

Review Article

LEGAL REGIME OF A DOMAIN NAME AND PROCEDURE FOR RESOLVING DOMAIN DISPUTES IN UKRAINE

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ABSTRACT

Background: Domain name disputes arise concerning the protection of rights to domain names. The legal nature of a domain name as an object remains uncertain, leading to ambiguity in its legal regime. This uncertainty creates challenges in law enforcement and affects the procedures for resolving domain disputes. Ukraine's current civil legislation does not clarify the classification of domain names within the system of civil rights objects. However, the growing role of the digital environment has significantly increased the importance of domain names, contributing to increased disputes over their ownership and use.

While the law does not provide for a special procedure for the consideration and resolution of domain name disputes, both judicial and extrajudicial protection procedures are applied, taking into account the peculiarities of the legal nature of domain names. A unique feature of the protection of rights to domain names is the possibility of initiating and resolving a domain name dispute under the UDRP without the involvement of state institutions such as courts or bodies of the Antimonopoly Committee. The absence of proper legal regulation of the domain name as an object and the specifics of domain name dispute resolution has led to ongoing academic discussions on these issues.

Methods: The article's primary purpose is to investigate the legal nature of domain names and study the procedures for resolving disputes related to them. In this regard, the article first analyses a domain name as an object, defines its legal nature, characterises the position of the ECHR while contributing to the broader scientific discussion on the legal certainty of domain names. The article further analyses the peculiarities of judicial and extrajudicial protection of rights to domain names. It establishes that such protection can be pursued through both jurisdictional (judicial procedure or appeal to the Antimonopoly Committee of Ukraine) and non-jurisdictional forms. The study further describes the procedure for resolving domain name disputes by the court and the Antimonopoly Committee of Ukraine, identifying the main problematic aspects associated with these processes.

Particular attention is given to the scientific analysis of the procedure for resolving domain name disputes by the UDRP. The article outlines the main stages of domain name dispute resolution under the UDRP and explains the content and peculiarities of bad faith domain name registration, which often serves as the basis for disputes. Subsequently, the author formulates conclusions on improving the legal regime of a domain name, as well as on the procedure for resolving domain disputes.

Results and conclusions: Domain disputes are a common category of cases resolved both in and out of court. The author considers that difficulties in resolving domain disputes are caused by the legal uncertainty of a domain name as an object of civil rights. Currently, the legal nature and legal regime of domain names are not defined in the law. There is no special law governing domain names, and while the Civil Code of Ukraine and other legislative acts mention them, they do not comprehensively regulate the rights associated with them.

The study proves that, in this regard, domain name rights are protected through other objects reflected in a domain name, such as trademarks, commercial names, geographical indications, copyrighted objects, and names of individuals. The author substantiates that a domain name is an independent object that may be subject to sui generis law and which grants domain name owners (in particular, registrants) special property rights to use a website (administration, use, etc.); these rights can be transferred (for a fee or free of charge) and can be waived.

The author further establishes that domain name disputes may be resolved in or out of court. It is considered that the practice of resolving domain disputes under the UDRP is widespread. At the same time, its drawback, which should be addressed, is that it applies only to disputes involving trademarks reflected in domain names. The approach to resolving such a dispute is based solely on proving the unfair nature of the domain name registration. It is substantiated that these circumstances significantly narrow the possibilities for applying the UDRP in resolving domain name disputes. To address this limitation, the author proposes supplementing the Law on Marks to include a special method of protection: granting trademark certificate holders the right to demand the re-delegation of a domain name as an additional method of protection.

1 INTRODUCTION

Domain name disputes arise over the protection of rights to domain names. However, the legal nature of a domain name as an object is uncertain. The lack of a clearly defined legal regime gives rise to problems of law enforcement, making it difficult for registrants to always effectively enforce their rights. This issue is not limited to Ukraine, where domain names are mentioned in only a few legislative acts, none of which specifically regulate them. The Law of Ukraine "On the Protection of Rights to Trademarks and Service Marks"¹

1 Law of Ukraine no 3689-XII of 15 December 1993 'On the Protection of Rights to Trademarks and Service Marks' (amended 31 December 2023) <<https://zakon.rada.gov.ua/laws/show/3689-12#Text>> accessed 25 November 2024.

(hereinafter - Law on Marks) and the Law of Ukraine "On Electronic Communications"² reference domain names, but these legislative acts are not aimed at legal regulation of domain names and do not define their legal regime. Likewise, the Civil Code of Ukraine does not clarify the status of domain names within the system of civil rights objects.

Despite this legal ambiguity, domain names are frequently the subject of numerous disputes, which should be called domain disputes because they arise in relation to a domain name. The law does not prescribe a special procedure for the consideration of domain disputes; instead, both judicial and extrajudicial remedies are applied, taking into account the peculiarities of the legal nature of domain names. A unique feature of enforcing rights to domain names is the possibility of initiating and resolving a domain name dispute under the UDRP without the involvement of state institutions. The absence of proper legal regulation of a domain name as an object and the peculiarities of domain name dispute resolution lead to numerous scientific discussions on these issues.

This article aims to define the legal nature of domain names, examine the procedure for enforcing rights to domain names, determine the specifics of the UDRP's application, and substantiate conclusions on improving the legal regulation of the relations under study.

2 RESEARCH METHODOLOGY

In accordance with the research's purpose and objectives, the authors employed general scientific and special legal methods of scientific cognition, including analysis and synthesis, comparative legal methods, formal-logical methods, analogy methods, systemic and structural methods, and dialectical methods. The choice of methods was determined by the specific nature of the research subject.

The analysis method was applied to determine the legal nature of a domain name as a special property right associated with using a particular website, highlight the content of this concept, and determine the specifics of domain disputes. Conversely, the synthesis method was used to define the concept of "domain name" and to create a list of entities with rights to a domain.

Cognitive methods such as induction and deduction facilitated an in-depth examination of Ukrainian legislation on judicial and out-of-court domain dispute resolution. The analogy method was used to study the ECHR's case law and the practice of applying the UDRP. The modelling method assisted in formulating legal cases and situations regarding certain forms of realisation of the right to domain names and their protection.

The comparative legal method allowed a comparison of national legislation and other regulations governing the procedure for resolving domain name disputes. The formal and

2 Law of Ukraine no 1089-IX of 16 December 2020 'On Electronic Communications' [2021] Official Gazette of Ukraine 6/306.

logical method allowed the formulation of judgments and conclusions based on the analysed scientific positions, empirical material, and case law.

The historical and legal method traced the evolution of law enforcement concerning the exercise of rights to domain names, as well as the formation and development of judicial and extrajudicial practice on the protection of domain name rights. The formal legal method of cognition is used to study the sources of domestic and foreign legislation.

3 DOMAIN NAME

3.1. Legal nature of a domain name

A domain name is an object of civil rights, and it has value as an asset usually used in legal entities and individuals' business activities.

Formally, a domain name, as a record consisting of letters or characters, holds no value. However, the content of a website that is "hidden" behind this domain is essential. Despite this, the domain name remains an important element of a website as an integral object; without it, a website cannot function as such. Instead, it would merely exist as a collection of certain information, including copyrighted works and other objects that are digitally stored, without being publicly accessible on the Internet.

The definitions of a domain name given in the law reflect its technical aspects rather than its legal nature.³ The legal nature of a domain name is debatable, and for the most part, scholars and law enforcement practice treat domain names either as a right that arises on the basis of an agreement between the registrar and the registrant or as an object of property rights, including intangible ones.⁴ Ukrainian legislation pays little attention to the domain as an object of civil rights, so its legal nature remains debatable. As noted in the scientific literature, the domain name as an object is at the stage of legal uncertainty.⁵ The Law of Ukraine "On Electronic Communications" defines a domain in Article 2 as a part of the hierarchical address space of the Internet, uniquely identified by its domain name, served by a group of domain name servers, and centrally administered.⁶

From this definition, we can see the correlation between the concepts of "domain" and "domain name": a domain is a broader concept, encompassing various features such as its role within the hierarchical address space of the Internet, its management by a group of domain name servers, and its centralised administration. Among these attributes, it

3 Gergana Varbanova, 'Legal Nature of Domain Names' (2022) 1 Economics and Computer Science 54.

4 Claudio Caruana, 'The Legal Nature of Domain Names' (2014) 4 ELSA Malta Law Review <<https://www.um.edu.mt/library/oar/handle/123456789/124078>> accessed 25 November 2024.

5 Konstantinos Komaitis, *The Current State of Domain Name Regulation: Domain Names as Second Class Citizens in a Mark-Dominated World* (Routledge 2010) 39, doi:10.4324/9780203849583.

6 Law of Ukraine no 1089-IX (n 2) art 2.

includes a unique name—the domain name—which serves to identify it. In other words, a domain name is a verbal (alphabetic) expression of a digital domain address, necessary for its individualisation and distinction from other domains.

The Law on Marks defines a domain differently, focusing on its role in regulating trademark-related rights. Thus, Article 1 of this Law states that a domain name is a name used to address computers and resources on the Internet.⁷ However, this definition is not informative and needs to be harmonised with the concept of a domain defined in other legislative acts. In addition, the narrow scope of the Law on Marks, which applies exclusively to trademarks, cannot outline all possible areas of use of domain names since a domain name is not only a form of use of a trademark but also a form of use of other means of individualisation, such as commercial names, geographical indications, other commercial designations, copyrighted items, and names of individuals.

The Civil Code of Ukraine (hereinafter referred to as the CC of Ukraine) does not mention a domain name. A domain name is undoubtedly an object of civil rights, an object in civil circulation. Article 177 of the CC of Ukraine, which defines the types of civil rights objects, does not mention a domain name but provides an exhaustive list of civil rights objects.⁸ The analysis of the scientific literature shows that the domain applies to digital things, the results of intellectual and creative activity, property rights, and other tangible/intangible goods.

This diversity of opinions is due to legislative uncertainty regarding the legal nature of a domain name. This, in turn, leads to difficulties in enforcing the rights to a domain name in case of their violation. Thus, courts often require a clear legal identification of a domain as a certain object whose rights have been violated. Therefore, enforcing rights to a domain name independently is practically impossible. Instead, claimants must rely on enforcing trademark rights or rights to a commercial name, which are exercised through the use of a domain name.

If a Claimant does not provide legal identification of the domain name in their claim, the court may dismiss the claim for termination of the infringed right to the domain name.⁹

To address domain-related disputes, the .UA Domain Name Dispute Resolution Policy and the .UA Domain Name Dispute Resolution Policy Rules regulate the procedure for resolving disputes arising from domain names and trademark infringement.¹⁰ This globally recognised approach has been implemented in many countries to resolve domain name disputes, which was introduced by the World Intellectual Property Organization (hereinafter referred to as the WIPO).

7 Law of Ukraine no 3689-XII (n 1) art 1.

8 Civil Code of Ukraine no 435-IV of 16 January 2003 (amended 3 September 2024) <<https://zakon.rada.gov.ua/laws/show/435-15#Text>> accessed 25 November 2024.

9 Case no 14/190pd (Economic Court of Donetsk Region, 25 October 2006) <<https://reyestr.court.gov.ua/Review/211108>> accessed 25 November 2024.

10 'UA-DRP - Domain Dispute Resolution Policy in the .UA Domain' (.UA, 2024) <<https://www.hostmaster.ua/policy/ua-drp>> accessed 25 November 2024.

3.2. Domain name as an object of civil rights

Part 2 of Article 179 of the CC of Ukraine provides for the possibility of civil rights objects both in the material world and in the digital environment. This determines the form of objects, peculiarities of acquisition, exercise, and termination of civil rights, and obligations in relation to them.¹¹

A domain exists in the digital environment, but no law defines the procedure for acquiring, exercising, and terminating rights and obligations in relation to it.

Article 179-1 of the CC of Ukraine describes a digital thing as a good that is created and exists solely in the digital environment and has property value. In general, a domain exists solely in the digital environment and does have property value for its owner.¹²

The law defines the list of digital things, which includes virtual assets, digital content, and other benefits to which the above provisions apply to the concept of a digital thing.

A domain cannot be attributed to virtual assets or digital content as it does not fall within the legal definition of these objects. Thus, a virtual asset is an intangible good, has value and is expressed as a set of data in electronic form; its existence and turnover are ensured by the system of guaranteeing the turnover of virtual assets; it can certify property rights.¹³

A domain is similar in legal nature to a virtual asset, as it is an intangible good, has a value expressed in electronic form, and certifies property rights to administer and use a website. However, the system of ensuring the turnover of virtual assets does not ensure the domain's existence and turnover, which does not allow it to be classified as a virtual asset.

Digital content cannot include a domain, as it is data created and exists in digital form (computer programs, applications, music files, digital games, video and audio files, and e-books). Instead, a domain is the address of a website where certain digital content can be found.

Therefore, a domain can be interpreted as another object (good) created and existing exclusively in the digital environment, with inherent property value as it certifies special property rights to use a particular website. This interpretation allows us to refer to domains as digital things.

At the same time, we emphasise that the property rights to a particular website granted by a domain should not be equated with the property rights related to the right of ownership as a real right. If a domain were considered a thing, its legal regime would fall under the legislation governing real rights (on the right of ownership), which in Ukraine, in particular, is Book Three of the CC of Ukraine.

11 Civil Code of Ukraine (n 8) art 179.

12 *ibid*, art 179-1.

13 Law of Ukraine no 2074-IX of 17 February 2022 'On Virtual Assets' [2022] Official Gazette of Ukraine 31/1629.

As a result, applying remedies in rem—such as vindication, negative claim, a claim for recognition of rights—to a domain is impossible. Instead, disputes over domain names are resolved through special remedies, including re-delegation and cancellation of domain name registration.

A domain is an object that grants special property rights related to the use of a particular website (its administration, use, etc.); these rights can be transferred, donated, or abandoned. In this case, the word "property" (in the phrase "property rights") characterises a domain as an asset, as a certain good that can generate profit or that can be useful in other ways (but has a certain property value).

Although domain disputes formally and legally arise over a domain name, a website's content (content) is also essential. Often, the parties to a domain dispute carry out identical or similar activities, and it is the domain as a means of individualisation that helps consumers choose a particular website.

3.3. Domain name in the ECHR case law

In 2007, the ECtHR addressed the legal nature of a domain name in a domain name dispute. In *Paeffgen v. Germany*, the ECtHR stated that property rights should be understood in a broad sense, not limited to property (tangible things), and therefore, property rights also apply to intangible assets (benefits), such as the right to use a domain name.¹⁴

When analysing this decision of the ECtHR, it should be borne in mind that the ECtHR was considering a case of violation by the state of the provisions of the European Convention on Human Rights (1950). Specifically, in *Paeffgen v. Germany*, the Court investigated whether Article 1 of Protocol No.1 of the Convention (adopted on 20 March 1952), which refers to the peaceful enjoyment of property (protection of property rights), had been violated. Notably, the Convention itself does not define the concept of "property," nor does Article 1 of Protocol No.1 of this Convention contain its definition. Therefore, as of 2007, the concept of "property" has acquired a broad interpretation, and the ECtHR has repeatedly applied it in the context of the protection of property rights, intellectual property rights, labour, and social rights.

In this context, the right to property under Article 1 of Protocol 1 is used in the broadest possible sense, as well as the concept of property as the object of protection. The ECtHR considers a domain name as an object of protection of property rights, treating it as a special property right related to the use of a website. This position of the ECtHR has given rise to numerous academic discussions on interpreting the said decision.

14 *Paeffgen GmbH v Germany* App nos 25379/04, 21688/05, 21722/05 and 21770/05 (ECtHR, 18 September 2007) <<https://hudoc.echr.coe.int/eng?i=001-82671>> accessed 25 November 2024.

Building on the above ECtHR conclusion, Nekik K. points out that a domain name should be considered a special type of property—a property right and, accordingly, an object of property rights. She points out that to determine whether a domain name is an object of property rights, it is necessary to establish whether its use affects financial interests and whether such an object has economic value. The domain name owner has the right to determine how it is used independently; therefore, the exclusive right to use a domain name has economic value and, accordingly, is a property right within the meaning of Article 1 of Protocol No. 1 to the Convention.¹⁵

Oliynyk K. points out that the registrant does not own the entire property rights to a domain but only the right to use and dispose of it for a certain period. This distinction determines certain peculiarities of the disposal of a domain name as an object of civil rights. At the same time, since a domain name can be considered in civil law as a good, i.e. an object of a certain value, the ECtHR in *Paeffgen GmbH v. Germany* recognised that the right to use and dispose of a domain name qualifies as a property under the broad interpretation of "property".¹⁶

Bulat N. contends that a domain name, by its legal nature, is a special object of intellectual property rights. Such a domain name feature is not only that it has special, inherent features and is separate from other objects, but also that, given the improper regulation of relations in the field of domain names, the legal protection of these objects remains unprotected.¹⁷ V. Bontlab proposes to provide a special chapter on domain names in civil legislation, specifically under the provisions governing intellectual property rights.¹⁸

We argue that a domain name is not an object of intellectual property rights, though it may reflect certain objects of intellectual property rights.¹⁹ Instead, it should be regarded as an intangible asset, granting a special property right to use, administer, and manage a particular web resource. In addition, domain names may incorporate trademarks, commercial names, geographical indications, copyrighted works, or personal names. If such elements are used in a domain name without the consent of the respective right holder, the resulting dispute is treated as a domain name dispute. However, its core issue revolves around enforcing intellectual property rights against unlawful use within a domain name. These disputes may be adjudicated in court, and in some cases, the antimonopoly bodies may also play a role in their resolution.

15 Kateryna Nekit, 'Domain Name as an Object of Civil Rights' (2017) 23 *Journal of Civil Studies* 40.

16 'Domain Name Disputes: Ukrainian and International Current Practice' (*YURIST & ZAKON*, 24 October 2019) <https://ips.ligazakon.net/document/EA013152?ed=2019_10_24> accessed 25 November 2024.

17 Nataliia M Bulat, 'The Main Ways of Existing Legislation Improvement Concerning Domain Names Protection' (2020) 31-1(2) (70) *Scientific notes of Taurida National VI Vernadsky University, Series: Juridical Sciences* 74, doi:10.32838/2707-0581/2020.2-1/14.

18 Vasyly V Bontlab, 'Civil Law Regulation of Domain Names' (PhD thesis, Taras Shevchenko National University of Kyiv 2006) 8.

19 Graham JH Smith, *Internet Law and Regulation* (Sweet & Maxwell 2007) 160.

4 JURISDICTIONAL AND NON-JURISDICTIONAL FORMS OF ENFORCEMENT OF RIGHTS TO DOMAIN NAMES

4.1. General principles of enforcement of rights to a domain name

Inadequate legal regulation of domain names contributes to the emergence of domain disputes.²⁰ Domain names cannot be an independent object of enforcement either in or out of court. The domain name owner may enforce his/her right to a domain by using the mechanisms of enforcement of intellectual property rights to the objects reflected in domain names (trademarks, commercial names, geographical indications, copyrighted objects, etc.) or by enforcing his/her data (for example, the name of an individual reflected in a domain name). Most often, in case of infringement of rights to a domain name, their registrants resort to the enforcement of intellectual property rights and thus indirectly enforce the right to a domain name.

The procedure for enforcing intellectual property rights to objects used in domain names may be carried out within the jurisdictional form of rights enforcement: judicial procedure or appeal to the bodies of the Antimonopoly Committee (out-of-court protection).

Non-jurisdictional form of intellectual property rights protection includes dispute resolution:

- a) through alternative domain name dispute resolution such as the UDRP or other arbitration procedures
- b) through negotiation or mediation.

Domain name disputes regarding the unlawful use of a trademark in a domain name may be resolved in accordance with the UDRP. UDRP and the Domain Name Dispute Resolution Policies developed under it (in particular, the UA-DRP Domain Name Dispute Resolution Policy - hereinafter referred to as the UA-DRP, the UA-DRP Policy) are aimed at prompt and professional consideration of a domain name dispute. At the same time, resolving domain disputes through the UDRP procedure aims to enforce intellectual property rights exclusively to trademarks, significantly narrowing the possibilities for enforcing rights to domain names (as they may also reflect other intellectual property rights).

The global practice of applying the UDRP in different countries also indicates a unified approach to considering domain disputes only if the domain name reflects only a trademark, since a domain dispute under the UDRP procedure is aimed at protecting the rights of its owner. The DRP rules in almost all countries are similar and copy the UDRP with minor changes that reflect national characteristics. For example, in Japan, according to the JP-DRP (.jp), it is possible to protect rights not only to a trademark but also to other

20 Stella Tsybizova, 'Problems of legal regulation of domain names: the experience of the United States of America' (2023) 4 Law Review of Kyiv University of Law 169, doi:10.36695/2219-5521.4.2023.30.

designations.²¹ However, this can be explained by the narrow meaning of a trademark, which is specified in the Japanese Trademark Law. Expanding the scope of the UDRP deserves attention since trademarks are not the only ones used in domain names.

It should be noted that the EU has Regulation (EU) 2019/517 of 19 March 2019 on the implementation and functioning of the .eu top-level domain name.²² This Act is important for regulating the acquisition, exercise and protection of rights to .eu top-level domain names. It states that domain disputes concerning .eu top-level domain names must be resolved by authorities located in the Union and that the relevant national law shall apply. At the same time, the Regulation provides the possibility of using alternative dispute resolution procedures to resolve domain disputes, particularly ICANN's UDRP.

4.2. Resolving domain name disputes in court

4.2.1. Domain name as an object of judicial enforcement

Given the uncertain legal nature of a domain name, it cannot be treated as an independent object of judicial enforcement. Instead, domain name rights can be indirectly enforced in court by filing lawsuits aimed at enforcing intellectual property rights to trademarks, trade names, geographical indications, and similar rights reflected in the domain name.

Judicial proceedings are a universal mechanism for enforcing any violated right, including the right to a domain, which is protected through other objects. In such cases, claims are aimed at stopping the violation of rights and are often formulated to oblige the Defendant to stop using a certain domain name or to oblige the Defendant to re-delegate the domain name registration to the Claimant.

While a domain dispute is being resolved in court, the Claimant may block any changes to the record of the disputed domain name, ensuring the domain remains functional for mail, website, etc. To do this, the Claimant, upon filing a statement of claim with the court, must provide a copy of it (with evidence of acceptance by the court) to the administrator. This request results in the private domain being placed in "FROZEN" status, meaning no changes can be made to its record—such as re-delegation or cancellation—while the dispute is ongoing.

An appeal to the administrator will be more effective if the court takes measures to secure the claim. It should be borne in mind that according to the provisions of the Civil Procedure Code of Ukraine and the Commercial Procedure Code of Ukraine, interim measures that

21 European Union Intellectual Property Office, *Comparative Case Study on Alternative Resolution Systems for Domain Name Disputes* (EUIPO 2018) 6, doi:10.2814/294649 TB-06-18-312-EN-N.

22 Regulation (EU) 2019/517 of the European Parliament and of the Council of 19 March 2019 on the Implementation and Functioning of the .eu Top-Level Domain Name and Amending and Repealing Regulation (EC) no 733/2002 and Repealing Commission Regulation (EC) no 874/2004 [2019] OJ L 91/25.

are identical to the satisfaction of the stated claims are not allowed if the dispute is not resolved on the merits.

Thus, interim measures in disputes concerning the enforcement of intellectual property rights to objects used in domain names on the Internet may include prohibiting the registrant from taking any actions to re-delegate the domain name in favour of other persons, as well as prohibiting the registrar from taking actions to re-delegate a domain name in favour of any person. Such a court ruling is subject to immediate execution from the date of its issuance, regardless of its appeal and the opening of enforcement proceedings.

4.2.2. Ways to enforce rights to domain names

The enforcement of intellectual property rights related to objects used in domain names typically focuses on stopping the infringement, although another method provided for by contract or law may be applied.

Special legislation in the field of trademark enforcement also specifies that using another's trademark or similar sign in a domain name violates trademark rights (Part 2, Article 2 of the Law on Marks).²³ In other words, the prohibition of using a trademark in a domain name will be the most appropriate method of enforcement that meets the law's requirements in this case.

In line with this, the Supreme Court of Ukraine in its decision of 21 May 2012 in Case №. 6-20цс11 established that: "...legislative restrictions on substantive legal remedies for the protection of a civil right or interest are subject to the provisions of Articles 55, 124 of the Constitution of Ukraine and Article 13 of the ECHR, according to which everyone has the right to an effective remedy not prohibited by law. Since the provisions of the Constitution of Ukraine and the Convention have the highest legal force (Articles 8, 9 of the Constitution of Ukraine), and the restrictions of substantive law contradict these provisions, violations of civil rights or civil interests will be subject to judicial protection in a manner not provided for by law, in particular Article 16 of the CC of Ukraine, but which is an effective remedy, that is, one that corresponds to the content of the violated right, the nature of its violation and the consequences caused by this violation."²⁴

Such a way of enforcing the violated right as re-registration, transfer, or re-delegation of a domain name to the Claimant fully meets the outlined criteria.

The judicial procedure for resolving domain name disputes is a universal mechanism for enforcing violated rights. Court proceedings are based on the principles of competitiveness, equality, and dispositive, which guarantee that both parties to a domain dispute can prove the validity of their claims and objections with appropriate and admissible evidence.

23 Law of Ukraine No. 3689-XII (n 1) art 2.

24 Case no 6-20cs11 (Supreme Court of Ukraine, 21 May 2012) <<https://reyestr.court.gov.ua/Review/24704776>> accessed 25 November 2024.

4.2.3. Respondent in domain name disputes

Legal relations related to the registration and use of domain names are included .UA and .YKP domains involve three key parties:

- a) public domain administrator: a person who carries out measures for administrative support of the public domain and ensuring its performance;
- b) domain name registrar: a person who provides services necessary for technical support of registration, delegation and functioning of the domain name;
- c) domain name registrant: a person in whose interests the registration and delegation of the domain name are carried out.²⁵

The identity of the domain name registrant can be established through various methods. One approach is using the WHOIS service (public data). Alternatively, this information can be obtained by submitting a request through an attorney or directly from the court.

The WHOIS service contains publicly available information about the domain name registrar. If the disputed domain name is registered in the .UA domain zone, the open LICENCE field in WHOIS displays the number of the trademark certificate, which greatly facilitates the identification of the domain name registrant. In addition, the *Created* field in WHOIS displays the date of creation of the domain name, which may be relevant for determining the fact of prior use of the trademark in accordance with the provisions of Part 1 of Article 500 of the CC of Ukraine.

If the disputed domain name is registered in the private third-level domain zone, domain name registrars withhold information about the domain names' registrants from public access, citing the Law of Ukraine "On Personal Data Protection" and the GDPR.

Please note that the Law of Ukraine "On Copyright and Related Rights" in Part 11 of Article 56 provides for the obligation of website owners (who are the registrants of the respective domain name and/or the recipient of hosting services, or other person who establishes the procedure and conditions for the use of the website), except for individuals who are not business entities, and the obligation of hosting service providers to provide information about themselves publicly (including in the WHOIS service). This includes their name, location, and contact information.²⁶

The law requires website owners who are individuals and not business entities to make their contact information, such as email addresses and telephone numbers, freely available on the websites they own or in public databases of domain name records (WHOIS). This legislative approach makes it possible to identify the person who owns the website, i.e., the domain name registrant.

25 Rules of the Dispute Resolution Policy for Domain Names in the .UA domain (entered into force on 1 November 2024), see: UA-DRP (n 10).

26 Law of Ukraine no 2811-IX of 1 December 2022 'On Copyright and Related Rights' [2023] Official Gazette of Ukraine 3/196.

However, these legislative provisions are currently not practically enforced. In addition, if the website owner (registrant) is an individual (not an entrepreneur), the law requires only an email address and phone number to be provided on the website and in the WHOIS service. This data, even if the provisions of the law are met, may not be sufficient to identify the Defendant.

Thus, the initial Defendant in these disputes is the domain name registrar. If the right holder is unable to directly provide information about the registrant, they have the right to file a motion requesting the court to obtain the evidence, as stipulated in Article 81 of the Commercial Procedure Code of Ukraine and Article 84 of Civil Procedure Code of Ukraine (depending on the type of proceedings). In cases where this information is critical to the dispute, the court may request evidence before filing a claim as a measure to secure evidence by the procedure established by Articles 110-112 of Commercial Procedure Code of Ukraine, Articles 149-151 of Civil Procedure Code of Ukraine.²⁷

Upon receipt of information about the domain name registrant, at the plaintiff's request, the court of first instance will involve the domain name registrant as a co-defendant in the case.

4.3. Enforcement of rights to domain names in the bodies of the Antimonopoly Committee of Ukraine

4.3.1. Unfair competition and domain names

The unfair competition consists of the use of trademarks in domain names and also of other objects of industrial property rights.²⁸ The enforcement of rights to domain names in the Antimonopoly Committee is carried out under the provisions of the legislation on protection against unfair competition (the Law of Ukraine "On Protection against Unfair Competition"). Domain names are not explicitly mentioned as an object of protection under this law, but the Antimonopoly Committee may still enforce their rights. In this case, the provision of Article 4 of this law is decisive ("Unlawful Use of Designations").²⁹

From this provision, it is evident that the law uses the term "designation" as a generic term that includes:

- a) name (obviously of the entrepreneur);
- b) commercial (brand) name;

27 Commercial Procedure Code of Ukraine no 1798-XII of 6 November 1991 (amended 19 October 2024) <<https://zakon.rada.gov.ua/laws/show/1798-12#Text>> accessed 25 November 2024; Civil Procedure Code of Ukraine no 1618-IV of 18 March 2004 (amended 19 October 2024) <<https://zakon.rada.gov.ua/laws/show/1618-15#Text>> accessed 25 November 2024.

28 Pedro de Miguel Asensio, *Conflict of Laws and the Internet* (2nd edn, Edward Elgar 2024) 282.

29 Law of Ukraine no 236/96-BP of 7 June 1996 'On Protection against Unfair Competition' (amended 16 October 2020) <<https://zakon.rada.gov.ua/laws/show/236/96-%D0%B2%D1%80#Text>> accessed 25 November 2024.

- c) trademark;
- d) advertising materials;
- e) design of packaging for goods and periodical; and
- f) other designations used by business entities.

A domain name may be a form (method) of using a trademark (most often), a commercial name, or an individual's name. A domain name also falls under the concept of another commercial designation a business entity uses. In this case, the phrase "other designations used by business entities" is used in contrast to the existing means of individualisation (trademark, commercial name, and geographical indication). Therefore, the legislator uses the word "other" commercial designations that are not directly provided for in the law, and a domain name belongs to such designations if it does not reflect the above means of individualisation.

4.3.2. Domain name as another commercial designation

The disadvantage of legal regulation is that in other provisions of the Law on Protection against Unfair Competition, the legislator does not disclose the content of the concept of "other commercial designation", and the only mention of it in Article 4 of this law does not provide this object with proper legal protection. Therefore, we have a double discussion on the legal regime of both other commercial designations and the legal regime of a domain name that may be reflected in such a designation, which does not contribute to the proper protection of domain name rights.

The Commercial Code of Ukraine in Article 33 duplicates the provisions of Article 4 of the Law of Ukraine "On Protection against Unfair Competition", emphasising in Part 2 of this article the illegality of using the designations of other entities.³⁰ At the same time, the word "priority" is not specified in the law. It refers to the priority in the fair use of a specific designation, including a domain name, in commercial (economic) activities. The Supreme Court, in resolving a dispute over unfair competition, emphasised that priority means the preemptive right to use the results of lawful, bona fide and honest business activities.³¹

Thus, the legal regulation of "other (commercial) designations", which may include a domain name, is limited to their mention in the Law of Ukraine "On Protection against Unfair Competition" and the Commercial Code of Ukraine.

Another commercial designation is often used by entrepreneurs and business entities in their business activities. Traditionally, this refers to a brand, business name, etc., which, despite its use, is not registered as a trademark or geographical indication and does not

30 Commercial Code of Ukraine no 436-IV of 16 January 2003 (amended 15 November 2024) <<https://zakon.rada.gov.ua/laws/show/436-15#Text> > accessed 25 November 2024.

31 Case no 910/15222/18 (Supreme Court of Ukraine, 10 March 2021) <<https://reyestr.court.gov.ua/Review/95567204>> accessed 25 November 2024.

coincide with a commercial name. Almost every business entity wants to be represented on the Internet, and for this purpose, a website is used, the domain name of which usually duplicates the relevant brand (which is not protected as a named means of individualisation, in particular, as a trademark). Thus, in this case, the domain name acquires the legal regime of another commercial designation and, therefore, may be protected by the procedure established by the legislation "On Protection against Unfair Competition". However, in this case, the domain name is a form (method) of use of the "other commercial designation" and is not an independent object of protection in these legal relations.

The Supreme Court, in its Resolution of 18 August 2021 (Intellectual Property Chamber), emphasised that the "designation" itself is not an independent object with a specially provided status, which gives rise to certain rights and obligations and, therefore, does not have specific (special) protection. This was also discussed above in this article. The Supreme Court notes that according to the competition law, namely, Article 4 of the Law of Ukraine "On Protection against Unfair Competition", a designation (including a domain name that reflects such a designation) receives protection in competitive relations and not as an independent intellectual property object. At the same time, the critical issue will be business entities' good faith/bad faith use of such designation.³²

We consider the position of the Supreme Court to be debatable but formally correct since the few references to another commercial designation in the Law of Ukraine, "On Protection against Unfair Competition," and the Civil Code of Ukraine determine the use of another commercial designation as an object of competitive relations rather than intellectual property rights. Therefore, the rights to it can only be enforced within the framework of competitive relations by appropriate remedies, and consequently, it is possible to apply to both the court and the Antimonopoly Committee. Undoubtedly, this approach has significantly narrowed the possibilities for owners of commercial designations (including domain name owners) to enforce their rights since the possibility of the plaintiff (complainant, applicant) to refer to the provisions of the Civil Code of Ukraine on intellectual property is excluded. Consequently, this approach encourages owners of digital commercial designations to register these as trademarks, granting them better legal protection.

4.3.3. The right to apply to the Antimonopoly Committee of Ukraine

The owner of the rights to a domain name may file a complaint with the Antimonopoly Committee in case of violation of the legislation on unfair competition. However, in such a case, it should be clearly stated what exactly is the violation of the complainant's domain name rights since, as mentioned above, a domain is not an independent object of protection but is only a form of use of a trademark, other means of individualisation, or a form of use of another commercial designation.

32 Case no 922/1966/18 (Supreme Court of Ukraine, 18 August 2021) <<https://reyestr.court.gov.ua/Review/99087668>> accessed 25 November 2024.

In this case, the subject of the appeal must be the owner of a trademark certificate, the owner of rights to another means of individualisation (or another person who legally owns intellectual property rights to these objects), or the owner of rights to another commercial designation, who must also have the status of a business entity. In this case, the complainant must additionally prove the existence of rights to the domain name in which the relevant intellectual property right or other commercial designation is expressed. The owner of a website is the account holder who sets the website's terms of use. The website's owner is presumed to be the registrant or the recipient of hosting services.³³ Therefore, the applicant must prove that he or she is the registrant, pays for hosting services, or provides other evidence of ownership of a particular website. Usually, business entities are rarely the registrants of a domain name; instead, the registrant is an individual close to the relevant business entity, a person related to it. Therefore, it is vital to demonstrate the applicant's connection with a particular domain name, in defence of which proceedings are initiated before the Antimonopoly Committee.

Thus, by the decision of the Administrative Board of the Kyiv Regional Territorial Department of the Antimonopoly Committee of Ukraine dated 20 September 2016, No. 43, the unlawful use of the designations "REHAU" and "REHAU" in the domain name without the permission (or consent) of LLC "REHAU", which had previously started using them in its business activities, was addressed. The Defendant was obliged to cease infringement of trademark rights within two months by removing the domain name <http://rehau.kiev.ua/trademarks> "REHAU" and "REHAU".³⁴

The application for enforcement to the Antimonopoly Committee is primarily related to the facts of unfair competition, which results in the likelihood of confusion among consumers (buyers, clients) between the activities of the owner of a certain commercial designation (trademark, other means of individualisation or other commercial designation) and the activities of a business entity that illegally uses such designations, including in its domain name.

For competition to exist and for a complaint to be filed with the Antimonopoly Committee, several conditions must be met: the respondent's business activities must be identical and have the same geographic region of operation. If these conditions are not met, no competition exists between business entities, and there are no grounds to file a complaint with the Committee. It is important to note that a website is not always used for commercial purposes. Therefore, we believe that if a domain name refers to a website used for non-commercial purposes, it cannot be protected, in particular, as another commercial designation in the framework of the proceedings of the Antimonopoly Committee.

33 Law of Ukraine no 2811-IX (n 26).

34 Case no 975/33-p-02-05-16, Decision no 43 (Administrative Board of the Kyiv Regional Territorial Department of the Antimonopoly Committee of Ukraine, of 20 September 2016) <<http://www.amc.gov.ua/amku/doccatalog/document?id=84156&schema=kyivr>> accessed 25 November 2024.

Of course, in cases involving the protection of rights to trademarks, other means of individualisation, and other commercial designations used in domain names (and the dispute concerns the termination of the use of such a domain name by the infringer), geographical boundaries may disappear or be an optional condition for protection, since the digital environment (the Internet) has no formal borders. However, in this case, the complainant must prove that its activities, which are covered on a particular website with a particular domain name, extend to the entire territory of Ukraine. In this case, the geographical factor of the competition may be levelled.

In the course of consideration of cases by the Antimonopoly Committee concerning unfair competition involving the use of signs in a domain name, the Antimonopoly Committee authorities, having established the fact of the violation, may decide to bring the guilty person to justice by imposing a fine. However, the Committee is not authorised to oblige the infringer (the Respondent) to cease using the domain name, nor are they permitted to re-delegate the domain name or cancel its registration. The application of these remedies is the prerogative of the court, or some of them (re-delegation, cancellation of domain name registration) may be applied as part of the domain name dispute procedure in accordance with the UDRP.

The Antimonopoly Committee considers cases to stop unfair competition. Therefore, this procedure for protecting domain name rights is rather limited regarding possible remedies. Among the positive aspects of the proceedings before the Antimonopoly Committee are the possibility of establishing the fact of infringement as well as the creation of prejudice for further prosecution of the infringer in court.

5 APPLICATIONS OF THE UDRP POLICY

5.1. UDRP Policy: General Remarks

Domain names are vital for digital identity and can lead to disputes when they conflict with trademarks, and UDRP is a globally accepted mechanism for dealing with issues such as cybersquatting and unauthorised control of domain names.³⁵ The commercial significance of domain names is directly reflected in the disputable situations, and a domain name portfolio needs to be the strongest intellectual property asset to promote and support a business and protect its online identity.³⁶ The practice of resolving domain disputes by the judiciary shows that the proceedings may take more than one year, during which the right holder may suffer significant financial and reputational losses.

35 Christopher Gibson, 'Domain Name Arbitration' in Simon Klopschinski and Mary-Rose McGuire (eds), *Research Handbook on Intellectual Property Rights and Arbitration* (Edward Elgar 2024) 200.

36 Almosova Shahnoza, 'Analysis of Problematic Issues between Domain Names and other Means of Individualization' (2024) 4(2) *International Journal of Law And Criminology* 73, doi:10.37547/ijlc/Volume04Issue02-13.

WIPO and ICANN proposed a more balanced approach to resolving this category of cases under the UDRP Policy, which focuses on proving the bad faith nature of the domain name registration. The UDRP is a private international procedure for resolving domain disputes efficiently, primarily conducted online with simple rules, which makes it easy to understand.³⁷ The UDRP is characterised by a high level of regulation of all aspects of filing a complaint, providing evidence and objections, and deadlines for issuing decisions.³⁸

Unfortunately, as of today, this domain name dispute resolution mechanism applies solely to domain names that reflect trademarks. UDRP is only a mechanism for prompt protection of trademark rights.³⁹

According to Konstantinos Komaitis, domain names should be separated from trademark law (in the context of protection of rights), and the *sui generis* right should be extended to them.⁴⁰ Bulat N. also states that the resolution of domain disputes should protect rights to trademarks and other objects—a commercial name, a geographical indication, the name of a world-famous person, a previously registered domain name.⁴¹ We support a broader approach, as it would enable the protection of domain names as independent objects while safeguarding the rights to other objects (including intellectual property rights reflected in it) within the framework of a domain dispute.

In 2023, WIPO received more than 6,200 applications filed by brand owners to resolve domain name disputes under the UDRP procedure—an increase of more than 7% compared to 2022.⁴²

There is another opinion that arbitration procedures (UDRP) are not always effective, which necessitates going to court.⁴³

Neither domestic law nor domestic justice is ready to deal with cases related to domain disputes, because in practice they face the problem of clarifying judicial jurisdiction and the impossibility of applying the rules of international law.⁴⁴ Therefore, resolving a domain dispute under the UDRP has its advantages.

37 Olena M Skazko, 'Legal Framework for the Domain Name Dispute Resolution in Ukraine' (PhD thesis, Research Institute of Informatics and Law of the National Academy of Legal Sciences of Ukraine 2021) 167.

38 *ibid* 191.

39 MV Petriv, 'The Procedure for Resolving Domain Disputes' (2023) 78(1) Uzhhorod National University Herald, Series: Law 203, doi:10.24144/2307-3322.2023.78.1.32.

40 Komaitis (n 5) 39.

41 Nataliia Bulat, 'Comparative Legal Characteristics of Measures of Protection against Cybersquatting Established by Administrators of .UA and .UKR Domains' (2024) 5 Journal of Kyiv University of Intellectual Property and Law 19, doi:10.32782/chasopyskiivp/2024-5-3.

42 'WIPO ADR Highlights 2023' (WIPO, 2024) <<https://www.wipo.int/amc/en/center/summary2023.html>> accessed 25 November 2024.

43 SA Tsybizova, 'Legal Regulation of Domain Names: European Experience' (2024) 1 Irpin Legal Chronicles 52, doi:10.33244/2617-4154.1(14).2024.51-60.

44 Alla Diduk and Stepan Lytvyn, 'Domain Disputes: Problematic Aspects' (2021) 2(59) Scientific works of National Aviation University, Series: Law Journal "Air and Space Law" 128, doi:10.18372/2307-9061.59.15606.

Compared to court proceedings, the UDRP offers several advantages:

- a) It supports a large number of domain zones, including the .UA and COM.UA domain zones - UA-DRP.⁴⁵
- b) Cases are typically resolved in approximately 60 calendar days.
- c) The arbitrators who decide the case are experts in the relevant field.
- d) Decisions are executed promptly, with implementation occurring 10 days from the decision date.
- e) Cases are generally decided in absentia (unless the arbitrators decide, as an exception, that a face-to-face hearing is necessary to decide the case).
- f) Available remedies including re-delegation or cancellation of the domain name (for the .UA domain zone - only re-delegation is permitted).
- g) All correspondence is conducted electronically.
- h) electronic payments.
- i) The domain name registrar cannot be involved in the dispute, as the UDRP does not consider the registrar to be a party to the dispute (the registrar may be requested to provide the necessary information).
- j) The procedure provided by the UDRP is out-of-court and does not preclude the case from being brought to court.

At the same time, the UDRP Policy and Rules cover only those domain name disputes in which there is a conflict between a domain name and a trademark and do not address disputes related to the conflicting use of domain names and other intellectual property rights. Under the UDRP Policy and the UDRP Rules, domain name disputes should be considered through the prism of enforcement against unfair competition and compliance with the principle of good faith.

Domain name disputes concerning .UA domains under the UA-DRP procedure may be considered exclusively by the WIPO Arbitration and Mediation Center.

The main advantages of the UA-DRP procedure over judicial proceedings are the certainty of the place of consideration of the case, the possibility of quick domain blocking, prompt receipt of information about the domain owner, and the term of consideration of cases up to three months.⁴⁶

Despite its procedural advantages, the UDRP cannot be considered a type of international commercial arbitration, primarily due to the following reasons:

- a) An absence of an arbitration agreement between the applicant and the domain name registrant.
- b) The parties may not, at their discretion, agree on the procedure for appointing an arbitrator or arbitrators.

45 UA-DRP (n 10) Rules.

46 AV Khodosh, 'Domain Name Disputes arising from Trademark Infringements: Possible Ways of their Resolution' (2021) 10 Juridical Scientific and Electronic Journal 185, doi:10.32782/2524-0374/2021-10/45.

- c) The language of the dispute cannot be determined by the parties.
- d) Unlike commercial arbitration awards, all UDRP awards are published in the public domain.
- e) An arbitral award may be challenged in court only on the grounds specified by law, while the UDRP and court proceedings on the merits are substantively independent.

5.2. Stages of domain name dispute resolution under the UDRP

We note that the UDRP procedure for resolving domain name disputes consists of the following stages:

- a) Filing a complaint: The Complainant submits a complaint to an organisation authorised by ICANN.⁴⁷ The subject of the complaint may be one or more domain names, provided they belong to the same registrant—usually, such situations arise when one person owns several similar domain names that contain the complainant's trademark.
- b) Respondent's reply: The domain name registrant has 20 days to submit a response. If the Respondent fails to do so, the dispute shall be further considered based on the available materials (as per Clause 5(e) of the Policy).
- c) Panel appointment: A panel of one or three experts is appointed to review the case.
- d) Deciding and notifying all interested parties.
- e) Implementation: The domain name registrar executes the decision, which may result in refusing the claims, cancelling the registration, or transferring the domain name to the complainant.

The Complainant's complaint must also indicate the Complainant's decision as to whether the dispute should be heard by a one- or three-arbitrator panel. Suppose the Applicant decides to proceed before a one-arbitrator panel. In that case, the Respondent must indicate whether it is necessary to have the dispute resolved by a three-arbitrator panel (Paragraph 5(b)(iv) of the Rules). If there is a disagreement between the parties to the dispute regarding the number of arbitrators (the Complainant wants one, the Respondent wants three), then the Respondent is obliged to pay half of the fee for considering the dispute.⁴⁸

47 'Rules for Uniform Domain Name Dispute Resolution Policy' (ICANN, 21 February 2024) <<https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en>> accessed 25 November 2024. These Rules are in effect for all UDRP proceedings in which a complaint is submitted to a provider on or after 31 July 2015.

48 *ibid.*

5.3. Bad faith domain name registration as a ground for satisfaction of a complaint in a domain name dispute

The UDRP identifies the following conditions of unfair domain name registration, which, if established by the Panel, lead to a decision to satisfy the complaint:

- a) identity (or similarity) of the domain name and trademark;
- b) the registrant has no rights (interests) in the domain name;
- c) bad faith in registering and using a domain name (clause 4(a) of the Policy, clause 3(a)(ix) of the Policy).⁴⁹

Unlike the UDRP, the UA-DRP formulates the third element of bad faith more dispositive: the domain name was registered **or** used in bad faith.⁵⁰ A sign of a domain dispute is the registration or use of the domain name in bad faith.⁵¹ To some extent, this approach narrows the scope of proof for the complainant, as it is necessary to prove only one unlawful, bad-faith action of the Respondent (registrant): either bad-faith registration of the domain name or its bad-faith use.

During the proceedings, the applicant must **prove the existence of each of the three elements**. Let us consider them in more detail.

The first element of the UDRP is the identity (or confusingly similar) of the domain name and the complainant's trademark.

This provision involves comparing the domain name and the trademark (verbal part). The purpose is to assess the recognizability of the trademark within the contested domain name. In the event of a coincidence (including the dominant element) of a trademark and a domain name, they will be considered confusingly similar.

A domain name that contains a trademark misspelled intentionally is also treated by arbitrators as confusingly similar to the trademark. This is because the domain name contains recognisable aspects of the respective trademark.

Given the peculiarities of the Internet's global nature, the jurisdiction in which the trademark was registered is irrelevant for arbitrators when assessing the first element.⁵²

49 *ibid.*

50 Policy for Resolving Disputes Regarding Domain Names in the .UA domain (entered into force on 1 November 2024), see: UA-DRP (n 10).

51 Skazko (n 37) 43.

52 Case no D2007-1629 *Hoffmann-La Roche AG v Relish Enterprises* (WIPO, 17 December 2007) <<https://www.wipo.int/amc/en/domains/decisions/html/2007/d2007-1629.html>> accessed 25 November 2024.

Geographical indications used only in their ordinary meaning, except for their registration as a trademark, do not give rise to proceedings under the UDRP.⁵³

The transliteration or translation of a trademark that is reflected in a domain name may also indicate their similarity to the point of confusion.⁵⁴

Arbitrators usually do not consider the relationship of the website content to the domain name when assessing similarity under the first element.

The second element of the UDRP states that the registrant has no rights (interests) in the domain name.

To confirm rights (legitimate interests) in a domain name, the Respondent can prove the following:

- a) Bona fide use (preparation for use) of the domain name prior to the date of filing of any dispute notice;
- b) The Respondent was known to a wide range of persons under the domain name in question, even without holding any trademark rights; or
- c) Lawful non-commercial or fair use of the domain name without intent to obtain commercial advantage by luring consumers, misleading them or discrediting the trademark or service mark to which the rights are claimed.⁵⁵

When assessing the second element of the UDRP, arbitrators identify and consider the following factors:

- a) The purpose behind using the domain name, determining whether it serves a legitimate purpose or is intended as a means for the Respondent to obtain commercial benefit;
- b) Whether it is transparent to Internet users visiting the Respondent's website that the applicant does not operate the website;
- c) Whether the Respondent tried to avoid registration of domain names corresponding to the marks owned by the applicant or third parties;
- d) The presence or absence of a link (including explanatory text) to the trademark owner's website; and
- e) Whether the Respondent has warned individuals by email (but whose messages are intended for the Complainant) that the message was sent to the wrong recipient;

53 Case no D2000-0617 *Kur- und Verkehrsverein St Moritz v StMoritz.com* (WIPO, 17 August 2000) <<https://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0617.html> > accessed 25 November 2024.

54 Case no D2004-0279 *Compagnie Générale Des Etablissements Michelin - Michelin & Cie v Graeme Foster* (WIPO, 25 May 2004) <<https://www.wipo.int/amc/en/domains/decisions/html/2004/d2004-0279.html>> accessed 25 November 2024.

55 Case no D2012-2006 *B-Boy TV Ltd v bboytv.com c/o Whois Privacy Service / ChiefRocka LTD, formerly named BreakStation LTD* (WIPO, 23 November 2012) <<https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2012-2006>> accessed 25 November 2024.

- f) The presence or absence of a connection between the Applicant's trademark and the relevant content of the website under the disputed domain name; and
- g) Whether the registration of the domain name and its use by the Respondent consistently complies with the pattern of good faith activity, both online or offline.⁵⁶

If certain persons (intermediaries, distributors, etc.) use a domain name that contains the Complainant's trademark, but such activity is in good faith (such as trading the Complainant's goods, repairing such goods, providing services for such goods), they may be granted the right to use the domain name. In doing so, the following circumstances are taken into account, which must be present in the aggregate (the so-called Okidata test):

- a) The Defendant must offer the goods or services in question;
- b) The Defendant must use the website to sell only goods or services labelled with the respective trademarks;
- c) The website must accurately disclose the registrant's relationship with the trademark owner; and
- d) The Respondent should not attempt to "lock the market" in domain names that reflect the trademark.⁵⁷

The prior registration of a trademark corresponding to a domain name usually supports to prove the Respondent's good faith, however does not automatically confer rights or legitimate interests on the Respondent, since when considering the case it should be established whether the registration of the trademark is not aimed at circumventing the application of the UDRP rules.⁵⁸

Using a domain name for illegal activities (e.g., selling counterfeit goods or illegal pharmaceuticals, phishing) cannot confer rights and legitimate interests on the respondent. Cybersquatting is an unethical practice that involves parties acquiring domain names related to well-known brands and companies, intending to exploit their reputation for their own gain.⁵⁹

The third element of the UDRP states that the domain name is registered and ("or" for UA-DRP) used in bad faith.

56 Case no D2015-1128 *Philip Morris USA Inc v Borut Bezjak, A Domains Limited* (WIPO, 11 September 2015) <<https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2015-1128>> accessed 25 November 2024.

57 Case no D2001-0903 *Oki Data Americas, Inc v ASD, Inc* (WIPO, 6 November 2001) <<https://www.wipo.int/amc/en/domains/decisions/html/2001/d2001-0903.html>> accessed 25 November 2024.

58 Case no D2000-0847 *Madonna Ciccone, p/k/a Madonna v Dan Parisi and "Madonna.com"* (WIPO, 12 October 2000) <<https://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0847.html>> accessed 25 November 2024.

59 Gaytri Devi and Muskan Vats, 'The Threat of Cyber Squatting: Understanding the Risks of Digital Identity Theft' (SSRN, 3 August 2024) <<https://ssrn.com/abstract=4915086>> accessed 25 November 2024.

Bad faith means parasitism on the Complainant's trademark. The trademark confers advantages, and therefore the unlawful (without the permission of the right holder) use of these advantages by the Defendant is unlawful. The Complainant must prove that their rights have been violated. Paragraph 4(b) of the UDRP provides for instances that constitute evidence of bad faith on the part of the Respondent:

- a) the Respondent registered or purchased the domain name not for actual use, but for sale to the Complainant or a competitor of the Complainant;
- b) the Respondent registered the domain name to prevent the trademark owner from registering;
- c) the Respondent registered the domain name with the intent to disrupt the business of a competitor; or
- d) using a domain name to attract users to own website, who, by mistake, through misleading, have visited this particular site, believing it to be the site of the owner of a certain trademark that is reflected in the domain name.

The circumstances of the case may indicate that the Respondent, by registering a domain name (reflecting a "foreign" trademark), intended to make a profit, which indicates the Defendant's bad faith. Such cases include:

- a) the Defendant's alleged knowledge of the complainant's rights;
- b) distinctiveness of the complainant's trademark;
- c) the model of improper registration by the Defendant;
- d) threats to post objectionable content on a website that is offensive to the trademark;
- e) threats to sell the domain to third parties who offer a high price;
- f) the Respondent's inability to provide a reliable justification for the domain name registration;
- g) past behaviour or business operations; and
- h) after receiving a notification from the Complainant about the violation of their rights, committing actions that aggravate the fact of the violation, such as registration of additional domain names that reflect the Complainant's mark.

In particular, if the disputed domain name is identical or similar to a well-known trademark, arbitrators will not consider the Respondent's arguments regarding the ordinary registration of the trademark, as such actions are directed against the trademark owner.⁶⁰

Given the foregoing, if the Respondent has a right or legitimate interest in the domain name, they can sell it and an offer to sell that domain name will not constitute evidence of bad faith for purposes of the UDRP.

60 Case no D2015-0379 *Revevol SARL v Whoisguard Inc / Australian Online Solutions, Domain Support* (WIPO, 18 May 2015) <<https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2015-0379>> accessed 25 November 2024.

Refusal to use a domain name does not prevent the detection of bad faith under the doctrine of passive abstention.

5.4. Domain name dispute resolution in accordance with the UDRP

Domain disputes are disputes that are resolved online using technical means and most often do not involve direct (including visual) contact between the parties.⁶¹ The Panel shall render its decision based on the applications and documents submitted following the UDRP Policy and any rules and principles of law it deems appropriate. If the Panel consists of three arbitrators, the Panel's decision shall be made by a majority vote. The Panel's decision shall be made in writing and shall contain the grounds on which it is based, as well as the date and names of the arbitrators, and then it is sent to the parties, to the public domain administrator and the respective Registrar.

Within three business days of receipt of the decision in the case, the relevant Registrar shall notify each Party and the Authorised Organisation of the date of execution of the decision made by the UDRP Policy.

The consideration of the case under the UDRP procedure does not prevent the interested party from initiating legal proceedings and protecting the rights to the domain name in court. Suppose the Panel decides that it is necessary to delete or re-delegate the domain name registration. In that case, the Authorised Organisation shall wait ten business days after receiving the notification from the Authorised Organisation of the decision of the Administrative Panel before implementing such decision.

In other words, the deadline for appealing a decision under the UDRP procedure is ten business days from the decision date, after which it will be enforced. At the same time, the obligation to prove the fact of applying to the court is imposed on the party who will file a claim with the national court.

6 CONCLUSIONS

Domain disputes are a common category of cases that can be resolved both in and out of court. Difficulties in resolving domain disputes are caused by the legal uncertainty of a domain name as an object of civil rights. Their legal nature and regulatory framework remain undefined, as no specific law governs domain names. While the CC of Ukraine and other legislative acts mention domain names, they do not establish a clear legal regime for their exercise.

61 OO Izbash, 'Mediation and Alternative Dispute Resolution Online' (2022) 1 Kyiv Law Journal 80, doi:10.32782/klj/2022.1.12.

In this regard, domain name rights are protected through other objects reflected in the domain name, such as trademarks, commercial names, geographical indications, copyrighted objects, or personal names. At the same time, a domain name functions as an independent object subject to sui generis law, granting special property rights to the administration and use of a particular website. These rights are transferable and can be waived.

Domain name disputes may be resolved in court or out of court. The practice of resolving domain disputes under the UDRP Policy is widespread. However, a notable drawback is the possibility of resolving only those domain disputes that relate to trademarks reflected in domains. The resolution process focuses solely on proving the unfair nature of domain name registration, which significantly limits the possibility of applying the UDRP to resolve domain name disputes.

To improve the legal regulation governing domain disputes, the Law on Marks should be amended to introduce a provision allowing trademark certificate owners to apply special methods of protecting their rights. This would enable more effective enforcement in cases where a trademark or a similar designation is used in the domain name without authorisation. Specifically, it is advisable to supplement Article 20 of the Law on Marks with the following provision: “The owner of the certificate may also demand the re-delegation of a domain name in which his trademark or designation specified in paragraph 5 of Article 16 of this Law has been used without his consent.”

This amendment would expand the list of special methods of protecting trademark rights and eliminate legal uncertainty regarding domain name redelegation. Courts sometimes perceive such claims critically due to the absence of explicit legal provisions allowing this method of protection.

It is also advisable to supplement Article 21 of the Law on Marks with a provision on the possibility of protecting trademark rights in the arbitration procedure for resolving domain disputes in accordance with the UDRP. Currently, the law permits the protection of trademark rights only through courts or other procedures established by law, without expressly recognising arbitration for domain disputes. To eliminate this legal gap, it is necessary to provide the owner of the trademark certificate with the opportunity to protect their rights in the procedure provided for by the UDRP, including UA-DRP in particular. This approach would provide legal legitimacy to Panel decisions in domain name disputes.

REFERENCES

1. Bontlab VV, 'Civil Law Regulation of Domain Names' (PhD thesis, Taras Shevchenko National University of Kyiv 2006).
2. Bulat N, 'Comparative Legal Characteristics of Measures of Protection against Cybersquatting Established by Administrators of .UA and .UKR Domains' (2024) 5 Journal of Kyiv University of Intellectual Property and Law 16, doi:10.32782/chasopyskiivp/2024-5-3.
3. Bulat NM, 'The Main Ways of Existing Legislation Improvement Concerning Domain Names Protection' (2020) 31-1(2) (70) Scientific notes of Taurida National VI Vernadsky University, Series: Juridical Sciences 74, doi:10.32838/2707-0581/2020.2-1/14.
4. Caruana C, 'The Legal Nature of Domain Names' (2014) 4 ELSA Malta Law Review <<https://www.um.edu.mt/library/oar/handle/123456789/124078>> accessed 25 November 2024.
5. Devi G and Vats M, 'The Threat of Cyber Squatting: Understanding the Risks of Digital Identity Theft' (SSRN, 3 August 2024) <<https://ssrn.com/abstract=4915086> > accessed 25 November 2024.
6. Diduk A and Lytvyn S, 'Domain Disputes: Problematic Aspects' (2021) 2(59) Scientific works of National Aviation University, Series: Law Journal "Air and Space Law" 128, doi:10.18372/2307-9061.59.15606.
7. Gibson C, 'Domain Name Arbitration' in Klopschinski S and McGuire MR (eds), *Research Handbook on Intellectual Property Rights and Arbitration* (Edward Elgar 2024) 200.
8. Izbash OO, 'Mediation and Alternative Dispute Resolution Online' (2022) 1 Kyiv Law Journal 80, doi:10.32782/klj/2022.1.12.
9. Khodosh AV, 'Domain Name Disputes arising from Trademark Infringements: Possible Ways of their Resolution' (2021) 10 Juridical Scientific and Electronic Journal 182, doi:10.32782/2524-0374/2021-10/45.
10. Komaitis K, *The Current State of Domain Name Regulation: Domain Names as Second Class Citizens in a Mark-Dominated World* (Routledge 2010) doi:10.4324/9780203849583.
11. Miguel Asensio P de, *Conflict of Laws and the Internet* (2nd edn, Edward Elgar Publ 2024).
12. Nekit K, 'Domain Name as an Object of Civil Rights' (2017) 23 Journal of Civil Studies 40.
13. Petriv MV, 'The Procedure for Resolving Domain Disputes' (2023) 78(1) Uzhhorod National University Herald, Series: Law 198, doi:10.24144/2307-3322.2023.78.1.32.
14. Shahnoza A, 'Analysis of Problematic Issues between Domain Names and other Means of Individualization' (2024) 4(2) International Journal of Law And Criminology 73, doi:10.37547/ijlc/Volume04Issue02-13.

15. Skazko OM, 'Legal Framework for the Domain Name Dispute Resolution in Ukraine' (PhD thesis, Research Institute of Informatics and Law of the National Academy of Legal Sciences of Ukraine 2021).
16. Smith GJH, *Internet Law and Regulation* (Sweet & Maxwell 2007).
17. Tsybizova S, 'Problems of legal regulation of domain names: the experience of the United States of America' (2023) 4 Law Review of Kyiv University of Law 169, doi:10.36695/2219-5521.4.2023.30.
18. Tsybizova SA, 'Legal Regulation of Domain Names: European Experience' (2024) 1 Irpin Legal Chroniclles 51, doi:10.33244/2617-4154.1(14).2024.51-60.
19. Varbanova G, 'Legal Nature of Domain Names' (2022) 1 Economics and Computer Science 54.

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АНОТАЦІЯ УКРАЇНСЬКОЮ МОВОЮ

Оглядова стаття

ПРАВОВИЙ РЕЖИМ ДОМЕННОГО ІМЕНІ ТА ПОРЯДОК ВИРІШЕННЯ ДОМЕННИХ СПОРІВ В УКРАЇНІ

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АНОТАЦІЯ

Вступ. *Спори стосовно доменних імен виникають щодо захисту прав на доменні імена. Їхня правова природа як об'єкта залишається невизначеною, що призводить до неоднозначності правового режиму доменного імені. Ця невизначеність створює проблеми для правоохоронних органів і впливає на процедури вирішення доменних спорів. Чинне цивільне законодавство України не роз'яснює належність доменних імен до системи об'єктів цивільних прав. Однак зростання ролі цифрового середовища значно підвищило важливість доменних імен, що сприяє виникненню спорів щодо їхнього володіння та використання.*

З урахуванням особливостей правової природи доменних імен застосовуються як судові, так і позасудові процедури захисту, хоча законодавство не передбачає спеціального порядку розгляду та вирішення спорів щодо доменних імен. Унікальною особливістю захисту прав на доменні імена є можливість ініціювання та вирішення доменного спору за UDRP без залучення державних інституцій, таких як суди чи органи Антимонопольного комітету. Відсутність належного законодавчого регулювання доменного імені як об'єкта та особливостей вирішення доменних спорів призвела до наукових дискусій.

Методи. *Основна мета статті – дослідити правову природу доменних імен та вивчити порядок вирішення спорів щодо них. У зв'язку з цим у роботі було вперше проаналізовано доменне ім'я як об'єкт, визначено його правову природу, схарактеризовано позицію ЄСПЛ, а також зроблено внесок у ширшу наукову дискусію щодо правової визначеності доменних імен. У дослідженні проаналізовано особливості судового та позасудового захисту прав на доменні імена. Встановлено, що такий захист може здійснюватися як у юрисдикційній (судовий порядок чи звернення до Антимонопольного комітету України), так і в неюрисдикційній формі. Далі в статті описано порядок вирішення спорів щодо доменних імен судом та Антимонопольним комітетом України, визначено основні проблемні моменти, пов'язані з цими процесами.*

Окрему увагу приділено науковому аналізу процедури вирішення спорів щодо доменних імен UDRP. У статті викладено основні етапи вирішення доменного спору за UDRP та роз'яснено зміст та особливості недобросовісної реєстрації доменного імені, яка часто є підставою для спорів. Згодом були сформульовані висновки стосовно вдосконалення правового режиму доменного імені, а також щодо порядку вирішення доменних спорів.

Результати та висновки. Доменні спори є поширеною категорією справ, які вирішуються як у суді, так і поза ним. Автор вважає, що труднощі у вирішенні доменних спорів викликані правовою невизначеністю доменного імені як об'єкта цивільних прав. На сьогодні права природа та правовий режим доменних імен не визначені законодавством. Спеціального закону, який регулює це питання, немає, і хоча Цивільний кодекс України та інші законодавчі акти згадують про доменні імена, вони не регулюють комплексно права, пов'язані з ними.

У дослідженні доведено, що у зв'язку з цим права на доменне ім'я захищаються за допомогою інших об'єктів, відображених у доменному імені, таких як торговельні марки, комерційні найменування, географічні зазначення, об'єкти авторського права, а також імена фізичних осіб. Автор обґрунтовує, що доменне ім'я є самостійним об'єктом, який може бути суб'єктом права *sui generis* і який надає власникам доменних імен (зокрема, реєстрантам) особливі майнові права на використання веб-сайту (адміністрування, користування тощо); ці права можна передати (за плату або безкоштовно) і від них можна відмовитися.

Також було встановлено, що спори стосовно доменних імен можуть вирішуватися в судовому або позасудовому порядку. Вважається, що практика вирішення доменних спорів за UDRP є поширеною. У той же час його недоліком, на який слід звернути увагу, є те, що він застосовується лише до спорів щодо торговельних марок, відображених у доменних іменах. Підхід до вирішення цієї проблеми ґрунтується виключно на доведенні недобросовісності реєстрації доменного імені. Обґрунтовано, що ці обставини суттєво звужують можливості застосування UDRP у вирішенні спорів щодо доменних імен. Для усунення цього обмеження автор пропонує доповнити Закон «Про знаки для товарів і послуг» спеціальним способом захисту: надання власникам свідоцтв на знаки для товарів і послуг права вимагати делегування доменного імені як додаткового способу захисту.

Ключові слова: доменні імена, інтелектуальна власність, торговельна марка, цифрове середовище, Інтернет, UDRP, недобросовісна конкуренція.