



The existing experience and trends in judicial law enforcement practice

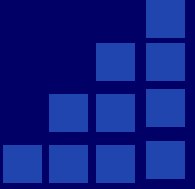
A presentation by Mariya Malysheva, TCI

**International conference for ccTLD registries and registrars of CIS, Central and
Eastern Europe**

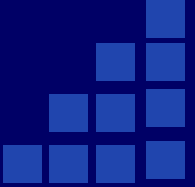
Greece, Creta, September 2013



ARE YOU SURE?



**Don't you want
to go to the
beach???**



There are 3 main criteria

for recognizing the domain name registration of unfair competition:

(Resolutions of the Supreme Commercial Court of the Russian Federation dated 11.11.2008 № 5560/08 and 18.05.2011 №18012/10)

- the domain name is identical or confusingly similar to the trademark of a third person;

AND

- the domain name holder does not have any legitimate rights and interests in respect of the domain name;

AND

- the domain name was registered and used in bad faith.



Assessment of identity or confusion similarity of the domain name with the trademark:

- Specifying the disputed item along with any other original element in the domain name can be recognized legitimate

HOLODILNIK-TSHOK.RU VS «HOLODILNIK» & «XOLODILNIK»

(Resolution of the Federal Arbitration Court of North-Western district dated 03.04.2013 on the case №A56-21873/2012)

- Using the domain name which does not have any additional elements can be recognized legitimate, if other signs are posted directly on the website

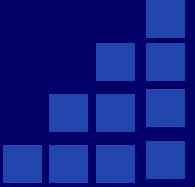
ASTRO777.RU VS «ASTRO7»

(Resolution of the Federal Arbitration Court of North-Western district dated 06.03.2013 on the case №A56-1448/2012)

- It is necessary to take into account the full domain name, including the zone designation (top level domain) when determining similarity of the domain name with the trademark

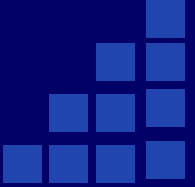
ЛУЧШИЕЛЮДИ.РФ VS «ЛУЧШИЕ ЛЮДИ РОССИИ»

(Resolution of the Federal Arbitration Court of Moscow district dated 24.11.2011 on the case №A40-152366/10-51-1282)



The legitimate rights and interests in respect of the domain name:

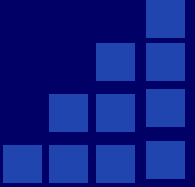
- If domain name holder has rights for the same trademark
 - domain name matching that of the same trademark, cannot be used for the classes of International (Nice) Classification of Goods and Services for the Purposes of the Registration of Marks, for which the trademark was registered (*Resolution of the Federal Arbitration Court of Ural district dated 13.07.2012 г. on the case №Ф09-5287/201212*)
 - registration of trademark, matching that of the same disputed domain name after the dispute does not give additional advantages to her holder – the priority is taken into consideration (*Resolution of the Federal Arbitration Court of Moscow district dated 27 сентября 2012 г. on the case №А40-62105/11-27-505, Resolutions of the Supreme Commercial Court of the Russian Federation dated 04.06.2013 г. №445/13*)
- Matching the domain name with the name and surname or the brand name



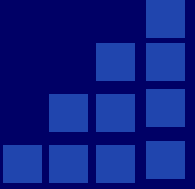
Bad faith use of the domain name:

(Resolutions of the Supreme Commercial Court of the Russian Federation dated 18.05.2011 г. №18012/10, Resolution of the Federal Arbitration Court of North-Western district dated 11.07.2012 on the case №A05-9458/2011, Resolution of the Federal Arbitration Court of Moscow district dated 02.11.2012 г. On the case №A40-4735/12-5-47, Resolution of the Federal Arbitration Court of Moscow district dated 25.10.2012 on the case №A40-73876/11-12-626)

- It does not matter whether the domain name holder uses his/her domain name for similar activities with the rightholder or not
- It does not matter for what particular purposes (commercial or non-commercial) use the domain name is used
- It does not matter that the domain name is not used
- the date of the domain name registration does not matter



- The Brand name has priority over the domain name (*Resolution of the Federal Arbitration Court of Central district dated 27.06.2012 on the case №A35-7580/2011*)
- As regards the rights the domain name which is similar to the brand name and the trademark belonging to different persons, the trademark holder has priority even if his/her rights arose later (*Resolution of the Federal Arbitration Court of Moscow district dated om 03.04.2012 on the case №A40-45986/11-110-369*)



- Registry's Terms and Conditions of Domain Names Registration in domains are recognized by the RF VAS as normative document
- The mandatory content of a judicial act: should be explicitly pointed to the necessity of fulfillment by the Registrar of actions for cancelling the registration
- Execution of judicial acts by non-state subjects - the registrars (without participation of the government agencies for compulsory execution)*

** In accordance with the Program of the efficient of execution (2011-2020) developed by the RF Ministry of Justice*



Domain names can get more or less effective legal protection only in case when they belong to the owner of similar «traditional» means of individualization.



The trademark holder has in fact absolute priority to use his/her mark as the domain name.



Questions?

Drop 'em at:

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