

Some problems of judicial proceedings on domain disputes



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Abstract. The article deals with the main problems of judicial review of domain disputes. A complex of changes and additions to security measures on the Internet have been analysed. A method to overcome problems of judicial proceedings on domain disputes has been suggested.

Keywords: *domain names, domain disputes, judicial proceedings, judicial jurisdiction, proof, defendant, security for claim.*

Problem statement

Analysis of scientific researches dealing with the problems of the legal status of domain names on the World Wide Web testifies to the fact that modern civil law pays little attention to the judicial proceedings of domain disputes. Domain names have a complex legal nature for they are similar to trade marks (service signs), commercial (company) names, natural person's name and that often leads to legal collisions related to the rights for domain names and other similar objects of intellectual property law [1, p. 26]. This causes different application of legislation by courts in this sphere.

By registering a domain name the rightsholder of the brand can acknowledge the fact that it sounds similar to his brand, but is registered by another person. In this case, the parties engage in a domain dispute. Thus, a domain dispute is a dispute arising due to the legal nature (bad faith) of registration and using a domain name between the rightsholder of the domain name and another interested party (e.g. owner of the trademark certificate) (service mark).

One can say that domain disputes arise due to the infringement of the law called cybersquatting – seizure of domain names – registration of domain names that are the same or similar to brand with their further use in bad faith both for their own commercial aims and to resell them to the corresponding brand owners [2, p. 215].

In Ukraine, legal practice in the sphere of domain disputes is not yet widespread, however, every year the number is gradually growing. It may be related to the fact that solving domain disputes requires special knowledge in the sphere of exact sciences and information technologies. In fact, this is the most difficult issue for both the parties to the domain dispute, and the intermediaries trying to regulate it.

The position is open to discussion for even the court (or another person, or body) do not require an obligatory expert's opinion to prove the claims or objections of the parties when hearing cases of this kind. We consider that special knowledge in this case should be understood in a different way: what is meant is the technical understanding of the web site's functioning, differentiation of the technical functions of the registrant, registrar, and administrator of the Internet addressing space, technical possibilities to change the web site's owner, etc. A judge or a lawyer can have general technical knowledge, but it will be difficult to understand the technical details of some issues correctly.

Analysis of the latest researches and publications

Legal nature issues and the definition of domain names in the system of intellectual property law objects were researched by the following scientists: Boiko D.V., Bontlab V.V., Hrytsai V.I., Ennan R.Ye., Kalyatin V.O., Kodynets A.O., Korshakova O.M., Kulinich O.O., Maidanyk N, Milyutin Z.Yu., Nesterovych S., Sergo A.G., Kharitonova O.I. and others. However, the specific character of judicial proceedings of domain disputes was insufficiently researched. Still, some researchers investigated in their works cases of infringement of rights for domain names and the order of their protection: Volina T., Gorkusha M., Zerov K., Nagornyak G., Neznamov A., Nosik Yu., Sklyarov R., Tarasenko L. and others. A characteristic feature of researches of this kind is the fact that the problems the parties to the domain dispute face are described from the practical point of view and the authors attract the readers' attention to the deficiencies of national justice. Moreover, numerous problems on the specific character of judicial proceedings on domain disputes remain still unsolved.

The **aim** of this article is to determine the main problems of judicial proceedings on domain disputes and to offer ways of their settlement.

Statement of basic materials Despite the availability of two forms of protection of infringement of rights (jurisdictional and non jurisdictional), the most widespread and the

most effective mechanism of protecting intellectual property rights in the context of domain disputes are judicial proceedings. However, one can apply Alternative Dispute Resolution methods as well.

Taking into account the novelty of cases related to domain disputes, Ukrainian courts are practically not ready to hear them for the national legislation does not regulate the concrete procedure of hearing domain disputes by any of the mechanisms of protecting infringed rights (including judicial protection), and there is no Uniform Dispute Resolution Policy (UDRP) to resolve domain disputes for the .UA domain zone.

Thus, judicial protection of rights related to the use of domain names has some problems that are manifested in many aspects. Let us dwell on some of them.

Let us define court jurisdiction of domain disputes. Most often, such disputes in Ukraine arise on the basis of protection of rights for a trade mark (service sign) and commercial (company) name, that is why they are heard in commercial courts, as a rule, at the location of the registrant of the domain name. Other cases of this kind are heard in courts of general jurisdiction.

It might be easier to prove that somebody illegally uses another person's commercial (company) name in the domain name because the intellectual property right for the commercial (company) name is valid from the moment it is first used and is protected without obligatory application for it

or its registration irrespective of the fact whether the commercial (company) name is part of the trade mark (service sign).

However, in this case the court can ask the person who claims his rights were infringed to prove he really uses the commercial (company) name. The evidence to prove the validity of using the commercial (company) name is determined separately in each particular case. For instance, Kyiv Commercial Court of Appeal in its resolution of 14.12.2009 p. № 20/590 ruled that

“On the territory of Ukraine the plaintiff uses the shortened commercial name “MICHELIN” and it is proved by the materials of the case [evidence], namely: copies of the account for the delivery of tyres to the territory of Ukraine, Analytical report from the project “Surveying the level of awareness of the “MICHELIN” trade mark” of the company IFAK in June 2009, articles from mass media and an Internet article that the appellate court’s board of justices considers proper and ample evidence.

Thus, the plaintiff’s right for the commercial name *Compagnie Generale des Etablissements Michelin – MICHELIN & Cie* and correspondingly for the shortened commercial name “MICHELIN” that is a derivative of the full name is protected on the whole territory of Ukraine.

One should also pay attention to the people participating in domain disputes. Usually, they are the administrator, the registrant, and the registrar of domain names.

Administrator is the company administering the addressing space of the Ukrainian segment of the Internet network. It is understood as: “... a complex of organizational and technical measures necessary to provide for the functioning of technical means of maintaining addressing including servers of domain names of the Ukrainian segment of the Internet network, .UA domain register in coordination with the international system of administering the Internet network directed at systematization and optimization of use, accounting and administration of second level domains, as well as creation of conditions to use the domain name space on the principles of equal access, protection of the rights of Internet service customers and free competition” (part

1 of article 56 of the Law of Ukraine “On telecommunications”) [3].

However, some researchers claim that administrator’s functions are now performed by Hostmaster Ltd. – a company founded by natural persons [4]. Yet, according to legislation in force (part 3 of article 56 of the Law of Ukraine “On telecommunications”) [3]: “Administering the addressing space of the Internet network in the .UA domain shall be performed by a non-governmental organization that is formed by self-governing organizations of Internet operators / providers and shall be registered according to international requirements”.

Registrant is a person that has exclusive right for the domain name for a period it is registered for. Registrant’s data are in the “admin-c” field of the “WHOIS” protocol and its main application is to obtain registration data on the owners of domain names, IP addresses and autonomous numbers in the Internet network.

It should also be mentioned that the field “admin-c” often includes another person, not the one who obtained the right to use the domain name, for instance, it can be a company employee who registered the domain name, hosting company, etc. In this case, they have the right to use the domain name and to avoid possible domain disputes it is recommended that the registrar be the person using it.

According to paragraph 2.7.2. of the .UA domain Regulations a registrar is a business entity rendering services to the registrant that are necessary for the technical provision of delegation and functioning of the domain name. Registrars function on the basis of a contract with the administrator of the public domain. The official list of registrars in the domain names .UA, .COM.UA, .KIEV.UA is on the site of the administrator of the domain zone .UA – Hostmaster Ltd. According to the principles of activity of Hostmaster Ltd., the service realization scheme of .UA ccTDL and public 2DL must be two-level, the registrars are in economically equal conditions, fairly compete with each other and work directly with the end user. Thus, a registrar is a person the registrant directly addresses to register a domain name. Moreover, this person may also re-delegate (transfer usage right as specified in paragraph 2.19 of the .UA

domain regulations) a domain name to another registrant.

It should be noted that these specified people form the parties to a litigation on the rights for a domain name. A separate issue in domain disputes is the choice of defendants for the majority of domain disputes are aimed at cancelling the delegation of the domain name with its further registration on the legal rightsholder.

Thus, with the proper parties to the litigation arising due to registration and the use of domain names, the participants are:

- *Plaintiff*: a person whose rights are infringed (in most cases – the owner of the trade mark (service sign) that is the same or easily confusable with the name used in the domain);

- *Defendant*: 1) user of the delegated domain names, i.e. a person in whose interests the domain name was registered with the use of disputable trade marks (service signs) – registrant; 2) registrar in case registrant and registrar are represented by one person;

- *Third party*: registrar as a subject who in case of claim adjustment shall perform actions to execute the resolution (cancellation of registration, change of domain holder, etc.).

There are discussions to involve the administrator as a defendant or a third party to participate in the disputes.

However, acquisition by a person of a processual status of a defendant, according to the law, is related not to the availability of jural relationships between the parties and the corresponding obligation of the defendant to perform certain actions in favour of the defendant or to forbear from their execution to protect and realize the rights and legal interests of the plaintiff, but only to the fact of bringing of a suit to the person.

At the same time, a proper defendant in the case is only a person having obligations to the plaintiff under the circumstances that form the subject of the claim. In other cases, claim adjustment is impossible for the defendant has no obligations to the plaintiff to stop infringing his rights and legal interests for he is not the person to be accountable for the disputable jural relationships.

Thus, in case the court ascertains that an action was brought in against the wrong party that has to be liable to the plaintiff in a material and jural relationship, then the court with the claimant's approval changes the wrong defendant for the competent one or disallows the claim due to absence of legal foundation.

Court rulings of the Superior Commercial Court of Ukraine testify to the fact that competent defendant in cases on the protection of intellectual property rights infringed as a result of registration and usage of domain names is the registrant, i.e. the person in whose interests the domain name was registered with the use of disputable signs for goods and services.

Thus, to properly settle disputes related to the infringement of intellectual property rights for goods and service signs by using their names in the domain names one needs to determine the immediate holder of disputable domain names, i.e. the person in whose interests the domain name was registered by means of using disputable goods and service signs. (The legal position of the Superior Commercial Court of Ukraine, resolution of 14.03.2006 in case №21/71).

Thus, administrator of the domain .UA Hostmaster Ltd. (or other administrators) are not the people to be responsible to the owners of trade marks (service signs) in cases on the protection of their intellectual property rights due to the registration and use of domain names that are easily confusable or the same.

According to part 2 of article 56 of the Law of Ukraine "On telecommunications" the domain's administrator is also not obliged to control the activity of registrars and registrants during the registration of a domain by means of checking each case of registration whether the rights of third parties have been infringed [3].

That is why the administrator's role at the stage of performing the decision is not completely understandable. Thus, Kyiv Commercial Court in its ruling of 30.11.2010 № 12/25-20/334 enacted that "under the given circumstances the court comes to the conclusion that the plaintiff's references to the Regulations of the .UA domain are unsubstantiated and unreasonable in the plaintiff's claim for the plaintiff and the

Hostmaster Ltd. have no contractual relations with the Regulations appended to them”.

Moreover, the court states that according to the Law of Ukraine "On telecommunications" defendant-2 as an authorized organization has no authority to make the decision on cancelling the delegation of private domain name in the public domain and to cancel the specified domain name [3].

Therefore, administrator's role as a defendant in domain disputes is still not fully determined.

Besides the parties, procedural participants of the court hearing include third parties without independent demands and with independent demands (are equal to a plaintiff) on the subject of the dispute. Moreover, third parties without independent demands include people whose rights and obligations in relation to one of the parties can be influenced by the court's decision.

The domain administrator, as it has been mentioned above, does not directly register domains. In case of claim adjustment on the transfer of the disputable domain the rightsholder of identical or easily confusable trade marks (service signs) / retention of the domain with the current owner (registrant) / cancellation of the domain registration for the current owner of the domain name (registrant) / etc., the administrator shall have no obligations towards the parties to the dispute (the right of the owner of the trade mark (service sign) and registrant) and such resolution shall have no influence on his rights.

Considering this, there is also no legal justification to include the domain administrator in the case as a third party without independent demands for the matter of dispute on the side of one of the parties.

What concerns domain registrars, they can be involved by third parties in the case, however, just like the administrator, they are not qualified defendants in cases of this kind.

Commercial courts usually apply provisions of the procedural legislation properly, taking into account the content of jural relationships of the administrator, registrar, and the registrant.

Thus, in case № 12/25-20/334 Google Inc. sued GOU OGLE Ltd., Hostmaster Ltd. to stop infringing intellectual property rights for

the commercial name and Kyiv Appellate Commercial Court in its resolution of 21.02.2011 opportunely called attention to the following:

according to part 2 of article 56 of the Law of Ukraine "On telecommunications" an authorized organization administers the addressing space of the Ukrainian segment of the Internet network [3].

Hostmaster Ltd. is an organization authorized to administer .UA domain and that can be verified by Agreement № 1/2001 on the transfer of administrative powers of 25.03.2001 concluded between Kokhmanyuk Dmytro Sergiyovych and Svrydov Ihor Anatoliyovych who were authorized to administer .UA domain according to ICANN rules and that fact is verified by information from the IANA/ICANN registration database in the record on the .UA domain and that information was part of the materials of the case on the side of one party and Defendant 2 on the other and are not disclaimed by Defendant 2.

In conformity with its statute, Hostmaster Ltd. determined its object of activities including the creation of organizational, technical, economic, informational and other conditions to provide for the registration of domain names by subjects of the Ukrainian segment of the Internet network as well as maintaining the functioning of these domain names in the global network.

Thus, part 4 of article 56 of the Law of Ukraine "On telecommunications" specifies that creation of addressing space, distribution and giving addresses, data routing between addresses shall be done in conformity with international requirements [3]. Thus, Hostmaster Ltd. as the domain administrator of the Ukrainian segment of the Internet network must keep to the international standards in the sphere of Internet.

The court ascertained that the rights of Google Inc. for the commercial name was infringed because GOU OGLE Ltd. used the plaintiff's commercial name in the domain name google.ua that was delegated to GOU OGLE Ltd.

Satisfaction of the Plaintiff's claim to GOU OGLE Ltd. to stop using the commercial name "Google" in the domain name google.ua

means restitution of rights of Google Inc. to use its commercial name in the domain name google.ua for discontinuance of usage includes discontinuance of delegation of the specified domain name to Hostmaster Ltd.

At the same time, the appellate court considered that the actions of Hostmaster Ltd. derived from the actions of those people who directly use the .UA domain name. That is why Hostmaster Ltd. did not infringe the rights of Google Inc., for it did not use disputable domain names and did not help others to do it. It only performed its duties mentioned in the contracts concluded with its contractors. Neither in the appeal, nor in the course of its hearing did the plaintiff prove that Hostmaster Ltd. infringed the rights of Google Inc. by its actions.

What concerns registration of the domain "Google" to Google Inc., it is only possible on the basis of the contract concluded between the Plaintiff's registrar and the administrator of the .UA domain and that is not a matter at issue in this case.

Thus, the finding of the trial court to dismiss the plaintiff's claims towards Hostmaster Ltd. is well grounded. Under the circumstances, the appellate court found no grounds to reverse or change the court's decision and to satisfy the appeal of Google Inc.

Secondly, there arise difficulties in the process of presenting evidence in domain disputes. Preparation of argumentation for this type of disputes has a lot of specific peculiarities and details.

The systematic analysis of the norms of the legislation in force and court practice testifies to the fact that the circumstance in proof in disputes, arising due to the registration and use of the domain names, includes the following circumstances:

- the domain name of the registrant of the disputable domain that is identical or easily confusable with the trade mark (service sign) for which the plaintiff has rights;

- the domain registrant has no rights for the trade mark (service sign) that corresponds to the domain name he registered in other classes of the international classification of goods and services;

- a disputable trade mark (service sign) was used in a disputable domain name on a

web site it is related to without sufficient legal justification, thus infringing the rights of the owner of the trademark (service sign), whose name corresponds to the disputable domain.

To settle the claim directed at the protection of the rights of the owner of the trademark (service sign) it is necessary to determine all the specified circumstances in general. Absence of at least one of the mentioned circumstances gives grounds to dismiss the claim.

Thus, in the process of hearing domain disputes by the national courts it is very important to pay special attention to the fact that the analysis of legislative provisions leads one to the conclusion that taking into account the legal matter of the trade mark (service sign), an obligatory condition of using the sign is its use with reference to the goods and services it was registered for.

Placement of a verbal sign, similar to the trade mark (service sign) for some goods and services, even in the .ua domain and on web site pages without producing goods and rendering services, for which the disputable trade mark (service sign) was registered, cannot evoke associations of the designation with goods and services of the person owning the relevant trade mark (service sign). Moreover, the use of the disputable designation in the Internet network for Ukraine can only be accepted in case of registration of the site that reproduces the trade mark (service sign) in the .ua domain. (The legal position of the Superior Commercial Court of Ukraine, resolution of 18.073.2006 in case №20/500).

In the process of collecting evidence for cases of this kind one needs to take into account the interpretation given by the Superior Commercial Court in paragraph 46 of the Resolution of the Plenum № 12 of 17.10.2012, according to which web pages in the light of the provision of part 1 of article 5 of the Law of Ukraine "On electronic documents and electronic documents circulation" are considered electronic documents that cannot be delivered to court, however, they can contain significant information on the circumstances of the case if they are objects of copyright or adjacent laws). Thus, taking into account part 1 of article 32, part 1 of article 36 as well as provision of part 1 of article 39 of the Code of

Commercial Procedure of Ukraine, the court takes into account the concrete circumstances of the case and is not deprived of the right to inspect and study the evidence in the place of their location with the record of corresponding procedural actions in the minutes that shall meet the requirements of article 811 of the Code of Commercial Procedure of Ukraine.

Correspondingly, the specific nature of the Internet as a sphere of functioning of domain names, as some researchers claim, leads to the fact that traditional means of evidence often become non-effective to record significant facts to resolve disputes; and vice versa, non-traditional means of evidence (e.g. documents in electronic form, e-mails) can characterize the state of jural relationships of the parties to the dispute in the best way [6, p. 311]. However, courts are very careful with this kind of evidence.

Thus, video and audio records of the investigation process can be used as evidence by any of the vested interests of the site that is known to be infringing copyright or adjacent laws; this record on an electronic or other medium (computer hard drive, floppy disk, laser sensing system disc, other information medium) is submitted to the court specifying when, who and under what circumstances made the record and then it can be used as a *corpus delicti* in the case. Written evidence can also be certificates obtained from providers and network search services.

Print-outs from Internet web sites cannot serve as evidence in a case. However, if the relevant documents were issued or attested by an institution or a specially authorized person having the power to do so according to an established form, adhibited by an official stamp on the territory of one of the member states of CIS, then in compliance with article 6 of the Treaty on the order of resolving disputes, related to performing economic activity of 20.03.1992 they have the evidential force of official documents on the territory of Ukraine.

T. Volina states that courts of general jurisdiction accept print-outs from the site. Commercial Courts do not regard it as evidence. That is why, in a commercial process the judge himself can view the information on the site (however, it can disappear until the court hearing), or one needs to turn for help to an expert. However,

expertise of this kind can be long-term and expensive. It would be cheaper to record the information on video and the Superior Commercial Court will consider it a proper evidence in the case [5].

Taking into account the number of issues that are to be cleared up, one may conclude that courts in the course of settling disputes do not have to restrict themselves to expert reports in the expertise they prescribe, but also determine in each particular case whether the court expert trespassed beyond his powers.

Court practice testifies to the fact that court experts often undertake the resolution of legal issues, though only the court has the power to do so.

Thus, incase № 21/462Kyiv Commercial Court on 25.11.2008 ruled that the defendant's actions referring to the use of .pegintron.com.ua and.schering-plough.com.ua domain names infringed the exclusive rights of SCHERING PLOUGH LTD for the goods and service signs, as attested by the Certificate for the goods and service signs № 5448 of 15.06.1994 and the Certificate for the goods and service signs № 22558 of 15.01.2002. The court accepted as main evidence the conclusion of the court expertise in the sphere of intellectual property according to which relevant designations that are protected by the plaintiff's Certificates are used on the corresponding site situated at a disputable domain address, and the information on the site with such a domain address can be confused with the activity of the plaintiff.

Moreover, the court did not analyse the content of the specified Conclusion, and based its decision on it.

Furthermore, in the process of hearing domain disputes to prevent the evidence of infringement of rights being destroyed the plaintiff should present a statement of claim and apply for a security for a claim.

The majority of Ukrainian courts do not apply international regulations. It is conditioned by the fact that according to article 4 of the Code of Commercial Procedure of Ukraine such norms are not introduced into the list of references that Commercial Courts base their decisions on when hearing disputes [8].

Only owners of registered trade marks (service signs) can protect infringed rights related to the use of the domain name. Therefore, Nahornyak H. and Sklyarov R. claim that Ukrainian courts tend to consider that protection should only be given to owners of registered trade marks (service signs), however, this does not include cases when a commercial name is well-known. Court decisions obliging to transfer the domain to the owner of the trade mark (service sign) have a reverse side as well. Taking into account the position of the court, a mala fide user has the possibility to "take over" the domain by registering a trade mark (service sign) with the same name, for the availability of a trade mark makes it highly probable the court will rule in favour of the certificate owner. Unfortunately, this course of events is possible not only in case the domain emerged prior to registration of the trade mark (service sign), but also before the sign emerged. In this case, the court will be governed by law, and the law forbids to illegally use trade marks (service signs). Moreover, the time of registration of the sign and the domain is irrelevant. Popular site owners cannot be sure of the safety of their domain name if the domain is not registered as a trade mark (service sign). Taking into account recent court decisions any person may demand transfer of the domain name it likes by simply registering a trade mark (service sign) with the same name [9, p. 224].

To overcome the above-mentioned and other problems of court hearings on domain names we suggest the following complex of changes and additions to the now available security measures in the Internet network.

1) *as to the anonymity of parties and their identification* – to introduce an obligatory check by registrars of domain names (web addresses) of data from the "whois" service that are used to direct requests to obtain information on the registration of the domain name as well as on the actual delegation of the web address to the client, thus checking the given information for registration in the context only, whether this information exists at all, but not the adequacy of the specified data;

2) *to protect the rights of owners of trade marks (service signs), whose names*

contain elements that can be used by evil-doers to advertise their products:

– to create a service monitoring identical domain names that can be similar to the registered trade marks (service signs) and inform the owners of the exclusive rights for the relevant names and designations about the revealed coincidences; it will improve the speed of reaction to the infringement of rights and will solve the problem of recording such similarity as far as the system itself will be able to inform the rightsholders in both electronic and written form with appropriately attested conclusion on the identity, known information on the owner of the similar web address;

– side by side with the provisions of the Internet Corporation for Assigned Names and Numbers (ICANN) and by introducing into the national legislation, the owner company of the .ua domain should create for web addresses in this and regional domain zones an electronic registry of web sites on the basis of the "whois" database with a further possibility for the web site owner to print out the relevant certificate extract that would serve as proof of the valid rights for the address specified in it and the validity of which (certificate) would be possible to check in court by comparing the certificate registration number and the entry of the web address in the register, full access to which would have only registrars and courts, as well as other authorized institutions. This approach simplifies the possibility to obtain a document certifying corresponding rights and simplifies the demonstrability of the specified data;

– enable regional registrars to settle domain disputes individually according to ICANN regulations provided both parties agree to this kind of settling the dispute, and to leave the alternative possibility to turn to court;

3) *with the aim of establishing the fact of reaching certain agreements which give rise to rights and duties of the parties to the jural relationships* – to introduce a separate service of "public protocol" with the help of which the person using the network would agree to recording the information on his stay on some web resources, and later on, if needed, could get an extract of the protocol of his actions on the Internet as well as attested print screens of his actions (agreements of the parties to

conclude a contract, discussion of the terms) as proof of the fact of entering internet jural relationships. Moreover, people participating in such jural relationships would be warned of the use of such a protocol by one of the participants and would then agree to use their certificate in this form, would get access to such information on the actions performed by them;

4) *to improve the efficiency and speed of evaluation of the evidence by court* – to guarantee the possibility for the court to study the evidence that is only electronic in form, to create system support for the court to check electronic signature certificates, to submit relevant materials only on the basis of their prior registration in the base of the Accredited centre of key certification as well as authentication by a signature with an enhanced certificate; to supplement part 1 of the article 111 of the Civil Processual Code of Ukraine with paragraph 8 in the following formulation: “storing electronic evidence submitted by the parties” and with paragraph 9: “check certificates verifying electronic signatures in the documents of the electronic circulation of documents submitted by the parties” [10, p. 3-4].

The authors of the research share the view on the suggested ways to overcome the problems of judicial proceedings on domain disputes. However, they consider that it is

more efficient to overcome these problems at the stage of registration of the domain names, the procedure of which can be improved by introducing the following ideas:

1) to introduce the procedure of checking the domain name that the registrant mentions during registration whether it is the same or similar to the registered trade marks by means of an automatic analysis of the Registry of trade marks that are in force on the territory of Ukraine and of the Database of international trade marks (service signs) functioning on the territory of Ukraine;

2) this procedure should be conducted by the Registrar. In case of registration of a domain name similar to the trade mark (service sign) the Registrar must bear responsibility together with the Registrant;

3) to introduce changes to the domain regulations and specify the order of involving the registrar as a defendant to cases related to illegal use of the trade mark (service sign) or a commercial (company) name, the rights for which belong to third parties [11].

Conclusion

In the process of the research we have come to the conclusion that neither native legislation, nor native justice are ready to hear cases related to domain disputes. In practice, courts face the problem of determining judicial jurisdiction and fail to apply the norms of international law. The plaintiff faces the problem of identification of the defendant, there are difficulties in evidence and the necessity to apply for a security for a claim. Most often, the plaintiff is only the owner of the registered trade mark (service sign).

One can overcome the available problems of judicial proceedings on domain disputes by improving the procedure of registration of domain names, thus making it impossible to infringe the rights of brand owners, of civil circulation participants, goods and services, and in case these rights are infringed it will lay the legal foundation to involve the registrant as a defendant together with other offenders.

This article dealt with the most problematic issues arising in the process of hearing domain disputes. No doubt, absence of adequate legislative regulation, incompetence of judges and other participants of the trial in the technical aspects, delegation, re-delegation, as well as functioning of domain names complicates the efficient hearing of cases. National courts, especially trial courts most often do factual errors having no necessary special technical knowledge that is essential in this sphere. That is why it seems plausible to introduce to court hearings on domain disputes relevant IT

specialists who will give qualified findings on the case. Furthermore, judges have to ascertain in each particular case whether an expert goes beyond his powers.

References:

1. Diduk A.H., Biloshitcka Y.M. Domain names in the system of objects of intellectual property rights: problems / Diduk A.H., Biloshitcka Y.M. // In: Small and medium business. (Right. State. Economy) / Economic, legal, scientific and practical journal. – 2016, № 1-2 (64-65). - P. 26-30.
2. Nagornyak G. Status and problems of the protection of information products as objects of copyright in the Internet / Nagornyak G. // In: Socio-economic problems and the state. – 2012. – Issue 2 (7). – P. 209-217 [Electronic source]. – Available at:
 1. <http://sepd.tntu.edu.ua/images/stories/pdf/2012/12nhsumi.pdf>
 2. About telecommunications: Law of Ukraine from 18.11.2003 № 1280-IV // In: Information from the Verkhovna Rada of Ukraine. – 2004. - № 12. – Article 155
 3. Protection of the name on the site: court practice in the field of domain disputes [Electronic source]. – Available at: <http://kmp.ua/ua/eksklyuziv/651-zahyst-imeni-na-sajti-sudova-praktyka>
 4. Volina T. Disputes over the name. Under what conditions the trademark owner will win a dispute with the domain registrar / Volina T // In: Law and business, 2015. - № 15 (1209) [Electronic source]. – Available at:
 5. http://zib.com.ua/ua/print/115629za_yakih_umov_vlasnik_torgovoi_marki_vigrae_spir_z_reestrant.html
 6. Nosik U.V. Contemporary jurisprudence regarding domain names / Nosik U.V. // In: Legal and political sciences: state and law. – Issue 45. – P. 309-315
 7. Незнамов А.В. Особенности компетенции по рассмотрению Интернет-споров: национальный и международный аспекты: дис. к. ю. н. 12.00.15 - гражданский процесс; арбитражный процесс / Незнамов Андрей Владимирович / Ural State Law Academy. – Yekaterinburg, 2010. – 229 p.
 8. Economic Procedural Code of Ukraine from 18.03.2004 p. № 1618-IV // In: Information from the Verkhovna Rada of Ukraine. – 2004.- № 40-41, 42. – Article 492
 9. Nagornyak G., Sklyarov R. Problematic issues of application of legal protection of objects of intellectual property rights / Nagornyak G., Sklyarov R. // In: Матеріали XVIII наукової конференції ТНТУ ім. І. Пулюя, 2014. – P. 223-224
 10. Gorkusha M.U. Prospects for solution Internet - dispute [Electronic source]. – Available at:
 11. <http://bulletin.uabs.edu.ua/store/jur/2012/f0d4f8adcf2b1d9b6fad2d809caf29be.pdf>
 12. The fourth module: trademarks on the Internet // In: Training materials for representatives of commercial courts within the framework of the project EC Twinning, 2016. – 39 c. [Electronic source]. – Available at: sips.gov.ua/i.../004-TRADEMARKS-UKR0416.pdf

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