



# **TRADEMARK AND DOMAIN NAME INTERFACE: COMPARATIVE ANALYSIS OF THE LEGISLATION OF THE KYRGYZ REPUBLIC**

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## **ABSTRACT**

Internet has brought numerous challenges to the intellectual property legislation, and in particular, trademark law. Trademarks serve as a source of identifier of goods, while the domain name function through representing Internet Protocol addresses is the same. Both are registered on a first-come-first-served basis. Yet uniqueness of each string of alphanumeric characters as an Internet address and global nature of domain names differ from traditional trademark law features such as territoriality and specificity allowing similar trademarks co-exist for different classes of goods and services. These distinguishing features resulted in emergence of such phenomenon as “cybersquatting” and its numerous variations. The efficient mechanisms for trademark and domain name disputes resolution have been developed in the U.S. legislation and through Uniform Domain Name Dispute Resolution Policy elaborated by Internet Corporation for Assigned Names and Numbers.

The Kyrgyz laws regulating trademark and domain name interface are ill-equipped for settlement of such disputes. Therefore, amendments and adoption of new legal acts, guidelines and policies based on UDRP, laws and case law of other countries are necessary to establish efficient legislative framework regulating trademark and domain name disputes in .kg zone.

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## INTRODUCTION

The concept of intellectual property is very popular and important in the modern world, the same is happening with the Internet. The Internet is a special means of communication in terms of speed and scale. The endless possibilities of the Internet communication attract more people all over the world. Active use of the Internet has brought huge possibilities for entrepreneurs to get profit and growing number of consumers. Entrepreneurs are trying to register their inventions and get patents, their trademarks and service marks, in order to be protected, to be distinguished, to gain profit. Different international and national laws protect the rights of intellectual property owners. However, the development of the Internet brought the new issues with regard to intellectual property issues to be regulated on international as well as on national levels.

The development of the Internet accompanied some problems for the owners of intellectual property rights. Even though the Internet is considered to be the source for various types of violations, it proved at the same time to be huge market for businesses that could spread their goods and establish on the markets. The Internet is considered to be an indispensable tool for marketing of the companies, and thus has found special popularity among trademark owners. One of the ways to “establish” a market on the Internet is to register the domain name. Emergence of domain name system allowed registration of words or their combination, hence providing for individualization. Domain names became an intangible asset, which was similar to trademarks. However, this brought clashes between the real world and virtual one.

The most common court proceedings relating to the Internet are between trademark owners and domain name holders for the right to own particular domain name. Such type of domain name disputes started to first appear at the late 1990s, and that time gave rise to new type

of “entrepreneurial” activity, namely “cybersquatting” when one registered domain name as famous trademark with the aim of selling it to the trademark owner. However, not all trademark owners were willing to buy the domain names, especially when the price requested was too ridiculous, but refer to the courts. At that time when first cybersquatting issues arose there was no specific legislation regarding the dispute resolution of such cases, therefore, the courts were rendering various types of decision, which often contradicted each other or were unfounded.

In the 1997 World Intellectual Property Organization (“WIPO”) developed recommendations on domain name dispute resolution for top level domain names in order to solve the issue that was at the high peak. Later, on the basis of these recommendations, Uniform Domain Name Dispute Resolutions Policy (“UDRP”) was adopted, and TLDs such as .com, .net, and .org were covered under this policy.

Since this topic is relatively new in the country, the laws of the Kyrgyz Republic regulating trademark and domain interface need to have some amendments. Analysis of the current legislative framework is presented. The work is done in order to come up with possible recommendations for establishing efficient legislative framework in the field of trademarks and domain names. The interface of trademark and domain names in general is main focus of the present work, particularly, trademark and domain name dispute resolution.

Chapter I of this work explains the operation of domain name system as well as main features of trademarks and domain names. Also, it indicates the controversies that appear between the trademarks and domain names. In addition, the Chapter provides brief introduction into the basics of trademark law and its regulation in the Kyrgyz Republic.

Chapter II is specifically devoted to the UDRP that was approved by Internet Corporation for Assigned Names and Numbers (“ICANN”), which is an organization managing the global

domain name system. The UDRP was specifically drafted to resolve disputes between trademark and domain names, and it is administered by several ICANN-accredited dispute resolution service providers. In this Chapter the U.S. legislative, Russian judiciary, and European trademark and domain names dispute resolution techniques are described.

Finally, Chapter III of the work describes the situation with trademark and domain name interface in the Kyrgyz Republic with the analysis of legislature, and emerging case law.

## CHAPTER I. THE CURRENT LEGAL AND REGULATORY FRAMEWORK FOR TRADEMARKS AND DOMAIN NAMES

As a starting point it is necessary to begin with and to provide the basic information on regulation of the trademark issues from legal perspective. In addition, the general picture on the World Wide Web and the Internet domain name system is required. These basic outlines should help to understand and to demonstrate the interface between the trademarks and domain names.

### *1.1. Trademark Law: Regulation under International and Kyrgyz Laws*

The most important feature of trademarks is to identify and distinguish between the goods and services<sup>1</sup> coming from various sources. It is considered that evolvement of trademarks started from the time when the trade started to develop and circulation of good started to take place.<sup>2</sup> It is considered that “the history of marks is as old as the histories of mankind and religion.”<sup>3</sup> While at the beginning serving for the purposes of proving ownership rights, the marks later started to be used as differentiation sign of one artisan from the work of another, whose goods might be of a lower quality. As craftsmen were part of guilds, the latter’s existence created an incentive to generate products of a higher quality in order “to maintain monopolies by the guild members”<sup>4</sup>, but also not to be an example of not meeting the guild’s standards.<sup>5</sup> With further development, later with the creation of free business, marks started to represent and identify the source of goods. Hence, it was and still is crucial to know where the goods are originated from and, sometimes in connection with the previous, what is the goods quality.<sup>6</sup>

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<sup>1</sup> Hereinafter throughout the text “services and goods” shall be referred as goods.

<sup>2</sup> SHOEN ONO, OVERVIEW OF JAPANESE TRADEMARK LAW, Section 1 on History of Trademark Law at 1-2 (second ed. Yuhikaku 1999) available at < <http://iip.or.jp/translation/ono/ch2.pdf> > (last visited in March, 2010).

<sup>3</sup> *Ibid.*

<sup>4</sup> *Ibid.*

<sup>5</sup> *Ibid.*

<sup>6</sup> HECTOR MACQUEEN *ET AL.*, CONTEMPORARY INTELLECTUAL PROPERTY: LAW AND POLICY 542-43 (New York: Oxford University Press 2007) (hereinafter, “MACQUEEN, CONTEMPORARY IP”).



Relating to the development of free business and out of the issues of forgery, counterfeiting and fraud laws, about this time special criminal laws protecting trademarks were also developed, whereas civil protection was gradually established against those who would use another's mark without permission. Today virtually each country of the world has its own unified legal system to protect trademarks within its borders.<sup>7</sup>

Apart from the task of identifying and distinguishing the source of goods, trademarks have the function of defining the quality of goods, which the consumer associates with the given product. Namely, they represent the goodwill of the company that is working behind the trademark.<sup>8</sup> Moreover, trademarks are considered to be as profitable investment tool<sup>9</sup>, as for example with the cloth, usually consumers pay for the name and the quality of the product and not its actual production cost. Yet the main function of trademarks, as it might be also considered to be a main function in other fields, is the protection of consumers from confusion and deception, so making "the perception of the consumers paramount"<sup>10</sup>, regardless whether goods are similar or not, and it is of very importance "to guarantee that the items bearing trademark had originated under the control of a single undertaking responsible for their quality"<sup>11</sup>.

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<sup>7</sup> The basis of trademark law is the territoriality principle, according to which "trademark rights exist in each country solely according to that country's statutory scheme", *Person's Co. v. Christman*, 900 F.2d 1565 (Fed.Cir.1990), available at < <http://altlaw.org/v1/cases/413286> > (last visited in March, 2010). *See also*, MACQUEEN, CONTEMPORARY IP, at 557, where it is said that even Paris Convention does not provide "protection extending beyond the territory in which it [trademark] is registered", thus limiting the protection of the trademark to a particular territory. Moreover, author refers that "the scope of protection available under a trademark is limited to the geographical territory where protection has been obtained" (at p.686). *See also* YEE FEN LIM, CYBERSPACE LAW 454 (Oxford University Press 2002), stating that the rights inherent in trademarks "are limited by two defining characteristics": domesticity and specificity. The former refers to the territoriality ("the trademark will only be protected within the jurisdiction within which it operates"), while the latter refers to "the idea that protections are limited to the general sphere of business within which the goods or services are traded – that is, the protection is specific to a particular industry, product or service".

<sup>8</sup> MACQUEEN, CONTEMPORARY IP<sub>2</sub> at 544.

<sup>9</sup> *Ibid.*

<sup>10</sup> *Ibid.*, at 540.

<sup>11</sup> *Ibid.*, at 666.

Trademark law in general on international level started to develop from XIX century; it dates back to the period of adoption of Paris Convention for the Protection of Industrial Property<sup>12</sup> and Madrid Agreement Concerning the International Registration of Marks<sup>13</sup>. Since many countries started to accede to these international instruments, it influenced the development of trademark laws in those countries. With the lapse of time intellectual property started to become more and more economically significant and because of that in the early 1990s it was incorporated into the World Trade Organization's ("WTO") negotiations, which promoted protection of intellectual property through adopting Agreement on Trade –Related Aspects of Intellectual Property ("TRIPS Agreement"). As Kyrgyzstan acceded WTO in 1998<sup>14</sup>, this accession as well as obligations under the other international intellectual property treaties fostered the compliance of the trademark legislation to the country's international obligations. It should be noted that while trademark legal framework in Kyrgyzstan was being shaped mostly by international treaties, the countries of the European Union are in addition bound under the European Community obligations, e.g. Regulations, Directives.<sup>15</sup>

The main law regulating trademarks' registration, protection and use in the territory of Kyrgyzstan is a Law of the Kyrgyz Republic "On Trademarks, Service Marks and Appellations

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<sup>12</sup> Paris Convention for the Protection of Industrial Property 1883, full text is available at: < [http://www.wipo.int/treaties/en/ip/paris/trtdocs\\_wo020.html](http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html) > (last visited in March, 2010). (hereinafter "Paris Convention"). *See also* MACQUEEN, CONTEMPORARY IP, at 25-7, 557.

<sup>13</sup> Madrid Agreement concerning the International Registration of Marks, full text is available at: < [http://www.wipo.int/madrid/en/legal\\_texts/trtdocs\\_wo015.html](http://www.wipo.int/madrid/en/legal_texts/trtdocs_wo015.html) > (last visited in March, 2010). The main goal of Madrid Agreement is to provide "simplified mechanism for filing trademark applications. The applicants have to file and obtain registration in the home state, and afterwards apply for the international registration to WIPO. (hereinafter "Madrid Agreement"). *See also*, Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, 1989 (hereinafter "Madrid Protocol"). The Madrid Protocol as well as Madrid Agreement was aimed at creating more simple procedure for trademark application filings. *See also*, MACQUEEN, CONTEMPORARY IP, at 558.

<sup>14</sup> Starting from December 20, 1998 Kyrgyzstan is a member of WTO. *See*, < [http://www.wto.org/english/thewto\\_e/countries\\_e/kyrgyz\\_republic\\_e.htm](http://www.wto.org/english/thewto_e/countries_e/kyrgyz_republic_e.htm) > (last visited in March, 2010).

<sup>15</sup> MACQUEEN, CONTEMPORARY IP, at 563.

of Places of Origin of Goods” (hereinafter “Trademark Law”), which was adopted in 1998.<sup>16</sup> This law encompasses the definition of the trademark expressing the main functions of the trademark, and providing that “a trademark is a designation capable to distinguish goods and services of one legal entities or individuals from homogenous goods and services of other legal entities or individuals.”<sup>17</sup> One can register trademark in words, three-dimensional, graphic and others or combinations thereof, as well as trademark can be registered in any color or combination thereof, however, registration of scent and sound is not allowed under the laws of the Kyrgyz Republic.<sup>18</sup> In order to register an exclusive trademark one has to file an application to State Intellectual Property Service (hereinafter “Kyrgyzpatent”).<sup>19</sup> The exclusive trademark means that the trademark owner “shall have the exclusive right to use its trademark” and prohibit its use by other third parties.<sup>20</sup> This protection is granted for a period of ten years, which can be prolonged continuously for another ten years, thus providing almost unlimited time for protection, i.e. as long as protection is renewed according to the applicable laws and established procedures.<sup>21</sup>

If any third party without any authorization manufactures, uses, imports, offers for sale, sales, stores or in other way uses a trademark or goods bearing the trademark or the mark confusingly similar with the trademark of homogenous goods, third party will be infringing

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<sup>16</sup> Dated January 14, 1998 (as amended on February 27, 2003).

<sup>17</sup> Article 2 of the Trademark Law. Trademarks shall also hereinafter include service marks. Translated version of the law is available on < <http://patent.kg/en/laws/trademark> > (last visited in March, 2010), however, translated version does not express fully the Russian text of the Trademark Law. Therefore, difference can be found between the internet available version and what is presented in this work.

<sup>18</sup> *Ibid.*

<sup>19</sup> Article 3 of the Trademark Law. It should noted that before 2009 State Intellectual Property Service was referred to as State Patent Service of the Kyrgyz Republic, but still the community referring to it as Kyrgyzpatent, the very first shortened version of the Service.

<sup>20</sup> *Ibid.*, Article 3.

<sup>21</sup> Article 15 of the Trademark Law.

trademark owner's rights.<sup>22</sup> Even more, the Trademark Law also contains a special clause pursuant to which unauthorized use of a mark identical or confusingly similar with a mark of the trademark owner as an address in the Internet is also deemed to be infringement of the trademark owner's rights.<sup>23</sup> The Trademark Law further refers to special rules regulating the use of a trademark or mark confusingly similar with the trademark in the Internet.<sup>24</sup>

Kyrgyz laws provide for civil, administrative and criminal liabilities in case of infringement of trademark rights.<sup>25</sup> Thus, if a person registers domain name identical or similar to the trademark, a person unlawfully using the registered trademark has to cease the infringement and compensate trademark owner for losses incurred.<sup>26</sup> Illegal use of trademark entails administrative liability in the form of fine.<sup>27</sup> The Kyrgyz laws also provide for criminal liability for illegal use of trademark in the form of (a) fine; (b) triple ayip, a penalty in the form of treble damages imposed by the decision of the court in monetary terms or in kind; or (c) public works for the term of between 180 and 240 hours.

Furthermore, the Law of the Kyrgyz Republic "On Restriction of Monopolistic Activity, Development and Protection of Competition" (the "Anti-Monopoly Law")<sup>28</sup> provides a list of actions that constitute unfair competition. The most relevant to the issue of trademark and

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<sup>22</sup> Article 3 of the Trademark Law.

<sup>23</sup> *Ibid.* See also, ERIC MACRAMALLA, *Canada, in DOMAIN NAME LAW AND PRACTICE: AN INTERNATIONAL HANDBOOK* 161 (Torsten Bettinger ed., Oxford University Press 2005). (It should be noted that in UK and US the mere registration of trademark as a domain name is considered to be use of trademark, namely, "for the purposes of trademark dilution, mere registration of a domain name without more is not typical commercial use" (Panavision International, L.P. v. Toeppen, 141 F.3d 1316, 1325 (9<sup>th</sup> Cir.1998)); this registration should be with the intention of selling).

<sup>24</sup> Procedure on Usage of Trademarks, Service Marks, Appellations of Places of Origin of Goods, and Trade Names as an Address in Internet approved by Resolution of the Government of the Kyrgyz Republic on January 31, 2007, No. 26 (hereinafter "Procedure").

<sup>25</sup> Article 41 of the Trademark Law.

<sup>26</sup> Article 1113 of the Civil Code of the Kyrgyz Republic dated January 5, 1998 (as amended on July 17, 2009).

<sup>27</sup> Article 341 of the Administrative Liability Code of the Kyrgyz Republic dated August 4, 1998 (as amended on February 10, 2010).

<sup>28</sup> Dated April 15, 1994, No. 1487-XII (as amended on August 1, 2003). See also, Procedure for Consideration of Unfair Competition Cases approved by Resolution of the Ministry for Economic Development, Industry and Trade of the Kyrgyz Republic dated April 13, 2004, No. 19.

domain name interface are (a) confusion of a consumer with respect to a character, manner and place of production, properties, suitability for application or quality of goods; (b) unauthorized use of trademark; (c) actions causing confusion with respect to enterprises, goods or industrial or trade activity of a competitor. The unfair competition is defined by the Anti-Monopoly Law as any actions undertaken by an economic entities<sup>29</sup> aimed at gaining advantages in business activities, which contradict the provisions of the Anti-Monopoly Law, customary business practices, decency, reasonableness, and fairness and may or have caused loss to other competing entities or damage to their business reputation.

## ***1.2. Internet and Domain Name System***

Internet is described as a global “network of networks”.<sup>30</sup> Internet contains thousands of documents that are located on different Web pages. Millions of people use the Internet to access news, radio, video services, images, chat rooms, “shops”, to communicate with each other, or to use search engines, etc.<sup>31</sup> Users can transmit pictures and sounds and this information can be accessed by other the Internet users from any part of the world.<sup>32</sup>

Domain Name System (“DNS”) is the system of global navigation within the Internet.<sup>33</sup> Each page of information is assigned a unique “address”, which is called a Uniform Resource Locator (“URL”).<sup>34</sup> This address is made up of several sections. To illustrate how the DNS works, let’s look at a typical URL: <http://www.ceu.hu/studentlife/>, where http indicates that this

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<sup>29</sup> Pursuant to Article 4 of the Anti-Monopoly Law economic entity are entities engaged in economic activity of production, sale or purchase of goods, collective, cooperative, joint-stock , state, public or other enterprises engaged in independent business activities, and associations thereof with or without formation of a legal entity.

<sup>30</sup> *ACLU v. Reno*, 929 F.Supp.824 (E.D.Pa. 1996), *aff’d*, 521 U.S. 844 (1997).

<sup>31</sup> *Ibid.*

<sup>32</sup> *Ibid.*

<sup>33</sup> See Marshall Brain, *How Domain Name Servers Work*, available at < <http://www.howstuffworks.com/dns.htm> > (last visited in March, 2010).

<sup>34</sup> See also, Australian Legal Information Institute, A Brief Guide to Using the Internet, available at < <http://austlii.org/austlii/guide/current/20030315--2.html> > (last visited in March, 2010).

page uses hypertext transfer protocol; www indicates that the page is found on the World Wide Web; and <ceu.hu> is the unique address of Central European University. Furthermore, when we type <ceu.hu>, we will be first addressed to the unique Internet Protocol (IP) numbers (10.120.021.01 or 27.99.679.93) that belong only to <ceu.hu> and only then we will be able to access university's website. Thus, there are two options of accessing the CEU website: first, through typing the "numerical "address,"<sup>35</sup> and secondly, through typing the "alphabetical address" (<ceu.hu>).<sup>36</sup> Domain names represent the latter, therefore comparing to memorizing numbers, it is much simpler to learn and know the words which allow users to access web sites on the Internet. Domain names were specifically developed to make it easier for the internet users to remember the desired web-site.

Typical alphabetical addresses consist of three elements: Top Level Domain (TLD), Second Level Domain (SLD), and Third Level Domain (ThLD). TLDs are the top-level domains which can be divided into two major categories: generic top-level domains (gTLDs) and country-code top-level domains (ccTLDs). For illustrative purposes, in the domain name <www.google.com>, the TLD is <.com>, the SLD registered in the top-level registry <.com> file zone is <google>. The domain name <www.ceu.hu>, the <.hu> is the ccTLD belonging to Hungary, the <ceu> is the SLD referring to Central European University. The ccTLD designated to the Kyrgyz Republic is <.kg>.

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<sup>35</sup> Zohar Efroni, *Names as Domains, Names as Marks: Issues Concerning the Interface Between Internet Domain Names and Trademark Rights* in "Intellectual Property And Information Wealth: Issues And Practices In The Digital Age", Peter K. Yu, ed., Praeger Publishers (2007), available at SSRN: <http://ssrn.com/abstract=957750> > (last visited in March, 2010), at 374-375. (hereinafter, "Efroni, *Internet Domain Names and Trademark Rights Interface*").

<sup>36</sup> *Ibid.*

ICANN<sup>37</sup> is the organization that manages the global domain names system. It is a non-profit company, responsible for Internet Protocol (IP) address space allocation, protocol identifier assignment, generic (gTLD) and country code (ccTLD) Top Level Domain name system management, and root server system management.<sup>38</sup> ICANN has been operated under a Memorandum of Understanding (“MOU”) with the U.S. Department of Commerce (“DOC”)<sup>39</sup> since 1998. The MOU was replaced in September 2006 by the Joint Project Agreement (“JPA”) between ICANN and the DOC, which expired in August 2009, and now this JPA is replaced with Affirmation of Commitments of September 30, 2009.<sup>40</sup>

As of today ICANN introduced 20 gTLDs<sup>41</sup> and about 252 ccTLDs<sup>42</sup> all over the world. Initially, back in 1980s seven gTLDs were created, namely .com, .org, .net, .gov, .mil, .edu and .int. But not all of them are freely available to register in, e.g. the last four are of limited purpose: gTLDs .gov and .mil are reserved exclusively for the United States government and military, whereas the gTLD .edu is reserved for post-secondary institutions accredited by an agency on the U.S. Department of Education’s list of Nationally Recognized Accrediting Agencies and the gTLD .int – is reserved for international-treaty based organizations.<sup>43</sup>

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<sup>37</sup> ICANN was formed to manage the policy and technical aspects of the Internet Domain Name System (DNS) and is the only body that controls administration of the DNS. More information about ICANN is available at <[www.icann.org](http://www.icann.org)> (last visited in March, 2010).

<sup>38</sup> Brief general information about ICANN is available at <<http://en.wikipedia.org/wiki/ICANN>> (last visited in March, 2010). One of the functions include preservation of “the operational stability of the Internet”; promotion of competition; achievement of “broad representation of global Internet community”; and development of “policies appropriate to its mission through bottom-up, consensus-based processes.”

<sup>39</sup> See the text of MOU at <<http://www.icann.org/en/general/icann-mou-25nov98.htm>> (last visited in March, 2010).

<sup>40</sup> See Affirmation of Commitments by the US Department of Commerce and ICANN <<http://icann.org/en/announcements/announcement-30sep09-en.htm#announcement>> (last visited in March, 2010).

<sup>41</sup> More information on gTLDs can be found on WIPO web-site at <<http://wipo.int/amc/en/domains/gtld/>> (last visited in March, 2010). See also note 43 on Structure and Organization of the DNS.

<sup>42</sup> A list of ccTLDs is available at <[http://wipo.int/amc/en/domains/cctld\\_db/output.html](http://wipo.int/amc/en/domains/cctld_db/output.html)> (last visited in March, 2010).

<sup>43</sup> TORSTEN BETTINGER, *Structure and Organization of the Domain Name System*, in DOMAIN NAME LAW AND PRACTICE: AN INTERNATIONAL HANDBOOK 17-35 (Torsten Bettinger ed., Oxford University Press 2005).

Since then, after each process initiated by ICANN, the new gTLDs were introduced by it (namely, seven gTLDs in 2001-2002<sup>44</sup>, or six new gTLDs in 2003<sup>45</sup>). Notably, that the emergence of new gTLDs not all the time depends on ICANN, but its creation can be the result of sponsorship emanating from a group interested in creation of such gTLD.<sup>46</sup>

ICANN delegated the administration of the ccTLDs registries to the respective national governments or commercial registrars. Commercial registrars operate on the basis of a license issued by ICANN-approved TLD registries. Commercial registrars sell requested SLDs to individual registrants on a first-come-first-served basis. The sponsoring organization (individual country managers<sup>47</sup> either national governments or commercial registrars) files a request for delegation and/or redelegation of ccTLDs with Internet Assigned Numbers Authority (“IANA”), which “is responsible for receiving requests relating to the delegation and redelegation of a sponsoring organization for ccTLDs.”<sup>48</sup> The latter organization shall operate in the best interest of the population where the domain is intended to be served.<sup>49</sup> IANA evaluates the requests

<sup>44</sup> *Ibid.* Notably, .aero (for aeronautical industry); .biz (for business activities); .coop (for accredited cooperatives), .info (for various activities), .museum (for museums), .name (for personal names), and .pro (for professional entities).

<sup>45</sup> *Ibid.* .asia (for the Pan-Asia and Asia Pacific community), .mobi (dedicated to delivering the Internet to mobile devices), .jobs (for the international human resources management community), .tel (for registrants to "store and manage all their contact information and keywords directly in the DNS"), .travel (for the global travel community), .cat (for the Catalan linguistic and cultural community).

<sup>46</sup> A.A.VENEDYUHIN, DOMENNYE VOINY [DOMAIN WARS] (SPb.: Piter 2009) (hereinafter, “VENEDYUHIN, DOMAIN WARS”). The gTLDs are also divided into sponsored and unsponsored. The difference between two lies in the policy decision making, meaning who will decide what policies would be applied to TLD, *i.e.* ICANN or sponsor. See Ellen Rony, *The Domain Name Handbook: High Stakes and Strategies in Cyberspace. The Envelope, please: new TLDs on the Horizon*, available at < <http://www.domainhandbook.com/newtlds.html> > (last visited in March, 2010).

<sup>47</sup> ICANN, ICANN/IANA: Internet Domain Name System Structure and Delegation (ccTLD Administration and Delegation), May 1999. More information is available at < <http://www.icann.org/en/icp/icp-1.htm> > (last visited in March, 2010).

<sup>48</sup> VENEDYUHIN, DOMAIN WARS, at 50. Previously the allocation of the address space was managed by IANA (Internet Assigned Numbers Authority) that is now the subdivision of the ICANN. See also IANA, Procedure for Establishing ccTLDs, available at < <http://www.iana.org/procedures/cctld-establishment.html> > (last visited in March, 2010).

<sup>49</sup> IANA, Understanding the ccTLD Delegation and Redelelegation Procedure. < <http://www.iana.org/domains/root/delegation-guide/> > (last visited in March, 2010).



taking into account both technical and public interest criteria, and after thorough investigation the decision is taken whether to grant the request or refuse.<sup>50</sup>

For example, in the Kyrgyz Republic functions of the sponsoring organization are performed by AsiaInfo limited liability company, which acts as a commercial registrar.<sup>51</sup> “AsiaInfo” is responsible “for adoption of procedures and policies for the assignment of SLDs and [...] performing a public service on behalf of the Internet community.”<sup>52</sup> However, today there is a big debate with regards to who or what organization is going to be main administrator of the .kg zone.<sup>53</sup> In 2009, President of the Kyrgyz Republic issued the Decree of April 7, 2009, requiring transfer of administration functions to the Kyrgyzpatent, also, the request was filed to ICANN asking for this transfer. ICANN’s response was that it is for the internet users’ community to decide what are their best interests and whether the administration should be left with the AsiaInfo LLC or transferred to Kyrgyzpatent. The later development showed that under the most likely scenario is the administration is with the governmental entity while AsiaInfo LLC remains the registrar of domain names.<sup>54</sup>

### ***1.3. Conflicts between Trademark Law and Domain Names***

As was discussed earlier, trademarks serve as a source of identifier of goods.<sup>55</sup> The same function is performed by domain names through designating the Internet Protocol addresses.

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<sup>50</sup> *Ibid.* “ICANN Board of Directors that ultimately decides whether to approve requests. IANA is also responsible for implementation of requests that have been approved by the ICANN Board.”

<sup>51</sup> See IANA, Delegation Record for .kg that is available at < <http://www.iana.org/domains/root/db/kg.html> > (last visited in March, 2010). See also, corporate web-site of AsiaInfo LLC available at < [www.asiainfo.kg](http://www.asiainfo.kg) > or <<http://cctld.kg/en>> regarding the .kg domain name registry, the web-site will start functioning fully when the administration will be transferred to Kyrgyzpatent (last visited in March, 2010).

<sup>52</sup> More information is available at < <http://www.icann.org/en/icp/icp-1.htm> > (last visited in March, 2010).

<sup>53</sup> More detailed information on .kg zone, Domain Name delegation as well as ICANN communications is available at < <http://patent.kg/en/cctld?page=1> > (last visited in March, 2010).

<sup>54</sup> Lyudmila Pavlovich, *We’ll Dominate*, Slovo Kyrgyzstana (Bishkek), Feb. 16, 2010, available at < <http://patent.kg/en/story/2010/02/19/domain> > (last visited in March, 2010).

<sup>55</sup> See *supra* section 1.1.

Both trademark and domain names are registered on a first-come-first-serve basis. Moreover, registration of a domain name comparing to establishment of trademark's goodwill is cheap. However, possibility to register a domain in an alphabetical order as an address in the Internet and availability to be "present" in every part of the world resulted in a clash of trademarks and domain names.<sup>56</sup> Trademark law aims at protecting the goodwill of the trademark owner and protecting and preventing consumers from confusion as to the origin of the goods within the particular territory where the trademark registered for its protection. However, it should be noted that similar mark can co-exist if they are registered to different classes of goods according to the established Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks.<sup>57</sup> For example, Nike trademark (and presuming that the mark does not consider being well-known) registered for sportswear can also be registered as a trademark of cooking apparatus manufacturer (it is presumed that consumers will not believe that apparatus for cooking belong to Nike sportswear and assuming that trademark was not registered for every class available). However, if both Nike sportswear producer and Nike cooking apparatus manufacturer apply for registering a domain name, only the one who registers it first can have it. However, the domain name registrant may be not only one or the other of Nike producers, but also any third party not related to them. The most frequent situation is when a third party registers a domain name identical or confusingly similar with well-known trademarks with the aim of gaining profit, *i.e.* in a bad faith.

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<sup>56</sup> Helfer L.R. and G.B. Dinwoodie, *Designing Non-National Systems: The Case of the Uniform Domain Name Dispute Resolution Policy*, Stanford/Yale Junior Faculty Forum, Research paper 01-05 (2001).

<sup>57</sup> The Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957) (hereinafter "ICGS"). The agreement contains 45 international trademark classes. *See also* WIPO, International Classification of Goods and Services, available at < <http://www.wipo.int/classifications/nivilo/nice/index.htm> > (last visited in March, 2010).

Such situation resulted in the emergence of a phenomenon known as “cybersquatting”. In one of the first U.S. cases of cybersquatting, the court of the Northern District of Illinois described typical cybersquatters as “[i]ndividuals [that] attempt to profit from the Internet by reserving and later reselling licensing domain names back to the companies that spent millions of dollars developing the goodwill of the trademark.”<sup>58</sup> Cybersquatting today has different forms. For instance, *classic cybersquatting* refers to the situations when a person registers one or more domain names that correspond with well-known trademarks with the aim of transfer of the registered domain name(s) to the well-known trademark(s) owner(s) for valuable consideration.<sup>59</sup> So called, *non-commercial cybersquatting* covers situations when a person has registered typically one domain name for a predominantly non-commercial purpose, namely for the purposes of providing comments about the activities of the owner of trademark, which corresponds to the registered domain name.<sup>60</sup> *Typosquatting* refers to registration of domain names that incorporate marks typically with deliberate misspelling of a trademark.<sup>61</sup> Sometimes disputes with respect to a domain name may occur among trademark owners or individuals, who have legitimate interest in the same domain name (for instance, two or more companies have a

<sup>58</sup> *Intermatic, Inc. v. Toeppen*, 947 F.Supp. 1227, 1233 (N.D.Ill.1996). *See also*, *Panavision Int’l, L.P. v. Toeppen*, 141 F.3d 1316, 1325 (9<sup>th</sup> Cir.1998). Dennis Toeppen, as well as Dan Parisi, is famous for multiple registrations of many Internet domain names corresponding with famous corporate trademarks in the early days of Internet.

<sup>59</sup> *See* CPR Institute for Dispute Resolution, File No. CPR009: “herstyle.com” (2000).

<sup>60</sup> *See* WIPO cases on issues of “exampletrademarksucks.com”, where arbitrators at first considered that the domain name is identical to the trademark in issue, however, the trend changed when arbitrators started to regard this issue as expression of freedom of speech (specifically, when party was only commenting the activities of the company and did not provide any advertisement on the web-page.” *See also*, A.M. MINKOV, RASSMOTRENIE SPOROV O DOMENNYKH IMENAKH V SOOTVETSTVII S PROCEDUROI UDRP [DOMAIN NAME CONTROVERSIES HEARING IN ACCORDANCE WITH UDRP PROCEDURE] (Wolters Kluwer 2004).

<sup>61</sup> Typosquatters “...relay largely on typing errors and after diverting users to their sites, they typically “lock” the users in so-called “mouse-traps”, causing them to view advertisements, However, not in every case this type of typesquatters would be acting in bad faith, for instance, see WIPO Case No. D2008-1267: “hairywinston.com” (2008) (defendant was justified on the ground of parody). *See also*, Efroni, *Internet Domain Names and Trademark Rights Interface*, at 377. *Also*, Thomas Pattloch, *China*, in *DOMAIN NAME LAW AND PRACTICE: AN INTERNATIONAL HANDBOOK* 191 (Torsten Bettinger ed., Oxford University Press 2005) (Interestingly, that in China under its ccTLD “an infringement of a registered trademark requires the goods to be identical or similar [...]”, however, if the domain name will differ in at least one letter, then it “would constitute a new address.”)

similar trademark corresponding to a specific domain name). Disputes involving personal names cover disputes involving celebrity names, politicians, names of private individuals, geographical locators and culturally significant names.<sup>62</sup>

Taking into consideration the global nature of the Internet, indefinite location of the domain name registrant on the one hand and territorial protection of trademark rights on the other, trademark owners faced with difficulties with regard to the issues of domain names, specifically when there is no a single body of rules governing the disputes. Therefore, the trademark owners were eager to have streamlined and inexpensive dispute settlement alternatives. At the international (or even non-national) level such dispute settlement mechanism was eventually created by ICANN in late 1999 and is currently known as Uniform Dispute Resolution Policy, which will be discussed at length in the following Chapter.

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<sup>62</sup> See also, Jacqueline D. Lipton, *Beyond Cybersquatting: Taking Domain Name Disputes Past Trademark Policy*, 40 Wake Forest L. Rev. 1361 (2005), available at < <http://ssrn.com/abstract=770246> > (last visited in March, 2010) (hereinafter, “Lipton, *Beyond Cybersquatting*”).

## CHAPTER II. APPROACHES OF TRADEMARK VS. DOMAIN NAME RESOLUTION

### 2.1. *Dispute Resolution under Uniform Domain Name Dispute Resolution Policy*

The development of Uniform Domain Name Dispute Resolution Policy (“UDRP”) started in 1998.<sup>63</sup> During that year WIPO started to develop set of recommendation in order to resolve disputes between trademarks and domain names.<sup>64</sup> As the Internet has no borders and person cannot limit it to some particular territory, this made it difficult at the beginning for the courts to resolve the conflicts between trademarks and domain names.<sup>65</sup> In April 1999 WIPO came up with report containing set of recommendations, where it mainly coped with issues of “bad faith registration and use of trademarks as domain names,”<sup>66</sup> i.e. referring to the cases of classical cybersquatting, and accordingly establishing uniform dispute-resolution procedure to deal with those disputes.<sup>67</sup> Based on these recommendations, ICANN adopted UDRP<sup>68</sup> and the latter became widespread because of its time, efficiency and cost-effectiveness.<sup>69</sup>

As it was noted above, the major goal of the UDRP was and is to deal with cybersquatting problems. “The UDRP is sometimes called a mandatory or administrative “arbitration” mechanism”<sup>70</sup> due to its compulsory nature and fixation in all registration

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<sup>63</sup> ICANN, Uniform Domain Name Dispute Resolution Policy adopted on August 26, 1999, full text is available at < <http://www.icann.org/en/udrp/udrp-policy-24oct99.htm> > (last visited in March, 2010) (“UDRP”).

<sup>64</sup> WIPO. First WIPO Internet Domain Name Process, available at < <http://www.wipo.int/amc/en/processes/process1/index.html> > (last visited in March, 2010). *See also*, <http://www.wipo.int/amc/en/processes/process1/report/summary.html> > (last visited in March, 2010).

<sup>65</sup> *Ibid.*

<sup>66</sup> *Ibid.*

<sup>67</sup> The Recognition of Rights and the Use of Name in the Internet Domain Name System, Report of the Second WIPO Internet Domain Name Process (September 2, 2001), available at < <http://www.wipo.int/amc/en/processes/process2/report/html/report.html> > (last visited in March, 2010).

<sup>68</sup> *Ibid.*

<sup>69</sup> Peter K. Yu, *A summary of the final report of the Second WIPO Internet Domain Name Process*, available at < <http://www.peteryu.com/gigalaw0102.pdf> > (last visited in March, 2010).

<sup>70</sup> Zohar Efroni, *A Guidebook to Cybersquatting Litigation: The Practical Approach in a Post-Barcelona.Com World*, Fall, 2003 U. Ill. J.L. Tech. & Pol'y 457, available at < <http://ssrn.com/abstract=676542> > (last visited in March, 2010). *See also*, Lipton, *Beyond Cybersquatting*.

agreements with regard to gTLDs between a domain name registrant and domain name registrar. Even though the UDRP is being compared with the arbitration process, the UDRP does not to that extent similar to arbitration clause in contract. For instance, some of the courts in Russian Federation confirmed this difference. Starting from October 1999 UDRP, as a clause, was to be incorporated in all agreements with gTLD domain name registrants.<sup>71</sup> In case of issue under ccTLD the UDRP will be applicable if the registrar voluntary accepts the UDRP and incorporates it into registration agreement. Otherwise, the disputes between trademarks and domain names usually resolved in courts or specifically created offices or through arbitration.<sup>72</sup>

The UDRP stipulates for two remedies available to a successful complainant, namely cancellation of the domain name or transfer of the domain name to the complainant<sup>73</sup>. Thus, if a party is interested in claiming something more than cancellation or transfer it should refer to the other available means of dispute settlement, namely courts.

The UDRP also contains rules (“UDRP Rules”)<sup>74</sup> implementing the UDRP policy use, in particular, the UDRP Rules set out the procedures and other requirements for each stage of the dispute resolution administrative procedure. The whole procedure is administered by dispute resolution service providers accredited by ICANN.<sup>75</sup> The main grounds on basis of which

<sup>71</sup> *Ibid.* See also ICANN, Timeline for the Formulation and Implementation of the Uniform Domain-Name Dispute-Resolution Policy, available at < <http://www.icann.org/en/udrp/udrp-schedule.htm> > (last visited in February, 2010).

<sup>72</sup> See also, Andrew F. Christie, *The ICANN Domain Name Dispute Resolution System as a Model for Resolving Other Intellectual Property Disputes on the Internet*, The University of Melbourne Faculty of Law, Public Law and Legal Theory Research Paper No. 30, 2002, available at < [http://ssrn.com/abstract\\_id=319201](http://ssrn.com/abstract_id=319201) > (last visited in March, 2010) (Professor Christie provides comprehensive scheme of the UDRP process operation and underlines two key structural features of the ICANN domain name dispute resolution system: (a) the uniform application of the UDRP to all potential respondents to a cybersquatting action and (b) the automatic execution of an effective remedy for successful complainant).

<sup>73</sup> Clause 4(i), UDRP.

<sup>74</sup> ICANN, Rules for UDRP adopted on October 24, 1999, full text is available at < <http://www.icann.org/en/udrp/udrp-rules-24oct99.htm> > (last visited in March, 2010) (“UDRP Rules”).

<sup>75</sup> WIPO Arbitration and Mediation Center (approved effective 1 December 1999); Asian Domain Name Dispute Resolution Centre (ADNDRC) (approved effective 28 February 2002). It has three offices in Beijing, Hong Kong and Seoul; National Arbitration Forum (NAF) (approved effective 23 December 1999) located in the United States and dealing mostly with the cases where complainants are from and based in North America; Czech Arbitration

claimant makes the complaint presented below, it should be noted that to succeed all three grounds should be met:

- (i) that the disputes domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) that the registrant has no rights or legitimate interests in respect of the domain name, and
- (iii) that the domain name has been registered and is being used in bad faith.<sup>76</sup>

The above grounds largely resemble some important elements of trademark law, like identical or confusingly similarity, bad faith, or legitimate interest. Furthermore, the UDRP provides domain name holder with list of defenses in order to show legitimate interests in the domain name and as well as list of circumstances for trademark owners indicating bad faith registration and use.

Pursuant to Clause 4(c) of UDRP a domain name holder can demonstrate one's rights or legitimate interests in a domain name in a response to an arbitration claim, accordingly showing that

- (a) the domain name [...] has been used with a *bona fide* offering of goods and services prior to receiving notice of the dispute;
- (b) the respondent has been commonly known by the domain name as an individual, business or organization, even if she has acquired no trademark or service mark rights in the name; or
- (c) the respondent is making legitimate non-commercial or fair use of the domain name with no intent to make a commercial gain or to misleadingly divert customers or to tarnish the trademark or service mark at issue.<sup>77</sup>

This indicated list is not exhaustive, thus respondent may present other evidence to support its argument of having legitimate interest in the disputed domain name, which a panelist or panel may take into consideration.

The bad faith evidence stipulated in the UDRP relates to the claimant establishing:

- (a) circumstances indicating that a registrant has registered or acquired the domain name in question primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant where the

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Court (CAC) has been approved in January 2008. More information on the list of approved dispute-resolution service providers is available at < <http://www.icann.org/en/dndr/udrp/approved-providers.htm> > (last visited in March, 2010).

<sup>76</sup> Clause 4 (a) (i) – (iii), UDRP.

<sup>77</sup> Clause 4(c) (i) – (iii), UDRP.

complainant is the owner of a trademark or service mark or to a competitor of the claimant, for valuable consideration;

- (b) that the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that a pattern of such conduct can be established;
- (c) that the registrant has registered the domain name primarily for the purpose of disrupting a competitor, or
- (d) that by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to her website by creating a likelihood of confusion with the complainant's trademark as to the source, sponsorship, affiliation or endorsement of the registrant's website or of a product or service available on that website.<sup>78</sup>

Under the UDRP one fails to prove bad faith if the domain name was registered before the trademark itself,<sup>79</sup> interestingly that in order to claim protection trademark owner does not have to have protection "in the country in which domain name was registered and being used."<sup>80</sup>

The outcome of the UDRP procedure is binding on the registrar who will have to either transfer or change domain name holder or cancel the domain name according to the decision taken. Importantly, the decision taken by the panel under the UDRP is not binding on the court considering the same dispute as the UDRP is considered to be alternative dispute resolution. Therefore, the parties to a dispute are not precluded from referring and "submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded."<sup>81</sup>

As a lot of trademark owners used the UDRP to protect their rights and interest, the UDRP system is proved to be effective mechanism for dispute resolution. One of the ways of its effectiveness, probably in a way that even if Respondent takes no actions and do not participate in the proceedings, the dispute will nevertheless be resolved according with the UDRP norms expressed above and the case will be resolved on the basis of information presented by

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<sup>78</sup> Clause 4(b) (i) – (iv), UDRP.

<sup>79</sup> Torsten Bettinger, *Uniform Domain Name Dispute Resolution Policy*, in *DOMAIN NAME LAW AND PRACTICE: AN INTERNATIONAL HANDBOOK* 991 (Torsten Bettinger ed., Oxford University Press 2005).

<sup>80</sup> *Ibid.*

<sup>81</sup> Clause 4(k), UDRP. It should be noted here that if one of the parties initiate legal proceedings in court of competent jurisdiction during an administrative proceeding, it would be upon discretion of the Panel to decide whether to suspend or terminate administrative proceeding, or to proceed to a decision (Clause 18 (a) of the UDRP Rules).



complainant. Many cases were successfully resolved, and this might be an incentive for developing countries, especially for the courts, to refer to those rules and policies in order to resolves disputes in their respective countries if the laws in those countries do not refer to be effective or mature enough.

However, despite successful operation, the UDRP is not all the time considered to be *the* ultimate process and is subject to criticism.<sup>82</sup> For instance, the Policy is criticized for being more complainant-friendly<sup>83</sup>, for unfair time allocation, namely 20 days for respondents reply is “too short”<sup>84</sup> in order for respondent to prepare the adequate answer in order to defense.<sup>85</sup> It is also claimed language of the UDRP is not easy for domain name registrant to understand the policy, especially when the registrant is lawfully registered the domain and for him to defend his legitimate rights.<sup>86</sup> Other important concern is in the absence of consistent interpretation of the UDRP, it is claimed that the interpretation of the UDRP is not consistent since the “panelists [are] from various countries with different legal systems.”<sup>87</sup>

WIPO Arbitration Center as one of the first approved dispute resolution providers has on its web-site wide arrange of information regarding the statistics of cases on domain names and trademark interface.<sup>88</sup> In 2008 the Center proposed to eliminate the submission of paper copies

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<sup>82</sup> Pablo Cortes, *An Analysis of the UDRP Experience: Is it Time for Reform?* (27 August 2007). Computer Law and Security Report, Vol. 24, No. 4, 2008. Available at SSRN: < <http://ssrn.com/abstract=1010088> > (last visited in March, 2010).

<sup>83</sup> *Ibid.* See also, Jacquelin D. Lipton, *A Winning Solution for Youtube and Utube? Corresponding Trademarks and Domain Name Sharing*. Harvard Journal of Law and Technology, Forthcoming, available at SSRN: < <http://ssrn.com/abstract=1080313> > (last visited in March, 2010). In Professor Lipton’s opinion, the disadvantage of UDRP is in the fact that “it is geared towards the protection of trademark holders against bad faith cybersquatters”.

<sup>84</sup> Clause 5(a), UDRP Rules.

<sup>85</sup> Cortes, *supra* note 83.

<sup>86</sup> *Ibid.*

<sup>87</sup> *Ibid.*

<sup>88</sup> For instance, WIPO, Record Number of Cybersquatting Cases in 2008, WIPO Proposes Paperless UDRP. < [http://www.wipo.int/pressroom/en/articles/2009/article\\_0005.html](http://www.wipo.int/pressroom/en/articles/2009/article_0005.html) > (last visited in March, 2010). “The disputes include both contractual disputes (e.g. patent and software licenses, trademark coexistence agreements, distribution agreements for pharmaceutical products and research and development agreements) and non-contractual disputes (e.g. patent infringement).”

that were required along with online communications, and starting from December 14, 2009 they implemented this undertaking.<sup>89</sup>

Recently another even more simplified process was introduced, namely *Uniform Rapid Suspension System*.<sup>90</sup> This system intends to resolve disputes even in shorter period of time and aimed at cases where there is no dispute at all whether registration was in violation of trademark owner's rights.<sup>91</sup> Moreover, the system is not going to replace the UDRP but to supplement it.<sup>92</sup> However, what if it appears that actually there can be doubt whether the domain name holder has legitimate interest, should then trademark owner refer to the UDRP procedure, thus paying all the costs of the latter procedure or court, and being dissatisfied with the decision refer to the courts. It seems that the costs are even more increased, however, from the other hand, the existence of this procedure simplifies the protection of the trademark owner's rights, but the higher threshold for proving bad faith was proposed.<sup>93</sup> Its further development will show whether this procedure is effective enough as to be referred to.

## ***2.2. U.S. Approach to Trademarks vs. Domain Names Dispute Resolution***

Roughly at the time of implementing the UDRP the U.S. Congress enacted the Anti-Cybersquatting Consumer Protection Act of 1999 ("ACPA").<sup>94</sup> The ACPA was then incorporated into the Lanham Act, the statutory embodiment of U.S. trademark laws.<sup>95</sup> The ACPA establishes standards for defining and prosecuting unlawful cybersquatting. The ACPA

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<sup>89</sup> WIPO, WIPO Launches Paperless Proceedings (Dec.11, 2009), available at < [http://www.wipo.int/pressroom/en/articles/2009/article\\_0057.html](http://www.wipo.int/pressroom/en/articles/2009/article_0057.html) > (last visited in March, 2010).

<sup>90</sup> Implementation Recommendation Team Report, *IRT Recommendation for an IP Clearinghouse, a globally protected marks list, and other top and second-level rights protection mechanisms* 25-46, available at < <http://www.icann.org/en/topics/new-gtlds/irt-final-report-trademark-protection-29may09-en.pdf> > (last visited in March, 2010).

<sup>91</sup> *Ibid.*

<sup>92</sup> *Ibid.*

<sup>93</sup> *Ibid.*

<sup>94</sup> 15 U.S.C. Section 1125(d).

<sup>95</sup> 15 U.S.C. Sections 1051 – 1129.

provides for a broad definition of “domain names” (subject matter jurisdiction), notably “any alphanumerical designation which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet.”<sup>96</sup>

The ACPA provides for a test identifying cybersquatting activity. A domain name registration violates the test if (a) a protected mark is involved; (b) a corresponding domain name was registered, trafficked, or used without regard to goods and services; and (c) there is a bad faith intent to profit from that activity.<sup>97</sup> “The most important innovations of the ACPA are the substitution of the “trademark use” requirement with bad faith registration and the likelihood of confusion test with the “identical or confusingly similar” standard.”<sup>98</sup>

The ACPA provides for explicit protection of registrations that are identical, confusingly similar or dilutive of a mark that was famous or distinctive as of the moment of registration.<sup>99</sup> The ACPA further provides for a non-exclusive list of circumstances that may indicate the bad faith intent.<sup>100</sup> Yet it is the courts’ discretion to find any other bad faith intents under specific circumstances as section specifically provides.

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<sup>96</sup> 15 U.S.C. Section 1127.

<sup>97</sup> 15 U.S.C. Section 1125(d)(1)(A).

<sup>98</sup> Efroni, *Internet Domain Names and Trademark Rights Interface*, at 382.

<sup>99</sup> 15 U.S.C. Section 1125(d)(1)(A)(ii)(II).

<sup>100</sup> 15 U.S.C. Section 1125(d)(1)(B)(i), in particular provides: “In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, but not limited to—

(I) the trademark or other intellectual property rights of the person, if any, in the domain name;

(II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III) the person’s prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(IV) the person’s bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V) the person’s intent to divert consumers from the mark owner’s online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI) the person’s offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person’s prior conduct indicating a pattern of such conduct;(VII) the person’s provision of

In case of successful claim and ability to meet the requirements of the test, the trademark owner shall have the right to remedies that include forfeiture or cancellation of the domain name and its transfer to the trademark owner.<sup>101</sup> Moreover, the latter also has the right to seek statutory damages up to USD 100,000 per each infringing domain name under the ACPA and actual damages and attorney's fees under the Lanham Act.<sup>102</sup>

However, if the domain name owner has a reasonable ground to consider that its use of the domain name is fair and not in any way unlawful, then he may claim that registrant is protected under the ACPA's good faith provision pursuant to which a court may conclude there was no violation.<sup>103</sup>

Comparing the ACPA as the U.S. Federal statute applied by U.S. court and UDRP, a kind of arbitration process based on contractual relationship between registrants and registrars,<sup>104</sup> some important differences can be singled out resulting in emergence of "a variety of legal issues regarding the relationship between the ACPA and the UDRP, ranging from personal jurisdiction questions to forum-shopping, choice of law complexities, and other private-international law matters."<sup>105</sup> Comparing the test provided in the ACPA with the one defined in the UDRP, the

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material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of subsection (c)(1) of this section.

<sup>101</sup> 15 U.S.C. Section 1125(d)(1)(C).

<sup>102</sup> 15 U.S.C. Section 1117(a), (d).

<sup>103</sup> Good faith provision is also known as "safe harbor" provision. 15 U.S.C. Section 1125(d)(1)(B)(ii). *See also*, Martha L. Arias, *Internet Law – Parody: Safe Harbor under the Anti-Cybersquatting Protection Act* (October 6, 2008), available at < [http://www.ibls.com/internet\\_law\\_news\\_portal\\_view.aspx?s=latestnews&id=2147](http://www.ibls.com/internet_law_news_portal_view.aspx?s=latestnews&id=2147) > (last visited in March, 2010).

<sup>104</sup> However, these two procedures are considered to be different ones, see *Parisi v. Netlearning Inc.* 139 F. Supp. 2d 745 (E.D. Va. 2001) (the court considered that UDRP panel decision does not equal to the decision of the arbitral tribunal)..

<sup>105</sup> Efroni, *Internet Domain Names and Trademark Rights Interface*, at 461.

ACPA differs from the cybersquatting standard presented in the UDRP. The ACPA's standard is deemed to be more pro-trademark owners as plaintiffs under the ACPA do not have to show that the registrant had no legitimate interests in the domain name. Under the ACPA showing of bad faith registration, trafficking or use of the domain name identical or confusingly similar to a distinctive mark is sufficient. The UDRP contains an explicit list of defenses available to registrants, the ACPA, on the other hand, provides only for the "safe harbor" provision.<sup>106</sup> Some note that "parody is the valid excuse for using trademark as a domain name"<sup>107</sup>, however, it should be proved without any doubt. Moreover the remedies under the ACPA are much stronger than the ones stipulated by the UDRP.<sup>108</sup> However the most prominent difference lies in the situation when the losing party in a domain name dispute seeks to reverse the outcome. The situation is simpler if the losing party only appeals the decision of the U.S. court made under the ACPA and even if the losing party challenges the court's decision by filing a complaint under UDRP.<sup>109</sup> On the contrary if the losing party seeks reversal of the UDRP decision, such party may face *de novo* review of the dispute by the court applying rules of the ACPA.

These constraints can be indeed encountered by any losing party from any country. It was exactly this situation where the Japanese trademark owner found itself, when the UDRP decision was challenged in Russian courts and subsequently reversed.

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<sup>106</sup> *Ibid.*

<sup>107</sup> Martha L. Arias, *Internet Law – Parody: Safe Harbor under the Anti-Cybersquatting Protection Act* (October 6, 2008), available at < [http://www.ibls.com/internet\\_law\\_news\\_portal\\_view.aspx?s=latestnews&id=2147](http://www.ibls.com/internet_law_news_portal_view.aspx?s=latestnews&id=2147) > (last visited in March, 2010).

<sup>108</sup> As is discussed above, the UDRP panelist or panel have the power to order either cancellation or transfer of the disputed domain name, whereas U.S. courts can order the forfeiture, cancellation, transfer of the domain name, as well as grant statutory damages, actual damages and attorneys' fee.

<sup>109</sup> "Although the [UDRP] Policy does not explicitly preclude such option, it appears unlikely that panels will accept disputes that have already been decided in federal courts, and will be even less likely to attempt to "reverse" them. The subordination of the UDRP to national courts of "competent jurisdiction" is manifested, inter alia, in Clauses 3(b) and 4(k) of the [UDRP] Policy". <sup>109</sup> Efroni, *Internet Domain Names and Trademark Rights Interface*, at 392.

### ***2.3. Russian Approach to Trademark vs. Domain Names Dispute Resolution***

Legal protection<sup>110</sup> of trademarks under the Russian law is similar to the one under Kyrgyz law.<sup>111</sup> Therefore, in considering trademark and domain names disputes, the most relevant law in both countries is trademark law.<sup>112</sup> Pursuant to Russian Civil Code unauthorized use of a mark identical or confusingly similar with a mark of the trademark owner as an address in the Internet is deemed to be infringement of the trademark owner's rights.<sup>113</sup> Therefore, most disputes arisen in connection with trademarks and domain names were considered by Russian courts through application of trademark law provisions with the decisions made frequently in favor of plaintiffs. However, comparing with common law countries, such as United States, where decisions of the courts are based on precedents, courts in civil law countries, and in particular, in the Russian Federation strictly apply the statutory provisions to the issue at dispute. Courts are more reluctant to take a decision if it was not expressly regulated in the legal framework. If the decision of a court is based on poorly or badly formulated statutory provision, then the decisions rendered may result in something incomprehensible.

One of the most famous domain name cases in the Russian Federation is dispute over <kodak.ru> domain name.<sup>114</sup> It emerged in the mid of 1999 and has been considered during three years having passed through all courts' instances. Eastman Kodak Company Corporation filed a suit against an individual who registered <kodak.ru> domain. The respondent owned a shop

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<sup>110</sup> See A.P.SERGEEV. PRAVO INTELLEKTUALNOI SOBSTVENNOSTI V ROSSIISKOI FEDERACII [INTELLECTUAL PROPERTY RIGHTS IN RUSSIAN FEDERATION] (Prospect 1999).

<sup>111</sup> See, discussion of major provisions of Kyrgyz Trademark Law. Usually legislators in Kyrgyzstan mostly follow the legislation of Russian Federation.

<sup>112</sup> As of writing this work, trademark law of the Russian Federation was repealed by Part IV of the Civil Code of the Russian Federation, please, refer to note below. However, the cases discussed in this work were considered under the old trademark law of the Russian Federation "On Trademarks, Service Marks and Appellations of Places of Origin of Goods" dated September 23, 1992 #3520-1 (as amended on December 11, 2002) (hereinafter, "Russian Trademark Law").

<sup>113</sup> Article 1484, Chapter 76, Part IV, Civil Code of the Russian Federation of November 30, 1994, as amended on December 6, 2007. See also A.N. Kyle, Postateinyi kommentaryi k chasti IV GK RF (Moskva: 2008).

<sup>114</sup> Kodak.ru case brief is available at < [www.internet-law.ru/intlaw/domens/kodak-1.htm](http://www.internet-law.ru/intlaw/domens/kodak-1.htm) > (last visited in March, 2010).

where he was reselling, notably, legitimately purchased Kodak goods. The registrar of domain name, specifically Russian Institute for Public Networks (RosNIIROS)<sup>115</sup> has been involved in the case as a third party. The plaintiff claimed infringement of its trademark rights requesting the court to prohibit the respondents to use Kodak trademark as a domain name and publish the decision of the court in one of the major newspapers. The court refused in considering the claim having reasoned that the major goal of the domain name in the Internet is to distinguish one area of informational space from another. The court further stated that the domain name is neither a good, nor services, moreover the respondent clearly stated on the web-site that it did not belong to Eastman Kodak Company. The court also noted that as of the date of considering the case there are no laws or any other acts that regulate relationship related to the domain name, therefore no claims regarding the domain names can be brought forward. Disagreeing with the court's decision, the plaintiff appealed.

However, the appellate and cassation courts upheld the reasoning and decision of the first instance court adding that use of domain name is not an advertising and that exhaustion of rights principle should apply (respondent's web-site contained legitimately purchased Kodak goods from Kodak or its official dealers, therefore, further use of Kodak goods can not be prohibited). In time the case reached the Highest Arbitration Court, which reversed the decisions of the lower courts, and explicitly stated that absence of statutory regulation of use of trademarks as domain names does not preclude the court from recognizing such use to be an infringement of trademark

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<sup>115</sup> RIPN, What is RosNIIROS? < <http://www.ripn.net:8080/about/en/> > (last visited on March, 2010). Russian Institute for Public Networks (RosNIIROS) was founded in 1992 by the Higher School Committee of Russia, Russian Research Centre "Kurchatov Institute" and Computer Centre of Kurchatov Institute. The goals of the RosNIIROS are to develop computer communications in the interests of Research & Education (R&E); to coordinate IP networking in Russia; to support R&E organizations in getting access to the Internet information resources via public networks. One of the main tasks of the RosNIIROS is to support the Network Information Centre (NIC) for xSU/RU. One of the constituent parts of the NIC activity is administration of .ru top level domain. RosNIIROS provides technical maintainability of the DNS functioning of ccTLD. Until 2000 RosNIIROS was registering domain names in .ru ccTLD. This function of registration was later transferred to different competing independent and accredited registrars. *See also* Venedyuhin, Domennyye voyny.

rights of Eastman Kodak Corporation.<sup>116</sup> Thus, the court sent the case back to the first instance arbitration court for reconsideration.<sup>117</sup>

The next case currently under consideration of Russian courts relates to the domain name <denso.com>. The dispute was initially considered by WIPO Arbitration and Mediation Center.<sup>118</sup> The dispute arose between Japanese Denso Corporation, a legal entity based in Aichi, Japan (“Denso Corporation/the complainant”) and DenSo LLC<sup>119</sup>, a legal entity based in Saint-Petersburg, Russian Federation (“DenSo LLC/the respondent”). Japanese Denso Corporation registered its trademark “DENSO” in 103 countries all over the world including Russian Federation. It was registered on August 31, 2000 with the priority date of July 31, 1996 for classes 4, 5, 6, 7, 8, 9, 10, 11, 12, 14, 16, 37, 38 and 42 of the ICGS which include wide variety of goods.<sup>120</sup> The respondent had a license on the trademark “DENSO”, which was registered on May 29, 2002 with the priority date of October 6, 2000. The respondent’s trademark was registered for the class 39 regarding “transportation/delivery and storage services (transportation/delivery; packaging and storage of goods; travel arrangements)”. The disputed domain name was registered on March 13, 2000.<sup>121</sup>

In 2003 the WIPO Arbitration Center issued a decision to transfer <denso.com> domain name to the complainant. However, the respondent having disagreed with such decision filed a

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<sup>116</sup> When making a decision, the Highest Arbitration Court based on the following: the respondent used the trademark owned by the plaintiff without any authorization from the latter; the respondent deliberately registered the domain name identical to the trademark of the plaintiff therefore the respondent had an opportunity to attract potential buyers to its web-site and received an economic profit from visits of potential customers of his web-site.

<sup>117</sup> As of the date of writing this work the domain name <Kodak.ru> belongs to Eastman Kodak Company, information is available at < <http://www.ripn.net:8080/nic/whois/whois.cgi> > (last visited in March, 2010).

<sup>118</sup> Case No. D2003-0482.

<sup>119</sup> The name “DenSo” was an abbreviation of the Russian version “День Софии (ДенСо)” of [Day of Sophie], see Decision of Highest Arbitration Court No. 5560/08, available at < <http://kolosov.info/domennye-spory/denso.com-a56-46111-2003-ot-11.11.2008> > (last visited in March, 2010).

<sup>120</sup> According to International Classification of Goods and Services.

<sup>121</sup> Case No. D2003-0482.



suit with Arbitration Court of Saint-Petersburg,<sup>122</sup> which recognized the right of DenSo LLC to use the <denso.com> domain name. The Denso Corporation appealed.<sup>123</sup> However the Arbitration Appellate Court upheld the decision of the Arbitration Court of Saint-Petersburg. It is interesting to note the reasoning of both arbitration courts. Initially both courts engaged in detailed consideration of procedural norms, in particular, the first instance court declined (and the appellate and cassation court upheld such decision) the request of Denso Corporation (the plaintiff) to terminate the proceedings based on the decision of the WIPO Arbitration Center. According to the first instance arbitration court consideration of a case under UDRP is not true arbitration proceedings, therefore, the decision adopted under UDRP can not be appealed in the court. The court further explained that the parties of the dispute, *i.e.* Denso Corporation and DenSo LLC had no arrangements as to consideration of the dispute under UDRP. Based on the above the court made a decision to consider the case *de novo* under the Russian laws. While considering the facts presented by the parties of the case, the courts seemed to ignore the fact that the Denso Corporation is a legitimate owner of Denso trademark registered in 103 countries of the world, including the Russian Federation (priority date: July 31, 1996) for as many as 14 classes of ICGS. The court only pointed to the fact that DenSo LLC is a legitimate licensee for Denso trademark registered in the Russian Federation for one class 39 of ICGS (priority date: October 6, 2000).

On November 11, 2008 the Highest Arbitral Court rendered a decision where it cancelled the decisions of appellate and cassation courts and upheld the decision of the district court of February 2, 2007, where district court so to say “awarded” the domain name to the Denso

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<sup>122</sup>Decision of Arbitration Court of Saint-Petersburg and Leningrad Region dated April 20, 2005, Case No. A56-46111/2003 available at < <http://internet-law.ru/intlaw/domens/denso2.htm> > (last visited in April, 2009).

<sup>123</sup> Resolution of the 13<sup>th</sup> Arbitration Appellate Court dated July 13, 2005, Case No. A56-46111/2003 available at < <http://internet-law.ru/intlaw/domens/denso2.htm> > (last visited in April, 2009).

Corporation.<sup>124</sup> In its reasoning the Highest Arbitration Court referred to the UDRP in order to define, that the Japanese Corporation had prevailing rights over the DenSo LLC as at the time of the latter's registration the Denso Corporation was already existing and considered to be well-known in the market, moreover, there was no actual use of the domain name.<sup>125</sup> However, the decision of the Highest Arbitration Court is subject to criticism, namely that the court disregarded the main clause of UDRP according to which the national courts should consider the case *de novo*, or the decision was criticized for not observing the procedural norms of the Russian Federation, to name few.<sup>126</sup>

Before the final decision of the Highest Arbitration Court, the appeal court was taking into account bona fide rights of the both parties and their good faith interest in the domain name,<sup>127</sup> as the court identified that both DenSo LLC and Denso Corporation have formally equal rights to the disputable <denso.com> domain name, which are expressed in the form of registered firm names and trademarks of the said companies. And cassation court considered that the mere registration of the domain name cannot be considered as a violation of the exclusive rights of the trademark owner.<sup>128</sup> However, there is now the last decision of the Highest Arbitration Court that might be taken into account by the courts of the Russian Federation.

The above cases represent a bright example of evolving judicial practice of Russian courts in considering trade mark and domain name disputes. Despite the growing number of domain name disputes in Russia the approaches to such disputes resolution have not been yet

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<sup>124</sup> Resolution No. A5560/08 of Highest Arbitration Court of Russian Federation of November 11, 2008, available at < <http://kolosov.info/domennye-spory/denso.com-a56-46111-2003-ot-11.11.2008> > (last visited in March, 2010).

<sup>125</sup> *Ibid.*

<sup>126</sup> *Ibid.*

<sup>127</sup> See also, Resolution of Federal Arbitration Court of North-Western Circuit dated November 11, 2005; Resolution of the 13<sup>th</sup> Arbitration Appellate Court dated October 5, 2007, Resolution of Federal Arbitration Court of North-Western Circuit dated January 11, 2008, available at < <http://kolosov.info/cases.php?p=40> > <<http://kolosov.info/domennye-spory/denso.com-a56-46111-2003-ot-05.10.2007> > (last visited in March, 2010).

<sup>128</sup> *Ibid.*

established. There are also many issues related to domain name disputes that have not been even raised and considered by the Russian courts.

#### ***2.4. European and Community Approach to Trademark vs. Domain Names Dispute Resolution***

European Union consists of twenty seven member states each of them having their specific regulation as to trademark and domain name interface. Countries, members of European Union, shall follow and comply with the recommendations of the enacted community laws for unification of legislature, such as Regulations, Directives. The important laws regulating trademarks were First Council Directive of 21 December 1988 to Approximate the Laws of the Member States Relating to Trademarks, and Regulation on the Community Trade Mark.<sup>129</sup> However, there was an interest of creating a new TLD for the whole European Union, namely <.eu>. Eventually the new TLD was introduced and in this regard there were also new community legislation adopted for the purposes of this TLD. Of course, with the adoption of new TLD there is high risk of trademark infringement. Thus, there is need for regulation of possible disputes and on community level Regulation on alternative dispute resolution was adopted, namely Commission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the <.eu> Top Level Domain and the principles governing registration. The procedure under the Regulation is very similar to the UDRP.<sup>130</sup> However, under <.eu> ccTLD any one can start alternative dispute resolution procedure as soon as one will claim that “a domain name is speculative or abuse within the meaning of Art.21 of Regulation 874/2004.”<sup>131</sup> It has differences in the time periods for submitting the defense or time for filing to the court after the alternative dispute settlement

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<sup>129</sup> CATHERINE SEVILLE, EU INTELLECTUAL PROPERTY LAW AND POLICY 213, 220-69 (Edward Elgar 2009).

<sup>130</sup> Torsten Bettinger, *Alternative Dispute Resolution Procedure for “.eu”*, in INTERNATIONAL DOMAIN NAME LAW AND PRACTICE: AN INTERNATIONAL HANDBOOK 1141-1159 (Torsten Bettinger ed., Oxford University Press 2005).

<sup>131</sup> *Ibid.*

procedure, number of language available for proceedings.<sup>132</sup> Other radical differences are that (1) EU Regulation covers not only trademarks, but other industrial rights as well; (2) the domain name dispute resolution under the national laws is not binding upon the Alternative Dispute Resolution Providers appointed by the registry; (3) under the UDRP all the requirements should be proven in a cumulative manner, while under the Regulation No. 874/2004 a party should prove “either registration or use [...] in bad faith or cannot assert any rights or legitimate interests in the domain name.”<sup>133</sup> It should be noted that the resolution of disputes for <.eu> ccTLD is designed only for “preventing speculative or abusive domain registrations” anything else should be resolved to the courts.<sup>134</sup>

To take some examples of some of the European Union countries, in Austria the legal grounds for protecting trademarks are reflected in the Trademark Protection Act, General Civil Code and Act against Unfair Competition.<sup>135</sup> Again, what is taken into account is consumer’s possible confusion, and some courts considered that there is a likelihood of confusion even if one letter in the domain name was replaced.<sup>136</sup> The content of the website placed under the specific domain name was of importance in deciding whether the goods offered by the trademark holder and the registrant of the domain name are similar.<sup>137</sup>

What if the company has existed in the market for 5 years already, and its abbreviation is similar to the protected trademark. What will be the result? In Austria the similar case Supreme Court held that if there is a conflict between two names “which interest is more worthy of protection where two persons use elected names within the framework of the general freedom of

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<sup>132</sup> *Ibid.*

<sup>133</sup> *Ibid.*, at 1152.

<sup>134</sup> *Ibid.*, at 1149.

<sup>135</sup> Reinhard Schanda, *Austria*, in DOMAIN NAME LAW AND PRACTICE: AN INTERNATIONAL HANDBOOK 80 (Torsten Bettinger ed., Oxford University Press 2005).

<sup>136</sup> *Ibid.*, at 88.

<sup>137</sup> *Ibid.*

action is to be determined according to the priority principle, according to which, as a rule, the person who first uses the sign has a better right”<sup>138</sup>, however, this priority right mostly refers to the priority of intellectual property rights, rather than “priority between intellectual property right and de facto registration of the domain name.”<sup>139</sup>

In France trademark owner can register the trademark under ThTLD, namely <.tm.fr> which was allocated specifically to those owners, it should be noted however, that registration under STLD as well as under TLD is the same as in Hungary, namely subject to specific regulations, there is a necessity of some connection with France such as establishment, domicile or in case of trademark its registration expressly including protection in France.<sup>140</sup>

While in Hungary a party can register a domain name mostly and probably only under second TLD, namely, <.tm.hu> or <.co.hu>, to name few. Moreover, only limited persons are allowed to register a domain name under <.hu> or it’s STLD.<sup>141</sup> If a party have a complaint concerning the registration or maintenance of the domain name, then the dispute will be resolved through arbitration panel and the latter’s decision is binding as if it was rendered by the usual court.<sup>142</sup> However, in the case if two parties having dispute over the domain name, then the dispute will be resolved through mediation, which would be “made up of independent experts”.<sup>143</sup>

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<sup>138</sup> *Ibid*, at 94.

<sup>139</sup> *Ibid*.

<sup>140</sup> Angela Bruning, *France*, in DOMAIN NAME LAW AND PRACTICE: AN INTERNATIONAL HANDBOOK 282-5 (Torsten Bettinger ed., Oxford University Press 2005).

<sup>141</sup> Torsten Bettinger, *Country Overviews: Hungary*, in DOMAIN NAME LAW AND PRACTICE: AN INTERNATIONAL HANDBOOK 1217-8 (Torsten Bettinger ed., Oxford University Press 2005). For instance except from nationals and legal entities founded under Hungarian Law, limited number of foreign persons, both natural and legal, “can register their sign as a trademark in Hungary as a domain name”. Domain name may be refused registration if it will found to be “illegal, abusive or delusive”, but most importantly, “a number of descriptive domain names were refused registration, such as <search.hu> or <travel.hu>.”

<sup>142</sup> *Ibid*, at 1218.

<sup>143</sup> *Ibid*.

What approach will take a Kyrgyz court should such dispute occur in the Kyrgyz Republic? Will it follow the UDRP policy or approach taken by the countries discussed? Are there clearly-formulated and well-developed laws regulating the interface of trademarks and domain names in the Kyrgyz Republic that would facilitate the judicial review and justice? Given the fact that only one dispute related to domain names is being considered in Kyrgyz courts, however, so far without any rendered decision of the court and without any information as to what the domain name is and what the conflicting parties are.<sup>144</sup> The next Chapter will deal with some of cases of trademark and domain name interface<sup>145</sup> (those that did not reach the courts yet), as well as specific recommendations will be proposed to streamline the current trademark and domain name interface at legislative and judicial levels.

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<sup>144</sup> This statement has been made based on the fact that no information is available at this point. The only publicly available information about domain name dispute involving a Kyrgyz citizen has been found in WIPO Arbitration Center database of cases, notably Alliant Credit Union v. Mark Andreev (Case No.D2007-1085) considered on October 15, 2007. The dispute arose between Alliant Credit Union, the United States company (“complainant”), and Mark Andreev, a citizen of the Kyrgyz Republic (“respondent”). The respondent registered domain name <alliant.org>, which is identical with the trademarks registered by the complainant. Following UDRP the panelist decided that the disputed domain name was identical to the complainant’s trademark. On the issue of legitimate interest the panelist contended that there was no *bona fide* offering of goods because the domain name contained and offered only links to other websites. Moreover, the panelist stated that the respondent was not commonly known by the domain name, and was not making a legitimate noncommercial or fair use. Additionally, the panelist noted that the links led to the complainant’s competitors’ websites. This fact indicated that the respondent knew about the complainant’s trademark, nevertheless he registered it, thus acting in a bad faith. The panelist also took into consideration the earlier cases with the involvement of the respondent, specifically concerning <kasparov.org> and <pnc.org> (considered by NAF). Such pattern of behavior of cybersquatting in the opinion of the panelist contributed to bad faith.

<sup>145</sup> Information regarding these cases was provided by the patent attorney law firm, conducting its activities in the Kyrgyz Republic, namely Atan Consult LLC.

## CHAPTER III. TRADEMARKS & DOMAIN NAMES INTERFACE UNDER KYRGYZSTANI LAWS

### *3.1. Trademarks & Domain Names Dispute Resolution in .kg TLD: Legislative and Regulatory Framework*

Taking into consideration the U.S. anti-cybersquatting legislative framework (known not only as the country, where the Internet was born, but also the country with the most well-developed and progressive Internet and trademark law), as well as evolving experience in domain name dispute resolution in the Russian Federation (a country with the legislative framework similar with the one of the Kyrgyz Republic) and experience of European Union and community, the interface between the trademarks and domain names in the Kyrgyz Republic will now be considered.

As was briefly described in Chapter 1, unauthorized use of a mark identical or confusingly similar with a mark of the trademark owner as an address in the Internet is deemed to be infringement of the trademark owner's rights. The Procedure on usage of trademarks, service marks, appellations of places of origin of the goods, and trade names as an address in the Internet (domain name) (the "Procedure") contains so called "safe harbor" for administrator of domain names. Under Kyrgyz law, organization that registers domain names and maintains their technical functioning (the "Administrator") is not liable for infringements arising from registration and use of identical or similar with a trademark domain names<sup>146</sup>. However, with the recent debates regarding the administration of the <.kg> and its transfer to the governmental agency Kyrgyzpatent, new "Rules on domain name registration in <.kg> zone" (the "Rules on

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<sup>146</sup> The Procedure extends its scope of applicability to trademarks, service marks, appellations of places of origin of goods and firm names. However for the purpose of this Thesis, the reference shall be made only to trademarks. See also, Regulation for Registration of a .kg Domain Name (the "Regulation") posted on the AsiaInfo web-site at <http://www.domain.kg/>. According to Clause 3 of the Regulation the Administrator has a right to stop delegation of the domain name until there would be clarifications made and information specified or it has a right to cancel it according to the decision of the court or other circumstances if the domain name holder violates the rights of third parties on trademarks, names, or copyrights or the laws of the Kyrgyz Republic.

<.kg> registration”) are expected to be adopted. According to this Rules, the domain name registrars might be liable if they register a domain name conflicting with a trademark, thus, registrars are recommended to verify whether the chosen domain name is conflicting with the interest of third parties, namely the holders of intellectual property rights.<sup>147</sup> Moreover, being liable for registration under the Rules, registrar is not liable for this under the UDRP. Question arises what is better? In France registrars were excluded from liability in case if customer will register domain name infringing trademark rights.<sup>148</sup> However, in Austria registrar “is liable as indirect participant [...] if injured party provided corresponding information and demanded intervention.”<sup>149</sup> As the practice in different countries is different, it is better to exclude the liability of registrars.

At the present moment, in Kyrgyzstan there is no alternative dispute resolution procedure available, however, if the Rules on <.kg> registration would enter into force, one of the provisions of the Rules provides for clause on dispute resolution by Board of Appeal under the Kyrgyzpatent. However, there are some ambiguities regarding the wording of the Rules, specifically, it is written that “court proceedings with regard to domain name and registered trademarks [...] shall be examined by Board of Appeal of the Kyrgyzpatent in accordance with its regulations.”<sup>150</sup> The question arises whether the Board of Appeal of the Kyrgyzpatent shall consider the issue or the Board must turn to the court for “court proceedings”? If the case is resolved by the Board of Appeal, what damages can the latter award or what are the possible consequences and remedies? How its decision is going to be enforced? At the same time, in the

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<sup>147</sup> Clause 4.2, the Rules on <.kg> registration.

<sup>148</sup> Intellectual Property Watch, *France: Domain Name Registrars Exempt from Trademark Liability* (Sept. 17, 2009) available at <<http://www.ip-watch.org/weblog/2009/09/17/france-domain-name-registrars-exempt-from-trademark-liability>> (last visited in October, 2009).

<sup>149</sup> Reinhard Schanda, *Austria*, in DOMAIN NAME LAW AND PRACTICE: AN INTERNATIONAL HANDBOOK 101 (Torsten Bettinger ed., Oxford University Press 2005).

<sup>150</sup> Clause 4.2, the Rules on <.kg> registration.



clause 6.6 of the Rules there is a reference to a court decision entering into legal force, thus should the Board of Appeal be disregarded? The transfer of the domain name will be on the basis of the court decision. The court decision will be based on the Regulation discussed above, thus, again there is no protection for the people who rightfully use their domain name, i.e. has legitimate interest in the domain name.

The Rules also contain the list of definitions, which is clearer and more precise in comparison to the definitions available in the Procedure, especially with regard to definitions of “IP address”, “domain name”, “administrator”, “KG” and “.KG zone.”<sup>151</sup> Moreover, the Rules provide grounds for the refusal of domain name registration that include: (a) the existence of domain name and existence of the trademark [...]; (b) domain name has been reserved; (c) the registration will contradict to the public policy, principles of humanity and moral (including obscene expressions, calls of inhuman character insulting human dignity or religious affiliations).<sup>152</sup> However, the grounds are too general, and any trademark whether registered in good or bad faith will be considered as violation of trademark owner’s right and refused registration.

Coming back to the existing legislative framework, the Procedure also provides some guidelines for judges considering trademark and domain names disputes, in particular, a plaintiff has to prove either of the following: (a) a domain name is identical or confusingly similar with a trademark owned by the plaintiff, or (b) registration and use of a domain name infringes

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<sup>151</sup> For example, 15 U.S.C. Section 1127 provides the definition of the domain name as any alphanumeric designation which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet. At the AsiaInfo web-site at < <http://www.asiainfo.kg/data/domain> > provided definition of the “domain” is the following: zone of Internet hierarchical names that is serviced by a set of Domain Name Servers (DNS) and is provided with centralized administration. A domain has its identification name. The Procedure defines the domain name as symbolic representation of IP-address.

<sup>152</sup> Clause 4.4, the Rules on <.kg> registration.

exclusive rights of the trademark owner. However, under more scrupulous considerations, these guidelines are not helpful.

According to this regulation, trademark holder is better off as in the court proceedings it has to show either first element “**or**” the second one. From the one side, it is clearly beneficial if the case is a clear cybersquatting one, but if the other party to the case is in bona fide use of the domain name, at the result seems to be unfair. The domain name holder’s right would be diminished. At first, this might create a precedent and possible incentive for the amendment of the existing laws, however, it is better to prevent the application of such law, rather than correct its consequences.

There was an issue between the trademark owner of UPS registered mark and the <upsgame.net> domain name owner. The trademark owner was ready to initiate court proceedings in the event if the domain name holder resists or in any way refuses to waive his rights over the domain name. The trademark owner was willing to receive the domain name and wanted to receive a declaration from the domain name holder that the latter is not going to register any similar or identical domain name in the future. Domain name owner being informed of the consequences for the violation of trademark owner’s right, transferred the domain name directly to the trademark owner. As the population is not willing to engage itself into the litigation it is much easier to give up the right in the domain name without claiming anything. It will save time, money and nerves, especially if there is no particular interest in the domain name. However, there is another case with different scenario.

German company trademark owner registered in 2000<sup>153</sup> in Kyrgyzstan trademark “ARIS” for certain classes of goods including class on providing of consultations, trainings to

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<sup>153</sup> The case is at the stage of negotiations between the law firm representing trademark owner and the agency, and does not yet reached courts of the Kyrgyz Republic. However, it is considered that there is low probability of

the public at large in the field of computers. In 2003 governmental legal entity is created in Kyrgyzstan having Russian language designation and its Russian letter abbreviation, namely “Agenstvo po Razvitiyu i Investirovaniyu Soobshchestv (which can be translated as Agency on Development of and Investment in Communities) and the abbreviation of the Agency’s name is “ARIS”, thus if used in Latin letters totally corresponds to the registered trademark namely “ARIS”. The Agency registered domain name <aris.kg>. The trademark owner company is willing to possess the domain name, and, apart from that, considers that services offered by the agency are similar to those offered by the company, thus making and creating some amount of the consumer confusion, in the way of some affiliation or connection between the companies. It should be noted that German company in the present case was willing to conclude a licensing agreement regarding the domain name.

The applicable rules in force on the territory of the Kyrgyz Republic are more beneficial for the trademark owner. While referring to the court the owner can and must prove one of the previous indicated conditions. As at the case at hand it is clear that the trademark is identical to the domain name, thus the domain name has to be transferred. There is a higher probability that the Agency is not willing to voluntarily give up the domain name as it is famous, well-known and properly advertised (specifically its sign can be found almost in every village in the city) governmental agency on the territory of the Kyrgyz Republic having multiple projects implemented and at the process of implementation, and being known under the said abbreviation.

It was noted that “there should be no automatic case of infringement if an identical or similar mark is used on the Internet as such.”<sup>154</sup> However, the existing law’s stipulations in the Kyrgyz Republic makes it clear that it is automatic infringement of the rights, as the entity has

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winning the case since the other party is the governmental entity, and governmental entities in the Kyrgyz Republic are more reluctant in giving up something that they tend to think is theirs.

<sup>154</sup> MACQUEEN, CONTEMPORARY IP, at 686.

to show that it has protected trademark on the territory of the country, and according to the applicable rules the other party will be in violation, and probably bear as was expressed at the beginning the consequences of civil, administrative or criminal nature. Even though there is clear priority of rights between these two entities, bona fide use and good faith of both parties still should be taken into consideration.

For instance in Britain the English court considered that the use of the trademark cannot be considered to be “*use*” only because anyone in any part of the world can access that site from the Internet. UK court considered that in order to define use “all the circumstances of a particular case, particularly the intention of the owner of the website and the understanding that a person using the internet would gain from reading the website”<sup>155</sup> should be taken into account.

Another solution for this kind of cases, where two existing marks, namely one as a trademark and another as a company name and both of the parties have a legitimate interest in the mark, can be the usage of the disclaimer.<sup>156</sup> For instance, in Austria Supreme Court found that denied the existence of confusion with regard to domain name <adnet.at> between the private party, defendant, and District of Adnet as plaintiff, as “defendant had placed a link to the palintiff’s website on the homepage of his website and expressly pointed out that his website was not the official website of the District.”<sup>157</sup> Thus, ARIS company owning domain name <aris.kg>, the other party namely GmbH – can register the same domain in the third level, e.g. <aris.com.kg><sup>158</sup>, as nothing prevents it from doing this on the first hand, and on the other side it can attach metatags<sup>159</sup> to its website, therefore, being listed as first as possible in the list of

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<sup>155</sup> *Ibid.*, at 687.

<sup>156</sup> *Ibid.*, at 689.

<sup>157</sup> Reinhard Schanda, *Austria*, in DOMAIN NAME LAW AND PRACTICE: AN INTERNATIONAL HANDBOOK 97 (Torsten Bettinger ed., Oxford University Press 2005).

<sup>158</sup> Moreover, the registration under the .com.kg domain is free, for more information, see <nic.kg>

<sup>159</sup> MACQUEEN, CONTEMPORARY IP, at 760. “Metatags are elements of the HTML language used to provide structured metadata about a webpage, that is, data about the material contained in the webpage.”

results provided by the search engine. However, this action might amount to a high level of confusion or trademark use, hence infringement. UK court indicated that “even if the use of a mark as a metatag amounted to trademark use, there was no consumer confusion: causing a site to appear in a search result does not suggest any connection with anyone else.”<sup>160</sup> And if user accesses the webpage even through the search results and is aware of what one is looking for, there will be no confusion. Moreover, on the website of ARIS one can find a charter of the Agency, hence, through reading it one cannot come to the conclusion that two companies are somehow related. But another issue of “dilution” may arise in modern society, when the owner of the trademark requires protection even if the goods are not similar and there is no consumer confusion.<sup>161</sup>

What if the case will reach the courts of the Kyrgyz Republic, how they will decide the case and settle the dispute. In this case we can say that these two companies, namely German trademark owner and the Agency, have legitimate interests in <aris.kg> domain name, especially taking into consideration the fact that Trademark Law prohibits *unauthorized* use of a mark identical or confusingly similar with a mark of the trademark owner as an address in the Internet, which cannot be said about the case at hand. Both companies involved have a legitimate claim to the domain name, thus, referring only to the Procedure available the Kyrgyzstani court will have difficulties in adjudicating such case as the law in its current state does not efficiently regulate the issue. Provision regarding unauthorized of a mark as an address in the Internet appeared due to absence of legal regulation of the issue.<sup>162</sup> However, the so-called Internet provision of the Trademark Law does raise numerous issues, which remain to be unregulated. In addition, this

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<sup>160</sup> *Ibid*, at 691.

<sup>161</sup> CATHERINE SEVILLE, EU INTELLECTUAL PROPERTY LAW AND POLICY 211 (Edward Elgar 2009).

<sup>162</sup> Provision regarding the use of domain name identical or confusingly similar as an address in Internet was introduced into the Trademark Law in 2003.

ARIS case is very similar to the <denso.com> case which was also discussed above. Even though the decision is criticized, this is also a possibility of resolving the case.

Moreover, there is a second issue regarding the governmental designations, like parliament or courts. Are they protected? Under the present regulation it is only trademarks usage in the domain name receives protection. What if one registers domain name “kyrgyzgovernment.kg” or “jogorkukenesh.kg” (= “parliament”/ “highest council”) and will set up a forum or some critical discussion on the government/parliament itself. Here two issues collapse with each other, on the one hand is protected freedom of speech (unfortunately) and on the other hand reference to the Kyrgyz Republic as the entity being accountable for its bodies. In Austria similar issue was resolved by equating “federal army,” namely “Bundesheer”, to protected name of a person as it was “designation with the function of a name if it referred to the bearer of the name as such or an enterprise.”<sup>163</sup> Moreover, in this case Supreme Court held that usage of the word “bundesheer” in the domain name and providing the opportunity for discussion provides for the owner of the domain name an advantage to which the latter is not entitled as being in no way related to the Federal Army. But most probably, the usage of this kind of domain names and comments would be considered contrary to the public policy issues.

There is another official dispute regarding the domain name <sk.kg><sup>164</sup> that belonged to the local newspaper, namely “Slovo Kyrgyzstana” [Word of Kyrgyzstan]. The domain name was registration was not used and not working, and assumingly it was free for registration by any other person. When the newspaper decided to restore the domain name it belonged to private person who posted on the web-site information about the hunting activities in Russian

<sup>163</sup> Reinhard Schanda, *Austria*, in DOMAIN NAME LAW AND PRACTICE: AN INTERNATIONAL HANDBOOK 93 (Torsten Bettinger ed., Oxford University Press 2005).

<sup>164</sup> Kyrgyzpatent, *Chief Editor of “Slovo Kyrgyzstana Plus” Newspaper requests “AsiaInfo” to return its domain name* (March 16, 2010), available at < <http://patent.kg/en/node/1591> > (last visited in March, 2010).

Federation. The publishing house required the transfer of the domain name back to it and involved Kyrgyz patent to this issue. Kyrgyzpatent on their part stated that “the transfer of the domain name «sk.kg», which is the official state information resource , contradicts to the public policy of the Kyrgyz Republic in the field of mass media.”<sup>165</sup> It was stated also that before any transfer of the domain name, registrar and administrator should first inform the previous domain name owner as to the latter’s willingness to possess further its domain name, otherwise, the domain name could be freely transferred to other persons or legal entities.

In relation to the issues of personal names, it can be said that sometimes the surname of the person is not the only one in the given country. For instance, in the Kyrgyz Republic the surname of the president is Bakiev. One person, having the same surname, however, not in any way related to the family of the president was willing to register domain name as <bakiev.kg> and offer there his photo service, i.e. taking pictures of different events, filming or some other similar activities. However, he was strongly advised not to do so. There is no legislation on this issue on the first place as personal names are not protected as trademarks and not considered to be trademarks. Secondly, he could have in good faith put a disclaimer that he is not in any way related to the president or his family and offer its services to the public at large. There is another issue with regard to personal names. If the person is no longer alive, but he was famous during his days (and still is), but another person knowingly registers the domain name with the <familyname.kg> of that person with the intent of selling that domain name. The laws are silent on this issue, thus, it is not clear whether it would be considered as a bad faith registration and unauthorized use of a person’s family name.

What if a trademark is used in three- and four-level domain names? Will that be considered unauthorized use of trademark in the Internet? For instance, if a web-site selling cars

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<sup>165</sup> *Ibid.*

online has headings by various models of cars (like, BMW, Mercedes-Benz, Honda, Toyota, and etc.), such as <bmw.auto.kg> or <honda.auto.kg>, which is a normal structure for sub-domain names, will the use of such headings be considered as unauthorized use of the trademarks? The current legislation is silent on the issues above.

As with the ARIS case, when one and the same trademark is registered under the ICGS for different classes of goods and services or firm name? Which of the trademark owner should be given preference in registering the identical domain name? How will the dispute between the legitimate trademark owners be decided? Another issue regarding the legitimate interests relates to personal names identical with the names of celebrities and politicians or with cultural and religious values. What if a person has the identical name with the famous politician? Will the latter have the priority right over the person who registered such domain name for his personal use?<sup>166</sup>

The law does not make it clear what prohibition of use of domain name identical or confusingly similar with the trademark means. Does it mean that a registrant may register such domain name and post a note “under construction” and such registration will not infringe the rights of a trademark owner? Or is it enough to merely register the domain name, thus “use” it.

Furthermore, if the legitimate trademark owner wins the case in the court and registration of the domain name identical or confusingly similar is terminated by the court’s decision, there is no any procedure that would allow the legitimate trademark owner to receive the domain name

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<sup>166</sup> It should be noted that there are many kinds of legitimate interests in domain names other than trademark interests that should be protected by the domain name system. These legitimate interests may result in new kinds of disputes, such as, (a) competitions between trademark holders and those wanting to criticize or parody them; (b) competitions between trademark holders and those wanting to assert free speech interests more generally; (c) competitions over domain names between people with corresponding personal names and those wanting to comment on those people, either in a positive or negative way; (d) conflicts between people with non-trademark interests, such as personal names, cultural or geographical interests, in particular domain names and cybersquatters attempting to extort money for use of the domain name, and (e) conflicts about competing interests in domain names relating to political campaigns. Jacqueline Lipton, *Domain Name Sharing*. See also, Jacqueline Lipton, *Beyond Cybersquatting*.



automatically. The period between the court's decision and a possibility of the trademark owner may be used by third parties or cybersquatters for registering this particular domain name. Probably, after the adoption

These are the major gaps identified in the current Kyrgyz laws attempting to regulate trademark and domain name interface, yet they clearly show that the current Kyrgyz laws are ill-equipped to resolve trademark and domain name disputes efficiently. The probable and possible solutions can be extracted from the experience of other countries. Like it was discussed above on the laws of the US, Russia, Europe, or UDRP what recommendations can come up?

### ***3.2. Framework for Efficient Trademarks and Domain Names Dispute Resolution in .kg TLD: Selected Recommendations***

Given the discussion above the following recommendations can be made as to improvement of the current Kyrgyz laws regulating trademark and domain name interface.

*Amendments and/or Adoption of Legal Acts:* There is a need to amend the Trademark Law and adopt a new anti-cybersquatting procedure. In particular, the Law and/or procedure should stipulate, for example, clearly formulated definitions of “cybersquatting activity”, “cybersquatters”, “domain name”, “sub-domain name”, “domain name registrar” and “domain name registrant”, “unauthorized use of domain name identical or confusingly similar with trademark”, explicit protection for well-known trademarks;<sup>167</sup> non-exhaustive grounds for bad faith registration; defenses available to registrants; strong remedies, such as forfeiture, cancellation and transfer (perhaps, automatic) of the domain name. As was discussed earlier, the Trademark Law does not contain any definition of “domain name”, and “cybersquatting”. In fact

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<sup>167</sup> Currently the well-known trademarks are protected by Regulation on Well-Known Trademarks in the Kyrgyz Republic approved by Resolution of the Government of the Kyrgyz Republic on August 24, 2000, No. 520 (as amended on May 15, 2001). However, perhaps stronger protection of well-known trademarks is needed with respect to use thereof as domain names.

the word “domain name” is not at all mentioned in the Trademark Law. The only definition of the “domain name” is found in the Procedure yet the formulation does not correctly reflect the nature of domain names.<sup>168</sup> Neither Trademark Law nor the Procedure contains grounds for identifying bad faith.

However, while having some concerns as to amendment it is necessary to take into account social values, which should be expressed in the trademark and domain name statutory provisions as well, such as promotion of free speech on the Internet, protection of personal privacy, facilitation of political communications, in particular, in the context of an election campaign.

*Guidelines for Judiciary:* Special guidelines based on the amended and/or new Trademark Law and Procedure should be developed for the judiciary; as well as capacity building of the judiciary in terms of understanding trademark law and domain interface is required.

*Adoption of UDRP or Similar Policy:* One of the possibilities for trademark and domain name dispute resolution is to include reference to UDRP applicability in an agreement executed between a registrar and registrant. However, dispute resolution under UDRP by one of the ICANN-accredited dispute resolution centers will be burdensome due to its relatively high fees. Therefore, perhaps a better solution will be adoption of UDRP-type policy, which will simultaneously serve as guidelines for the judiciary in resolving trademark and domain name disputes. While Kyrgyzstan does not recognize UDRP, the same way as Czech Republic, however, the latter has a “conflict resolution procedure for the <.cz> ccTLD”<sup>169</sup>, namely, the dispute might be solved through mediation, if not then the dispute can be submitted to

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<sup>168</sup> For instance, see, comparison of domain name definitions under Kyrgyz Law and ACPA and Regulations.

<sup>169</sup> Renata Potmakova, *Czech Republic*, in *DOMAIN NAME LAW AND PRACTICE: AN INTERNATIONAL HANDBOOK* 219 (Torsten Bettinger ed., Oxford University Press 2005).

arbitration.<sup>170</sup> However, if the Body of Appeal of Kyrgyzpanent is going to perform functions of alternative dispute resolution, then it should provide for all possible protection for both trademark owner and domain name registrant.

*Creation of a Special Arbitration Tribunal:* As an alternative dispute settlement mechanism, namely an arbitration panel for resolution of any disputes related to domain names or informational technologies in general, can be established in and administered by the Association of Communication Operators of the Kyrgyz Republic<sup>171</sup> with involvement of technical experts and lawyers specializing in intellectual property and internet law.

*Domain Name Sharing or Compulsory Licensing Arrangements:* Domain name sharing<sup>172</sup> can be applied in cases when competing legitimate interests are involved. Such sharing can be done through compulsory licensing arrangements which shall be applicable to political versus private personal name, personal names versus cultural and religious words and phrases.

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<sup>170</sup> *Ibid.*

<sup>171</sup> More detailed information about the Association of Communication Operators can be found at <[www.connect.kg](http://www.connect.kg)> (last visited in March, 2010).

<sup>172</sup> Jacqueline D. Lipton, *Beyond Cybersquatting*. Professor Lipton further notes that these are preventive rather than curative measures, nevertheless if used together with transfer and cancellation of the disputable domain name.

## CONCLUSION

The development of intellectual property law was all the time associated with its improvement and adoption to modern challenges at the legislative level. Comparatively recent challenge to trademarks rights was posed with the development of domain name system. Because of growing importance of the Internet and global feature of domain names, trademark owners saw a great opportunity to be present world-wide. For trademark rights being specifically protected within particular territory and applicable to certain class of goods and services opportunity to be present globally was attractive offer. However, because of the uniqueness of domain names the challenges started to arise.

Clashes between trademarks and domain names gave birth to the phenomenon of cybersquatting and its various forms. Disputes related to domain names also raised a number of non-trademark issues related to freedom of speech, personal privacy and cultural and religious values.

Whereas trademarks are protected under established international minimum standards, no international-level treaty exists with respect to domain names. Domain names are regulated through rules and policies adopted by ICANN, which is the main body governing domain names. With rise of the trademark and domain name disputes Uniform Domain Name Dispute Resolution Policy (“UDRP”), namely document regulating specifically these disputes, has been adopted for such generic top-level domains as .com, .org, .net. Some countries voluntary accepted the UDRP with respect to their country-specific top-level domain zones. The disputes under UDRP are resolved in several quasi-arbitration tribunals, who are accredited by ICANN and competent to resolve disputes related to domain name registration.

While the development of the Internet started in the United States, it was one of the first countries that adopted Anti-Cybersquatting Consumer Protection Act (“ACPA”). However, both UDRP and ACPA, even being efficient mechanisms for trademark rights protections, are considered to be efficient pro-trademark owner mechanisms.

Pursuant to UDRP a losing party of a trademark vs. domain name dispute has the right to protest on the decision of the UDRP panel in the national courts. The Russian case law is perhaps the first emerged in the post-Soviet area with regard to trademark and domain name disputes, specifically with regard to disagreement to UDRP panel’s decision on domain name transfer.

In the Kyrgyz Republic the issue of cybersquatting has not been yet considered by the courts with result of rendering decision. However, the cases already started to emerge, therefore, there is an urgent need to revise current Kyrgyzstani laws regulating the issues of trademark and domain name interface and provide for efficient resolution mechanisms. Following the currently developing Russian case law and similar statutory provisions regarding unauthorized use of trademarks as an address in Internet (or domain names), the Kyrgyz Republic is in an advantageous position in terms of revising and/or establishing an efficient legislative and regulatory framework in the area of trademark and domain name interface because at present cybersquatting is not a wide-spread phenomenon in the country. This provides a remarkable possibility to review the existing Kyrgyz laws governing trademark and domain names and improve it based on the experience of foreign countries, such as the United States; dispute resolution under UDRP; and Russian case law. In this regards, it is proposed to amend the Kyrgyz Trademark Law and draft new anti-cybersquatting procedure that would stipulate for clearly formulated provisions, including, but not limited to definitions (such as domain name,

cybersquatting, unauthorized use, and etc.), non-exhaustive list of bad faith factors, explicit protection of well-known trademarks, and strong remedies.

Moreover, there will be strong need to consider and provide in respective laws issues with regard to competing legitimate interests of several trademark owners, or with regard to a domain name owner having legitimate right and interest in the domain. The Kyrgyz Republic may consider and stipulate in the respective laws some post-ACPA and post-UDRP issues, which in particular include cases of personal names registered as a domain name vs. cultural and religious values (for instance, a person whose name is Mokhammed wants to register domain name <mokhammed.kg>); or personal name registered as a domain name vs. name of a celebrity (for instance, a person, whose name is Assol Moldakmatova or Dilbar, identical to the name of a famous Kyrgyz celebrity or fashion designer, wants to register domain name <assolmoldakmatova.kg>, <dilbar.kg>); registration of a domain name as a freedom of speech (for instance, a person is not satisfied with the services of a company X, wants to register the domain name <worstcompanyeverX.kg>; registration of a domain name identical to the name of a political party, which runs for elections (for instance, there is a person's name is Akjol, therefore, he registered <akjol.kg> prior to the political party "Akjol").

It might be possible to, so to say, share the domain name in the form of compulsory licensing arrangements (and sometimes temporary, for instance for the period of election campaign) can be a solution for some of the situations above. Yet should the above cases arise, it is up to Kyrgyz court to resolve the issue. This raises another problem, which mainly lies in poor capacity of the judiciary system in terms of adjudication on disputes related to domain names. Therefore, it is submitted that apart from clearly formulated statutory provisions the Kyrgyz

courts will need to have understanding and knowledge of the operation of domain names and interface thereof with trademarks and other non-trademark issues.

The information and communication technologies develop with an unusual pace, resulting in emergence of interesting issues and challenges. One of the examples of such interesting issues and challenges is trademark and domain name interface, which in the context of the Kyrgyz Republic requires specific legislative and regulatory measures shortly outlined in this work.

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