A DOMAIN NAME AND A TRADEMARK: A COMPARISON AND A RELATIONSHIP ACCORDING TO UKRAINIAN LEGISLATION

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Abstract: *In the contemporary information society, domain names constitute not only sets of symbols, but also means of Internet sources individualization. In this sense, they are similar to trademarks that are used for goods and services individualization. At the same time, according to Ukrainian legislation, there are some problems concerned with the relationship between a domain name and a trademark. The article presents a comparison of these two objects. It is argued that a domain name and a trademark are separate objects, which, besides similar, have some different qualities. It is also argued that a domain name is as valuable to its holder as a trademark is valuable to its one. That is why a conclusion is made that these two objects should have legal protection in equal measure without any priority.*

Keywords: *domain name, trademark, means of individualization, intellectual property, Ukrainian legislation*

INTRODUCTION

It is a well-known fact that a trademark is widely used for individualization of goods and services. This intellectual property object can be called traditional. It has a long history and is popular all over the world. At the same time, in the contemporary information society, the importance of a domain name is difficult to overestimate because the attendance of a website, its activity and popularity depend on to what degree a domain name is easy to remember and to what degree it is attractive to Internet users. Due to many websites contain advertisements of goods and services, act as online-shops, or are used with a commercial purpose in other ways, the popularity of a website is quite valuable. Therefore, a domain name is getting to become not only a set of symbols, but also a visit card of any Internet source, a means of its individualization.[1] Thus, a trademark is used for individualization of goods and services as well as a domain name is used for individualization of Internet sources.

Nevertheless, a domain name, in contrast to a trademark, continuous to be a 'new' object in Ukrainian legislation, and there are some legal problems concerned with the relationship between a domain name and a trademark. The legislation improvement requires legal researches. In particular, it is important to compare a domain name and a trademark. It enables to determine whether a domain name is just a way of using a trademark or a separate object that needs its own legal protection. It is also important to explore the relationship between a domain name and a trademark according to Ukrainian legislation in order to address the current situation and its possible changes.

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[1] See BULAT, N. Поняття брендового кіберсквотингу та шляхи боротьби з ним [A concept of a brand cybersquatting and ways to combat it]. *Вісник ОНУ імені І. І. Мечникова. Правознавство [Odesa National University Herald. Jurisprudence]*. 2018, Vol. 23, No. 1(32), p. 98.

The aim of the article is to compare a domain name and a trademark, to address their relationship according to Ukrainian legislation, and to propose solutions to legal problems related to this sphere.

1. A COMPARISON OF A DOMAIN NAME AND A TRADEMARK

According to Article 1 of the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services', a trademark is 'a sign by which goods and services of one person differ from goods and services of another person', and a domain name is 'a name used for addressing computers and resources on the Internet'.[2]

Comparing a domain name and a trademark, one can notice that these two objects are similar in a number of characteristics. The similarity gives an opportunity to make a conclusion that a domain name is very close to such a group of intellectual property objects as means of individualization, which traditionally include a trademark, a commercial name and a geographical indication.[3]

First of all, a domain name and a trademark have a common aim of use. Their main purpose is individualization of particular objects (goods, services and Internet sources).

Another common characteristic of a domain name and a trademark is that for their legal protection there is no importance of the creative nature of an obtained result. As it is known creative efforts of an author of an object, which is a means of individualization, have no sense for determining its legal regime. Means of individualization are results of an intellectual but not creative activity, and there is no such a subject as a creator in the relations that arise in connection with these objects.[4]

Consequently, rights to trademarks as well as to domain names do not include personal non-property rights, and only property rights constitute the content of the intellectual property rights to these objects.[5]

Despite the common characteristics, a domain name and a trademark are separate objects, and there is some difference between them.

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[2] The Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' of 15 December 1993 No. 3689-XII (Article 1).

[3] Although a domain name is not recognised as an intellectual property object by primary legislation, its legal nature is similar to this category. The intellectual efforts of a person are quite important in a domain name creation; the value of this object cannot be underestimated; the main purpose of using a domain name, which is to individualize a website, makes it similar to trademarks, commercial names and geographical indications. In addition, a domain name is recognised as an intellectual property object by the Concept of the State System Reforming of the Intellectual Property Legal Protection in Ukraine, which is a piece of subordinate legislation. Finally, many scientists have emphasised the similarity of domain name legal nature with other intellectual property objects. See BOIKO, D. *Правова природа доменних імен Інтернет [Internet Domain Names Legal Nature]*: the author's abstract dissertation for obtaining a scientific degree Candidate of juridical sciences: spec. 12.00.03. Kharkiv, 2005; BONTLAB, V. *Цивільно-правове регулювання доменних імен [Civil Regulation of Domain Names]*: the author's abstract dissertation for obtaining a scientific degree Candidate of juridical sciences: spec. 12.00.03. Kyiv, 2006; SHCHUROVA, I. *Доменные имена: понятие, осуществление и правовое обеспечение в предпринимательской деятельности [Domain Names: Definition, Realisation and Legal Enforcement in Business Activity]*. Moskva: YURKOMPANI, 2012.

[4] See KUBAKH, A. *Право інтелектуальної власності [Intellectual Property Law]*. Kharkiv: KhNAMH, 2008, p. 76.

[5] Ibid.

Firstly, while a trademark is used for individualization of goods and services, a domain name is used for the individualization of Internet sources. Therefore, a right to a domain name can belong to any person, not only to that who produces goods or provides services.[6]

Secondly, there are different requirements for signs used in trademarks and in domain names.[7]

Thirdly, while a trademark has a relative uniqueness, a domain name has the absolute one. In other words, to be registered as a trademark, a sign should be new in a particular country regarding to particular goods or services.[8] As for a domain name, it cannot be used for different Internet sources.

Consequently, fourthly, a holder of a domain name cannot transfer a right of using the domain name to another person with keeping this right for himself while as for a trademark this situation is possible.

Fifthly, a domain name holder, in contrast to a trademark one, usually has a unique right – he can provide a right of using domain names in 'his' domain zone by delegating appropriate domains of a lower level to other persons. The Ukrainian court practice calls a domain name delegation 'a process of providing an opportunity to use a certain domain name to a certain person'.[9]

Finally, there are different registrars of a domain name and a trademark and different procedures for a registration of these objects. While a trademark needs State registration, a domain name registration is carried out by a contract on a domain name registration.[10]

Analogous common features of means of individualization and domain names particularities were found by me while exploring a domain name as a means of Internet sources individualization.[11]

Thus, a domain name and a trademark are similar in many qualities. They can be related to the same group of intellectual property objects – means of individualization. At the same time, a domain name and a trademark are separate objects, and it is possible to find some differences between them.

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[6] See SERGO, A., GLADKAIA, E. *Правовое регулирование доменных имен* [Legal regulation of domain names]. *Хозяйство и право. Приложение [Business and Law. Annex]*. 2010, No. 3, p. 17.

[7] According to Article 5(2) of the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services', any signs (words, letters, numbers, illustrative elements, colours and their combinations) or any combinations of the signs can be objects of trademarks. At the same time, a domain name can contain only certain symbols (letters of an alphabet, Arabic numerals and a hyphen). It is also worth to notice that some exceptions of signs use related to a trademark according to Article 6(2) of the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' do not concern with a domain name. For example, it is impossible to register a trademark that contains only generic words, but a registration of such a domain name is allowed. See the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' of 15 December 1993 No. 3689-XII (Articles 5(2) and 6(2)); SERGO, A., GLADKAIA, E. *Правовое регулирование доменных имен [Legal Regulation of Domain Names]*, p. 17.

[8] See the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' of 15 December 1993 No. 3689-XII (Article 6(3)).

[9] The Decision of the Kyiv Commercial Court of 22 March 2016 in Case No. 910/28172/15.

[10] See SERGO, A., GLADKAIA, E. *Правовое регулирование доменных имен [Legal regulation of domain names]*, pp. 18–19.

[11] See BULAT, N. *Доменне ім'я як засіб індивідуалізації інтернет-ресурсів* [A domain name as a means of Internet sources individualization]. *Право і суспільство [Law and Society]*. 2020, Vol. 2, pp. 154–160.

Why is it important to emphasise the difference between a domain name and a trademark? In 2002 (it was the beginning of legal regulation of relations in a domain name sphere in Ukraine), Subparagraph 4 was added to Paragraph 2 of Article 16 of the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services'.[12] It established that using domain names confusingly similar to a trademark was recognised as using the trademark.[13] In fact, a domain name was considered not as a separate object, but merely as a means of using a trademark. This provision was modified in 2003, when it was established that using a trademark was using it on the Internet including using in domain names.[14] This norm was repealed in 2008. Instead of it, Subparagraph 2 was added to Paragraph 1 of Article 20 of the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services'.[15] It established a priority of trademarks over domain names (this priority will be explored below). The examination of the history of legal regulation in a domain name sphere in Ukraine demonstrates that the existing priority of trademarks over domain names arose from a misconception that a domain name is just a means of using a trademark. Despite the provision of Article 16(2)(4) was modified in 2003 and repealed in 2008, its influence is still observed. According to Ukrainian legislation, a domain name is no longer considered merely as a means of using a trademark. However, the misconception has generated an unequal status of domain names holders. That is why it is necessary to emphasise that a domain name and a trademark are separate objects. The difference between them leaves no room to consider a domain name as an object derived from a trademark.

2. THE LEGAL PROTECTION OF A DOMAIN NAME AND A TRADEMARK

Besides the difference explored above, it is possible to make another distinction between a domain name and a trademark in a legal sphere. While a trademark has its legal protection as an intellectual property object according to Ukrainian legislation, there is some ambiguity with the same status of a domain name.

Under Article 420 of the Civil Code of Ukraine, a trademark is included in a list of intellectual property objects.[16] The chapter 44 of the Civil Code of Ukraine provides its further protection.[17] A special law, which regulates the relations that arise in connection with acquisition and realisation of rights to trademarks, is the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services'.[18]

[12] See the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' of 15 December 1993 No. 3689-XII as Amended on 10 August 2002 (Article 16(2)(4)).
[13] Ibid.
[14] See the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' of 15 December 1993 No. 3689-XII as Amended on 25 June 2003 (Article 16(4)(4)).
[15] See the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' of 15 December 1993 No. 3689-XII (Article 20(1)(2)).
[16] See the Civil Code of Ukraine of 16 January 2003 No. 435-IV (Article 420).
[17] See the Civil Code of Ukraine of 16 January 2003 No. 435-IV (Chapter 44).
[18] See the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' of 15 December 1993 No. 3689-XII.

At the same time, there is no appropriate legal protection of a domain name as an intellectual property object because it has no recognition in this status in primary legislation.[19] In fact, there are only two articles in the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' and two articles in the Law of Ukraine 'On Telecommunications' where a domain name is mentioned in primary legislation. Article 1(15) of the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' provides a definition of a domain name and Article 20(1)(2) of this Law establishes a priority of trademarks over domain names.[20] As for the Law of Ukraine 'On Telecommunications', it also has some definitions (Internet address, Internet address space, domain, domain .UA, second level domain) and contains norms about the administration of address space of the Ukrainian Internet segment.[21]

Along with that, legal regulation of relations in a domain name sphere is provided by subordinate legislation, but it concerns with domain zones administration issues and generally does not clarify the legal nature of a domain name.[22] Only in the Concept of the State System Reforming of the Intellectual Property Legal Protection in Ukraine, a domain name is considered as an intellectual property object. In this Concept, domain names with such objects as genetic resources, traditional knowledge and folklore are mentioned in reference to a necessity of legal protection of 'non-traditional intellectual property objects and other results of intellectual activity'.[23] However, the Concept does not contain any other norms related to domain names.

Due to legal regulation in a domain name sphere is insufficient, there is uncertainty about considering a domain name as an intellectual property object. As it is known, to be an intellectual property object, an object should meet the next requirements: to be a result of intellectual creative activity and to be recognised as an intellectual property object by a law.[24]

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[19] See BULAT, N. Поняття та ознаки доменного імені [The concept and features of a domain name]. In: *Development of modern technologies and scientific potential of the world*: coll. of scientific papers «ΛΌГОΣ» with materials of the international scientific-practical conference. London: NGO "European Scientific Platform", 2019, Vol. 2, p. 34.

[20] See the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' of 15 December 1993 No. 3689-XII (Articles 1(15) and 20(1)(2)).

[21] See the Law of Ukraine 'On Telecommunications' of 18 November 2003 No. 1280-IV (Articles 1 and 56).

[22] See the Resolution of the Cabinet of Ministers of Ukraine 'On Approval of the Procedure of a Connection to Global Networks of Data Transfer' of 12 April 2002 No. 522; Mode of Executive Authorities Websites Operation of 25 November 2002 No. 327/225; The Decree of the Cabinet of Ministers of Ukraine 'On the Administration of the Domain '.UA' of 22 July 2003 No. 447-p; The Resolution of the Cabinet of Ministers of Ukraine 'On Approval of the Ordinance on the National Registry of Electronic Information Resources' of 17 March 2004 No. 326; The Decree of the Cabinet of Ministers of Ukraine 'On Approval of the Concept of Telecommunications Development in Ukraine' of 7 June 2006 No. 316-p; The Resolution of the Cabinet of Ministers of Ukraine 'Some Issues of Domain Names Use by State Authorities in the Ukrainian Internet Segment' of 21 October 2015 No. 851.

[23] The Concept of the State System Reforming of the Intellectual Property Legal Protection in Ukraine (Section 4(24)) Approved by the Decree of the Cabinet of Ministers of Ukraine of 1 June 2016 No. 402-p.

[24] See PIDOPRYHORA, O. Загальні положення про право інтелектуальної власності [General provisions about intellectual property law]. In: DZERA, O., KUZNIETSOVA, N., LUTS, V. (eds.). *Науково-практичний коментар Цивільного кодексу України [Scientific and Practical Commentary on the Civil Code of Ukraine]*. 5th rev. ed. Kyiv: Yurinkom Inter, 2013, Vol. 1, p. 709.

There is no doubt that a domain name is a result of intellectual activity because its creating requires some intellectual efforts.[25]

However, as for the second requirement to a domain name to be an intellectual property object, i.e. as for its recognition in this status by a law, it should be noticed that the situation in Ukraine is not clear.[26] On the one hand, a domain name is recognised as an intellectual property object by the Concept of the State System Reforming of the Intellectual Property Legal Protection in Ukraine, which is a piece of subordinate legislation.[27] In addition, the European Court of Human Rights in the case Paeffgen v Germany made a conclusion inter alia that a right to a domain name constituted a 'possession' in sense of the Convention for the Protection of Human Rights and Fundamental Freedoms.[28] It is worth to notice that regulation of relations in an intellectual property law sphere falls within the scope of Article 1 of Protocol 1 of the Convention for the Protection of Human Rights and Fundamental Freedoms.[29] It is also worth to notice that in Ukraine the Convention for the Protection of Human Rights and Fundamental Freedoms and the European Court of Human Rights practice are sources of law.[30] Therefore, a domain name should be considered as an intellectual property object. Nevertheless, on the other hand, from the decision of the European Court of Human Rights mentioned above the legal nature of a domain name is not clear. It is held that a right to a domain name constituted a 'possession' (the last-mentioned concept includes intellectual property), but whether a domain name should be classified as an intellectual property object is still an issue for discussion. In addition, a domain name is not recognised as an intellectual property object by Ukrainian primary legislation.

It represents that there is a gap in Ukrainian legislation, which makes the legal nature of a domain name uncertain and its protection difficult.

The problem of a domain name recognition as an intellectual property object exists not only in Ukraine, but also in other jurisdictions. For example, in Russian legislation domain

[25] Based on a dictionary definition, an intellectual activity can be determined as an activity, for which a working body is a brain, the cost of mental energy prevails, and a product of the activity is a thought (an idea) expressed in a form suitable for a transfer to other persons or for an embodiment into something. See ARHIPOV, A. (ed.). *Экономический словарь [Economic Dictionary]*. 2nd ed. Moskva: RG-Press, 2017, p. 266. This is the very activity required for creating a domain name. See BULAT, N. Поняття доменного імені як об'єкта права інтелектуальної власності [The concept of a domain name as an intellectual property object]. In: *Тенденції і перспективи розвитку інститутів права та держави [Trends and Prospects for the Development of Law and State Institutions]*: collection of proceedings of the International legal scientific and practical conference 'Topical Jurisprudence', materials of All-Ukrainian scientific readings in memory of academician S. Dnistrianskyi. Kyiv-Ternopil: VPTs 'Ekonomichna dumka', 2018, p. 70.

[26] BULAT, N. *Поняття доменного імені як об'єкта права інтелектуальної власності [The concept of a domain name as an intellectual property object]*, p. 70.

[27] See the Decree of the Cabinet of Ministers of Ukraine 'On Approval of the Concept of the State System Reforming of the Intellectual Property Legal Protection in Ukraine' of 1 June 2016 No. 402-p.

[28] See the Decision of the European Court of Human Rights of 18 September 2007 in Case PAEFFGEN GMBH against Germany (Application Nos. 25379/04, 21688/05, 21722/05, 21770/05).

[29] See COUNCIL OF EUROPE/EUROPEAN COURT OF HUMAN RIGHTS. Internet: case-law of the European Court of Human Rights. In: *European Court of Human Rights* [online]. 2015 [2019-08-05]. Available at: <www.echr.coe.int/Documents/Research_report_Internet_ENG.pdf>.

[30] See the Law of Ukraine 'On the Fulfillment of Decisions and Application of Practice of the European Court of Human Rights' of 23 February 2006 No. 3477-IV (Article 17).

names are mentioned in Articles 1484(2) and 1519(2) of the Civil Code of the Russian Federation, which establish that exclusive rights to use a trademark or a geographical indication may be exercised through using them on the Internet including using in domain names and by other ways of addressing.[31] It is obvious that such provisions can neither regulate all the issues related to a domain name sphere nor ensure appropriate legal protection for a domain name. Along with that, it is worth to notice that in a draft of Part 4 of the Civil Code of the Russian Federation a domain name was provided with legal protection as an intellectual property object.[32] However, in the final version these provisions were not included. As Ekaterina Gladkaia noticed, if a domain name had become a protected intellectual property object, this would had been a basis for further legislation improvement.[33]

Turning back to Ukrainian legislation, one can observe some preconditions for a domain name recognition as an intellectual property object. Firstly, it will correspond to the Concept of the State System Reforming of the Intellectual Property Legal Protection in Ukraine. Secondly, it will be in accordance with the decision of the European Court of Human Rights in the case Paeffgen v Germany, which is a source of law in Ukraine. Finally, the legislature should not ignore the fact that a domain name is a result of intellectual activity and is as valuable and popular as other means of individualization. All of this makes necessary to fill the gap in Ukrainian legislation at the legislative level in a strict sense (in primary legislation) by a clear affirmative response to a question whether a domain name is an intellectual property object.[34]

3. THE PRIORITY OF TRADEMARKS HOLDERS' INTERESTS OVER DOMAIN NAMES HOLDERS' ONES

Another problem arises in connection with the relationship between a domain name and a trademark. As it is provided by Article 20(1)(2) of the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services', 'Using the signs and symbols referred to in Article 16(5) of this Law in domain names without a consent of a certificate owner is also considered as a violation of his rights'.[35] Under Article 16(5) of the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services', these signs and symbols include ones that are the same as or similar to a registered trademark if they are used in reference to goods and services, which are the same as or similar to those listed in a trademark owner's certificate.[36] Based on a complex analysis of Articles 20 and 16 of the Law of Ukraine 'On Protection of Rights to

[31] See the Civil Code of the Russian Federation, Part 4 of 18 December 2006 No. 230- 3 (Articles 1484(2) and 1519(2)).

[32] See the Draft of the Civil Code of the Russian Federation, Part 4 of 23 March 2006 (Articles 1225 and 1542-1551).

[33] See GLADKAIA, E. *Правовой режим доменного имени в России и США [The Legal Regime of a Domain Name in Russia and the USA]*: dissertation for obtaining a scientific degree Candidate of juridical sciences: spec. 12.00.03. Moskva, 2014, p. 136.

[34] BULAT, N. *Поняття доменного імені як об'єкта права інтелектуальної власності [The concept of a domain name as an intellectual property object]*, p. 70.

[35] The Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' of 15 December 1993 No. 3689-XII (Article 20(1)(2)).

[36] See the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' of 15 December 1993 No. 3689-XII (Article 16(5)).

Trademarks for Goods and Services', it is possible to make the next observations. On the one hand, according to these provisions, the prohibition of using the relevant signs acts only if in domain names these signs can mislead consumers. For example, a holder of a domain name offers on his website goods (services) that are similar to those offered by a trademark holder.[37] On the other hand, to apply Article 20(1)(2) of the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services', there is no importance whether a domain name was registered in good faith or not.[38]

As for a possibility to balance this provision, it is worth to notice the following. According to Article 16(6)(2) of the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services', the exclusive right of a trademark holder to prohibit using a trademark does not extend to realisation of any right that arise before filling an application or declaring a priority related to the trademark.[39] Under Article 16(6)(5) of the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services', the exclusive right mentioned above also does not extend to a non-commercial sign use.[40] Despite domain names are not mentioned in these provisions, the latter are general and related to any sign. However, due to these norms are not special for regulation of relations in a domain name sphere, Ukrainian courts do not apply them while solving domain names disputes.[41]

It is likely that Subparagraph 7 was added to Paragraph 6 of Article 16 of the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' to make possible to protect rights directly to domain names. It establishes that the exclusive right of a trademark holder to prohibit using a trademark does not extend to using names or addresses in good faith.[42] Nevertheless, due to the ambiguity of such a statement, it is not clear what names (domain names or persons' names (the latter assumption seems more credible)) or what addresses (whether it may be IP addresses, i.e. domain names, or not) the legislature has meant.[43] As a result, Ukrainian courts do not apply the provision of Article 16(6)(7) of the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' while solving disputes and do not refer to this norm in their decisions.[44]

In fact, a domain name holder has very little possibility to protect his rights when they are challenged by a trademark holder. This situation can be called a priority of trademarks

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[37] BULAT, N. *Поняття брендового кіберсквотингу та шляхи боротьби з ним [A concept of a brand cybersquatting and ways to combat it]*, p. 102.

[38] See BULAT, N. Використання доменних імен і суміжних об'єктів: перспективи законодавчого вдосконалення [Domain names and contiguous objects use: prospects of legislation improvement]. *Правові новели. [Legal Novels]*. 2020, Vol. 11.

[39] See the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' of 15 December 1993 No. 3689-XII (Article 16(6)(2)).

[40] See the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' of 15 December 1993 No. 3689-XII (Article 16(6)(5)).

[41] See BULAT, N. *Використання доменних імен і суміжних об'єктів: перспективи законодавчого вдосконалення [Domain names and contiguous objects use: prospects of legislation improvement]*.

[42] See the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' of 15 December 1993 No. 3689-XII (Article 16(6)(7)).

[43] The ambiguity of this provision was considered by M. Dolotov. See DOLOTOV, M. Зворотне захоплення доменних імен та українське законодавство [Reverse domain name hijacking and Ukrainian legislation]. *Інформація і право [Information and Law]*. 2013, Vol. 1(7), p. 97.

[44] See BULAT, N. *Використання доменних імен і суміжних об'єктів: перспективи законодавчого вдосконалення [Domain names and contiguous objects use: prospects of legislation improvement]*.

holders' interests over domain names holders' ones.[45] This priority makes difficult or even impossible to protect the rights to a domain name registered in good faith.

It is obvious that the Ukrainian legislature aimed to protect trademarks holders' interests from possible violations by domain names registrants. With this purpose, relevant provisions were passed in other countries (the Anticybersquatting Consumer Protection Act in the United States, the Law concerning Abusive Registration of Domain Names in Belgium),[46] and some documents were designed to resolve domain name disputes according to arbitration proceedings. The brightest example is the Uniform Domain Name Dispute Resolution Policy (UDRP).[47] This document is based on the World Intellectual Property Organization's recommendations and approved by the Internet Corporation for Assigned Names and Numbers. It also aims to protect trademarks holders' interests, but, at the same time, the UDRP provides a possibility to keep the rights to a domain name registered in good faith.[48] It establishes two unlimited lists of circumstances that evidence domain names registrations made in bad faith and demonstrate the rights to and legitimate interests in domain names accordingly.[49]

Turning back to the priority of trademarks over domain names in Ukrainian legislation, it is worth to emphasise that the provisions, which establish this priority, are not fair and do not conform to the requirements of nowadays. Practically everyone who explores domain names from the angle of law pays attention to its value and usefulness.[50] It is obvious that in the current information society, a domain name is valuable to its holder to the same extent as a trademark is valuable to its one. Nevertheless, while a domain name is getting to become more and more popular, Ukrainian legislation does not protect it.

Considering practical aspects, one can notice that almost every court decision in Ukraine in domain name disputes aims to guarantee trademark holder's rights, and courts addressing these cases do not evaluate whether a domain name was registered in good faith or not. Along with that, the practical application of Article 20(1)(2) of the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' is related to another problem. The Ukrainian court practice is inconsistent on the question who is a violator of trademark holder's rights – a registrant or a registrar of a domain name. It is possible to distinguish at least three approaches to this issue.[51]

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[45] See BULAT, N. Правова регламентація відносин у сфері доменних імен в Україні: сучасний стан і перспективи [Legal regulations of relations in a sphere of domain names in Ukraine: modern status and prospects]. In: *Сучасний рух науки [Modern Movement of Science]*: proceedings of the 8th International Scientific and Practical Internet Conference. Dnipro, 2019, Vol. 1, pp. 238–239.

[46] See the Anticybersquatting Consumer Protection Act of 1996; The Law concerning Abusive Registration of Domain Names of 26 June 2003.

[47] See the Uniform Domain Name Dispute Resolution Policy of 26 August 1999.

[48] Ibid.

[49] Ibid., paragraph 4(b), (c).

[50] See CARUANA, C. The Legal Nature of Domain Names. In: *ELSA* [online]. [2019-08-05]. Available at: <www.elsa.org.mt/wp-content/uploads/2015/02/5.-Caruana-Claudio-The-Legal-Nature-of-Domain-Names.pdf>; GOYAL, H., PORWAL, M. India: Protection of Domain Name as a Trademark. In: *Mondaq* [online]. 14. 7. 2014 [2019-08-05]. Available at: <www.mondaq.com/india/x/327272/Trademark/Protection+of+Domain+Name+As+A+Trademark>; KOZHEMIAKIN, D. *Доменное имя в системе объектов гражданских прав [A Domain Name in the System of Civil Rights Objects]*: dissertation for obtaining a scientific degree Candidate of juridical sciences: spec. 12.00.03. Moskva, 2017, pp. 20–21.

[51] BULAT, N. *Поняття брендового кіберсквотингу та шляхи боротьби з ним [A concept of a brand cybersquatting and ways to combat it]*, p. 103.

1. A registrar as well as a registrant is recognised as a violator of trademark holder's rights.[52] For example, the High Specialised Court of Ukraine for Civil and Criminal Cases addressing the case No. 6-36781св12 noticed that a registrar had provided services to a registrant of a domain name and had violated a preferential right to use a trademark.[53] The Kyiv Commercial Court in the case No. 910/1185/15-г granted trademark holder's claims and prohibited a registrar from a violation of complainant's rights to the trademark by illegal delegating a relevant domain name to other persons. The court also obliged the registrar to cancel the domain name delegation.[54] The Kyiv Commercial Court of Appeal agreed with this conclusion.[55] The High Commercial Court of Ukraine ordered a retrial and emphasised a necessity to find out whether using the domain name had been in reference to the same (similar) goods and services as trademark holder's ones.[56] After finding that the goods provided on a respondent's website were of the same class that were listed in a trademark holder's certificate, the Kyiv Commercial Court prohibited the registrar from violation of complainant's rights to the trademark and obliged to cancel the domain name delegation.[57]

2. Only a registrant can be a violator of trademark holder's rights, and a registrar is not responsible for using relevant signs in domain names. Along with that, a registrar is a respondent in these cases and complainant's claims to a registrar about cancelling a domain name delegation or transferring a domain name to a complainant are granted.[58] For example, the Pecherskyi District Court in Kyiv in its decision (case No. 757/45200/16-ц) noticed that a registrar was not responsible for using domain names, but the registrar was authorised to amend registry data and to cancel a domain name delegation.[59] The Solomianskyi District Court in Kyiv addressing the case No. 760/21375/13-ц recognised a domain name registration as a violation of intellectual property rights. The court observed that transferring a domain name as a way to protect complainant's rights should be applied since it corresponded to the content of the violated rights, the nature of the violation and its consequences. In addition, this way is an effective means of complainant's rights protection from possible violations in the future.[60] The same conclusions were made by the Solomianskyi District Court in Kyiv in the cases No. 760/26510/14-ц and No. 760/21182/15-ц and the Kyiv Court of Appeal in the case No. 760/4672/14-ц.[61] It is worth

[52] Ibid.

[53] See the Determination of the High Specialised Court of Ukraine for Civil and Criminal Cases of 4 October 2012 in Case No. 6-36781св12.

[54] See the Decision of the Kyiv Commercial Court of 2 March 2015 in Case No. 910/1185/15-г.

[55] See the Resolution of the Kyiv Commercial Court of Appeal of 26 April 2016 in Case No. 910/1185/15-г.

[56] See the Resolution of the High Commercial Court of Ukraine of 16 August 2016 in Case No. 910/1185/15-г.

[57] See the Decision of the Kyiv Commercial Court of 8 December 2016 in Case No. 910/1185/15-г.

[58] BULAT, N. *Поняття брендового кіберсквотингу та шляхи боротьби з ним [A concept of a brand cybersquatting and ways to combat it]*, pp. 103–104.

[59] See the Decision of the Pecherskyi District Court in Kyiv of 30 November 2016 in Case No. 757/45200/16-ц.

[60] See the Decision of the Solomianskyi District Court in Kyiv of 25 November 2013 in Case No. 760/21375/13-ц.

[61] See the Decision of the Solomianskyi District Court in Kyiv of 24 December 2014 in Case No. 760/26510/14-ц; The Decision of the Solomianskyi District Court in Kyiv of 18 May 2016 in Case No. 760/21182/15-ц; The Determination of the Kyiv Court of Appeal of 5 October 2016 in Case No. 760/4672/14-ц.

to notice that granting claims against registrants and registrars the courts in these cases usually ordered to recovery legal costs only from registrants.[62]

3. A registrant alone is responsible for a domain name using. A registrar cannot be a violator of trademark holder's rights, and complainants' claims to registrars are not granted.[63] As the Shevchenkivskyi District Court in Kyiv noticed in its decision (case No. 761/39376/16-ц), a court should not take registrar's authorities and oblige a registrar to amend registry data.[64] The Kyiv Commercial Court addressing the case No. 910/14013/17 established that since a registrar was not a domain name user, complainant's claims to oblige the registrar to stop an illegal using of trademarks were not justified.[65] The same conclusions were made by the High Commercial Court of Ukraine (case No. 21/71).[66]

Answering a question who can be a violator of rights to trademarks, one should take into consideration that domain names are used by registrants and not by registrars. That is why only a registrant can be a violator of trademarks holders' rights. As for a registrar, he can participate the cases as a third party without separate claims.[67]

However, only legislation improvement is able to solve the issue. Courts in Ukraine have to apply legislation. Therefore, in a situation of a lack of norms related to a domain name sphere, the courts cannot fill the legislation gap themselves and their practice is continuing to be inconsistent. As it is obvious, the provision of Article 20(1)(2) of the Law of Ukraine 'On Protection of Rights to Trademarks for Goods and Services' is not only unfair as it establishes a priority of trademarks over domain names, but also insufficient as it cannot regulate all the issues that arise in connection with its application by courts.[68]

At the same time, in contrast to the legislative provisions, the Administrator of the domain zone .UA (Hostmaster Ltd) went to another extreme. The Administrator established that a private domain name of the second level in the domain zone .UA might be registered only by a person who has a right to a trademark and only if a declared domain name or its second-level component is the same as the trademark (its verbal part).[69] Therefore, there is no possibility to register a domain name of the second level in the domain zone .UA for a person who has not a trademark or whose trademark differs from the domain name he wants to register.[70]

Along with that, on 19 March 2019 the Administrator of the domain zone .UA approved the .UA Domain Name Dispute Resolution Policy (UA-DRP).[71] This document is a variation

[62] BULAT, N. *Поняття брендового кіберсквотингу та шляхи боротьби з ним [A concept of a brand cybersquatting and ways to combat it]*, p. 104. See, for example, the Decision of the Solomianskyi District Court in Kyiv of 18 May 2016 in Case No. 760/21182/15-ц.

[63] BULAT, N. *Поняття брендового кіберсквотингу та шляхи боротьби з ним [A concept of a brand cybersquatting and ways to combat it]*, p. 104.

[64] See the Decision of the Shevchenkivskyi District Court in Kyiv of 16 November 2017 in Case No. 761/39376/16-ц.

[65] See the Decision of the Kyiv Commercial Court of 13 October 2017 in Case No. 910/14013/17.

[66] See the Resolution of the High Commercial Court of Ukraine of 14 March 2006 in Case No. 21/71.

[67] BULAT, N. *Поняття брендового кіберсквотингу та шляхи боротьби з ним [A concept of a brand cybersquatting and ways to combat it]*, pp. 104–105.

[68] Ibid., p. 105.

[69] See the Policy on Peculiarities of Registration of Second-Level Private Domain Names in the .UA domain of 1 April 2014 (Section 3(3)).

[70] See BULAT, N. *Поняття брендового кіберсквотингу та шляхи боротьби з ним [A concept of a brand cybersquatting and ways to combat it]*, p. 105.

[71] See the .UA Domain Name Dispute Resolution Policy of 19 March 2019.

of the UDRP. With some exceptions, it represents the UDRP provisions. The main difference is that according to the UA-DRP a trademark holder to satisfy his claims should prove that either registration or use of a domain name was made in bad faith, whereas according to the UDRP it is necessary to prove both.[72] As for the other provisions, the UA-DRP keeps relevant key norms of the UDRP.

However, the approving of the UA-DRP by the Administrator of the domain zone .UA cannot be considered as a coherent step due to the following. The UDRP and the UA-DRP accordingly provide a possibility to protect a domain name if its holder demonstrates the rights to and legitimate interests in the domain name.[73] In this context, it is not important for a domain name registrant to be a holder of a trademark. For example, according to Paragraph 4c(ii) of the UA-DRP, a domain name registrant being commonly known by the domain name can protect his rights even if he has acquired no trademark or service mark rights.[74] It is obvious that since there is a requirement for a domain name registration to have rights to a relevant trademark according to the Policy on Peculiarities of Registration of Second-Level Private Domain Names in the .UA domain, Paragraph 4c(ii) of the UA-DRP will not be applied. As for the other provisions of Paragraph 4(c) of this document, they also do not require to have a trademark registered to demonstrate the rights to and legitimate interests in a domain name.[75] However, due to the prohibition of a domain name registration by a person who has not rights to a relevant trademark, the UA-DRP will be applied in a very narrow context. In fact, its provisions will be used only when a domain name registrant is at the same time a trademark holder. Bearing in mind that the Policy on Peculiarities of Registration of Second-Level Private Domain Names in the .UA domain leaves no room for the 'full' use of the UA-DRP, it begs a question: with what aim was the latter document passed? Will it be used only with limitations or will it become the impulse for allowing a domain name registration irrespective of having rights to a relevant trademark? Time will answer this question.

Meanwhile, the situation should not depend only on the Administrator of the domain zone .UA. It is obvious that changes will be more effective on the legislative level and a domain name should be protected by law. To this purpose, it is necessary to improve Ukrainian legislation. Firstly, as it was mentioned above, a domain name should take its recognition as an intellectual property object in primary legislation. Secondly, there should not be any priorities of trademarks over domain names. It was indicated above that these objects are separate and they are valuable for their holders in equal measure. As it is argued by Anton Sergo and Ekaterina Gladkaia, 'The understanding of a domain name as a means of using a trademark on the Internet is not correct'.[76] That is why legal protection of a domain name and a trademark should be also equal and separate. To this purpose, it is necessary to cancel a priority of trademarks over domain names. It is also worth to pass the

[72] See WIPO Domain Name Dispute Resolution Service for .UA. In: *WIPO* [online]. [2019-08-05]. Available at: <www.wipo.int/amc/en/domains/cctld/ua/index.html>.

[73] See the Uniform Domain Name Dispute Resolution Policy of 26 August 1999; The .UA Domain Name Dispute Resolution Policy of 19 March 2019.

[74] See the .UA Domain Name Dispute Resolution Policy of 19 March 2019 (Paragraph 4(c)(ii)).

[75] See the .UA Domain Name Dispute Resolution Policy of 19 March 2019 (Paragraph 4(c)).

[76] SERGO, A., GLADKAIA, E. *Правовое регулирование доменных имен [Legal regulation of domain names]*, p. 26.

Law of Ukraine 'On Domain Names', which should ensure the appropriate legal protection for a domain name. As for trademarks protection from a domain name registration made in bad faith, the UDRP can be considered as an effective mechanism in this sense. That is why, while improving Ukrainian legislation, it is efficiently to have its relevant provisions as an example.[77]

CONCLUSIONS

A domain name and a trademark are similar in many qualities. At the same time, these objects are separate, and there are differences between them that leave no room to consider a domain name merely as a means of using a trademark or as an object derived from the latter. As for the relationship between a domain name and a trademark, there are some legal problems in this sphere. Firstly, a domain name has no recognition as an intellectual property object in primary legislation. The next point is that according to Ukrainian legislation there is a priority of trademarks holders' interests over domain names holders' ones. The provisions, which establish this priority, are unfair. In addition, as Ukrainian court practice demonstrates, they cannot regulate all the issues that arise in connection with their application by courts.[78] At the same time, the Administrator of the domain zone .UA in an attempt to regulate relations in a domain name sphere provides no possibility to register a domain name of the second level in the domain zone .UA for a person who has not a trademark or whose trademark differs from the domain name he wants to register.[79]

Nevertheless, this situation does not conform to the requirements of nowadays. As it was proved above, a domain name and a trademark are separate objects, which differ from each other. Therefore, their legal protection should also be separate without any priority. Moreover, in the present-day reality domain names are used for Internet sources individualization as well as trademarks are used for goods and services individualization. That is why legislation should provide protection for these objects in equal measure. To this purpose, firstly, it is necessary to fill a gap and to recognise a domain name as an intellectual property object in primary legislation. Secondly, it should be cancelled a priority of trademarks holders' interests over domain names holders' ones. Instead of this priority, to cope with a domain name registration made in bad faith, it is efficiently to use relevant provisions of the UDRP as an example while improving Ukrainian legislation. These measures should be reflected in the Law of Ukraine 'On Domain Names', which is necessary to pass. It would ensure the rights of domain names holders to the same extent as the trademarks holders' ones.[80]

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[77] See BULAT, N. *Правова регламентація відносин у сфері доменних імен в Україні: сучасний стан і перспективи [Legal regulations of relations in a sphere of domain names in Ukraine: modern status and prospects]*, pp. 240–241.

[78] See BULAT, N. *Поняття брендового кіберсквотингу та шляхи боротьби з ним [A concept of a brand cybersquatting and ways to combat it]*, pp. 103–105.

[79] See the Policy on Peculiarities of Registration of Second-Level Private Domain Names in the .UA domain of 1 April 2014 (Section 3(3)).

[80] See BULAT, N. *Правова регламентація відносин у сфері доменних імен в Україні: сучасний стан і перспективи [Legal regulations of relations in a sphere of domain names in Ukraine: modern status and prospects]*, pp. 240–241.