

CHAMPAGNE Domain Names

A recent decision under the Uniform Domain Name Dispute Resolution Policy (the “UDRP”), deals with unregistered rights in the CHAMPAGNE mark which, it was asserted, were protectable in the United Kingdom under the common law doctrine of passing off.¹

The Facts

The complainant, Comité Interprofessionnel du vin de Champagne of Épernay, is a body established by statute under the laws of France. Among the Complainant’s statutory purposes is defending, preserving, and promoting the interests of all those involved in the production and marketing of the wines sold under the appellation of origin CHAMPAGNE. All producers of champagne in the Champagne district of France are required by law to subscribe to the complainant. The complainant’s powers include the power to sue and be sued, and the complainant represents all such producers in the Complaint.

Sales of wine under the name CHAMPAGNE in Europe and elsewhere have been very substantial for over two centuries, both in volume and value. Large sums of money have been spent to promote and enhance the name CHAMPAGNE, over and above the separate brand advertising undertaken by the individual producers represented by the complainant.

The complainant asserted that the expression CHAMPAGNE is distinctive only of wine produced in the Champagne region of France.

The Respondent operates an IT consultancy and computer sales business in London. He did not trade in champagne or beverages of any kind. He became aware of the proposed .co launch in July 2010, and decided to register a number of generic “.co” domain names with a view to future

¹. WIPO case DC02011-0026

sale. He applied for over 100 such domain names, and all were registered in July/August 2010. One of these was <champagne.co>.

The UDRP

Under paragraph 4(a) of the UDRP, a complainant has the burden of proving that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A panel must decide a complaint on the basis of the statements and documents submitted in accordance with the UDRP and principles of law that it deems applicable.

Paragraph 4(a)(i) of the UDRP requires that the complainant show that it holds rights in *a trademark or service mark*. The WIPO Overview, 2.0, which summarizes the consensus view of WIPO Panels concerning various issues under the UDRP, contains the following statement relating to rights in a geographical term:

Consensus View: the report of the Second WIPO Internet Domain Name Process declined to recommend specifically extending protection to geographical terms under UDRP. Some geographical terms, however, can be protected under the UDRP, if the complainant has shown that it has rights in a term and that the term is being used as a trademark for goods or services other than those that are described by or related to the geographical meaning of the term (secondary meaning).

The Decision

The Panel was not convinced that the complainant had established that CHAMPAGNE was an unregistered trademark of the kind contemplated by paragraph 4(a)(i) of the UDRP. First, it was noted that it is generally accepted that, to be a trademark, a sign must be capable of distinguishing the goods or services of an individual undertaking from those of other undertakings. The name CHAMPAGNE does not distinguish the wine of one champagne producer from the wine of another, and so does not fulfill the fundamental function of a trademark. A geographical indication is essentially designed to protect the producers of a particular region from loss caused by traders wrongfully applying that identifier to goods which have not been produced in the particular region. A geographical indication speaks fundamentally of the quality and reputation of the goods produced according to certain standards in a specific geographic area, but not of any particular or individual trade source as such.

Second, it appeared that the framers of the UDRP did not intend that a geographical term should be protected under the UDRP.

Comment

A geographical indication can be protected under the passing off doctrine despite the fact that it is not distinctive in the sense of denoting a specific source. If the impugned domain name were to be used inappropriately an action could be brought in the United Kingdom. However, this type of indication may not be protected under the UDRP.

