of a "bad buzz"** (see the emblematic "World Nutella® Day" case<sup>101</sup>). The affixing of a protected sign on a social network for the purpose of informing about the services offered is not an infringement. Nor is it an infringement to place a trademark on a website for the purpose of parody. Above all, the disputed use of the sign on the Internet must be as a trademark and must be in the course of business.

The holder who decides to act must, before bringing the matter before the judge, carefully consult the general conditions of use of the sites concerned.

In this context, most social networks require infringement notifications that are consistent with the hosting status of these operators.

Indeed, as indicated in part 1, the directive on electronic commerce 200/31/EC of 8 June 2000 established the principle of the subsidiary responsibility of the content host, a principle transposed in article 6-I-2 of the LCEN law<sup>102</sup>.

French case law generally considers that **social network operators are mere hosts**, and, in application of this regime, hosts are only obliged to remove contentious content once they have **received notification of it**<sup>103</sup>.

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<sup>101</sup> World Nutella® Day is an unofficial global day celebrated each year on 5 February to celebrate the Nutella® spread. The event was created in 2007 by an American blogger, Sara Rosso, who was a fan of Nutella®. In 2013, Nutella® sent Sara Rosso a formal notice for the use of the brand name in the event's name. This provoked a negative reaction from Nutella® fans who defended Rosso and used social media to express their disapproval of Nutella®. Eventually, Nutella® withdrew its formal notice and announced that it would support the event in the future (The Communicator's Blog, 2013) [58].

<sup>102</sup> Law on confidence in the digital economy of 21 June 2004 (LCEN)

<sup>103</sup> Social network service providers then offer detailed online forms called "Trademark Infringement Forms" which are very important to consult.

According to article 6-1-5 of the LCEN law, this notification must contain:

- ▷ The date of the notification;
- ▷ If the notifier is a natural person: surname, first name, profession, domicile, nationality, date and place of birth; if the applicant is a legal entity: its form, name, registered office and the body which legally represents it;
- ▷ The name and address of the addressee or, in the case of a legal entity, its name and registered office;
- ▷ The description of the facts in dispute and their precise location;
- ▷ The reasons for which the content should be removed, including the legal provisions and factual justifications;
- ▷ A copy of the correspondence addressed to the author or publisher of the contentious information or activities requesting their interruption, withdrawal or modification, or the justification that the author or publisher could not be contacted.

Then, only if the host does not promptly remove the contentious content, can it be held liable.

The existence of these general conditions of use and the specific procedures for protecting intellectual property rights certainly explain the low level of litigation in this area.

### C. Good practices to implement

Building a strong image on the Internet requires a global approach that combines **marketing, communication and the legal dimension**.

One must be able to take advantage of the potential of the Internet without neglecting the protection of one's assets.

Therefore, the producer group should develop a real action plan with clear milestones and dedicated budgets. Asset protection should be at the forefront, followed by actions on marketing and communication strategies.

#### 1. Protecting and preserving your rights

Maintenance of his rights by the holder, beyond the protection against third parties, also means managing the portfolio of existing rights in addition to the GI, such as:

- ▷ **Carrying out the formalities for the renewal of rights** (trademarks, domain names, etc.) and paying the associated fees (only the protection of geographical indications is granted in perpetuity);
- ▷ **Using the signs registered as trademarks** to avoid cancellation for non-use: If an owner does not use his trademark in a concrete and serious manner for an uninterrupted period of five years, he is liable to proceedings for revocation of his trademark. In other words, non-use can lead to the loss of trademark rights.

#### 2. Develop a marketing strategy

It is imperative that the rights holder builds a strong brand image, and that the protection strategy endures throughout the life of the assets. This requires in particular:

- ▷ The **creation of a strong identity**, combined with a coherent communication strategy: the name constituting the GI, the EU GI logo and the logo of the grouping, if applicable, should always be used in an visible way;

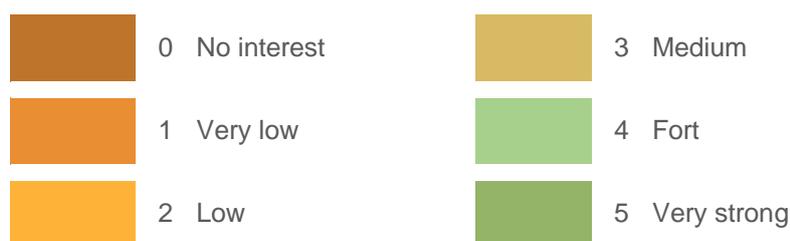
- ▾ The establishment of a **homogeneous visual identity** for the GI producer group: it is recommended to opt for a logo and a website common to all members, and to favour a similar graphic charter on the websites of each member, in order to build a common image.
- ▾ **Marketing conditions** should always be **consistent with the quality image of the GI**. In particular, it is recommended to avoid selling through third parties and to market on low-price sites (sale sites);
- ▾ An **appropriate presence**: while the creation of a website dedicated to the GI is the first step in building a coherent marketing strategy on the Internet, other communication channels should not be neglected.

As such, the organisations participating in the AREPO survey actually consider the website as the most effective digital marketing tool. It is closely followed by the social networks "Instagram", "Youtube", "Facebook". "Twitter" comes last in the ranking<sup>104</sup>.

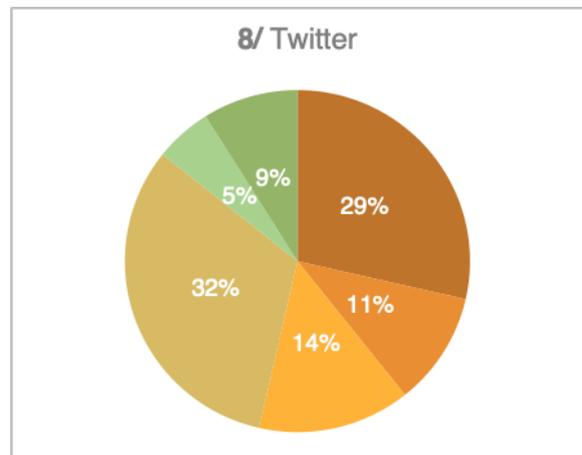
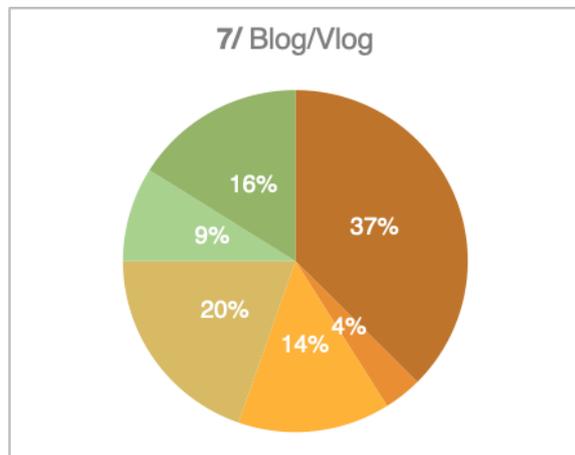
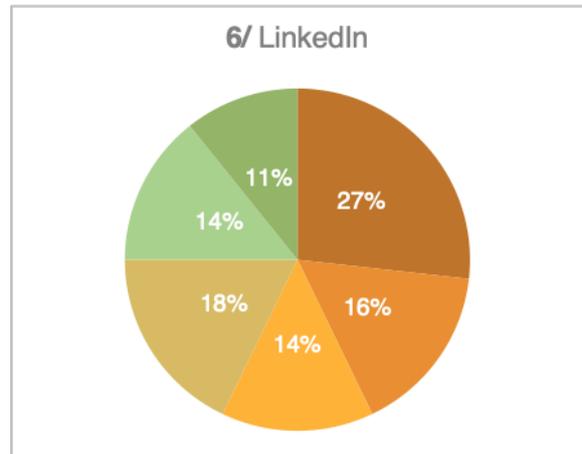
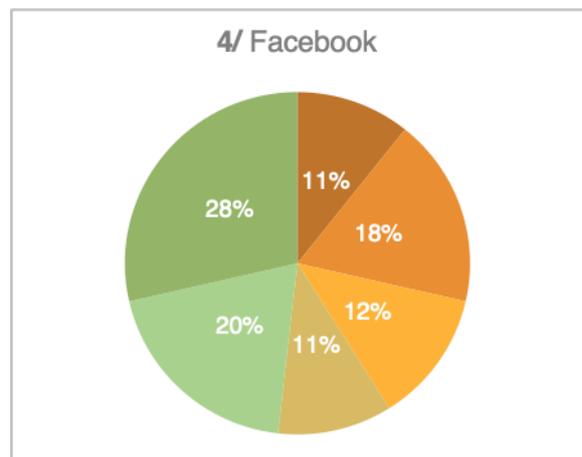
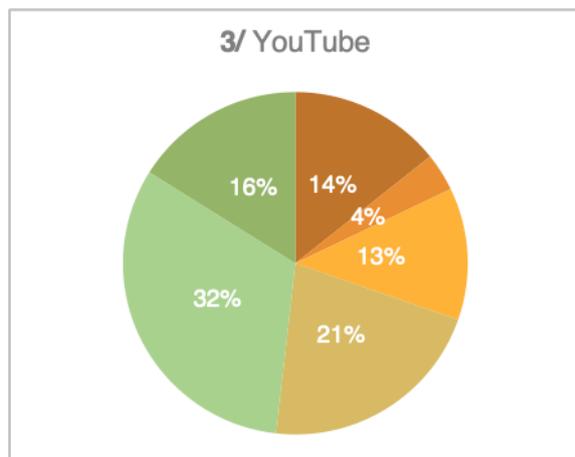
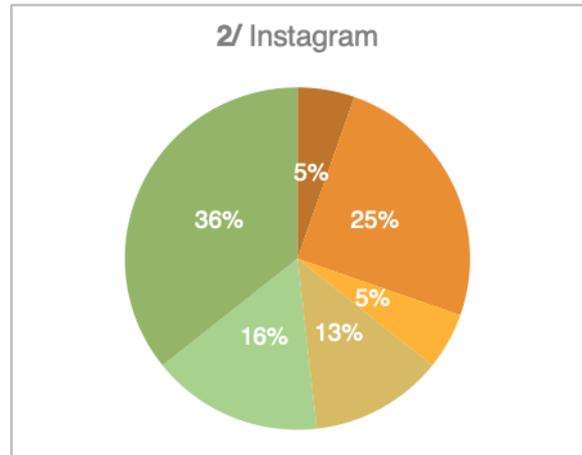
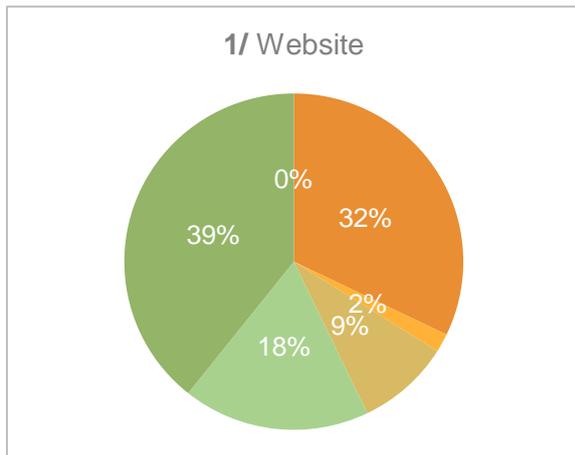
The graphs below show the digital marketing tools most used by the 56 organisations that responded to this question and the scores given to them.

**FIG. 31:** Survey results: Which digital marketing tools do you think are the most important to promote your products under EU quality schemes? (AREPO, 2022)

#### LEGEND:



<sup>104</sup> One of the organisations also mentioned the social network "TikTok", giving it a score of 5 out of 5.



Some producer groups have developed particularly effective Internet marketing strategies.

We will analyse two cases of good digital marketing practices of producer groups of different sizes. These producer groups participated in the AREPO survey and gave us permission to illustrate this guide with their communication tools.

### ► The case of the "Prosciutto di Parma" PDO

The "[Prosciutto di Parma](#)" PDO is an Italian ham from the Emilia-Romagna region with an international reputation and a marketing strategy that is a very good example of effective communication on the Internet. The Consorzio del Prosciutto di Parma has 156 producers with a turnover of almost 800 million euros (production value), of which 290 million euros are exported (Consorzio del Prosciutto di Parma, 2022) [43].

#### ► "Prosciutto di Parma" PDO website

First, the Consorzio created a **website dedicated to the PDO** with a consistent web address whose domain name includes the exact name of the GI associated with the most widely used top-level domain in the world ".com": "<https://www.prosciuttodiparma.com/>", which allows the website to be listed at the top of the list when a user types in the name of the GI in a search engine.

FIG. 32: Home page of the "Prosciutto di Parma" PDO group website



#### ► Valuation of logos

The [homepage](#) of the website immediately highlights the **group's logo**, as well as the EU **PDO logo**, which is an excellent practice to recommend to all GI groups. The video and images representing the know-how of the producers, the product and its geographical area, allow the consumer to immediately identify the intention of the website.

FIG. 33: Logo of the PDO "Prosciutto di Parma"



▷ Consistency of the graphic charter

The graphic charter of the website uses the **colour codes** (white and ochre) and **typography of the logo**, which makes the website visually attractive, modern and uncluttered, but above all easily identifiable and recognisable by the consumer.

▷ Links to other platforms

The **social network sharing buttons** are also highlighted directly on the home page and reappear on every page of the website. They allow users to share elements of the website to their own social networks or to other communication channels. In the case of "Prosciutto di Parma", the buttons allow users to share elements of the website to the "Facebook", "Twitter", "Instagram" and "Pinterest" networks, as well as "Whatsapp" and "Telegram".

The **icons of the group's social networks** are also accessible in the banner at the end of the home page (in the case of this website, the buttons lead to the "Facebook", "Twitter", "Instagram" and "Youtube" networks of the "Prosciutto di Parma" PDO), which allows users to easily access all the PDO's networks (by clicking on the desired icon) and thus generate new visits, and potentially new subscriptions. This practice is essential to give visibility to a geographical indication, provided that the pages in question are active, otherwise the opposite effect may occur.

▷ The languages

The website is available in the language of the GI, but also in English (the international language), and in five other languages. It goes without saying that not all producer groups have the financial or human resources to do this, nor the need (related to the reputation of the GI), but it is nevertheless recommended that the website be translated, at a minimum, **into the language of the GI's geographical area and into English**.

▷ Promotion of the GI system

The website also **promotes the PDO process and its logo** on the tab "[IL PROSCIUTTO DI PARMA](#)".

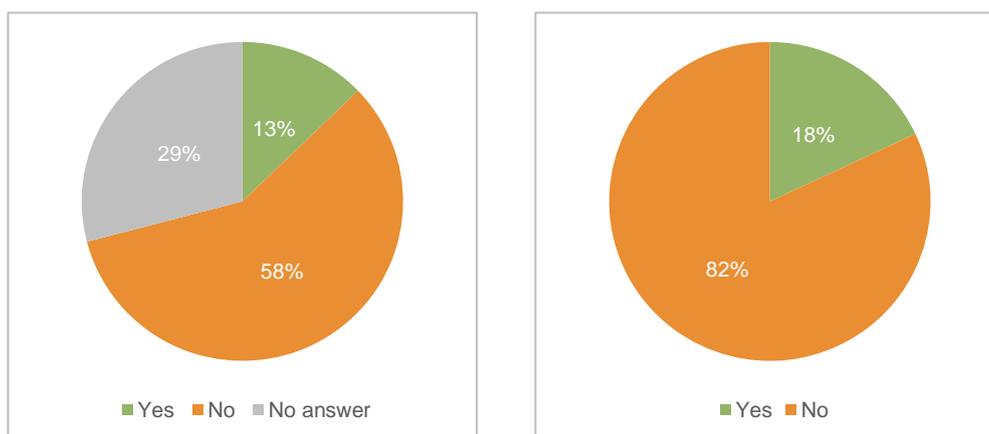
FIG. 34: Promotion of PDO certification on the website of the "Prosciutto di Parma" PDO group



The importance of **communication about the GI process** on the websites of the groups should be emphasised in order to increase consumer awareness of this certification, which deserves greater visibility.

In this respect, 58% of the organisations participating in the AREPO survey consider that the GI quality system is not sufficiently recognised by consumers on the Internet (82% after removing the non-response rate).

**FIG. 35:** Survey results: Do you consider that the GI quality scheme is sufficiently recognized by consumers online? (AREPO, 2022)

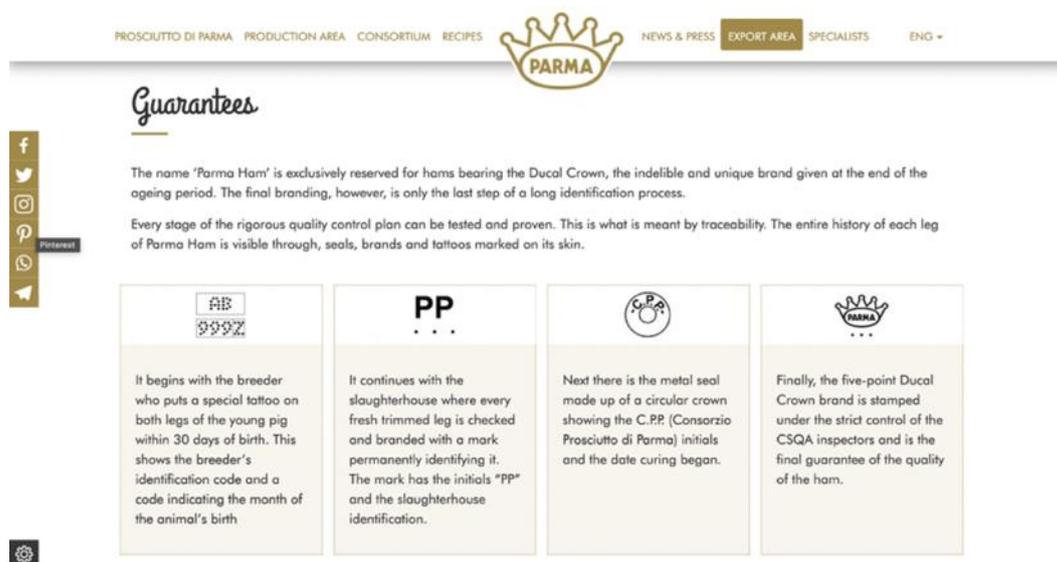


▷ Guarantee and traceability marks to combat counterfeiting

It is also advisable, as the "Prosciutto di Parma" PDO producers' group has done on the "[IL PROSCIUTTO DI PARMA](#)" tab, to indicate the **various means of identifying the real GI product** on the market, in order to **combat counterfeiting**.

A description of the group logo, the EU GI logo, or other guarantee marks available on the packaging or the product itself should be provided. In the case of "Prosciutto di Parma", the pig's leg is tattooed with the month of birth and the farmer's identification code, then branded with the initials "PP" ("Prosciutto di Parma") at the slaughterhouse, and finally branded with the crown, the symbol of the PDO.

**FIG. 36:** Prosciutto di Parma" PDO guarantee marks on the group's website



▷ The specificities of the product, the know-how of the producers and the terroir

The website dedicates the tab "[IL PROSCIUTTO DI PARMA](#)" to the history and **specificities of the product** and to the **know-how of the producers**, and the tab "[IL TERRITORIO](#)" to the **geographical area of the PDO**, which represents the soul of a geographical indication. This information is absolutely essential to promote the product and to make the consumer aware of the importance of the GI system.

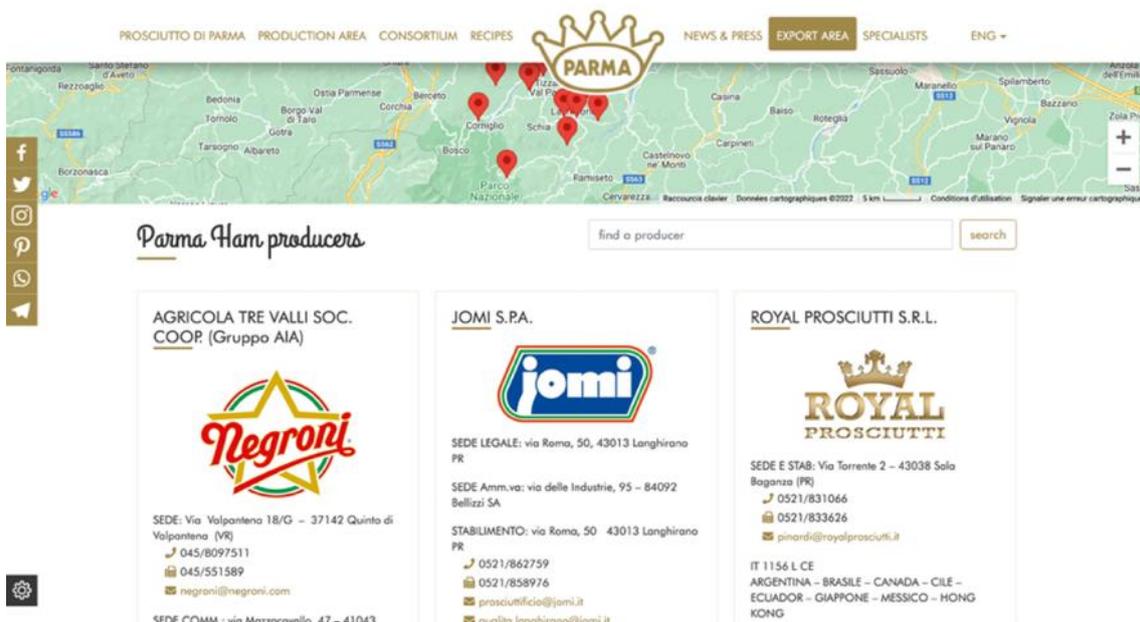
FIG. 37: Presentation of the geographical area of the PDO "Prosciutto di Parma" on the group's website



► The GI producer group and its members

Finally, the website dedicates the tab "[IL CONSORZIO](#)" to the **GI producer group and its members**, where it is possible to find the location, contact details and, if available, the websites of all the producers of the PDO "Prosciutto di Parma", thus increasing their visibility and offering guarantees to the consumer.

FIG. 38: Location and list of producers of the PDO "Prosciutto di Parma" on the website of the group



▷ The GI sector and its figures

It is also advisable to dedicate a space to **the GI sector and its figures**, as is the case on the "[IL CONSORZIO](#)" tab of the group's website.

FIG. 39: Figures for the "Prosciutto di Parma" PDO sector on the group's website



▷ Social networks of the PDO "Prosciutto di Parma"

"Prosciutto di Parma" PDO is present on a number of social networks, such as

- ▷ "Facebook", with the page "[@prosciuttodiparma](#)" which has more than 140,000 followers;

FIG. 40: "Prosciutto di Parma" PDO Facebook page



- ▷ "Instagram", with the page "[@prosciuttodiparma\\_it](https://www.instagram.com/prosciuttodiparma_it)" which has more than 17,000 followers;

FIG. 41: "Prosciutto di Parma" PDO Instagram page



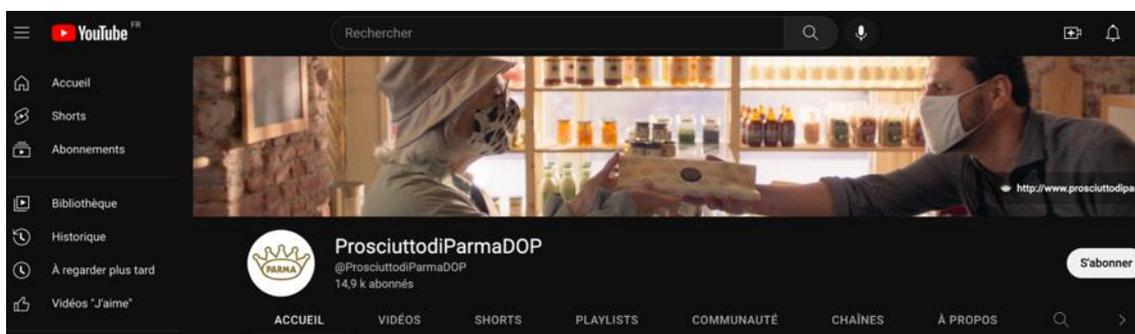
- ▷ "Twitter", with the page "[@prosciuttodiparma](https://twitter.com/prosciuttodiparma)" which has almost 17,000 followers;

FIG. 42: "Prosciutto di Parma" PDO Twitter page



- ▷ "YouTube", with the page "[@prosciuttodiparmadop](https://www.youtube.com/@prosciuttodiparmadop)" which has almost 15,000 followers.

FIG. 43: "Prosciutto di Parma" PDO YouTube page



These networks all have in common the **use of the exact name of the GI** in the names attributed to the pages and the **use of the group's logo in the profile photo**, which makes it possible to promote a strong visual identity and to mark the consumer's mind.

### ► The case of the "Ossau-Iraty" PDO

The "[Ossau-Iraty](https://www.ossau-iraty.fr)" PDO is a famous French sheep's cheese from the Nouvelle-Aquitaine region in France, whose marketing strategy is also a very good example of effective communication on the Internet. The Syndicat de Défense de l'AOP Ossau-Iraty groups together more than 1400 operators (milk producers, farm producers and ripeners, dairy cheese dairies and ripeners, etc.) (Syndicat de Défense AOP Ossau-Iraty, n.d.) [44] For an estimated turnover of nearly 55 million euros in 2021 (France Bleu, 2021) [45].

#### ► Ossau-Iraty" PDO website

The producer group has also created a **website dedicated to the PDO** with a consistent web address whose domain name includes the exact name of the GI associated with the national top-level domain ".fr": "<https://www.ossau-iraty.fr>", which allows the website to be listed at the top of the list when a user types the name of the GI into a search engine.

FIG. 44: Home page of the "Ossau-Iraty" PDO group website



#### ► Valuation of logos

As with the "Prosciutto di Parma" PDO, the home page of the website immediately highlights the **logo of the group**, as well as the **EU PDO logo**, which is an excellent practice to recommend to all groups. The video and images representing the producers' skills, the product and its geographical area, allow the consumer to immediately identify the intention of the website.

#### ► Consistency of the graphic charter

The graphic charter of the website uses the **colour codes** of the **group's logo** (white and red) and the **EU PDO logo** (red and yellow), which makes the website visually attractive and coherent, but above all easily identifiable and recognisable by the consumer.

#### ► Links to other platforms

The **icons of the group's social networks** are also accessible in the banner at the end of the home page (in the case of this website, the buttons lead to the "Facebook", "Twitter", "Instagram" and "Youtube" networks of the "Ossau-Iraty" PDO), which allows users to easily access all the PDO's networks by clicking on the desired icon and thus generate new visits and, potentially, new subscriptions.

FIG. 45: Logo of the "Ossau-Iraty" PDO



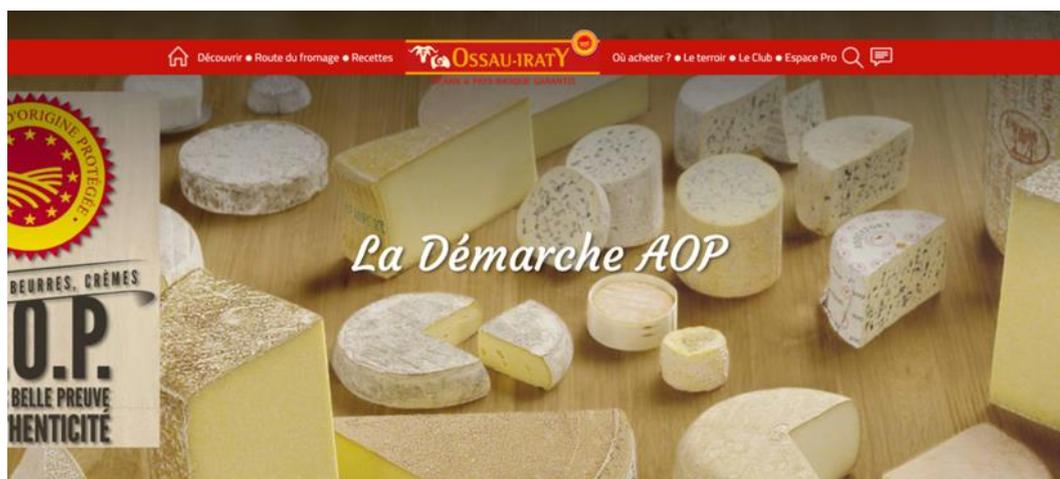
- ▷ The languages

In the case of "Ossau-Iraty", the website is only available in French. The sheep's cheese does not have the international reputation of "Prosciutto di Parma" but it is nevertheless advisable to **add an English translation** to increase visibility and export sales.

- ▷ Promotion of the GI system

The website also **promotes the PDO approach and its logo** on the "[Commitment and control](#)" tab.

FIG. 46: Presentation of PDO certification on the website of the "Ossau-Iraty" PDO group



- ▷ Guarantee and traceability marks to combat counterfeiting

Like the "Prosciutto di Parma" producers' group, the "Ossau-Iraty" producers' group has dedicated a page to "[Recognising Ossau-Iraty](#)" to teach buyers how to **identify genuine "Ossau-Iraty" cheese** in order to **combat counterfeiting**.

The **guarantee marks** for "Ossau-Iraty" are as follows (Syndicat de Défense AOP Ossau-Iraty, n.d.) [46]:

- ▷ For "Ossau-Iraty" cheeses from cheese dairies: they are stamped on the rind with a sheep's head seen from the side;
- ▷ For farmhouse "Ossau-Iraty" cheeses (made from raw milk): they are stamped on the rind with a sheep's head seen from the front;
- ▷ For farmhouse "Ossau-Iraty" cheeses from mountain pastures: in addition to the front sheep's head, they feature an edelweiss in a mountain.

These markings are made on the rind of the cheese or in the form of casein plates.

FIG. 47: Ossau-Iraty" PDO guarantee marks on the group's website



- The specificities of the product, the know-how of the producers and the terroir

The website also dedicates a tab "[Discover Ossau-Iraty](#)" to the history and **specificities of the product** and the **know-how of the producers** and a page "[The PDO area](#)" to the **geographical area** of the PDO.

FIG. 48: Presentation of the geographical area of the PDO "Ossau-Iraty" on the group's website



- The producer group and its members

Finally, the website dedicates the page "[The Ossau-Iraty PDO Defence Union](#)" to the **group** and the tab "[PDO Cheese Route](#)" to **its members**, on which it is possible to find the location, contact details and, where applicable, the websites of all producers of the "Ossau Iraty" PDO, making it possible to increase their visibility and offer guarantees to the consumer.

The website proposes an "Ossau-Iraty cheese route" to discover pastoralism and the traditional production of "Ossau-Iraty" while discovering the Basque Country and Béarn. These proposed "routes" are also excellent practices to be noted since they allow the product, the know-how of the producers and the geographical area of the GI to be promoted.

FIG. 49: Location of Ossau-Iraty PDO producers on the group's website



▷ The GI sector and its figures

It is also advisable to dedicate a space to **the GI sector and its figures**, as is the case on the "[History of Ossau-Iraty](#)" tab of the group's website.

FIG. 50: Figures for the "Ossau-Iraty" PDO sector on the group's website

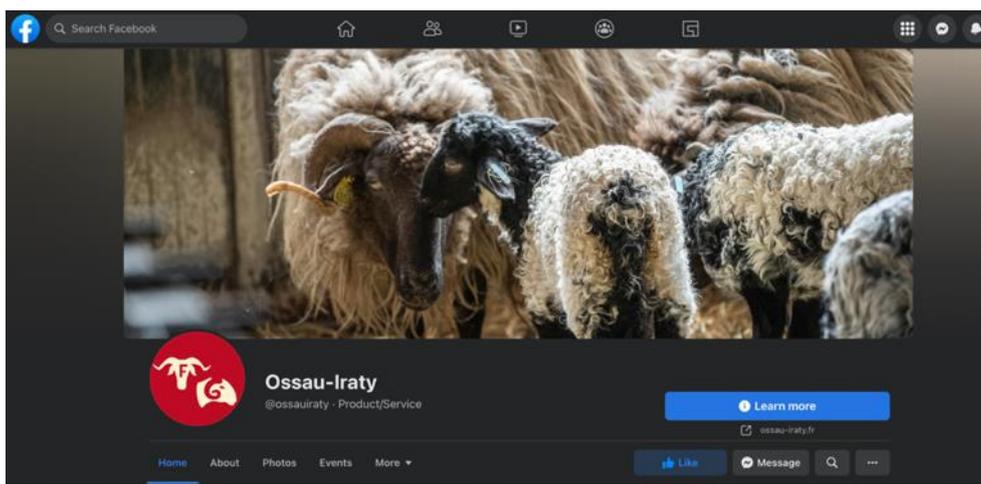


▷ The social networks of the "Ossau-Iraty" PDO

The "Ossau-Iraty" PDO is present on a large number of social networks, such as:

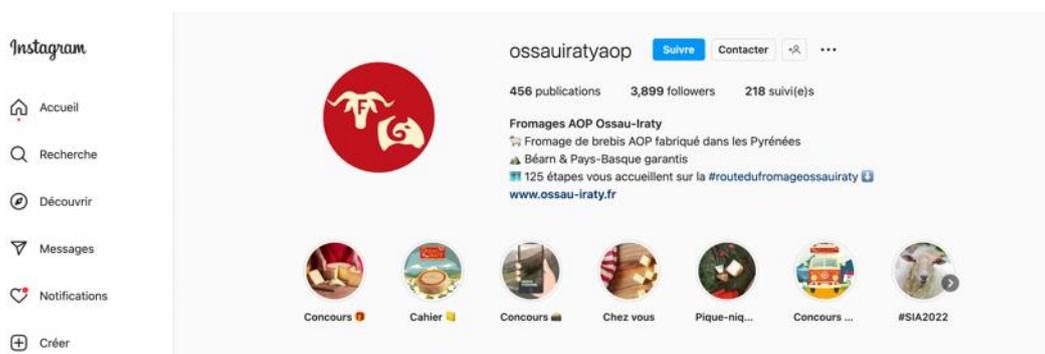
- ▷ "Facebook", with the "[@ossauiraty](#)" page, which has almost 32,000 followers;

FIG. 51: "Ossau-Iraty" PDO Facebook page



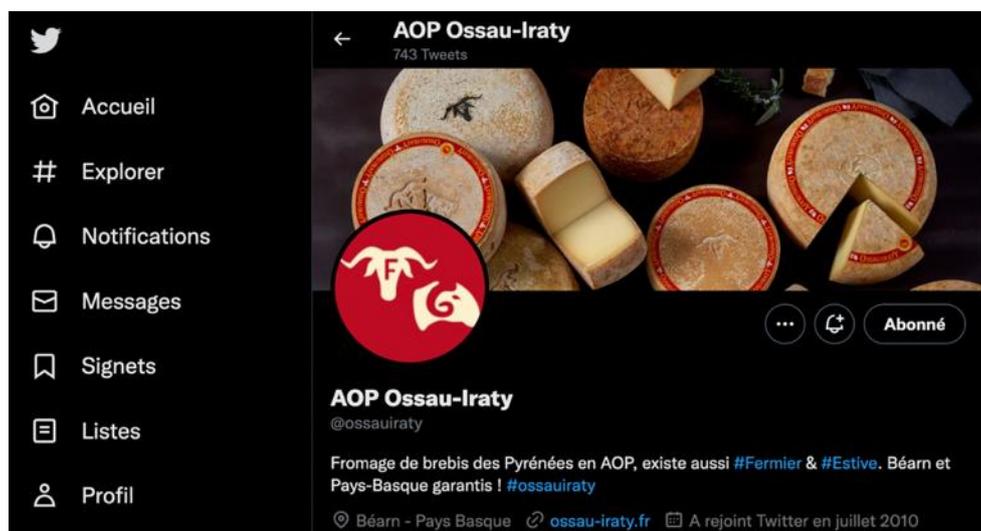
▷ "Instagram", with the page "[@ossairatyaoop](#)" which has almost 4000 followers;

FIG. 52: "Ossau-Iraty" PDO Instagram page



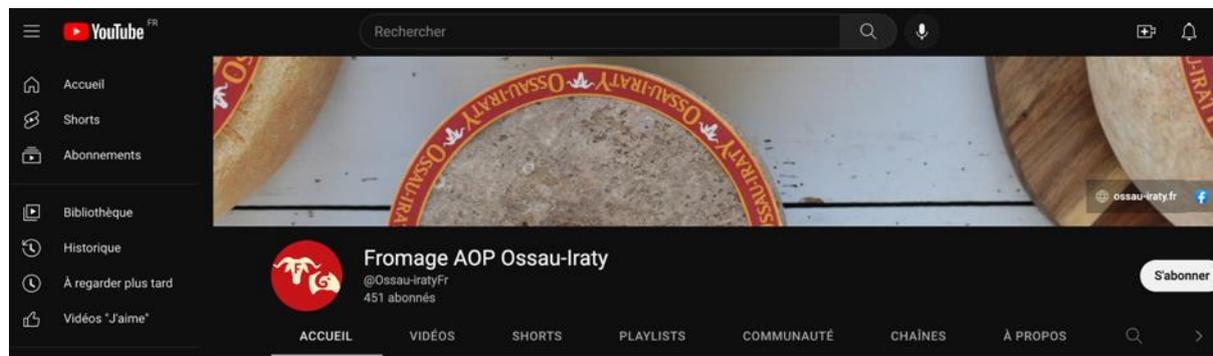
▷ "Twitter", with the page "[@ossairaty](#)" which has almost 700 followers;

FIG. 53: "Ossau-Iraty" PDO Twitter page



▷ "YouTube", with the page "[@ossau-iratyfr](#)" which has almost 500 followers.

FIG. 54: "Ossau-Iraty" PDO YouTube page



Once again, these networks all have in common the **use of the exact name of the GI** in the names assigned to the pages and the **use of the group's logo in the profile picture**, which makes it possible to promote a strong visual identity and leave a mark on the consumer's mind.



#### IV. Concrete examples of implementation

The extent of the efforts that GI producer groups must make at the national and international levels is clear from a quick study of some domain name decisions in France, Spain, Portugal, and before WIPO.

##### A. General state of case law on GIs and the Internet

The case law on geographical indications and the Internet remains **sparse to date**, due to the very recent emergence of the Internet.

As for the case law itself, it can be divided into two categories:

1. Litigious use of a GI on the Internet;
2. Conflicts between GIs and domain names.

Regarding the first category, **case law does not present any particularities of its own** compared to the traditional case law on the infringement of geographical indications. It always concerns the unauthorised use of a sign, whether this takes place on a physical medium or on the Internet.

It is therefore more appropriate to focus on the second category: domain name and GI disputes.

A large part of the litigation concerns above all the geographical indications considered as "prestigious" or well-known, and more particularly the name "Champagne".

This does not mean that other geographical indications are not infringed, but simply that there is a lack of action by their representatives. Indeed, as will be shown in later developments, domain name actions can lead to **uncertain results**. It may therefore sometimes be more appropriate to monitor disputed advertisements and take action to have them removed.

In this sense, the great peculiarity of domain names is that the UDRP procedure is only open to a claimant who **can demonstrate that he or she has rights in a trademark**. GIs are therefore not covered by the UDRP procedure unless a link can be established with a registered trademark.



**If a domain name infringes a geographical indication**, it could be revoked or transferred to the complainant in the UDRP proceeding, **provided that an earlier trademark containing the geographical indication has been duly registered** by the complainant.

## B. Examples of applicable case law

### 1. Before national courts

Before national courts and administrations, a GI may, in certain cases, constitute **prior art that can be used** against a domain name. In such cases, decisions often refer to the infringement of the reputation inherent in the geographical indication.

#### ► **Case "champ-pagne.com"**, TGI of Paris, Judgement of 7 September 2001, France

In 2000, the group of producers of the PDO "Champagne" - or "Comité Interprofessionnel du Vin de Champagne" (CIVC) - filed a complaint against the company "Saber Entreprises Incorporated" for the possession and fraudulent use of the domain name "champ-pagne.com" and for the marketing, by this means, of a spring water for pets under the name of "Champ-pagne".

The CIVC then argued that the use of the said domain name represented a violation of the PDO "Champagne": the doubling of the letter "P" and the division of the term did not alter the phonetics of the appellation and the misappropriation of the notoriety acquired by the wine of Champagne was unequivocal given the slogans accompanying the marketing of the water, such as "*Your best friend deserves the best in life [...]*"<sup>105</sup> (LEGALIS, n.d.) [47]

The court ruled in favour of the CIVC, stating that the use of the domain name 'champ-pagne.com' was misleading and likely to damage the image of the PDO 'Champagne'.

The owner of the domain name was ordered to cease all use of the domain name "champ-pagne.com" and to pay damages to the CIVC. The court also ordered the transfer of the domain name to the CIVC.

To find out more, [go here](#).

#### ► **Case "prosciuttodiparma.fr"**, SYRELI procedure of AFNIC, Decision of 29 November 2018 (request n°FR-2018-01699), France

In 2018, the "Prosciutto di Parma" PDO producers' group - or "Consorzio del Prosciutto di Parma" - applied for the transfer of the domain name "prosciuttodiparma.fr", which had been registered by a third party, via the SYRELI procedure of AFNIC.

The group then claimed that the use of the said domain name represented an infringement of the PDO 'Prosciutto di Parma' and that it created confusion among consumers as to the origin of the product. The disputed domain name gave access to a "parking" page<sup>106</sup> including sponsored links whose names

<sup>105</sup> Quote translated from French

<sup>106</sup> A "parking" page is a web page that exclusively hosts sponsored links that are generally not correlated to the thematic content of the page.

explicitly referred to the group's activity, such as "FOOD PROSCIUTTO", "DOP PROSCIUTTO", etc. (AFNIC, 2018) [48].

In support of its claim, the group asserted the European trademark "PROSCIUTTO DI PARMA" No 001116458, the domain names "prosciuttodiparma.com" and "prosciuttodiparma.it" and the PDO "Prosciutto di Parma".

AFNIC ruled in favour of the group, stating that the use of the domain name "prosciuttodiparma.fr" was misleading and likely to undermine the PDO.

AFNIC ordered the transfer of the domain name "prosciuttodiparma.fr" to the Consorzio del Prosciutto di Parma, considering that the registrant's objective was to take advantage of the notoriety of the opposing rights.

To find out more, [go here](#).

► **Case "Chuletón de Ávila", Regional Court of Burgos, Judgement of 28 March 2018 (decision no. 106/2018), Spain**

In 2018, the group of producers of the PGI "Carne de Ávila" - or "Consejo regulador de la IGP Carne de Ávila" - filed a lawsuit for trademark nullity and unfair competition against the companies "Gabinete de Estudios Ambientales Agronómicos Ingenieros S.L" and "Asociación Abulense de Empresarios de Hostelería" for the fraudulent use of the trademark "Chuletón de Ávila C.R." and the domain names "chuletondeavila.es" and "chuletondeavila.com.es" to market their own beef.

The group then argued that the use of this trademark and these domain names constituted an infringement of the PGI 'Carne de Ávila'.

The Court of First Instance found in favour of the group, pointing out that the trademark "Chuletón de Ávila" and the associated domain names constituted a commercial use of the geographical term "Ávila" protected by the PGI "Carne de Ávila", thus taking advantage of the reputation enjoyed by the PGI and risking creating confusion in the minds of consumers and damaging the image of the PGI (WIPO, n.d.) [49].

Thus, on the basis of the European Regulation on Geographical Indications (EU Regulation 1151/2012), the Trademark Law and the Unfair Competition Law, the Court declared the trademark "Chuletón de Ávila" invalid and the domain names "chuletondeavila.es" and "chuletondeavila.com.es" cancelled. The appeal confirmed the judgments of the court of first instance.

To find out more, [go here](#).



If a domain name incorporates a trademark that is considered to infringe a GI, the domain name is subject to cancellation.

The use of an infringing trademark can also be considered as an act of unfair competition on the market. Therefore, the use of a trademark as a domain name may constitute, de facto, an act of unfair competition.

Therefore, it is essential to **take legal action** not only **against the owner of the trademark**, but also **against the owner of the domain name**, which may otherwise be two separate entities:

- The legal action could be declared inadmissible due to a lack of legitimacy or standing to act, or;
- In the event of a favourable decision, this may be ineffective against the owner of the domain name who has not been taken to court.

► **Case "colares.pt", ARBITRARE, Judgment of 24 July 2012 (decision no. 129), Portugal**

The term "Colares" has several meanings: it can refer to necklaces, to a parish in Sintra and to a wine region from which the "Colares" PDO wine comes.

In 2012, an application was made by a third party to register the domain name "colares.pt", but this application was rejected by the Portuguese domain name registry on the grounds that the name "Colares" corresponded to a protected designation of wine origin in Portugal. The complainant appealed on the basis of a narrow interpretation of this ground for rejection.

The case was brought before ARBITRARE, the Portuguese arbitration body specialising in the resolution of domain name disputes on the Internet. The complainant argued that only unambiguous geographical names should be excluded from domain name registration, while words with multiple meanings should be accepted.

This reasoning was rejected by ARBITRARE, which considered that the name "Colares" had an explicit geographical meaning. ARBITRARE therefore opposed the registration of the domain name (ARBITRARE, 2012) [50].

To find out more, [go here](#).



In principle, this reasoning in favour of the geographical indication could not have succeeded before WIPO, unless the producer group of the GI concerned could **invoke a trademark right**.

2. Before the WIPO Arbitration and Mediation Center

► **Case "champagnes.fr", WIPO Arbitration and Mediation Center, Judgment of 4 July 2005 (decision n°DFR2005-0006)**

In 2004, the group of producers of the PDO "Champagne" - or "Comité Interprofessionnel du Vin de Champagne" (CIVC) - filed a complaint with WIPO against the company "Internet SARL" for the registration of the domain name "champagnes.fr".

The company "Internet SARL", whose activities are based on the design and publication of websites, registered the disputed domain name in December 2004 with the aim of creating an Internet platform for the presentation and distribution of champagne. The domain name was not yet in use at that time.

The CIVC then argued that the use of the said domain name violated the intellectual property rights of the PDO "Champagne" and requested the transfer of the domain name to it.

The company "Internet SARL" defended itself by explaining that it does not intend to use the domain name "champagnes.fr" to designate products not covered by the PDO "Champagne" and that the mere registration of the domain name could not constitute an infringement of the PDO.

However, the evidence provided by the company to prove its good faith was not considered sufficiently convincing by WIPO to demonstrate a serious intention to use the domain name to promote all Champagne wines (WIPO Arbitration and Mediation Center, 2005) [51].

WIPO thus ruled in favour of the CIVC and ordered the immediate transfer of the domain name, due to the infringement of the eponymous GI on the basis of French law applicable to the ".fr" domain.

To find out more, [go here](#).



This case illustrates that, even before WIPO, a geographical indication can, in some cases, be an **evidential means of demonstrating prior art**.

► **Case "gorgonzola.best"**, WIPO Arbitration and Mediation Center, Judgment of 31 January 2020 (Decision No. D2019-2848)

In 2019, the "Gorgonzola" PDO producers' group - or "Consorzio per la Tutela del Formaggio Gorgonzola DOP" - filed a complaint with WIPO against the holder of the domain name "gorgonzola.best".

The group then argued that the use of the name 'Gorgonzola' in the domain name 'gorgonzola.best' was misleading for consumers and infringed its trademarks and PDO.

The group is, in fact, the owner of two European Union trademarks "GORGONZONLA" (cf. figure n°55).

FIG. 55 EU trademark 010595015 of the group



Article 4(a) of the UDRP Regulation sets out the three conditions that a complainant must cumulatively meet in order to obtain the transfer of a disputed domain name belonging to a third party: the complainant must show that the disputed domain name is identical or similar to its trademark, that the domain name has been registered and used by the registrant without right or legitimate interest and in bad faith.

The requirement of similarity between the trademarks and the domain name is accepted without difficulty by the expert.

With regard to the legitimate interest requirement, the expert considers it likely, in view of *"the popularity of the GORGONZOLA trademark and of the Italian cheese by the same name"* (WIPO Mediation and Arbitration Center, 2020) [52], that the registrant of the disputed domain name has attempted to capitalise on the reputation of the name.

WIPO eventually ordered the transfer of the domain name "gorgonzola.best" to the Consorzio per la tutela del formaggio Gorgonzola (WIPO Mediation and Arbitration Center, 2020) [52].

To find out more, [go here](#).



It is interesting to note that it is the geographical indication, **under cover of the registered trademarks**, that has made the transfer of the domain name possible.

This decision is encouraging for GI beneficiaries and should encourage them to **register their GI name as a collective trademark**.

► **Case "champagne.co"**, WIPO Arbitration and Mediation Center, Judgment of 21 June 2011 (Decision No. DCO2011-0026)

In 2011, the group of producers of the PDO "Champagne" - or "Comité Interprofessionnel du Vin de Champagne" (CIVC) - filed a complaint with WIPO against the company "Steven Vickers" for the registration of the domain name "champagne.co".

The WIPO Arbitration Centre refuses to grant protection to the name "Champagne" because it is a protected appellation of origin and not a trademark with distinctive character.

The domain name "champagne.co" is therefore not covered by the protection of geographical indications and could be freely registered, transferred or sold.

This decision differs from the previous one, which shows that the competences of the arbitration body vary depending on the domain name extension.

Thus, for domain names with the ".fr" extension, the PDO "Champagne" may be protected, as the arbitrator must take into consideration the risk of confusion, or even parasitism, that could result from a domain name registration by buyers other than the representatives of the producers concerned. In contrast, in disputes decided under the UDRP procedure, geographical indications are not protected as such.

In reaching his conclusion, the arbitrator emphasised that the name "Champagne" does not constitute a trademark but merely enjoys the protection granted by French and EU law.

He even pointed out that the term cannot constitute a "common law trademark", which is protected not on the basis of administrative registration but by its repetitive use (WIPO Arbitration and Mediation Center, 2011) [53].

This reveals the fragmentation of the international legal order. The variable geometry protection granted in the WIPO framework for domain names is indicative of the inherent problems of international intellectual property law.

So much so that the arbitrator minimised the most important element of the CIVC's argumentation, namely the bad faith of the respondent who did not contest the allegation that his objective was simply to resell the disputed domain name. Moreover, given that the domain name in question was the Colombian extension ".co", which is similar to the popular extensions ".com" and ".co.uk", there is no doubt that the respondent was engaged in *cybersquatting* in this case.

It is unfortunate that the WIPO Arbitration and Mediation Center is supporting and encouraging this unregulated purchase of domain names.

In any case, the CIVC's mostly successful strategy of enforcing the guaranteed protection for geographical indications against trademarks has backfired on the protection of "Champagne" when the judge rules about domain names.

To find out more, [go here](#).



This case highlights the importance for GI advocates to **carefully choose the applicable law and jurisdiction** most likely to defend their case.

## V. The Internet issue in the EU GI reform

On March 30, 2022, the European Commission (EC) published a [proposal for a Regulation of the European Parliament and of the Council on European Union geographical indications](#) for wine, spirit drinks and agricultural products, and quality schemes for agricultural products.

The two main objectives of this proposed regulation are, on the one hand, to ensure effective protection of IPR (Intellectual Property Rights) in the EU, including the **reduction of new forms of infringements on the Internet**, in order to reward producers fairly for their efforts and, on the other hand, to increase the use of GIs throughout the EU for the benefit of rural economy.

This new regulation aims to create a unitary EU GI system, harmonising the provisions for agricultural products and foodstuffs, wines and spirits, which have so far been covered by four regulations (Regulation (EU) [No 1151/2012](#); Regulation (EU) [No 1308/2013](#); Regulation (EU) [No 2017/1001](#) and

Regulation (EU) [No 2019/787](#)). A single set of procedural rules for all sectors should ensure consistency and make the GI system more understandable.

In addition, in order to reduce the administrative burden, the EC proposes to rely on the technical assistance of the European Union Intellectual Property Office ([EUIPO](#)) for the examination of [applications for registration](#), amendment of specifications, opposition procedures and monitoring of infringements on the Internet. The EC will be able to entrust these tasks to the EUIPO by means of delegated acts.

The new Regulation therefore aims, among other goals, **to strengthen the protection of GIs on the Internet**, in particular with regard to sales via online platforms and protection against bad faith registration and use of GIs in the domain name system: “[...] *This concerns mainly: - How best to give effect to the fundamental right of producers for the IPR in their GIs to be protected. Producers holding the intangible asset of a GI have a right to have it protected and the Union seeks to do that as efficiently and effectively as possible, also in time of increased use of the internet; - How to prevent bad faith exploitation of product names by operators who have no rights or association with the authentic product. Enforcement, notably on the internet, and verification of compliance also need to be reviewed; [...]*” (European Commission, 2022) [54].

The proposal also aims to **give more powers and responsibilities to producer groups**, improve controls to ensure the authenticity of GIs and close legislative gaps (European Commission, 2022) [54].

To achieve the two main objectives mentioned above, one of the six sub-objectives of the EC proposal is to “[...] *improve the enforcement of GI rules to better protect IPR and better protect GIs on the internet, including against bad faith registrations and fraudulent and deceptive practices, and uses in the domain name system, and combat counterfeiting; [...]*” (European Commission, 2022) [54].

Three options were presented in the impact assessment report prepared by the EC and EUIPO services, the first option is to improve the instruments already in place and provide additional support to producers, Member State authorities and other stakeholders, **the second option aims to strengthen GI protection and improve the conditions of competition between operators** through a single set of control procedures for all sectors and the development of detailed rules on GI compliance with regard to internet sales, and finally, the third option aims to ensure full harmonisation through the creation of a single regulation containing unified rules on control and enforcement (European Commission, 2022) [54].

The second option seems to be the most relevant for the protection of GIs on the Internet, and this is also reflected in the conclusions of the EC and EUIPO impact assessment.

The recitals of the EC legislative proposal concerning the protection of GIs on the Internet are the following:

- ▷ “(18) Protection should be granted to names entered in the Union register of geographical indications with the aim of ensuring that they are used fairly and in order to **prevent practices liable to mislead consumers**. In order to strengthen the protection of geographical indications and to combat counterfeiting more effectively, the protection of designations of origin and geographical indications **should also apply to domain names on the internet**.” (European Commission, 2022) [54].
- ▷ “(25) The relationship between internet domain names and protection of geographical indications should be clarified as regards the scope of the application of the remedy measures, the recognition of geographical indications in dispute resolution, and the fair use of domain names. Persons having a legitimate interest on a geographical indication applied for registration before the registration of the domain name **should be empowered to request for the revocation or the transfer of the domain name in case of conflict**.” (European Commission, 2022) [54].
- ▷ “(56) In order to supplement or amend certain non-essential elements of this Regulation, the power to adopt acts in accordance with Article 290 of the Treaty on the Functioning of the European Union should be delegated to the Commission in respect of [...] entrusting the EUIPO

with the tasks related to [...] [the] establishment and **management of an alert system** informing applicants about the availability of their geographical indication as a domain name [...]" (European Commission, 2022) [54].

Finally, the articles relating to the protection of GIs on the Internet are the following:

- ▷ **Article 27:** Protection of Geographical Indications, which sets out inter alia the framework for the protection of geographical indications on the Internet:

*"1. Geographical indications entered in the Union register of geographical indications shall be protected against:*

*[...] (c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product that is used on the inner or outer packaging, advertising material, documents or information provided on websites relating to the product concerned, and the packing of the product in a container liable to convey a false impression as to its origin; [...]" (European Commission, 2022) [54].*

- ▷ **Article 32:** Producer groups, which defines the responsibilities of producer groups:

*"[...] 2. A producer group may exercise in particular the following powers and responsibilities:*

*[...] (e) combat counterfeiting and suspected fraudulent uses on the internal market of a geographical indication designating products that are not in compliance with the product specification, by monitoring the use of the geographical indication across the internal market and on third countries markets where the geographical indications are protected, including on the internet, and, as necessary, inform enforcement authorities using confidential systems available." (European Commission, 2022) [54].*

- ▷ **Article 33:** Recognised producer groups, which completes the list of responsibilities of producer groups defined in Article 32:

*"[...] 3. In addition to the powers and responsibilities referred to in Article 32(2), a recognised producer group may exercise the following powers and responsibilities:*

*[...] (d) with a view to protecting the geographical indication in the internet domain name systems outside the jurisdiction of the Union, to register an individual, collective or certification trade mark depending on the trade mark system concerned, containing, as one of its prominent elements, a geographical indication and restricted to product conforming to the corresponding product specification. [...]" (European Commission, 2022) [54].*

- ▷ **In particular, Article 34:** Protection of geographical indication rights in domain names:

*"1. Country-code top-level domain name registries established in the Union may, upon the request of a natural or legal person having a legitimate interest or rights, revoke or transfer a domain name registered under such country-code top-level domain to the recognised producer group of the products with the geographical indication concerned, following an appropriate alternative dispute resolution procedure or judicial procedure, if such domain name has been registered by its holder without rights or legitimate interest in the geographical indication or if it has been registered or is being used in bad faith and its use contravenes Article 27.*

*2. Country-code top-level domain name registries established in the Union shall ensure that any alternative dispute resolution procedure established to solve disputes relating to the registration of domain names referred to in paragraph (1), shall recognise geographical indications as rights that may prevent a domain name from being registered or used in bad faith.*

*3. The Commission shall be empowered to adopt delegated acts in accordance with Article 84 supplementing this Regulation by provisions entrusting EUIPO to establish and manage a domain name information and alert system that would provide the applicant, upon the submission of an application for a geographical indication, with information about the availability of the geographical indication as a domain name and, on optional basis, the registration of a domain name identical to their geographical indication. That delegated act shall also include the obligation for registries of country-code top-level*

*domain names, established in the Union, to provide EUIPO with the relevant information and data.”* (European Commission, 2022) [54].

The **protection of GIs on the Internet** is therefore a **central issue in the legislative reform of GIs**, and AREPO will update this guide as soon as more information is available and the proposed regulation is consolidated and adopted by the European Union.

## Annexes

### **Annex 1:** Survey on the needs of EU producer groups and agri-food cooperatives for the promotion and protection of GIs on the Internet

In order to identify more precisely the issues and needs of the organisations concerned by this guide, AREPO collected information from producer groups and agri-food cooperatives in the EU by means of a survey drawn up for this purpose, the details of which are given below, and the results of part 2 "Questionnaire on the protection of GIs on the Internet" of which can be found in annex 2.

The survey, initiated at the beginning of 2022, is still ongoing and has not collected all the expected responses. We therefore invite any organisation that has not yet participated to contribute to the survey in order to allow us to deepen our data.

AREPO, which is in charge of supervising this survey, undertakes to regularly update this guide if the member regions find it useful and to add the latest regulations on the protection of geographical indications on the Internet.

The survey presented below corresponds to the "paper" version which you can obtain in Word format by contacting Anne CLERMONTTELLE at the following e-mail address: [eu-projects@arepoquality.eu](mailto:eu-projects@arepoquality.eu). You can also complete the survey online [at the following link](#). The paper or online survey is available in 5 languages: English, French, Spanish, Portuguese and Italian.

The evaluation of the survey results on the protection of GIs on the Internet is based on the analysis of the data collected until 10 November 2022.



## SURVEY FOR GI PRODUCER CONSORTIA AND AGRI-FOOD COOPERATIVES FROM EU

Analysis of the needs of agri-food chains in terms of promotion and protection on the Internet of products that benefit from European quality schemes

### Introduction

AGROSMARTglobal is an Interreg Sudoe project that has identified the need to **promote and protect on the Internet agricultural and agri-food products that benefit from European quality schemes**. Official EU quality schemes, which cover 1. Geographical Indications (GIs) with more particularly Protected Denominations of Origin (PDOs) and Protected Geographical Indications (PGIs), 2. Traditional Specialties Guaranteed (TSGs) and 3. The EU Organic Label, are an important part of exports for the European countries.

For this reason, **AREPO**, in collaboration with **UTAD**, **IrRADIARE**, and competent experts in the field of intellectual property, has taken on the task of **drawing up a “best practice” guide** for GI producer consortia, producer associations and agri-food cooperatives which would aim to:

1. Improve their knowledge of **how to promote their products that benefit from EU quality schemes on the Internet**, to take better advantage of their added value in international digital marketplaces;
2. Provide them with operational tools **to protect their PDOs and PGIs on the Internet**. There is indeed no strong protection for GIs to date with regard to the allocation of domain names. Their protection is now threatened by the new approach proposed by ICANN (Internet Corporation for Assigned Names and Numbers). The fight against Internet fraud is essential to protect the rights of producers and consumers.

In order to develop the most relevant guide possible, we need to know more about your needs in both these areas, so we kindly ask you to help us by completing the following survey.

### Organisation information [Your contact details will be used for internal purposes only and will not be made public]

**Organisation name:** .....

**Localisation (country and Region):** .....

**Your role:** .....

**Type**

GI producer consortium  Agri-food cooperative

Producer association  Agri-food SME

Other:

**Size**

Micro (1 to 9 employees)  Small (10 to 49 employees)

Medium (50 to 500 employees)  Large (500 or more employees)



Survey developed in the framework of the AGROSMARTglobal project cofinanced by the Interreg Sudoe Programme

AREPO, UTAD, IrRADIARE, 2022

The survey is divided into two parts, one part with questions related to the promotion of your products that benefit from EU quality schemes on the Internet and one part with questions related to the protection of your GIs on the Internet. If you do not know how to answer one of the questions or do not wish to answer it, please move on to the next one.

If you work with more than one product that benefit from EU quality schemes, please complete the survey for all of them.

**What kind of products under EU quality schemes do you work with?**

Name: ..... Product category: .....  PDO  PGI  TSG  Organic

Name: ..... Product category: .....  PDO  PGI  TSG  Organic

Name: ..... Product category: .....  PDO  PGI  TSG  Organic

Name: ..... Product category: .....  PDO  PGI  TSG  Organic

Name: ..... Product category: .....  PDO  PGI  TSG  Organic

Name: ..... Product category: .....  PDO  PGI  TSG  Organic

Name: ..... Product category: .....  PDO  PGI  TSG  Organic

Name: ..... Product category: .....  PDO  PGI  TSG  Organic

Name: ..... Product category: .....  PDO  PGI  TSG  Organic

Name: ..... Product category: .....  PDO  PGI  TSG  Organic

**Part 1 | Survey on the promotion of European quality schemes on the Internet**

**1. Do you consider the recognition of your products as EU quality schemes as an added value for your entity?**

Yes  No

If yes,

Do you consider it beneficial to promote your products under EU quality schemes on the Internet?

Yes  No

If yes, please explain why:.....  
 .....  
 .....  
 .....

AREPO, UTAD, IrRADIARE, 2022

Do you consider the GI quality schemes to be a powerful digital marketing tool? *[If any]*

Yes  No

If yes, please explain why:.....  
.....  
.....  
.....

Do you consider the TSG quality scheme to be a powerful digital marketing tool? *[If any]*

Yes  No

If yes, please explain why:.....  
.....  
.....  
.....

Do you consider the EU Organic Label quality scheme to be a powerful digital marketing tool? *[If any]*

Yes  No

If yes, please explain why:.....  
.....  
.....  
.....

**2. Does your entity have a marketing strategy to promote your products under EU quality schemes on the Internet?** *[E.g. website, social networks, e-commerce, etc.]*

Yes  No

If yes,

What are the mains features of your strategy and which tools are used? *[E.g. objectives, channels used, target audience, etc. Please add links if available]*.....

.....  
.....  
.....

Do you consider the promotion of your products under EU quality schemes on the Internet to be sufficient and appropriate?

Yes  No

If no, what should be improved and how in your opinion? *[E.g. staff, training, funding, consultancy, etc.]*....

.....  
.....  
.....

**3. Which digital marketing tools do you think are the most important to promote your products under EU quality schemes?**

Please rate from 1 (not important) to 5 (most important). Not all need to be rated.

Digital marketing tools	1	2	3	4	5
Website					
E-commerce <i>[online sales platform such as Amazon, Alibaba, etc.]</i>					
Twitter					
LinkedIn					
Facebook					
Instagram					
YouTube					
Blog/Vlog					
Others					

If others, please indicate which ones: .....

**4. Do you consider that GIs have a wide presence on the digital sphere?**

- Yes                       No                       No opinion

**5. Do you consider that the GI quality scheme is sufficiently recognized by consumers online?**

- Yes                       No                       No opinion

If no, what should be done to fix this issue in your opinion? *[E.g. strengthen information actions on EU quality schemes and logos at EU institutions level, provide more funding for promotion, etc.]*.....  
 .....  
 .....  
 .....

6. Would you be interested in a practical guide listing the main strategies for promoting your products under EU quality schemes on the Internet?

Yes  No

If yes, what main information would you like to find? .....

.....

.....

.....

7. We would be very grateful if you would allow us to take screenshots of your communication tools to illustrate the future guide with good practices in terms of promotion. Do you agree? [E.g. screenshots of your website, social networks, and/or your products that we can find on the Internet. It will be used to illustrate the good practices only]

Yes  No

*If you agree, we can take care of it ourselves. Otherwise, you can send us what you agree to be shared, adding them as attachments when sending back the survey and giving us the right to use them for legal purposes and the copyright to be indicated.*

8. Would you be interested in participating in a European event to raise awareness about the promotion of your products under EU quality schemes on the Internet?

Yes  No

9. Any other comment:.....

.....

.....

.....

## Part 2 | Survey on the protection of GIs on the Internet

1. Is your GI registered as a domain name<sup>1</sup> in the DNS (Domain Name System)? [In case of a GI producer consortium]

Yes  No

If yes,

How many domain names have you registered? Could you please list them? .....

.....

.....

.....

Do you have an active website containing the domain name?

Yes  No

<sup>1</sup> Unique name displayed after the @ sign in e-mail addresses and after www. in web addresses

AREPO, UTAD, IrRADIARE, 2022

**2. Is your GI registered/covered as a trademark/collective trademark?** *[In case of a GI producer consortium]*

Yes  No

**If yes,**

In which territories? Could you please list them? .....

.....

.....

.....

**3. Would you say that your GI is sufficiently protected against fraud on the Internet?**

Yes  No  No opinion

**If no,**

Could you please explain why? .....

.....

.....

.....

What do you consider to be the main gaps in your organisation's legal protection? .....

.....

.....

.....

**4. Would you say that your organisation's knowledge in the matter of legal protection against Internet fraud is currently sufficient?**

Yes  No  No opinion

**If no,** what do you consider to be the main knowledge gaps in your organisation? .....

.....

.....

.....

**5. Does your organisation have regular monitoring of potential Internet fraud on your GI?** *[Such as frauds on the Internet market places, social networks, etc.]*

Yes  No

**If yes,** do you use a specific expertise to handle the monitoring? *[E.g. database, monitoring platform, lawyer, etc.]*

Yes  No

**If yes,** would you say it is effective? Do you consider its cost to be reasonable? Could you please give us its name? .....

.....

.....

AREPO, UTAD, IRADIARE, 2022

.....  
.....

If **no**, how do you organise yourself to carry out this monitoring? Have you employed specific staff to carry it out? Do you consider this internally organised monitoring to be sufficient?.....

.....  
.....  
.....

**6. Have you ever faced fraud from your GI on the Internet?**

**Yes**                       **No**

**If yes,**

What kind of fraud was it?

- GI's counterfeit                       Usurpation of the GI's denomination
- Misuse of the GI's reputation                       Misuse of the official EU GI logo
- Misuse of the entity's GI logo

Could you explain in detail what this fraud was about? *[If you have dealt with several cases of fraud, please give us details of your three most serious ones]*.....

.....  
.....  
.....

How did you solve this case? Did you use a lawyer or an expert to help you? Did the fraud authorities or customs get involved in solving this case? *[If you have dealt with several cases of fraud, please give us details of your three most serious ones]*.....

.....  
.....  
.....

Do you experience fraud on a regular basis?

**Yes**                       **No**

If **yes**, how regularly?.....

.....  
.....  
.....

AREPO, UTAD, IrRADIARE, 2022

**7. Do you find it easy to access information on the legal procedures to follow in case of a GI violation on the Internet?**

Yes

No

If no, what are the main challenges in your opinion? .....

.....

.....

.....

**8. Would you be interested in a practical guide listing the main actions to take in case of a GI violation on the Internet?**

Yes

No

If yes, what main information would you like to find? .....

.....

.....

.....

**9. Would you be interested in participating in a European event to raise awareness about the protection of GI products on the Internet?**

Yes

No

**10. Any other comment:**.....

.....

.....

.....

*“The European Commission support for the production of this publication does not constitute endorsement of the contents which reflects the views only of the authors, and the Commission cannot be held responsible for any use which may be made of the information contained therein”*

**Annex 2:** Evaluation method and survey results in Annex 1

The survey results presented below are based on data collection as of 10 November 2022. An update will be made regularly.

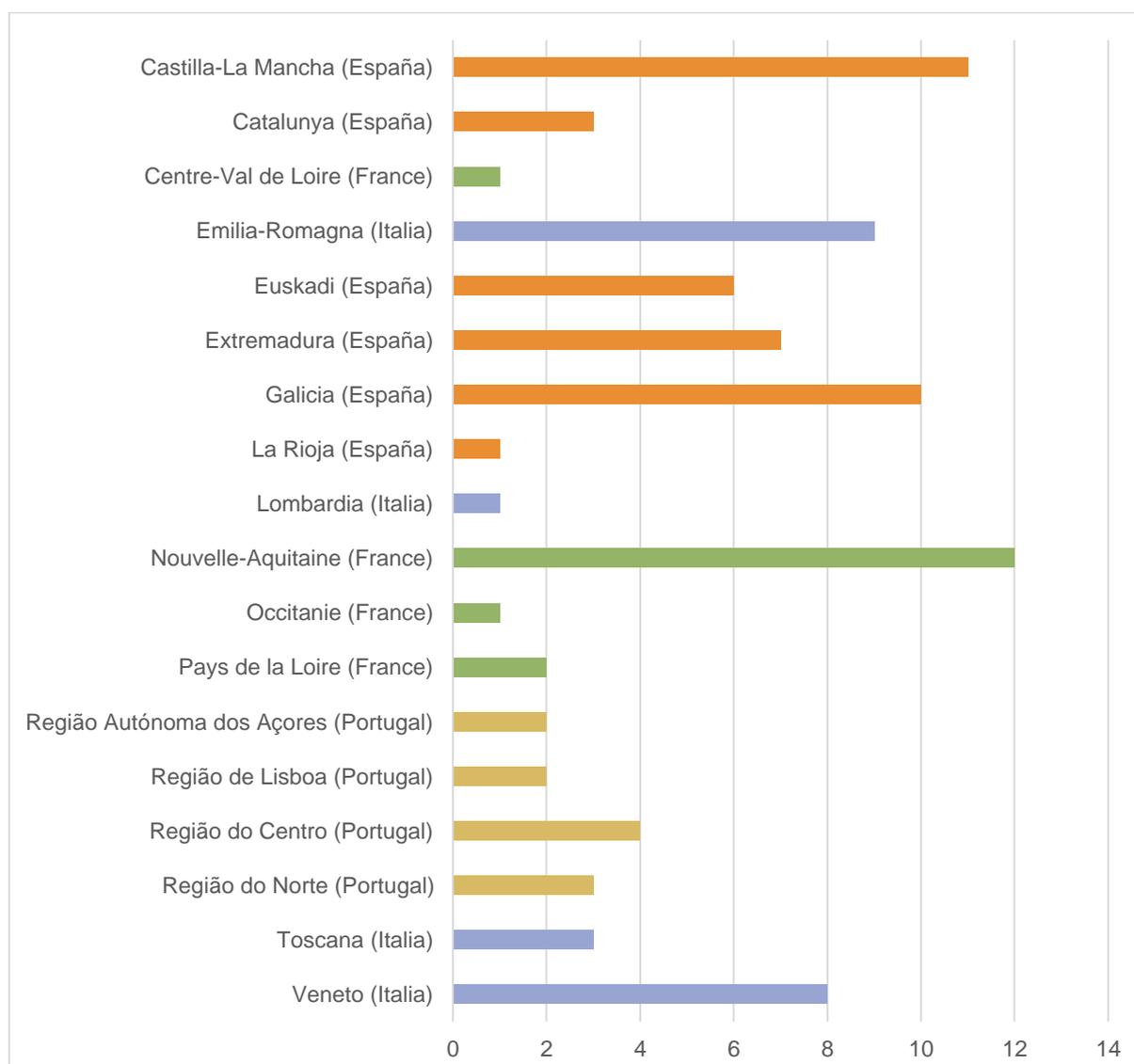
## Information on the participant panel

### 1. Geographical origin of the participant panel *[Open question]*

Of the 86 participating organisations in the panel, 38 are of Spanish origin, 21 of Italian origin, 16 of French origin and 11 of Portuguese origin.

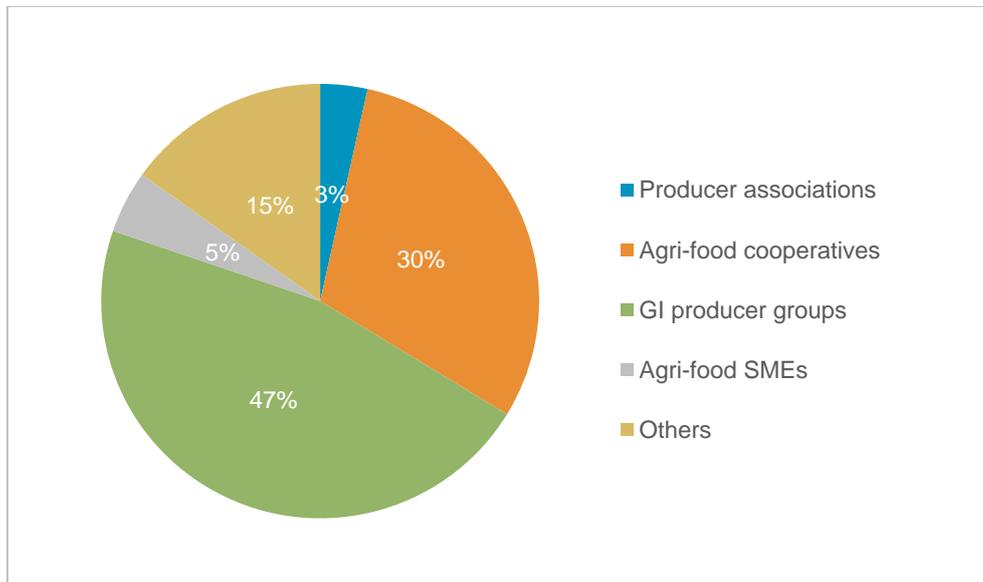
The regional distribution of the participating organisations in the panel is as follows:

**FIG. 56:** Survey results: Geographical origin of the participant panel (AREPO, 2022)



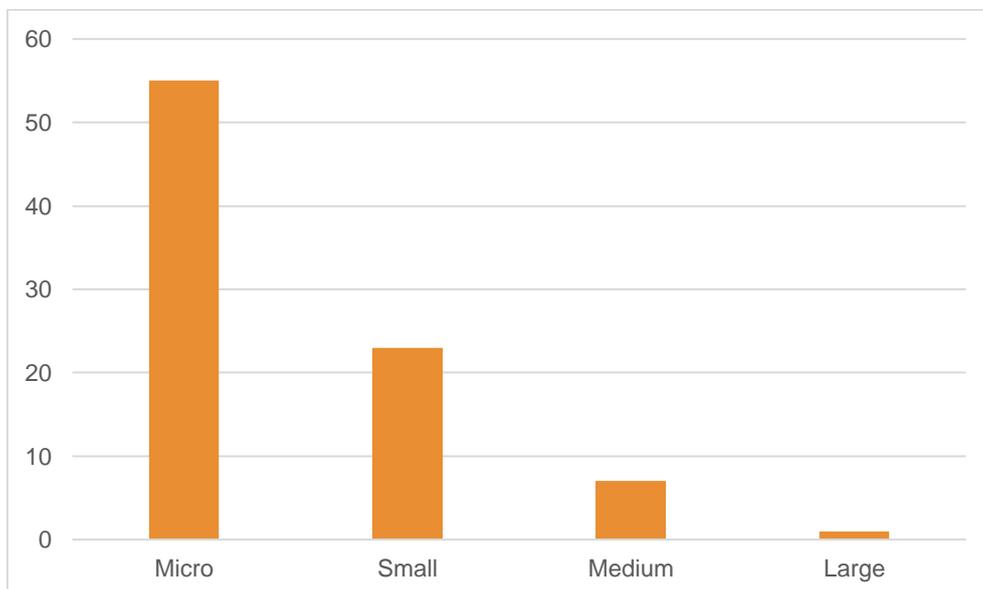
## 2. Type of organisations in the participant panel *[Closed question]*

**FIG. 57:** Survey results: Type of organisations in the participant panel (AREPO, 2022)



## 3. Size of organisations in the participant panel *[Closed question]*

**FIG. 58:** Survey results: Size of organisations in the participant panel (AREPO, 2022)



Micro (1-9 employees)

Small (10 to 49 employees)

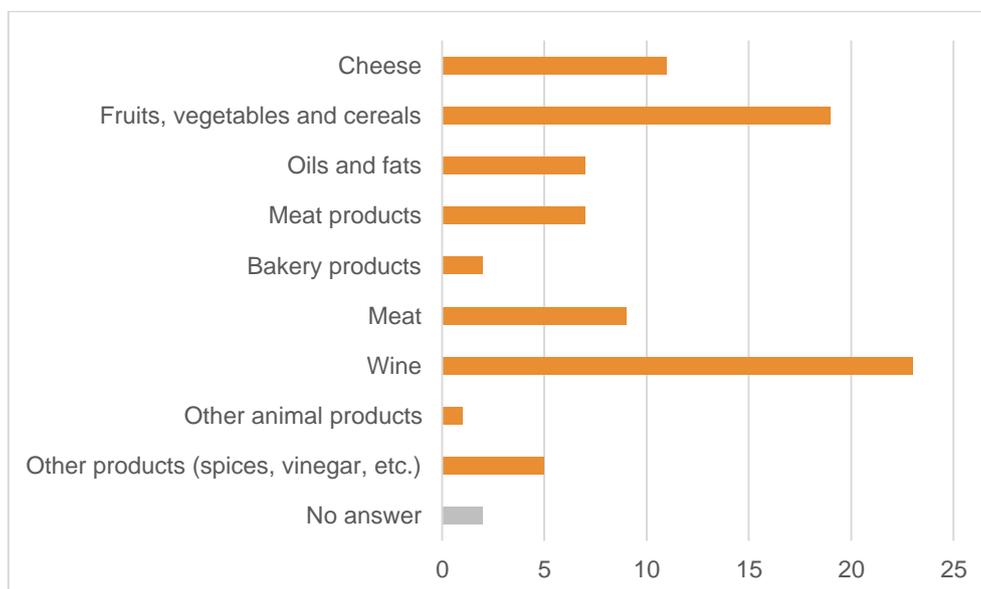
Medium (50-499 employees)

Large (500+ employees)

## Information on the products of the participant panel

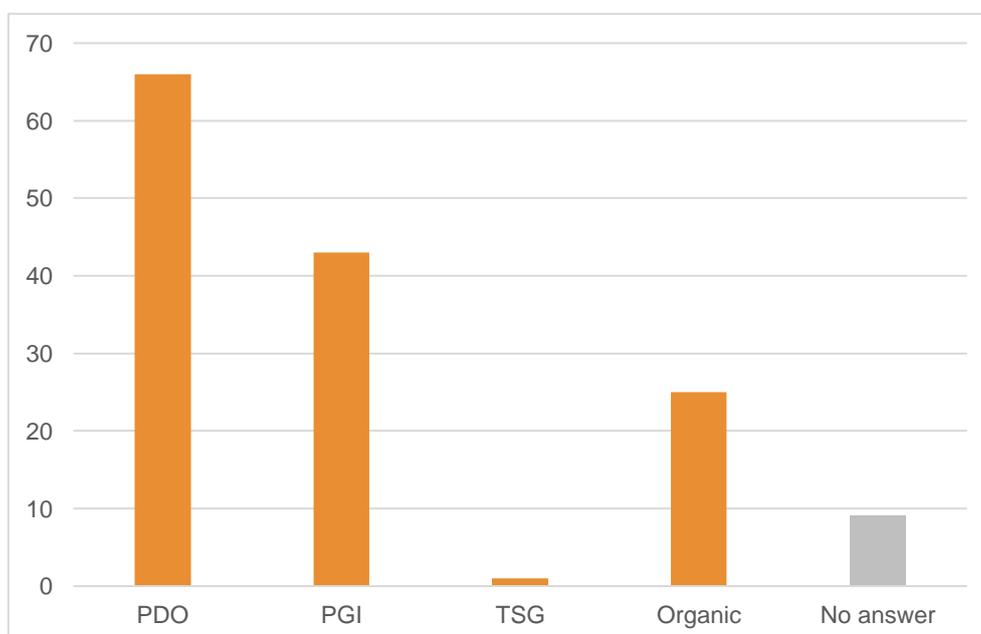
### 1. Product category of the participant panel *[Open question]*

FIG. 59: Survey results: Product category of the participant panel (AREPO, 2022)



### 2. Type(s) of product certification of the participant panel *[Closed multiple choice question]*

FIG. 60: Survey results: Type(s) of product certification of the participant panel<sup>107</sup> (AREPO, 2022)



<sup>107</sup> Some participants ticked off several certifications

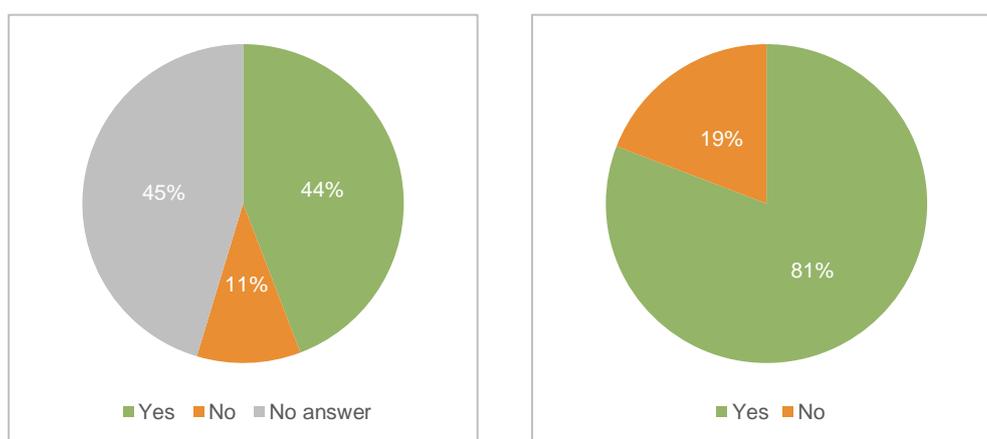
## Part 2 | Questionnaire on GI protection on the Internet

### 1. Is your GI registered as a domain name<sup>108</sup> in the DNS<sup>109</sup> (Domain Name System)? [Closed question]

Of the 86 participating organisations in the panel, the responses are as follows:

- ▷ Yes: 38
- ▷ No: 9
- ▷ No answer: 39

**FIG. 61:** Survey results: Is your GI registered as a domain name in the DNS? (AREPO, 2022)



#### 1.1. If so, how many domain names have you registered? Could you list them? [Open Question]

Of the 38 participating organisations in the panel that answered "yes" to question 1 (GI registered as a domain name in the DNS), 28 gave information on the top-level domain names they have registered, which is summarised below:

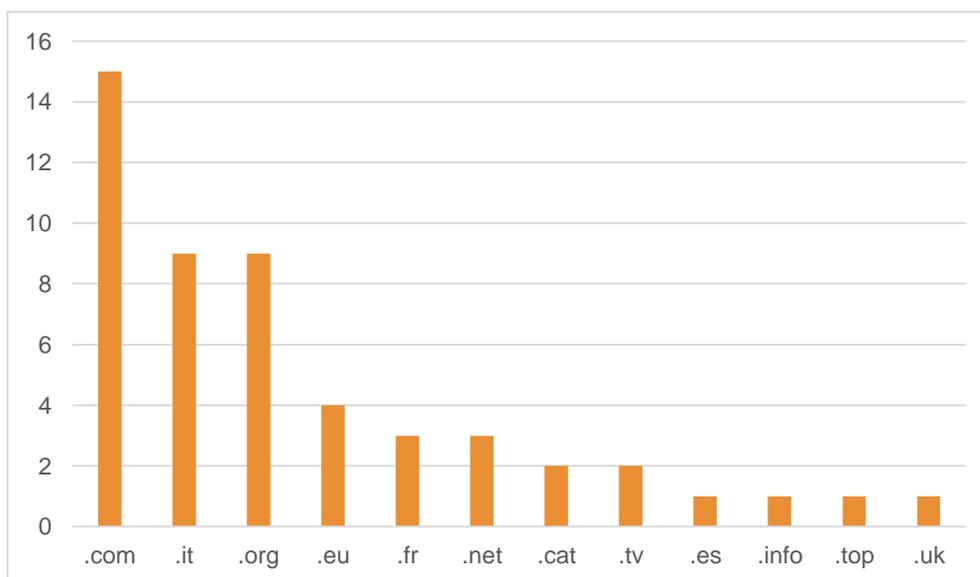
- ▷ 15 have registered their GI name with the generic top-level domain (gTLD): ".com";
- ▷ 13 have registered their GI name with the country code top-level domain (ccTLD) associated with the country of the GI: ".it", ".fr" and ".es";
- ▷ 9 have registered their GI name with the generic top-level domain (gTLD): ".org";
- ▷ 4 have registered their GI name with the EU code top-level domain (ccTLD): ".eu";
- ▷ 3 have registered their GI name with the generic top-level domain (gTLD): ".net";
- ▷ 2 have registered their GI name with the geographic top-level domain (geoTLD): ".cat";
- ▷ 2 have registered their GI name with the country code top-level domain (ccTLD): ".tv";
- ▷ 1 registered its GI name with the generic top-level domain (gTLD): ".info";
- ▷ 1 registered its GI name with the new generic top-level domain (New gTLD): ".top";
- ▷ 1 registered its GI name with the country code top-level domain (ccTLD): ".uk".

<sup>108</sup> Unique name displayed after the @ sign in e-mail addresses and after www. in web addresses

<sup>109</sup> Domain Name System

N.B.: It should be noted that most of the participating organisations were not able to list their domain names exhaustively due to lack of knowledge or because it would have been too long to list them (one of the participating organisations has 67 domain names registered for its GI alone). The above list therefore only includes the domain names mentioned during the survey and does not necessarily reflect reality.

FIG. 62: Survey results: Domain extensions registered by participating organisations (AREPO, 2022)



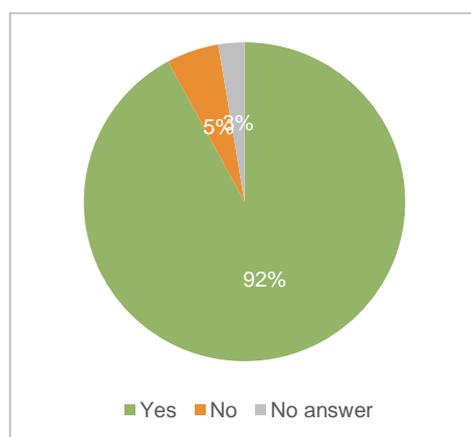
Of these 51 registered domain names:

- ▷ 32 were registered with the exact name of the GI, e.g.: "tartadesantiago.org" ("[Tarta de Santiago](#)"); "porcsdelasarthe.fr" ("[Porc de la Sarthe](#)"); "prosciuttodiparma.com" ("[Prosciutto di Parma](#)"); "pomadegirona.cat" ("[Poma de Girona](#)"), etc;
- ▷ 10 were registered with the name of the GI associated with the acronym of the label (PDO or PGI in the language of the associated country), e.g.: "dopoliterraalta.cat" ("[Oli de Terra Alta](#)" DOP); "cintasenesedop.it" ("[Cinta Senese](#)" DOP); "dovaldeorras.tv" ("[Valdeorras](#)" DO); "mortadelladipratoigp.it" ("[Mortadella di Prato](#)" IGP), etc.;
- ▷ 9 were registered with the name of the GI associated with the category of the GI (in the language of the associated country or in English), e.g.: "lamanchawines" ("[La Mancha](#)" wine); "formaggiopiave.it" ("[Piave](#)" cheese); "piavecheese.eu" ("[Piave](#)" cheese); "riojawine" ("[Rioja](#)" wine), etc.

#### 1.2. If yes, do you have an active website containing the domain name? [Closed question]

Of the 38 participating organisations in the panel that answered "yes" to question 1 (GI registered as a domain name in the DNS), the responses were as follows

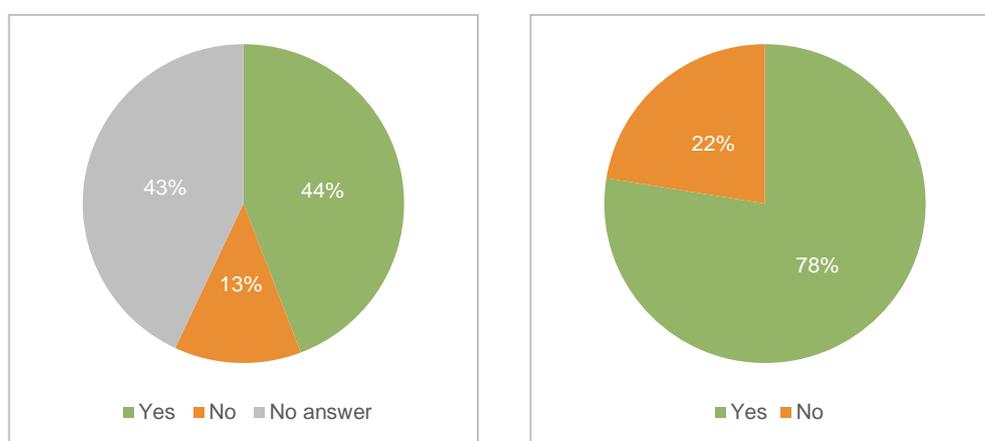
- ▷ Yes: 35
- ▷ No: 2
- ▷ No answer: 1

**FIG. 63:** Survey results: Do you have an active website containing the domain name? (AREPO, 2022)

## 2. Is your GI registered/covered as a trademark/collective trademark? [Closed question]

Of the 86 participating organisations in the panel, the responses are as follows:

- ▷ Yes: 38
- ▷ No: 11
- ▷ No answer: 37

**FIG. 64:** Survey results: Is your GI registered/covered as a trademark/collective trademark? (AREPO, 2022)

### 2.1. If so, in which territories? Could you list them? [Open question]

Of the 38 participating organisations in the panel that answered "yes" to question 2 (GI registered as a trademark/collective mark), 24 detailed the territories in which their GI is registered as a trademark/collective trademark, as follows:

**At the national level:** all 24 organisations that answered this question have registered their GI as a trademark/collective trademark in their own country, namely: Spain (10), Italy (9), France (3), Portugal (2)

**At the European level:** 18 organisations responding to this question have registered their GI as a trademark/collective trademark at the European Union level, of which 3 partially with a registration of their GI as a trademark in the following European countries: Germany (3); Benelux (3); Spain (3); France

(3); Portugal (3); Denmark (2); Greece (2); Ireland (2); Italy (2); Austria (1); Bulgaria (1); Croatia (1); Hungary; (1) Poland (1); Romania (1); Slovakia (1); Slovenia (1).

**At the international level:** 13 organisations responding to this question have registered their GI as a trademark/collective trademark at the international level. One of the participating organisations has registered almost 230 trademarks/collective trademarks to protect its GI in various countries around the world (not listed). Another of the participating organisations has registered its GI as a trademark/collective trademark in "most" third countries (not listed). The international countries listed in which the participating organisations have registered trademarks/collective trademarks are

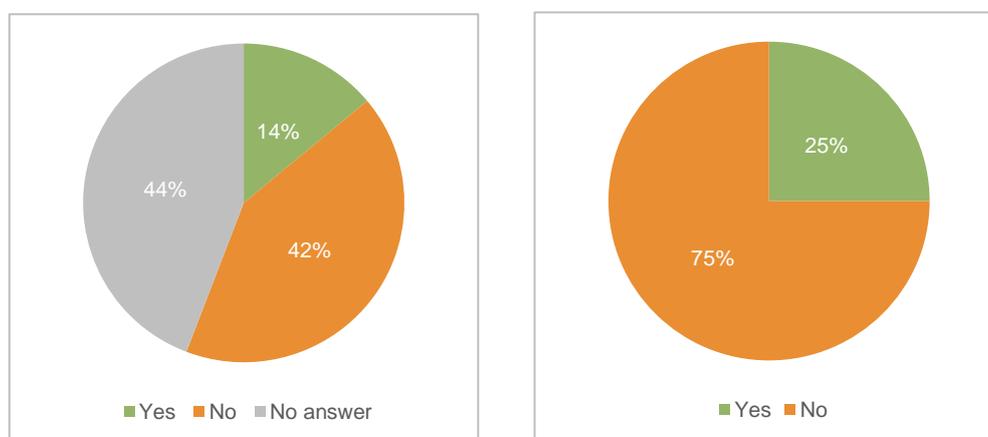
China (5); Japan (2); Switzerland (2); Argentina (1); Bosnia-Herzegovina (1); Brazil (1); Canada (1); Czech Republic (1); Liechtenstein (1); Monaco (1); Norway (1); New Zealand (1); Paraguay (1); Russia (1); San Marino (1); Singapore (1); Ukraine (1); United Kingdom (3); United States of America (1); Vietnam (1).

### 3. Would you say that your GI is sufficiently protected against fraud on the Internet? *[Closed question]*

Of the 86 participating organisations in the panel, the responses are as follows:

- ▶ Yes: 12
- ▶ No: 36
- ▶ No answer: 38

**FIG. 65:** Survey results: Would you say that your GI is sufficiently protected against fraud on the Internet? (AREPO, 2022)



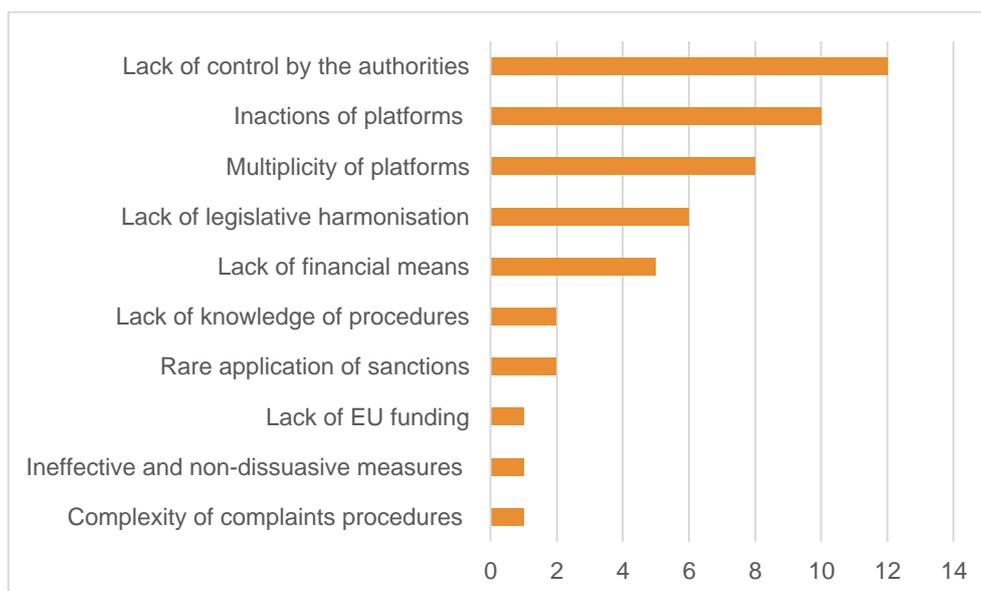
#### 3.1. If not, could you please explain why? *[Open-ended question]*

Of the 36 participating organisations in the panel that answered "no" to question 3 (lack of protection of GIs against internet fraud), 26 explained why, as summarised below:

- ▶ Lack or failure of fraud monitoring and control by the competent authorities: 12
- ▶ Inactions of relevant platforms: 10
- ▶ Extensive media with a multiplicity of websites and marketplaces offering fraudulent products: 8
- ▶ Lack of legislative harmonisation governing the protection of intellectual property on the Internet: 6

- ▼ Lack of financial and human resources to denounce fraud (too high monitoring and/or legal costs): 5
- ▼ Lack of knowledge about procedures for reporting fraud: 2
- ▼ Rare enforcement of convictions: 2
- ▼ Lack of EU subsidies to reduce costs: 1
- ▼ Measures taken ineffective and not a deterrent: 1
- ▼ Complexity of complaints procedures: 1

**FIG. 66:** Survey results: Reasons for the lack of protection of GIs against Internet fraud (AREPO, 2022)



**3.2. If not, what do you consider to be the main gaps in your organisation's legal protection?** *[Open-ended question]*

Of the 36 participating organisations in the panel that answered "no" to question 3 (GI not sufficiently protected against Internet fraud), 12 explained what they consider to be the main gaps in their entity's legal protection, as summarised below:

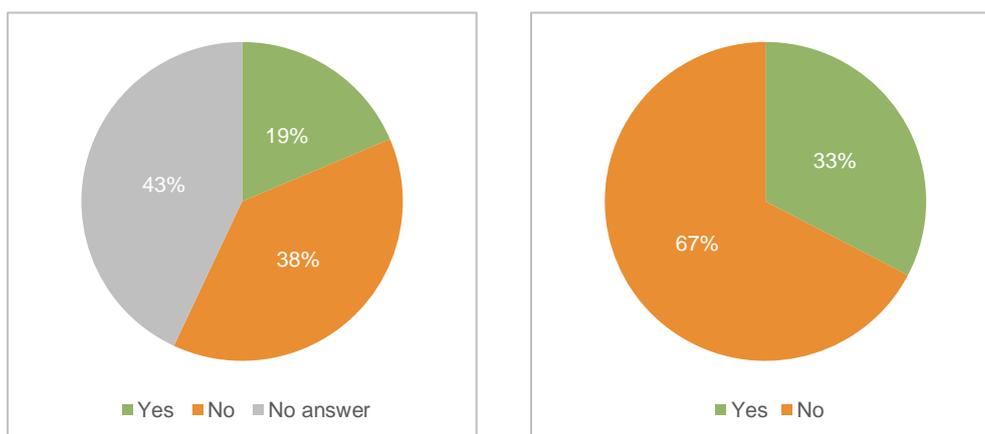
- ▼ Lack of financial and human resources: 9
- ▼ Lack of overall knowledge of applicable regulations and procedures to be implemented: 6

**4. Would you say that your organisation's knowledge in the matter of legal protection against Internet fraud is currently sufficient?** *[Closed question]*

Of the 86 participating organisations in the panel, the responses are as follows:

- ▼ Yes: 16
- ▼ No: 33
- ▼ No answer: 37

**FIG. 67:** Survey results: Would you say that your organisation's knowledge in the matter of legal protection against Internet fraud is currently sufficient? (AREPO, 2022)



#### 4.1. If not, what do you consider to be the main knowledge gaps of your organisation? *[Open-ended question]*

Of the 33 participating organisations in the panel that answered "no" to question 4 (insufficient knowledge of the entity about legal protection against Internet fraud), 14 explained what they considered to be the main shortcomings of their entity, as follows

- ▷ Legal expertise: 4
- ▷ Offensive protection strategies downstream of the breach (procedures to be implemented): 3
- ▷ Access to training: 3
- ▷ Little or no knowledge on the subject: 3
- ▷ Defensive protection strategies prior to the breach: 1
- ▷ Procedures to be implemented outside the EU: 1
- ▷ Information on cyber security: 1
- ▷ Operation of internal and external monitoring tools: 1
- ▷ Type of convictions (applicable sanctions): 1
- ▷ Access to information: 1

**FIG. 68:** Survey results: Gaps in legal knowledge of participating organisations (AREPO, 2022)



Other comments:

- ▷ Lack of a dedicated network: 1
- ▷ No common legislation: 1

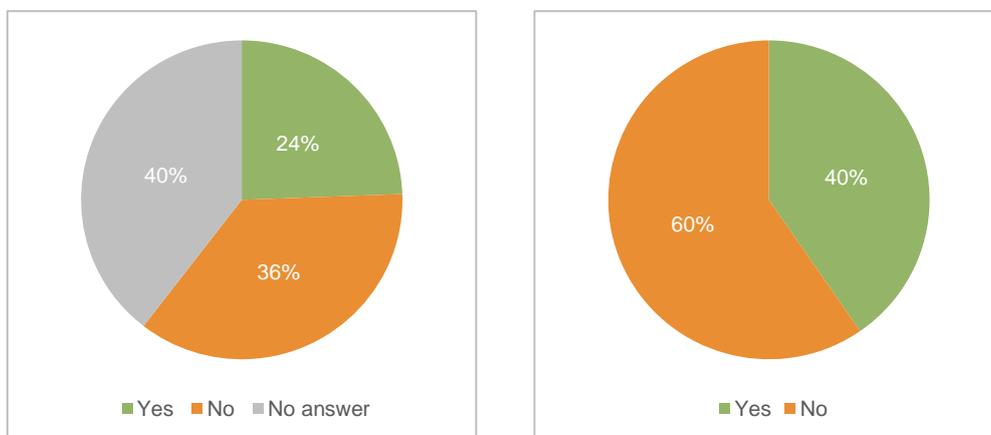
### 5. Does your organisation have regular monitoring of potential Internet fraud on your GI?

*[Such as frauds on the Internet marketplaces, social networks, etc.] [Closed question]*

Of the 86 participating organisations in the panel, the responses are as follows:

- ▷ Yes: 21
- ▷ No: 31
- ▷ No answer: 34

**FIG. 69:** Survey results: Does your organisation have regular monitoring of potential Internet fraud on your GI? (AREPO, 2022)

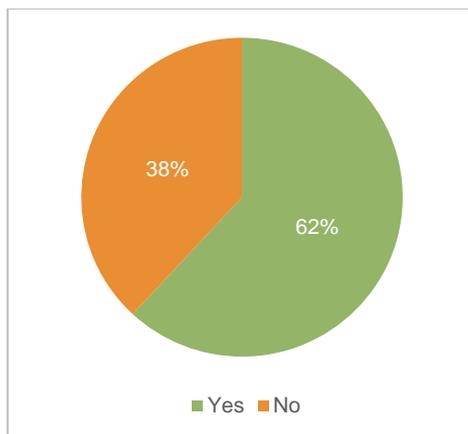


5.1. If yes, do you use a specific expertise to handle the monitoring? [E.g. database, monitoring platform, lawyer, etc.] [Closed question]

Of the 21 participating organisations in the panel that answered "yes" to question 5 (whether they regularly monitor their GIs for potential fraud on the Internet), the responses are as follows:

- ▷ Yes: 13
- ▷ No: 8

FIG. 70: Survey results: Do you use a specific expertise to handle the monitoring? (AREPO, 2022)



5.1.1. If so, would you say it is effective? Do you consider its cost to be reasonable? Could you give us its name? [Open question]

Of the 13 participating organisations in the panel that answered "yes" to question 5.1 (calling on specific expertise for monitoring), 5 gave details of the expertise they call on:

- ▷ Control agent or "agente vigilatore"<sup>110</sup>: 2 (the two organisations that provided this data are Italian);
- ▷ Private monitoring platform: 2 (the two organisations that provided this data are Italian and Portuguese)
- ▷ Trademark Observatory or "Osservatorio Marchi": 1 (the organisation that provided this data is Italian)
- ▷ External law firm: 1 (the organisation that provided this data is Italian)

One of the participating organisations uses the services of both an "agente vigilatore" and an external law firm.

The data provided by the participants on the effectiveness and costs of specific external expertise is not usable.

<sup>110</sup> For Italy, "The protection consortia [GI consortia] collaborate, according to the directives issued by Mipaaf [Ministero delle politiche agricole alimentari e forestali], in the monitoring, protection and safeguarding of PDOs and PGIs against abuses, acts of unfair competition, counterfeiting, misuse of protected designations and behaviour that is in any case prohibited by law (law 526/99, art. 14, paragraph 15, letter d)' (Mipaaf, n.d.) [55] (translated from Italian), through a control agent ("agente vigilatore" in Italian) approved by Mipaaf, for more information, [go here](#).

5.1.2. If not, how do you organise yourself to carry out this monitoring? Have you employed specific staff to carry it out? Do you consider this internally organised monitoring to be sufficient? *[Open question]*

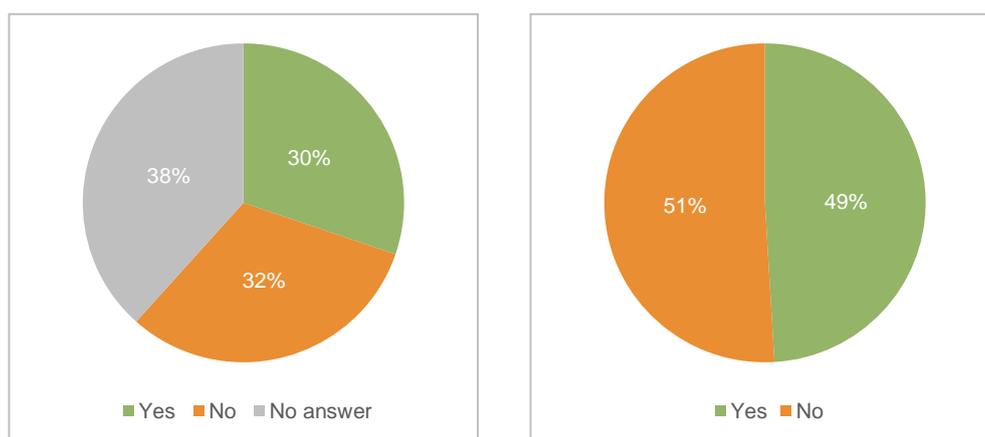
Of the 8 participating organisations in the panel that answered "no" to question 5.1 (soliciting specific expertise to ensure monitoring), 7 explained how their internal monitoring is organised, as follows: all the organisations use their own staff (employed by the group or GI operators themselves who then inform the group) to carry out monitoring using search engine tools such as "[Google Alerts](#)". The producer groups then inform the platforms or the competent authorities. Four of them consider this to be very insufficient and would like to see an improvement in the tools in place or new, more effective tools, and three did not comment on this subject.

## 6. Have you ever faced fraud from your GI on the Internet? *[Closed question]*

Of the 86 participating organisations in the panel, the responses are as follows:

- ▷ Yes: 26
- ▷ No: 27
- ▷ No answer: 33

FIG. 71: Survey results: Have you ever faced fraud from your GI on the Internet? (AREPO, 2022)

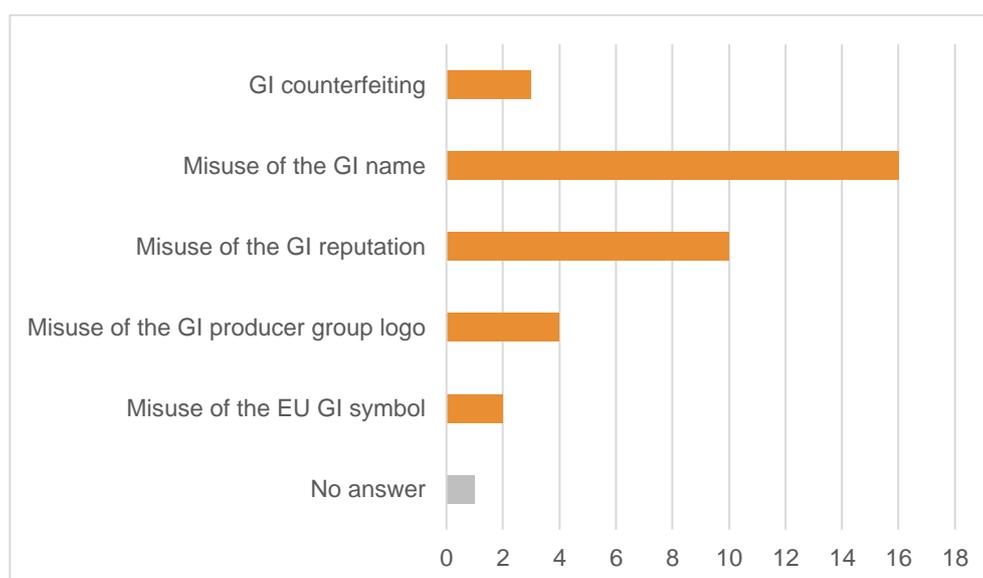


### 6.1. If yes, what kind of fraud was it? *[Closed multiple choice question]*

Of the 26 participating organisations in the panel that answered "yes" to question 6 (organisations that had already experienced Internet fraud by their GI), the responses were as follows:

- ▷ GI infringement: 3
- ▷ Misuse of the GI name: 16
- ▷ Misuse of the GI's reputation: 10
- ▷ Misuse of the entity's GI logo: 4
- ▷ Misuse of the official GI logo: 2
- ▷ No answer: 1

FIG. 72: Survey results: What kind of fraud was it? (AREPO, 2022)



6.2. If yes, could you explain in detail what this fraud was about? you specify what this fraud consisted of? *[If you have dealt with several cases of fraud, please give us details of your three most serious ones] [Open question]*

Of the 26 participating organisations in the panel that answered "yes" to question 6 (organisations that had already experienced Internet fraud by their GI), 21 explained what these frauds consisted of.

N.B.: As the names of the geographical indications involved in the frauds are not disclosable, we will use the answers to this question for internal purposes and will not make them public, as the participating organisations have been assured.

6.3. If so, how did you solve this case? Did you use a lawyer or an expert to help you? Did the fraud authorities or customs get involved in solving this case? *[If you have dealt with several cases of fraud, please give us details of your three most serious ones] [Open question]*

Of the 26 participating organisations in the panel that answered "yes" to question 6 (organisations that had ever been confronted with Internet fraud by their IG), 20 explained how these fraud cases were resolved by their entity, as follows

- ▷ Direct complaint to the usurper or the platform concerned: 8
- ▷ Intervention of a law firm (internal or external to the grouping): 7
- ▷ Solicitation of public fraud control services (such as DGCCRF in France, AICA in Spain, or ICQRF in Italy): 6
- ▷ Solicitation of public services in charge of the GI system (such as INAO in France or AGACAL in Galicia): 4
- ▷ Solicitation of the Ministry of Agriculture (regional or national): 4

**FIG. 73:** Survey results: Resolution of GI violations on the Internet (AREPO, 2022)

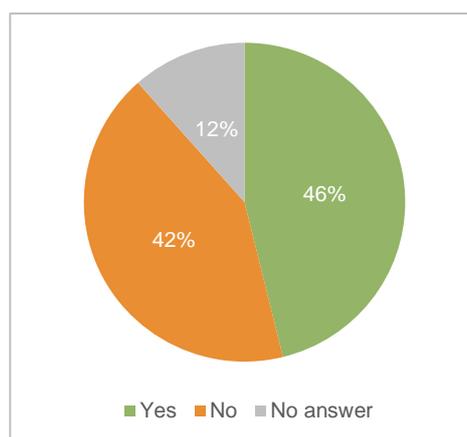


6.4. If yes, do you experience fraud on a regular basis? *[Closed question]*

Of the 26 participating organisations in the panel that answered "yes" to question 6 (organisations that had already experienced Internet fraud by their GI), the responses were as follows:

- ▷ Yes: 12
- ▷ No: 11
- ▷ No answer: 3

**FIG. 74:** Survey results: Do you experience fraud on a regular basis? (AREPO, 2022)



6.4.1. If so, how regularly? *[Open-ended question]*

Of the 12 participating organisations in the panel that answered "yes" to question 6.4 (entity regularly victim of Internet fraud), 8 gave the frequencies with which they experience such fraud, as follows

- ▷ Daily or almost daily: 5
- ▷ 5 to 10 cases per year: 1

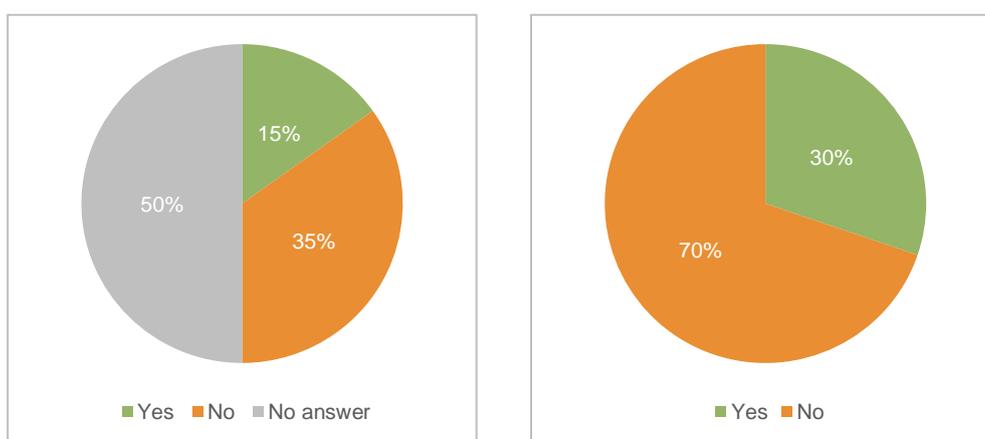
- ▷ 10 to 20 cases per year: 2

### 7. Do you find it easy to access information on the legal procedures to follow in case of a GI violation on the Internet? *[Closed question]*

Of the 86 participating organisations in the panel, the responses are as follows:

- ▷ Yes: 13
- ▷ No: 30
- ▷ No response: 43

**FIG. 75:** Survey results: Do you find it easy to access information on the legal procedures to follow in case of a GI violation on the Internet? (AREPO, 2022)



#### 7.1. If not, what are the main challenges in your opinion? *[Open-ended question]*

Of the 30 participating organisations in the panel that answered "no" to question 7 (difficulty in accessing information on legal procedures to follow in case of infringement of their GI on the Internet), 10 explained what they consider to be the main difficulties, as follows

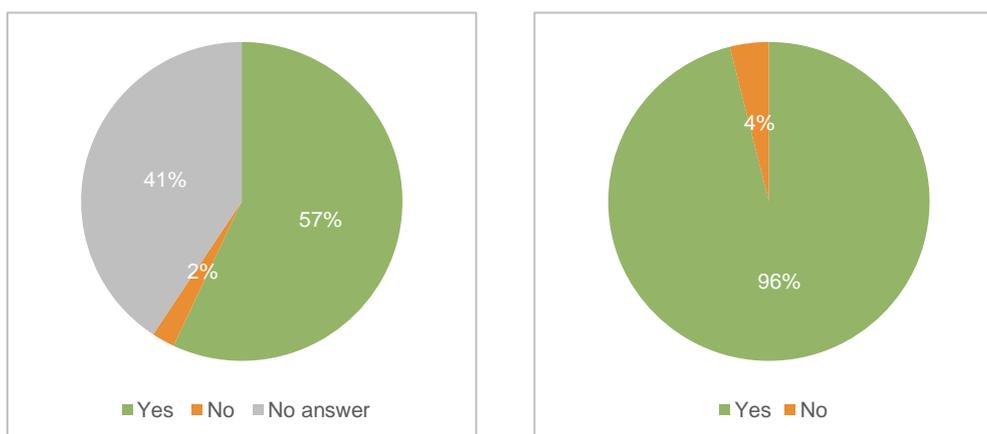
- ▷ Sporadic or partial information: 5
- ▷ Confusion about the procedures to be implemented (lack of harmonisation): 3
- ▷ No information available: 2

### 8. Would you be interested in a practical guide listing the main actions to take in case of a GI violation on the Internet? *[Closed question]*

Of the 86 participating organisations in the panel, the responses are as follows:

- ▷ Yes: 49
- ▷ No: 2
- ▷ No response: 35

**FIG. 76:** Survey results: Would you be interested in a practical guide listing the main actions to take in case of a GI violation on the Internet? (AREPO, 2022)

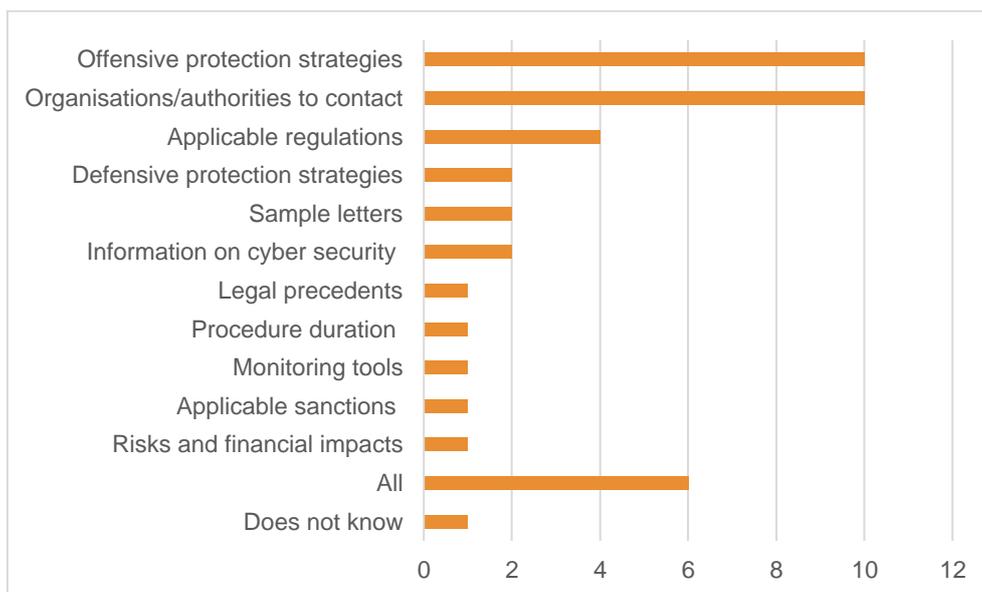


### 8.1. If so, what main information would you like to find? *[Open question]*

Of the 49 participating organisations in the panel that answered "yes" to question 8 (organisations interested in a practical guide listing the main actions to be taken in case of a breach of their GI on the Internet), 22 communicated the main information they would like to see in the guide, which is summarised below:

- ▷ Offensive protection strategies downstream of the breach (procedures to be implemented): 10
- ▷ List of organisations/authorities to contact, and when and how to contact them: 10
- ▷ All possible information on the subject: 6
- ▷ Regulations applicable on the Internet: 4
- ▷ Defensive protection strategies in advance of the breach: 2
- ▷ Sample letters to the usurper: 2
- ▷ Information on cyber security: 2
- ▷ Case studies of legal precedents: 1
- ▷ Time limits for procedures: 1
- ▷ Internal and external monitoring tools: 1
- ▷ Type of convictions (applicable sanctions): 1
- ▷ Financial risks and impacts: 1
- ▷ Don't know: 1

**FIG. 77:** Survey results: Information expected in the practical guide (AREPO, 2022)

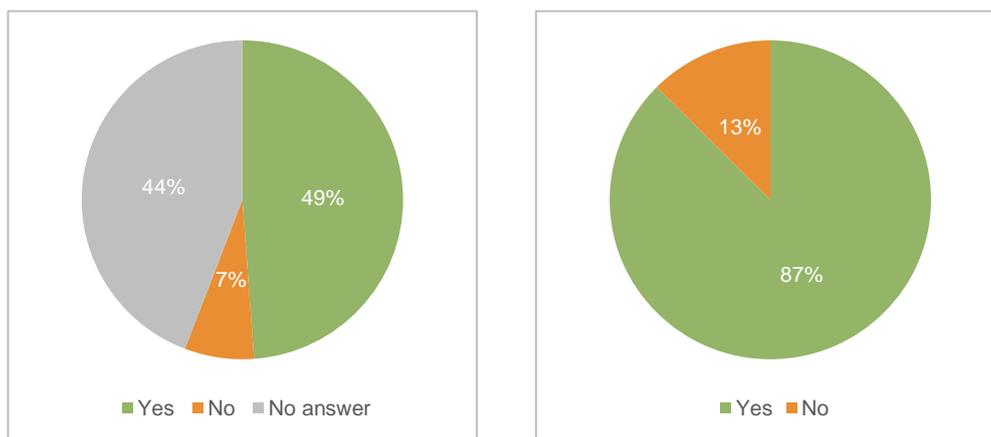


**9. Would you be interested in participating in a European event to raise awareness about the protection of GI products on the Internet?** *[Closed question]*

Of the 86 participating organisations in the panel, the responses are as follows:

- ▷ Yes: 42
- ▷ No: 6
- ▷ No response: 38

**FIG. 78:** Survey results: Would you be interested in participating in a European event to raise awareness about the protection of GI products on the Internet? (AREPO, 2022)



**Annex 3:** Model letter of formal notice

Name of recipient Address
Subject: Infringement of the geographical indication _____ - Consumer deception - Unfair and parasitic competition
Date: _____
Dear _____,
We are _____, the _____ PDO/PGI producer group. Our goal is to defend and promote the _____ PDO/PGI.
For more information, please visit our website at _____.
We have noted that you are making fraudulent use of the PDO/PGI name without right or authorization:
<ul style="list-style-type: none"> <li>▷ You have reserved the following domain names: _____;</li> <li>▷ You use the terms _____ which are components of the PDO/PGI name on your website _____ and on your pages on social networks _____;</li> <li>▷ _____.</li> </ul>
The marketing of the products and the communication to consumers as carried out on the above-mentioned Internet pages are prohibited under Articles 13 and 14 of EU Regulation N°1151/2012 of 21 November 2012 on quality schemes for agricultural products and foodstuffs.
These actions also constitute clear interference with our business, clear followership and free riding, constituting consumer deception and unfair competition.
In these circumstances, in order to avoid engaging in a long and costly dispute, we consider that an amicable settlement is possible subject to:
<ol style="list-style-type: none"> <li>1. The renunciation of your disputed domain names and of any other domain name that includes an evocation of the PDO/PGI;</li> <li>2. Removal of all infringing material from all your physical and Internet media;</li> <li>3. The communication, before _____, of a written commitment, dated and signed by you, as legal representative, including: <ul style="list-style-type: none"> <li>▷ Recognition of our PDO/PGI rights;</li> <li>▷ Your undertaking never to file, register or use a sign reproducing, imitating or evoking the PDO/PGI, alone or in association with any other nominal or figurative element or any related sign, for any purpose whatsoever, and in particular as a trademark, company name, trade</li> </ul> </li> </ol>

name, signboard, domain name, as well as for accounts on social networks, and in any form whatsoever, and on any medium whatsoever;

- ▷ Your commitment to cease all exploitation, in any capacity whatsoever, of a sign which contravenes the above provisions.

We are confident that by being so informed, you will understand our concerns, and be prepared to take prompt and amicable remedial action.

In the absence of a constructive and satisfactory response within fifteen days of receiving this letter, we shall be entirely at liberty to take any action against you to put an end to the litigious acts, to ensure the safeguarding of our rights and to compensate for our loss.

This letter shall be deemed to be a formal notice of default which may give rise to any time limit, interest or other consequence which the law and the Courts may attach to it.

Please note that this letter is not of a confidential nature, and may therefore be introduced into the proceedings in the event of subsequent litigation.

We look forward to hearing from you.

Location \_\_\_\_\_ Date \_\_\_\_\_

Name of sending organization \_\_\_\_\_

Signature

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# The protection of Geographical Indications on the Internet

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