

# XXXIII Nordic Intellectual Property Conference

New rules on domain names – national and regional systems.  
Conflicts involving trademarks.

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# Domain Dispute History – Sweden - 1

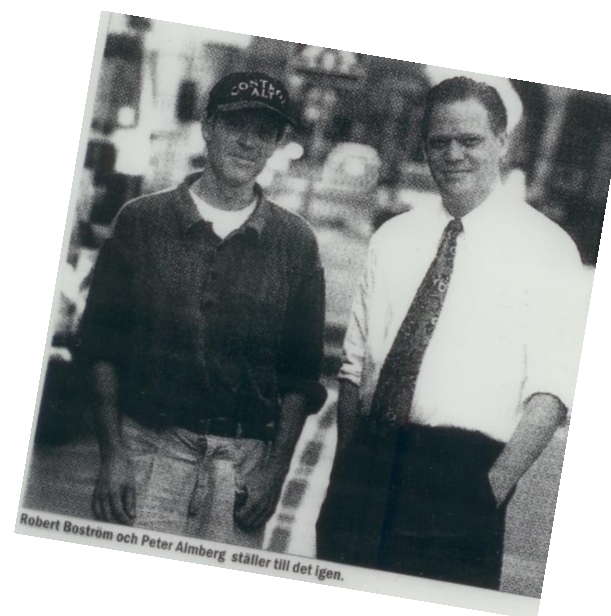
- 1985: .se is established by Mr Björn Eriksen (9 .se domain names registered this 1<sup>st</sup> year)
- February 1, 2000: More than 80 000 .se domains. Today (June 1, 2016): **1 370 484**
- Initial registration system:

Only a registered corporate name (main corporate name) could get a .se domain name. No trademarks, no personal names, no subsidiary company names...

(making .nu more popular)

- 1996: **Control Alt Delete:**

fiat.se, opel.se, skoda.se, mercedes.se, ferrari.se, kawasaki.se, astra-zeneca.se, gilette.se... Registered under.com



## Domain Dispute History – Sweden - 2

- 1998: iDRS – DRS – NDR - Nämnden för Domännamnsregler i Sverige (The Board for domain name rules). *“Is it possible to find a way to register trademarks under .se?”*
- 2000: 30 official sub domains: tm.se for trademarks, pp.se for private persons, press.se for periodicals, parti.se for political parties, a.se for local companies in Stockholm, etc
- 2003: The Swedish ADR (“ATF”)

## Domain Dispute History – Sweden - 3

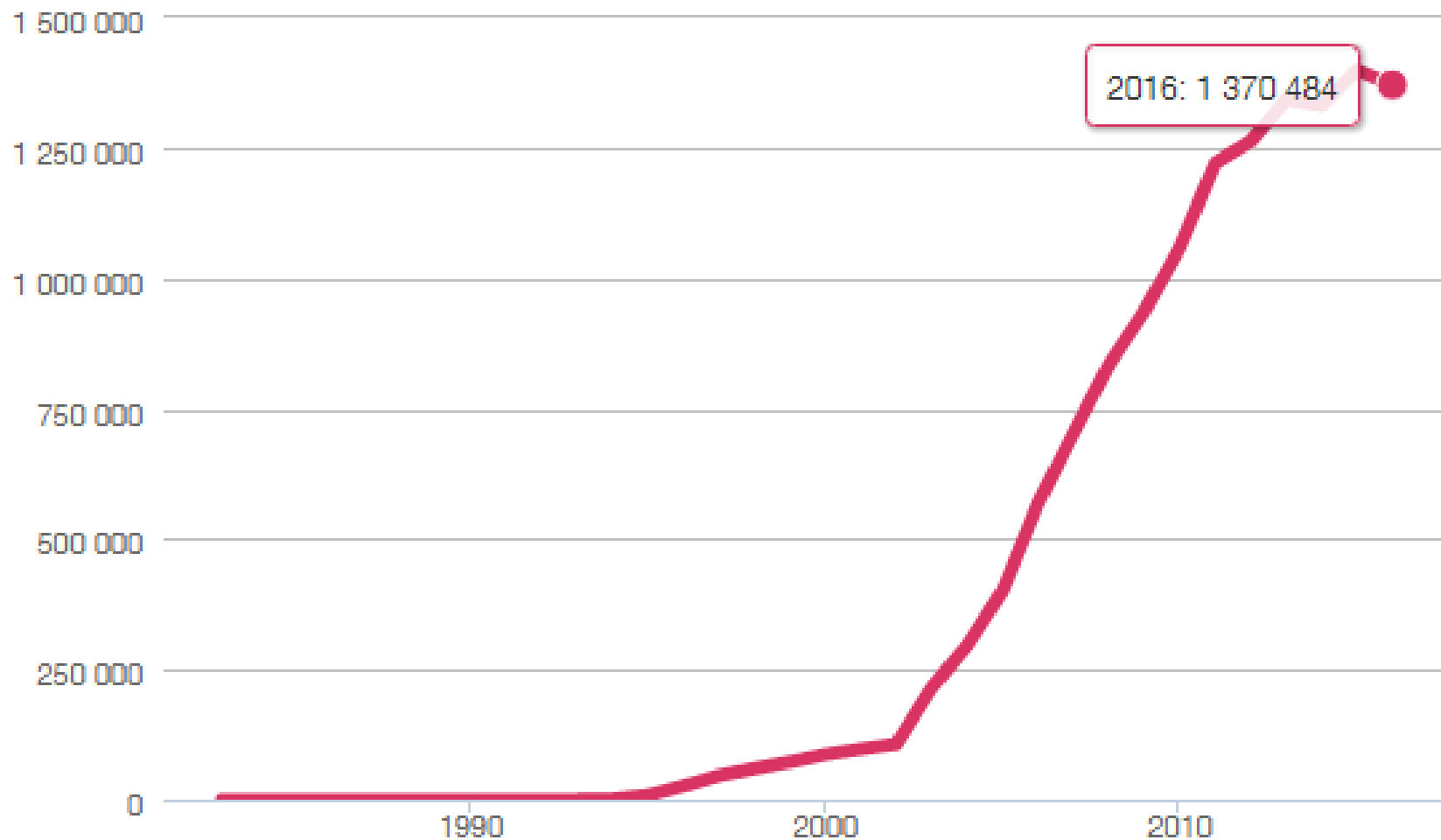
- 2003: .SE accepting Internationalized domain names containing å, ä, ö, ü and é (monsteras.se / Mönsterås)
- 2007: 250 new characters available, supporting names in all of the legally recognized minority languages of Sweden: Finnish, Meänkieli (Tornedalsfinska), Sami, Romani and Yiddish.
- 2011: Accelerated ADR is introduced



# Statistics

- 702 decisions as per June 10, 2016
- **2015**: 66 decisions, whereof
- 29 accelerated proceedings (3 of them refused)
- 34 replied by the holder
- 47 accepted
- 61 decisions with only 1 arbitrator

# Active Swedish domain names



# The ADR procedure...

**“ADR is a simple and fast process, intended for any party that considers that their protected right (i.e. a brand or company name) wrongly has been registered as a domain name by someone else. Anyone can apply to initiate an ADR matter”**

- The three absolute requirements:
  1. The disputed domain name is identical or similar to a name right (trademark, company name, family name, an artist's name, or be designation covered by European Council's Regulations) that is valid in Sweden and to which the applicant can claim rights to, and
  2. The domain name has been registered *or* used in bad faith, and
  3. The domain holder has no rights or justified interest in the domain name.
- Swedish or English
- IIS appoint an arbitrator and administers the proceedings
- The applicant can choose one or three arbitrators (from a list of 13)

# ...in Sweden

- The applicant may request - in the original application - that the accelerated proceeding is used, should the counterparty fail to respond to the application
- IIS an application fee for ADR:
  - Private individual, 1-5 domains, one arbitrator: 4 000 SEK
  - Swedish legal entity (not a SME) / governments, 6 – 10 domains, 3 arbitrators: 30 000 SEK
- ADR decided within 30 (one arbitrator) or 60 days (three arbitrators) after it has been turned over to the arbitrators.
- The accelerated proceeding is always decided by one arbitrator within 10 working days.
- Transfer within 14 days, if the holder has not filed a claim for claimed better rights in court



# ADR Accelerated Proceeding

- Introduced February 15, 2011, as a complement to standard ADR if the domain owner does not respond to the ADR application.
- The arbitrator shall consider all conditions applicable in a standard ADR case, but make a decision within 10 working days instead of the normal 30 days.
- The decision is provided only with a brief explanation.
- Full fee to be paid, but: If the accelerated proceeding is applied IIS will return the whole application fee to the applicant, in excess of SEK 2 000 in administrative charge.

# BANK

- Protected as part of a company name or (in certain cases) trademark – financial institution
- Geographical: Doggers bank, Banks island, Bankeryd
- Surname Bank
- Ban Ki Moon = **BANK**imoon.se

Start Debatt Helg Realtid Karriär Realtid Insikt

## "Statlig myndighet ägnar sig åt nätcensur"

Post- och Telestyrelsen, PTS, har hamnat i blåsväder för att de vill förhandsgranska alla domännamn som innehåller ordet "bank". "PTS ska inte som enda myndighet i Västeuropa tvinga på oss nätcensur", säger Petter Rindforth, jurist på Fenix.

tors, 2009-09-24 06:30    

Phishing på nätet, det vill säga skurkar som utger sig för att vara banker för att komma åt kundernas pengar, är ett växande problem.

**Nu vill statliga myndigheten** Post- och Telestyrelsen, PTS, tvinga Stiftelsen för internetinfrastruktur (som godkänner alla domännamn som slutar på .se) att förhandsgranska och alla ansökningar som innehåller ordet "bank".

Anmäl dig till Realtid.ses Nyhetsbrev Teknik, Media och Telekom som skickas ut varje tisdag.

# ATF 136: baltic.se

- Baltic Safety Products vs Name Navigation
- BALTIC trademark for lifejackets
- Baltic also a generic/geographical word
- Keyword marketing, however also with sponsored links to lifejackets
- TRANSFER – Majority decision. Minority: “BSP has not proved that BALTIC is a well-known TM, thereby not bad faith”

# ATF 166: lansforakringar.se



- Länsförsäkringar vs Merlana Global Corp (Cypern)
- Nearly identical, TM & company name well-known
- Owner – no response, thereby no legitimate interest
- Obvious knowledge and bad faith
- TRANSFER

# Family names

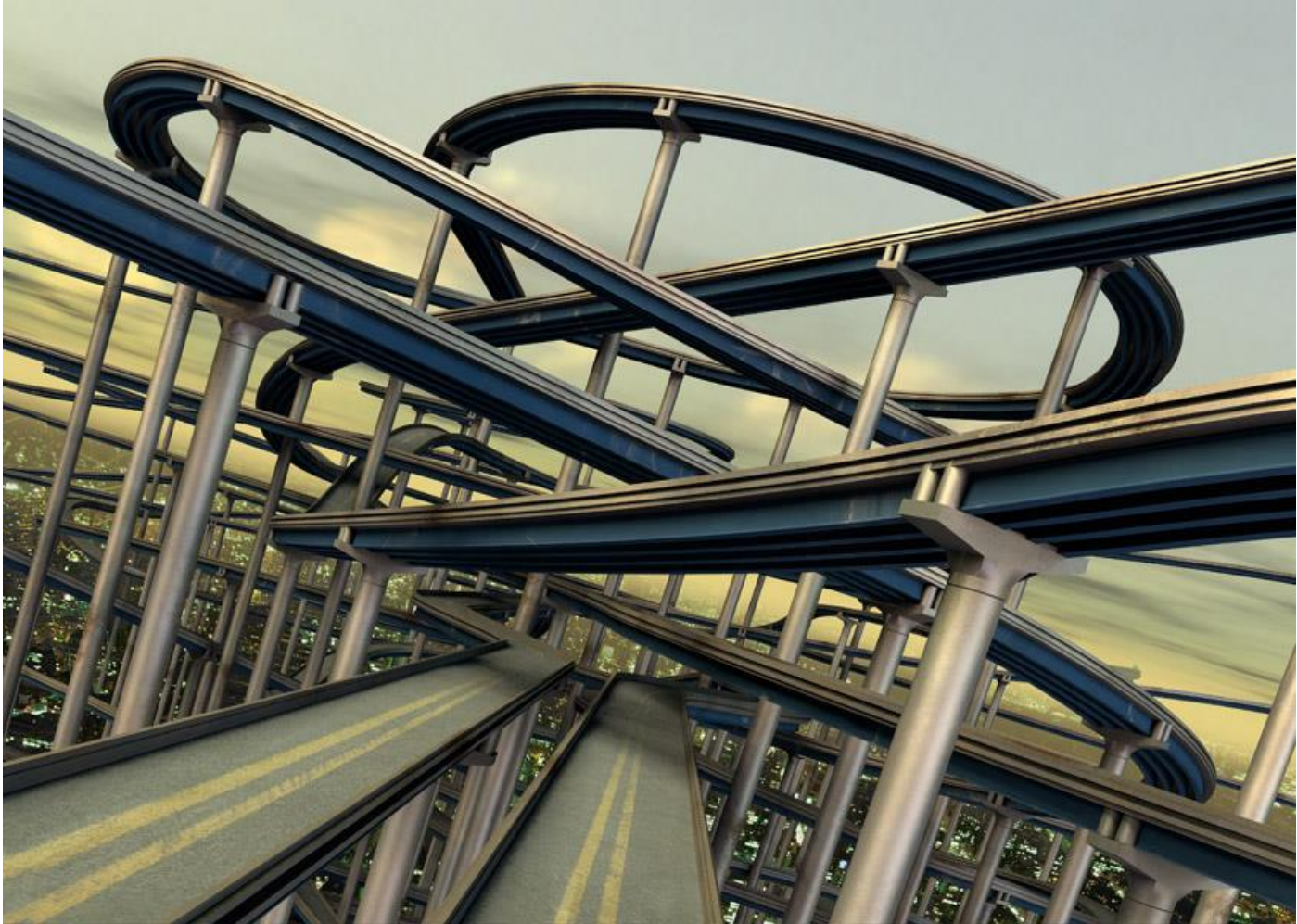


Foto: CORNELIA NORDSTRÖM

## **Aschberg.se / robertaschberg.se (Sweden)**

- 23 individuals with the surname Aschberg in Sweden
- Only the Complainant = Robert Aschberg
- Holder no rights + caused personal damage

# The road ahead...



# .SE disputes in the future

- Possible transfer of the administrative work to **WIPO Arbitration and Mediation Center**
  - Reduce the costs for IIS...
  - Swedish cases still searchable with comments from panelists?
  - The same fees?

# Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working Group

- **Phase One** will focus on a review of all the RPMs that were developed for the New gTLD Program, i.e.:
  - the **Trademark Clearinghouse** and associated notification and sunrise mechanisms,
  - the **Uniform Rapid Suspension** procedure, and
  - the **Post-Delegation Dispute Resolution Procedures**
- **Phase Two** will focus on a review of the Uniform Dispute Resolution Policy (**UDRP**) – January 2018



Thank you!  
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**.fenixlegal**  
*IP from a different angle*