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COMPARATIVE LEGAL CHARACTERISTICS OF THE 'UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY' AND THE 'EU ALTERNATIVE DISPUTE RESOLUTION RULES'

The 'Uniform Domain Name Dispute Resolution Policy' (UDRP) is a document based on recommendations of the World Intellectual Property Organization (WIPO) and approved by an international non-governmental organisation – the Internet Corporation for Assigned Names and Numbers (ICANN). The main aim of the UDRP is to provide a trademark holder with a possibility to protect rights in case of their violation by a domain name registration and use made in bad faith. Being a mandatory part of contracts on domain names registration in gTLDs, the UDRP is also applied in ccTLDs. At the same time, ccTLDs managers may modify the UDRP. Thus, there are some variations of the UDRP applied in different ccTLDs. One of the variations is the '.eu Alternative Dispute Resolution Rules' (ADR Rules) applied in .eu, .euo and .eu domains. The purpose of the paper is to compare the ADR Rules and the UDRP.

To meet the purpose, we will provide a comparison based on the following criteria.

1. The legal nature of the documents and a possibility of court proceedings. The UDRP approved by an international non-governmental organisation (ICANN) does not have binding nature. According to the UDRP, it is a part of contracts on domain names registration [1, paragraph 1]. Therefore, it is mandatory for a holder of a domain name but not for holders of trademarks who may initiate proceedings under the UDRP or at a court on their own wish. Regarding the ADR Rules, they were approved by the not-for-profit association EURid vzw appointed by the European Commission as the registry manager of the .eu, .euo and .eu domains [2]. The obligation for the EURid vzw to provide alternative dispute resolution rules are established by the Article 11 of the Commission Implementing Regulation (EU) 2020/857 of 17 June 2020 [3, art. 11].

According to the Preamble of the ADR Rules, 'The interpretation and application of these ADR Rules shall be conducted in the light of the EU legal framework, which shall prevail in the event of conflict' [4]. However, although the ADR Rules are based on the EU law, these rules per se do not have binding nature. Based on provisions of the 'Terms and Conditions for .eu, .europa and .europa Domain Names', it is possible to conclude that the ADR Rules act as a part of contracts on domain names registration and are mandatory for domain names holders as parties of these contracts [3], but not for trademarks or other objects holders who may decide whether to initiate a proceeding under the ADR Rules or to file a court proceeding.

Regarding further consideration of an issue of relationships between alternative domain name disputes proceedings and court proceedings, it is worth mentioning the following. Under the Paragraph 4(k) of the UDRP, 'the mandatory administrative proceeding requirements set forth in Paragraph 4 shall not prevent either you [a domain name holder] or the complainant from 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' [1, paragraph 4(k)]. Paragraph 5 of the ADR Rules contains an analogous provision, 'The conduct of the ADR Proceeding shall not be prejudiced by any court proceeding' [4, paragraph 5].

2. Protection of intellectual property and other objects. Although there are cases in which protection under the UDRP was granted not only to trademarks but to other objects (for example, a personal name in the case 'Jeanette Winterson v. Mark Hogarth' [5]), the UDRP literally protects only trademarks. In contrast to this, the ADR Rules consider protection of objects broadly. Under the Paragraph 1(b)(9) of the ADR Rules, these Rules provide protection to 'names in respect of which a right is recognised or established by the national law of a Member State and/or European Union law' [4, paragraph 1(b)(9)]. Such names may include 'copyright, trademarks and geographical indications provided in national law or European Union law, and, insofar as they are protected under national law in the Member States where they are held: unregistered trademarks, trade names, business identifiers, company names, family names and distinctive titles of protected literary and artistic works' [4, paragraph 1(b)(9)].

3. Applicable disputes. While under the UDRP, to grant a protection, a complainant shall prove all of the following facts: (i) a domain name is identical or confusingly similar to a trademark, (ii) a domain name holder has no rights or legitimate interests in respect of the domain name, and (iii) a domain name has been registered and is being used in bad faith [1, paragraph 4(a)], under the ADR Rules, a complainant shall prove the first fact (regarding to a trademark or other protected sign) and either the second or the third fact [4, paragraph 11(d)(1)]. In addition, regarding the third fact, under the ADR Rules, 'it is sufficient to prove that either registration or use of the disputed domain name by the registrant is in bad faith, whereas the UDRP requires the complainant to prove both' [6].

4. Evidence of bad faith. Both the UDRP and the ADR Rules establish non-limited lists of circumstances indicating bad faith registration and (or) use of a domain name [1, paragraph 4(b); 4, paragraph 11(f)]. However, the circumstances of the ADR Rules differ from the ones of the UDRP. For example, under the Paragraph 4(b)(i) of the UDRP, evidence of bad faith registration and use may be circumstances indicating that a domain name has been registered or acquired 'primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your [a domain name holder'] documented out-of-pocket costs directly related to the domain name' [1, paragraph 4(b)(i)]. The ADR Rules contains an analogous provision but (i) protecting not only a trademark but 'a name in respect of which a right is recognised or established by national and/or European Union law', (ii) taking into account that a domain name registration or obtaining shall be aimed primarily at a transfer of the domain name to the name holder or a public body, and (iii) without regard of a proposed price [4, paragraph 11(f)(1)]. The second circumstance of bad faith under the UDRP is a domain name registration aimed at prevention of an owner of a trademark to reflect the mark in a corresponding domain name, provided that a domain name holder has engaged in a pattern of such conduct [1, paragraph 4(b)(ii)]. The ADR Rules also contain this provision (regarding names, not only trademarks), but engaging in a pattern of conduct is only one factor which may be applied, the others are non-using a domain name 'for at least two years from the date of registration',

and declaration of intention to use a domain name but failing in doing so 'within six months of the day on which the ADR Proceeding was initiated' [4, paragraph 11(f)(2)]. The third and fourth circumstances of bad faith established by the UDRP and the ADR Rules are almost the same [1, paragraph 4(b)(iii, iv); 4, paragraph 11(f)(3, 4)]. Also, the ADR Rules contain an additional circumstance which is not included into the UDRP, 'the domain name is a personal name for which no demonstrable link exists between the Respondent and the domain name registered' [4, paragraph 11(f)(5)].

Having compared the UDRP and the ADR Rules based on the criteria mentioned above, it is possible to make the following conclusions. The UDRP and the ADR Rules do not have binding nature. They may act as parts of contracts on domain names registration and are mandatory for domain names holders as parties of such contracts but not for potential complainants. Both the UDRP and the ADR Rules leave room for courts proceedings. The difference between these documents is in their content. The ADR Rules provide broader protection from domain name registration or use in bad faith. Firstly, they may be applied not only regarding trademarks (as the UDRP) but regarding any names protected by national or the EU law. Secondly, to grant a protection under the ADR Rules, a complainant shall prove either lack of rights or legitimate interests in respect of a domain name by its holder, or bad faith registration or use of a domain name, while under the UDRP, it is necessary to prove all of the facts. Thirdly, there are different lists of bad faith circumstances established by the UDRP and the ADR Rules. Analysis of them leads to a conclusion that the ADR Rules provide more protection to a complainant than the UDRP does. In this context, a question is to what extent the ADR Rules provide good faith domain names holders with their rights' protection. This issue requires further research.

References

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