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Trademarks and Domain Names in Sweden

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Abstract

Internet domain names are considered to have a great value as trademarks and intellectual property assets. The systems regulating them are still in an early stage of evolution, they have not yet been harmonized and systems in different countries are very different. This paper will describe the Swedish system, which is administrated by a non-governmental organization that controls both the development of rules and considers applications for domain names. The most interesting and original aspect of the Swedish system is that there are very strict rules with requirements that need to be fulfilled in order to register a domain name in the Swedish top domain .se. This system has resulted in a very low number of disputes concerning the right to a registered domain name but, on the other hand, it has caused many disputes when companies have been denied to register a domain name they wanted. The system has been criticized for being bureaucratic as well as lacking predictability and legitimacy. This paper will present these problems and interesting cases and examples of the consequences of the rules. This paper will also discuss the pros and cons of the Swedish domain name system.

Introduction

Every computer connected to the Internet has an individual numerical address, referred to as an IP-number, which enables a message from one computer to another to find its way on the Internet.^[1] These IP-numbers are naturally too difficult for a human being to memorize. We are more used to remember addresses in the form of words and therefore we have created a system that translates the IP-numbers into words, the domain name system. A typical domain name consists of a maindomain located in a topdomain and subdomains attached to the maindomain. The appearance in an Internet browser window is subdomain.maindomain.topdomain. An example is the address to my department at the University "informatik.gu.se". Topdomains can be either generic, like .com, or belong to a nation, like .se. The maindomain name usually lead to the homepage^[2] of a website^[3], in my example "gu" (Gothenburg University), and then subdomains are linked to the homepage, like informatik (the Department of Informatics) in my example.

The domain name system requires everyone on the Internet to have a unique address. But at the same time different companies in different countries or different kinds of business do have similar or identical names. This is the problem with domain names and Sweden has tried to solve this in an original way, witch is interesting to study.

The Swedish system has been criticized and discussed for the last couple of years. This resulted in that the government formed The Committee on Domain Name Administration^[4] and ordered it to

evaluate the domain name system. The result was the preparatory work SOU 2000:30, .se?[5]. The committee suggested rather substantial changes but, partly due to that the states power over the Swedish top domain is not clear, it is not yet certain to what extent changes will be made.[6] The committee's evaluation and the process of changing the regulation will also be described below.

The importance of domain names

Since the domain name is the address that enables people to find other people, companies or organizations it is important. Today there are about 90,000 separate .se domains[7], i.e. approximately one domain per 100 inhabitants. The large interest in domain names alone proves that it is an important asset. But what is important is not just to have a domain name; it is just as important that the domain name is good, i.e. easy to remember and able to be noticed on the Internet.[8] For businesses the commercial importance of domain names, as trademarks can be tremendous.[9]

Generic domain names consisting of keywords describing the offered product or service are considered to supply a marketing advantage. Not only are they easier to remember[10], when for instance heard or seen in commercials, but the keywords will also help the website to rank higher on searches in a search engine.[11] In SOU 2000:30 domain names were said to be an important, perhaps even deciding, factor when it comes to doing business online.[12]

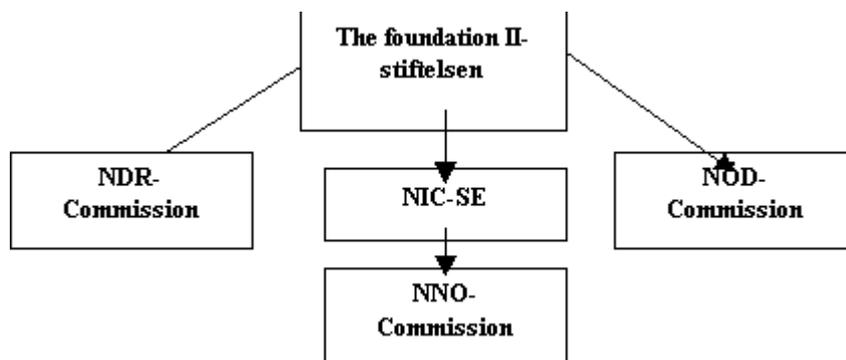
The Swedish system

In 1997 the responsibility for the top domain .se was transferred to the non-profit foundation IIS, Internet Infrastructure in Sweden (profits from operating the Internet in Sweden are invested in research and development). Earlier, from 1985-1997 the responsibility had been assigned to one single person, Björn Eriksen. The IIS foundation formed a company named NIC-SE (Network Information Centre Sweden AB) that is responsible for the marketing and administration of the top-domain .se.[13] In order to evaluate and develop the principles of assignment of domain names the foundation IIS also created a couple of commissions.

The NDR-commission creates and develops the rules concerning the assignment of domain names. NIC-SE then applies these rules when they receive an application for a registration of a new domain name. The applications for new, and the updating of existing, domain names are supplied by authorized representatives. These are often Law-firms or Patent-firms. The rules from the NDR-commission are supposed to minimize the possibility of cybersquatting, i.e. domain names being registered with the purpose of selling them. The rules are also supposed to make sure that the right company is represented by the domain name similar to the company name.

The NNO-commission was founded by NIC-SE and is the first possibility to appeal a decision by NIC-SE. The foundation IIS has also created one additional appeal court, the NÖD-commission.

The purpose of these commissions is to provide a quick and economical alternative to have a decision reconsidered. The decisions of NIC-SE and the commissions can also be taken to a public Swedish court.



The regulations

The regulation now in force is named *Regulations for the registration of domain names under the ".se" top domain Version 2.0 (Domain Name Regulations in Sweden)*.^[14] I will describe the part of the regulations that are the most important, how they differ from other countries and the regulations that have caused the most problems.

General regulations

"REGULATION A:

A domain name in Sweden (.se) can consist of the letters a-z, the numbers 0-9 and the hyphen. It must be started and ended by a letter or a digit, and cannot consist of just digits.

The domain name should contain at least three characters, and have a maximum of 63 characters."^[15]

This is the opening rule in the regulations. It has been the subject for criticism by companies and organizations wanting to register domain names with less than two characters. According to the Appendix of the regulations there is a possibility to make exceptions from the rule:

"In order for a domain name which consists of fewer than three characters to be able to be registered, it is required that the applicant can show that the domain name applied for is generally known in Sweden. For example, OK (OK Marknadsservice AB, ok.se), LO (Landsorganisationen, lo.se) [the Swedish Trade Union Confederation] and SJ (Statens Järnvägar, sj.se) [Swedish Railways]."^[16]

However, it has proved to be difficult to get an exception. For example the magazine *Privata affärer* was not allowed to register pa.se^[17], M2 Engineering Aktiebolag was not allowed to register m2.se^[18] and CD.SE Sverige AB was not allowed to register cd.se.^[19]

A domain name must reflect the name of an enterprise

"REGULATION B:

The domain name shall refer to an enterprise with a connection to Sweden, and reflect the name of the enterprise as this is stated on the registration certificate issued by the Swedish authorities.

If the name contains national characters (for example å, ä or ö), these shall be transliterated in accordance with Appendix 2."^[20]

Regulation B is the most important regulation in the Swedish domain name system. By demanding a domain name to refer to a registered company name the possibility to register domain names are limited. Since it is not allowed to register a generic name or a name describing a type of business as a company name the result is that one cannot register such a name as a domain name either. Generic domain names are considered to be one of the most efficient ways to market a product or service on the Internet[21] and therefore this regulation has been criticized and resulted in a number of appeals to the commissions.

The regulation is however not absolute; the Appendix supplies the possibility to make certain discrepancies between the domain name and the name of the enterprise. It is ok to register a name "if the discrepancies correspond better with how the enterprise is known by the majority of those who use the products or services of the enterprise. A condition is however that the domain name is closely linked to the registered name of the enterprise." [22] It is also allowed to change the form or sequence of the words and to register only the business name dominant or the equivalent.[23]

By applying to register only the business name dominant some companies have managed to get generic domain names. Examples are Golfbutiken Sverige Aktiebolag registering golfbutiken.se[24] (which translates as golfstore.se), Aktietrend Stockholm AB registering aktietrend.se[25] (which translates as stocktrend.se), Enkelt Sverige Aktiebolag registering enkelt.se[26] (which translates as simple.se) and Intelligence Sverige AB registering intelligence.se[27] But this does not mean that it is simple to get a generic domain name in the .se top domain. On the contrary it is very difficult to register a generic name as a company in Sweden.

dodging the regulations

There is however a loophole in the regulations that is used to register good domain names. Elbolaget i Norden AB applied for registration of elbolaget.se (which translates as theelectricitycompany.se) but the application was denied by NÖD because elbolaget is a descriptive word and that it also was too similar to other domain names.[28] Despite this the domain elbolaget.se does exist and takes you to the homepage of Elbolaget i Norden AB. The explanation is that Elbolaget i Norden AB registered a daughter company named Elböläget AB. Elböläget does not mean anything in Swedish so there was no problem with registering it as a company. Elböläget AB then applied for registration of elbolaget.se using the transliteration rules[29] to remove the dots over o and a.

The possibility to take advantage of the characters å ä ö and the transliteration rules does not always work. NIC-SE and the commissions might find that the name does not reflect the company name and not allow registration of the business name dominant. The result in the case above would be that Elböläget AB would not get the domain name elbolaget.se but elbolagetab.se[30], which is not as attractive. Examples are that Mäil Handelsbolag[31] was not allowed to register mail.se[32] and w&w&w Svenska Handelsbolag were not allowed to register www.se.[33]

Despite this attempt by NIC-SE and the commissions to apply the regulations strict in order to prevent registrations of generic domain names many have succeeded to do so. A Swedish company called 1-domain, Europe has the business idea of registering generic domain names and sell them. [34] The company is now offering 330 Swedish domain names generating 250.000 visitors per month.[35] Several of the names have been acquired by using the characters å, ä and ö the same way as Elbolaget did.[36] Selling domain names is of course not allowed by the Swedish domain name regulations but the company has solved this problem by selling the entire enterprise that registered the domain name and not only the name.[37]

Abbreviations and acronyms

The Appendix to Regulation B also offers the possibility to register business name abbreviations and acronyms if "the abbreviation is well-known in Sweden as the distinctive mark for a certain

enterprise, and that the abbreviation is connected in a natural way with the registered name. For example: Luossavaara-Kiirunavaara Aktiebolag has been established under the business name abbreviation LKAB, and is thus registered as lkab.se."[\[38\]](#)

This part of the Appendix can be questioned because it does not allow companies themselves to best decide how to shorten their names when wanting to go on the Internet. The established abbreviation is not necessary suitable as a domain name and all companies does not have an established abbreviation. A company might want to create a new trademark more suitable for the Internet. Examples in cases are that Investment Technology Sweden AB was not allowed to register investtech.se,[\[39\]](#) AC Cleaning Accessories AB was not allowed to register acca.se[\[40\]](#) and I.N.C Internet Communications AB was not allowed to register inc.se.[\[41\]](#)

What kind of enterprise can be registered?

Regulation C states, "Only one domain name can be registered per enterprise name".[\[42\]](#) According to Regulation F this now also includes "both principal companies as well as secondary companies and parallel companies".[\[43\]](#) But this has not always been the case. Prior to this version of the rules, which came in April 2000, the regulation applied only to principal company names. The change has resulted in a substantial liberalization and increased possibilities to register domain names. The SEB case is an interesting example of the application of the prior regulations and perhaps one of the most important reasons for changing them.

The SEB case

One of the biggest banks in Sweden SE-banken had registered sebank.se and used that address as the homepage for online-banking services, (which is very popular in Sweden both for companies and consumers). SE-banken later merged with one of Sweden's largest insurance companies Trygg-Hansa and they decided that the new company was to work and be marketed under the new trademark SEB. The change to the new trademark was prepared by substantial measures[\[44\]](#). NIC-SE and its appeal organ the NNO-commission did however deny the registration on the basis of Regulation C; one enterprise could only have one domain name. SEB appealed to the NÖD-commission who, realizing the importance of the large investments made to launch the new trademark and the large pool of consumers that were likely to use the new domain, granted the registration changing the NNO-commissions decision.[\[45\]](#)

Two months after the NÖD decision to grant the registration of seb.se NIC-SE made a decision to cancel the former domain name sebank.se. The reason was the same regulation[\[46\]](#) that one enterprise could only have one domain name. SEB did appeal and claimed that canceling the domain name sebank.se based on the fact that NÖD allowed the registration of seb.se was not possible. It would be a breach of the agreement between NIC-SE and the bank concerning the domain name sebank.se, it would be incompatible with the principle of predictability and it would lead to unacceptable consequences for the bank. NÖD allowed the bank to keep the two domain names but based its ruling on that the new company name was so unlike the old one.[\[47\]](#)

Other obstacles to domain name registration

Regulation D contains a number of obstacles that prevents a name from being able to register as a domain name:

A domain name cannot be registered:

- if it is identical to a previously registered domain name under the same domain,
- if it refers to a sub-domain of an already registered domain name,
- if it is evidently designed to cause offence or is in breach of good custom,

- if it is designed to mislead the general public,
- if it consists solely of a geographical word. "[48]

Examples of cases are that Connect IT i Göteborg Aktiebolag were not allowed to register connectit.se because connect-it.se already existed[49] and that Flashback Media Group AB were not allowed to register fuck.se.[50] The results of these decisions might seem reasonable but the regulations could still be questioned on the basis that the general trademark- and marketing-laws apply to this area. Why have special regulations only for domain names?

Trademarks

Regulation G state that "if the domain name refers to a trade mark, this must be registered under the .tm.se"[51] main domain. There are no exceptions to this rule. An example is that House of Prince Aktiebolag was not allowed to register prince.se.[52] The use of the possibility to register trademarks under the .tm.se sub level domain has proved to be minimal.

The trademark must also be protected either by registration at the Swedish Patent and Registration Office (PRV), protected in accordance with the so-called Madrid protocol or as a Distinctive mark, which by means of registration, such as the European Community trade mark, have legal force in Sweden.[53] The fact that the trademark is required to be registered is a further limitation. This causes problems for other trademark holders, companies that cannot afford to register their trademarks and the creation of new trademarks.

Registration under main domains

In order to widen the possibility to register domain names, as an answer to the criticism on that Regulation B allows only enterprise names to be registered, the NDR-committee has offered the possibility to register names under main domains. Those include the county domains for enterprises or organizations related to that county[54], .org.se for non-profit organizations[55], .parti.se for political parties[56], .press.se for Periodical publications (magazines)[57] and .pp.se for private individuals[58]. The possibility to register names under main-domains has not been considered an attractive alternative by companies, organizations and private individuals and the use has, just as with the .tm.se main domain, been minimal.

Other comments on the Swedish system

The problem with predictability

In 1999 Europolitan Stores AB tried to register europolitanstores.se but the application was rejected. Europolitan appealed to the NÖD-commission but lost the case. The motivation was that only one domain name per concern was allowed and that Europolitan Stores AB already had registered europolitan.se.[59] The case is published on the IIS-foundations homepage as a guiding example of which kind of domain names that are possible to register.

Nevertheless the europolitanstores.se website is online and belongs to Europolitan. The explanation is that the regulations had been changed after the decision and that Europolitan must have applied for registration again.[60]

Criticism and SOU 2000:30

The Swedish domain name system has been discussed and criticized, increasing with the popularity and importance of domain names, since the responsibility for the Swedish top domain was transferred to the foundation five years ago.[61] Both the rules and the organization have been criticized.[62] The present discussion is mostly concerned with the possibility to register trademarks.

Ingmar Albertsson marketing director at Arla Foods wants the possibility to register trademarks directly under .se. That would enable companies like Arla to register their trademarks in the .se top domain instead of, as at the time being, in the .nu top domain. He thinks that the world should be organized after the way people act.[63]

The discussion and criticisms resulted in that the government formed The Committee on Domain Name Administration[64] and ordered it to evaluate the domain name system. The result was the preparatory works SOU 2000:30.

SOU 2000:30

The committee found that the Swedish system has been substantially criticized. The criticism has primarily concerned the rules and not the organization.[65]

More Swedish companies have chosen to register under other national, or generic, top domains instead of under .se. Almost two thirds of all the Swedish users are registered under other top domains than the Swedish.[66] A lot of these users are unable to register under Swedish domain .se due to the rules.[67]

The Swedish system does not achieve the demands that can be put on national domain - that it should be the natural domain for anyone with a connection to the nation. The reason is primarily considered to be the rules.[68]

Suggested changes in organization

One reason for the opinion of lack of legitimacy is that the private organizations (the NDR-commission, NNO-commission and NÖD-commission) regulating the domain resembles governmental organs both in structure and names.[69] The assignment to handle the Swedish top domain .se should be formalized through an agreement between the Swedish government and the foundation IIS.[70]

Suggested changes in the regulations

The committee SOU 2000:30 suggests that the regulations is changed from the present system into a system with clear and simple regulations without any requirements having to be fulfilled in order to be able to register a domain name. Everyone who wishes to register a domain name in the Swedish top-domain .se should be able to do so as long as the requested name is available.[71] The evaluation then adds a few requirements. The applicant must be domiciled in Sweden or have a business with connection to Sweden and must also agree to sign an agreement with certain terms including that Swedish law must be obeyed.[72]

The committee also suggests that some names should be impossible to register[73] and that a registered domain name has to be used.[74]

The comments from different parties about whether or not a liberalization of the rules will cause trademark disputes varies from stating that it should be a big increase to that the risk of an increase is very little.[75] The committees view is that the problem with trademark disputes will be insignificant.[76] The agreement with the applicant will make it possible to cancel a registration that interfere with someone else's trademark rights. Besides, the public courts are able to deal with this kind of problem.[77] To make this process faster the committee suggests that a dispute resolution system similar to ICANN's should be created.[78]

The committees view on main domains and trademarks

Consumers cannot be aware of the different main domains and which one to look in.[79] The committee thinks that the rules should be adjusted after the users and not the other way around?[80] Trademarks should therefore be possible to be registered right under the top domain .se without and not under the main domain .tm.se.

Despite that there now are possibilities to register other names than company names, like trademarks and personal names, there are still limitations. A trademark has to be registered to be possible to register as a domain name.[81] This rule might also result in an increased workload for the PRV and cost more money for the users.[82]

IIS reply to the SOU and possible future changes

After the SOU 2000:30 the foundation IIS assigned the NDR-commission to develop suggestions for new regulations.[83] The result was the regulations 2.5 and 3.0 whereof version 2.5 was only an evolvement from the present version 2.0 while version 3.0 was almost entirely new compared to the old rules.[84] Version 3.0 is more like the more liberal regulations, that e.g. apply in Denmark, Germany and the UK, and puts the main responsibility for that the claim to a domain name is legitimate on the applicant.[85]

These suggestions were sent out to different organizations and interested parties for comment in April 2001[86] A massive majority of the comments suggested that more liberal regulations than the present were preferred and the foundation IIS and NDR are therefore now working on a revised regulation based on the suggestion 3.0.[87]

The foundation IIS has stated that the ambition is that the new rules will make it easier to acquire a domain name in the top domain .se and that the registration of trademarks directly under .se will be possible. However these ambitions does not mean making the domain free. The foundation IIS demands that there is an identified person or organization behind every domain name and that trademarks shall not be possible to be abused in the .se top domain.[88] The foundation IIS has also during the year 2001 developed a suggestion on a Swedish version of ICANN's Uniform Dispute Resolution Policy (UDPR) that would work as an alternative to the Swedish courts when it comes to solve the increased number of domain name disputes that the foundation IIS predicts will appear if the regulations are liberalized. The suggestion[89] is called ADR (Alternative Dispute Resolution) and will have been circulated to different parties for comments until January 2002.[90] It seems clear that new rules will come during the year 2002 but their appearance and effect will be very interesting.

Conclusion and future work

The organization IIS and the legitimacy of the control of the Swedish top domain .se can be questioned. The organization acts and appears as a part of the government but is really a private organization. However it is more important to consider the regulation and its consequences. One of the basic functions of a regulation is to supply predictability in society. One example is that predictability is an important factor when investing in enterprises or new ideas. The Domain Name Regulations in Sweden do not supply predictability. They are the result of an attempt to create a system that prevents disputes over domain names and protects trademarks but have had the side effect of lacking predictability. One example is the Europolitan Case; one day it was not allowed to register two domain names per concern but the next day the rules are changed. That the NÖD-decision rejecting the application is still presented on the IIS website as an example of application of the regulations is a blunder that further damages predictability. Another example is of course that generic domain names are not allowed but are possible to register when using the transliteration rules.

Perhaps the solution would be to follow the commission's suggestion in SOU 2000:30; liberalize the

regulations, accept all applications for a domain name as long as it is free, and leave the potential disputes to the trademark laws and public courts.

As future work I would like to continue to follow the development of the regulations and the control over the Swedish top domain .se. I would also like to make a further analysis and discuss the predictability, legitimacy and other legal aspects of the present system.

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NÖD decision 1999-05-26

NÖD decision 1999-05-28

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NÖD decision 2000-04-17

NÖD decision 2000-04-25

NÖD decision 2000-04-27

NÖD decision 2000-05-16

NÖD decision 2000-06-14

NÖD decision 2000-08-15

NÖD decision 2000-09-12

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NÖD decision 2001-11-15

NÖD decision 2001-11-21

NÖD decision 2001-12-05

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[1] Lindberg, A., Westman, D. *Praktisk IT-rätt*

[2] I will use "homepage" as the definition of the "first page" of a website, the page you are expected to first arrive to, like cocacola.com or microsoft.com.

- [3] I will use "website" as the definition of a set of linked web pages belonging to e.g. a company or an organization.
- [4] SOU 2000:30 p 17
- [5] SOU 2000:30, .se?
- [6] Yttrande över SOU 2000:30, .se?
- [7] Internets Infrastruktur i Sverige 2001
- [8] SOU 2000:30 p 52
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- [13] Internets Infrastruktur i Sverige 2001
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- [15] a.a.
- [16] Appendix 1 Explanation Regulation A, *Domain Name Regulations in Sweden Version 2.0*
- [17] NÖD decision 2001-11-15
- [18] NÖD decision 2001-11-10
- [19] NÖD decision 1998-10-29
- [20] *Domain Name Regulations in Sweden Version 2.0*
- [21] Artikel om Domain 1 Europe
- [22] Appendix 1 Regulation B, *Domain Name Regulations in Sweden Version 2.0*
- [23] Appendix 1 Regulation B, *Domain Name Regulations in Sweden Version 2.0*
- [24] NÖD decision 2000-05-16
- [25] NÖD decision 2000-04-27
- [26] NÖD decision 2000-04-17
- [27] NÖD decision 2000-03-22
- [28] NÖD decision 2000-04-25

[29] Regulation B and Appendix 2 which allows å ä ö to be transliterated to respectively a a o.

[30] AB is the Swedish abbreviation for the word Aktiebolag which translates as Company Limited

[31] Handelsbolag is another Swedish form of company

[32] NÖD decision 2001-11-21

[33] NÖD decision 2001-12-05

[34] <http://www.1-domain.se>

[35] Sajter med vanliga ord som domänadresser får fler besökare

[36] Artikel om Domain 1 Europe

[37] Lindberg, A., Westman, Daniel, *Praktisk IT-rätt*

[38] Appendix 1 Regulation B, *Domain Name Regulations in Sweden Version 2.0*

[39] NÖD decision 2000-09-12

[40] NÖD decision 2000-08-15

[41] NÖD decision No date - appeal of NIC-SE decision 1998-11-23

[42] Regulation C, *Domain Name Regulations in Sweden Version 2.0*

[43] Regulation F, *Domain Name Regulations in Sweden Version 2.0*

[44] NÖD decision 1998-11-18

[45] a.a.

[46] Regulation C, *Domain Name Regulations in Sweden Version 2.0*

[47] NÖD decision 1999-05-26

[48] Regulation D, *Domain Name Regulations in Sweden Version 2.0*

[49] NÖD decision 1999-12-17

[50] NÖD decision 2002-02-05

[51] Regulation G, *Domain Name Regulations in Sweden Version 2.0*

[52] NÖD decision 2000-06-14

[53] Regulation I, *Domain Name Regulations in Sweden Version 2.0*

[54] Regulation N, *Domain Name Regulations in Sweden Version 2.0*

[55] Regulation O, *Domain Name Regulations in Sweden Version 2.0*

[56] Regulation P, *Domain Name Regulations in Sweden Version 2.0*

[57] Regulation Q, *Domain Name Regulations in Sweden Version 2.0*

[58] Regulation R, *Domain Name Regulations in Sweden Version 2.0*

[59] NÖD decision 1999-05-28

[60] Olle Thysander, The IIS-foundation

[61] Källberg, J. *Vi har väntat i fem år, men öppenhet saknas*

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[63] Halvarsson, Ulrika, *ditt_varumärke_här.se - snart möjligt*

[64] SOU 2000:30 p 17

[65] SOU 2000:30 p 51

[66] SOU 2000:30 p 55

[67] a.a.

[68] SOU 2000:30 p 12

[69] SOU 2000:30 p 14

[70] SOU 2000:30 p 15

[71] SOU 2000:30 p 58

[72] SOU 2000:30 p 59

[73] a. a

[74] a. a.

[75] SOU 2000:30 p 65

[76] SOU 2000:30 p 66

[77] a. a.

[78] SOU 2000:30 p 67

[79] SOU 2000:30 p 57

[80] a.a.

[81] a. a.

[82] a. a.

[83] Halvarsson, Ulrika, *ditt_varumärke_här.se - snart möjligt*

[84] Från förprovning till efterprovning? NDR 2.5-3.0

[85] a.a.

[86] Halvarsson, Ulrika, *ditt_varumärke_här.se - snart möjligt*

[87] Enklare få domännamn under .se

[88] a.a.

[89] Ett alternativt tvistlösningsförfarande (ADR) för domännamn i toppdomänen ".se"

[90] Domännamnstvister - en svensk UDRP - Inbjudan att lämna synpunkter