

Domain Name Disputes in Russia

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General information

- Conflict with the traditional regulation on identifiers, on the one hand, and with the domain name regulation system, based on a principle «*first come first served*», on the other hand
- Nowadays we have about 200 domain name disputes in Russia
- 90% cases – disputes in relation with .RU domain names, a few - in .ORG, .INFO, .COM, .SU
- Most cases are heard in arbitrage courts (Russian courts for commercial disputes)
- We have one court decision that abolishes WIPO Arbitration and Mediation Center decision - denso.com: the court recognizes that settlement of intellectual property disputes through the WIPO Center cannot be considered as an appropriate arbitration trial according to the Russian law



Applicable Law

- There is **no law which specifically** deals with the use of domain names, although we have laws protecting trade marks and protecting competition in business:
 - ✓ Part IV of the Civil Code of Russian Federation protects rights of a trade mark owner
 - ✓ Russian Law on Protection of Competition



Part IV of the Civil Code

Violation of the rights of a trade mark owner is constituted by a use without the permission of the owner, identifiers similar to his trademark with respect to the goods for the individualization of which the trademark was registered or goods of the same type, if as the result of such use a likelihood of confusion will arise, for example by the using of the trademark in a domain name or other methods of addressing.

Violation of the rights of an owner of a geographical indication is constituted by a use without the permission of the owner, identifiers similar to his geographical indications with respect to the goods for the individualization of which the trademark was registered or goods of the same type, if as the result of such use a likelihood of confusion will arise, for example by its using in a domain name or other methods of addressing.



Recapture Protection in Russian legislation

- Recapture – registration of a trade mark primarily to obtain a specific existing domain name from its current administrator who has registered and uses domain name in good faith before the registration of trade mark
- Identifiers cannot be registered as trademarks if they are the same as, or confusingly similar with domain name rights to which arose in the Russian Federation for other persons earlier than the priority date of the trademark registration (Part IV of the Civil Code)
- There is one court decision concerning recapture – firm named *Elec.ru, LLC vs. domain name elec.ru*
 - ✓ This court decision was made before the enactment of Civil Court Part IV



Violations of a Competition Law

Unfair competition including trade, exchange or other transactions, if its infringes intellectual property rights or any identifiers of legal persons, its services and goods (passing-off) - is not allowed



General trends in court decisions

- For judges domain name is frequently the only way to identify trade mark owner (and its goods or services) on the Internet
- In the court an unfair use of domain name (existence or absence any information on identical or confusingly similar goods or services trade mark is registered for) should be proven
- Often mere registration of a domain name could make that name “an instrument of fraud” and could be considered as passing off. Registration of such domain name could be annulled under court decision



Most common court decisions

Most common court decisions:

- Forbid using of a domain name
- Recognize the administration of a domain name as an infringement of trade mark, unfair competition, abuse of right and, as a consequence, – to forbid using of trade mark in the domain name



Practical example: dispute on domain name vw.ru

- Issue of a consideration:
 - ✓ Infringement of a trade mark owner rights
 - ✓ Unfair competition
 - ✓ Abuse of rights
- Court established that:
 - ✓ Domain names, that consists of trade mark or firm name, have a commercial value
 - ✓ Choosing and registration of vw.ru domain name and its offer for selling is a form of an unfair competition
 - ✓ The use of the domain name is damaging business reputation of the Plaintiff
 - ✓ Absence of any information on the site vw.ru is not sufficient evidence for its not using
 - ✓ The use of the trade mark in the domain name is an abuse of right



Acting of a Registrar during a litigation

- According TLD .RU Registration Terms & Conditions it is up to the user to consider whether the registration or use of the domain name leads to the infringement of any rights of third parties
- Registrar discloses administrators contact data, if there is a legitimate reason, on written request of the third party
- Any actions with a domain name are blocked during the domain name dispute («hold on» policy)



Acting of a Registrar after receiving court decision

- Decision to annul the domain name registration does not involve automatically registration of it for trade mark owner
- Since court decision comes into force, the administrator has no right to transfer the domain support to another Registrar. Registration cancellation or domain administration rights transfer to another person are forbidden, only if the actions are evidently directed to execute the court decision
- The person who won the case in the court has the priority right for the domain name registration



Perspectives of ADR/UDRP in Russia

- In Russia there is a low culture of using an alternative (arbitration) procedures
- A state fee for court consideration is lower than for arbitration (10 Euro vs. 1000-2000 Euros)
- Parties always have a right to appeal the arbitrational court decision on a state court
- There is a court decision that abolishes WIPO Arbitration and Mediation Center decision. Many judges are very concerned about UDRP decisions ...
- Coordination Center for TLD .RU continues to consider the possibility to introduce ADR/UDRP in Russia

Thank you for
attention!

Q&A?

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