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Cybersquatting in Kazakhstan: The Bobcat Trademark Dispute

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In my previous articles—Trademark Squatting in Kazakhstan: From Russia with Love and its Part II—I reported cases where Russian companies attempted to register trademarks of well-known foreign brands in Kazakhstan. This post is now about the equivalent problem

in the digital space, where cybersquatting has become a pressing issue: domain names identical or similar to well-known trademarks are registered in bad faith to mislead consumers by implying an association with established brands, creating obstacles for trademark owners in securing their domain names.

As noted in Fighting Bad Faith Domains and Company Names in FYR Macedonia, such practices complicate brand enforcement efforts, particularly when it comes to proving the similarity of goods and services—a key criterion under trademark law for establishing infringement. Since legal frameworks often define trademark violations based on this similarity, trademark holders may face limited options: they can either purchase the domain from the registrant or attempt to license or reclaim it through a contractual agreement.

This challenge was at the core of a recent Kazakhstani court case.

Doosan Bobcat vs Pavel Gross-Dneprov

Doosan Bobcat North America, Inc. is the right holder of the BOBCAT trademarks in Nice Classes 7 and 12, registered in Kazakhstan under Registration No. 85237 and 85238. These registrations, effective from August 7, 2023, protect the brand's use in connection with construction and agricultural machinery, vehicles, and related equipment.

Registration №85237	Registration №85238
	BOBCAT

The domain "*www.bobcat.kz*" was registered by Pavel Gross-Dneprov on July 26, 2021. Doosan Bobcat argued that this domain name was confusingly similar to its registered trademark, that its use violated the company's exclusive rights, and that it could mislead consumers into believing an affiliation existed. Moreover, the domain had been listed for sale, indicating potential bad faith intent.

Pavel Gross-Dneprov, who refers to himself as a domain broker, but is also known as a cybersquatter, domainer, and domain investor, owned approximately 10,000 domain names (based on 2021 data).

The complexity of this case stemmed from the fact that, unlike in traditional trademark infringement cases, the defendant was not using the domain for similar goods or services. This raised questions under Article 43 of the Law on Trademarks, which requires similarity between the disputed use and the registered goods or services for a finding of infringement.

The court therefore also examined the defendant's conduct for bad faith intent, as required under Article 177 of the Entrepreneur Code of the Republic of Kazakhstan, which prohibits unfair business practices.

Despite the legal challenges, the case was ultimately resolved by Gross-Dneprov acknowledging the claim and conceding to the plaintiff's demands. As a result, there was no court decision on the merits, including on whether bad faith was established or how the legal criteria under Article 177 would have been applied.

Had the defendant not acknowledged the claim, it would have been hard for the plaintiff to prove trademark infringement, given the lack of direct commercial use and the requirement under Article 43 to establish similarity between the domain and the trademark's registered goods or services. The case would likely have turned on the bad faith argument if the claimant had provided evidence of the number of domain names held by the defendant or drawn an analogy to trademark squatting, as discussed in Part II, where LLC "ALAYV TRADE" sought trademark registration in 14 other countries.

Legal Changes and Their Impact

Proving trademark infringement was previously easier. Before a 2018 amendment, Article 43 of the Law on Trademarks recognized infringement not only in cases of unauthorized use of similar goods or services but also in instances where a trademark or designation of origin was used without

permission in public telecommunications networks, including the Internet.

This broader definition allowed trademark owners to challenge unauthorized domain names or online use, even without proving similarity of goods and services.

However, the 2018 amendment significantly narrowed this scope. The current Article 43 recognizes infringement only when there is similarity of goods and services or when unauthorized use occurs *in mass media*. This change has made it more difficult to enforce trademark rights against unauthorized domain names and online platforms.

As a result, trademark owners now face greater challenges in cybersquatting disputes and must rely on unfair competition or bad faith claims, rather than direct trademark infringement – unless of course the domain name is indeed used in relation to similar goods or services to those of the trademark holder.

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