

EXPERT DECISION

Swiss Life AG, and Swiss Life Intellectual Property Management AG v. Jetmir Matoshi
Case No. DCH2023-0003

1. The Parties

The Claimants are Swiss Life AG, and Swiss Life Intellectual Property Management AG, Switzerland, represented by FMP Fuhrer Marbach & Partners, Switzerland.

The Respondent is Jetmir Matoshi, Switzerland.

2. The Domain Name

The dispute concerns the following domain name <immoswisslife.ch>.

3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 15, 2023. On February 16, 2023, the Center transmitted by email to SWITCH, the “.ch” and “.li” registry, a request for verification in connection with the disputed domain name. On February 17, 2023, SWITCH transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Request. In response to a notification by the Center that the Request was administratively deficient, the Claimant filed an amendment to the Request on February 22, 2023. The Center verified that the Request together with the amendment to the Request satisfied the formal requirements of the Rules of procedure for dispute resolution procedures for “.ch” and “.li” domain names (the “Rules of Procedure”), adopted by SWITCH, on January 1, 2020.

In accordance with the Rules of Procedure, paragraph 14, the Center formally notified the Respondent of the Request, and the Dispute resolution procedure commenced on March 1, 2023. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was March 21, 2023.

The Respondent has neither filed a Response nor expressed his readiness to participate in a Conciliation in accordance with paragraph 15(d) of the Rules of Procedure.

On March 22, 2023, the Center notified the Claimant accordingly, who on March 23, 2023, made an application for the continuation of the Dispute resolution proceedings in accordance with specified in paragraph 19 of the Rules of procedure and paid the required fees.

On April 24, 2023, the Center appointed Philippe Gilliéron as Expert in this case. The Expert finds that it was properly appointed. In accordance with Rules of Procedure, paragraph 4, the above Expert has declared his independence of the parties.

4. Factual Background

“Swiss Life” stands for one of Switzerland’s largest life insurance companies and one of Europe’s leading comprehensive life and pensions and financial solutions providers, with approximately CHF 254 billion of assets under management by the end of 2019.

According to the Claimants, in 2019, the group generated a total turnover of more than CHF 23 billion and had around 9,300 employees and 14,000 consultants in order to serve its more than 4 million customers. According to ADV Ratings 2019, the Swiss Life group figures among the 15 largest European insurance companies according to their assets and is the fourth largest insurance company by market value. In Forbes’ list of the World’s Best Regarded Companies 2019 the Swiss Life group even ranks 125th, ahead of other famous companies such as the Volkswagen Group (#144), Swatch Group (#164) or Pfizer (#171).

The term “Swiss Life” is the distinctive part in the name of many of the Swiss and international subsidiaries (almost 100 only in Switzerland) of the Swiss Life group and serves as the generally accepted and used sign for the Claimants’ affiliates. The First Claimant was registered at the register of commerce of the Canton of Zurich on September 4, 1883. The Second Claimant was registered at the register of commerce of the Canton of Zurich on December 20, 2005.

The Swiss Life group holds numerous domain names to offer and market its insurance products and services, such as <swisslife.ch>, <swisslife.de>, <swisslife.be>, <swisslife.at>, <swisslife.li>, <swisslife.lu>, <swisslife.sk>, <swisslife.swiss>, <swisslife.fr>, <swisslife.sg>, <swisslife.hk>, <swisslife.com>, <swisslife.insurances>, <swisslife.shop>, and <swisslife.site>.

The Second Claimant manages the significant trademark portfolio of the Swiss Life group and holds numerous trademarks on a worldwide basis which consist in all or in part of the term “Swiss Life” in several classes, including class 36.

The Second Claimant notably holds the Swiss trademarks SWISS LIFE 491528 and 2P-436709, respectively registered in classes 9, 16, 35-36, 38, and 41-42 with a priority date as of August 2, 2001, for the first one, and in class 36 with a priority date as of March 21, 1996 for the second one.

The trademark SWISS LIFE is regularly ranked among the 50 most famous and valuable trademarks of Switzerland, whose value is estimated between CHF 250 and 300 million.

On September 25, 2020, the Respondent registered the domain name <immoswisslife.ch>, which currently leads to a website displaying a 403 error page.

5. Parties’ Contentions

A. The Claimants

The Claimants argue that the SWISS LIFE trademark is a well-known one, as acknowledged by the Swiss Supreme Court.

The Claimants first consider that the disputed domain name is confusingly similar to the Second Claimant’s trademark as it entirely incorporates the trademark SWISS LIFE and that the addition of the term “immo” is a mere descriptive element that will not exclude the resulting likelihood of confusion. As a result, the Second

Claimant's trademark exclusive rights would have been infringed by the registration of the disputed domain name.

The Claimants are both corporations incorporated under the laws of Switzerland and registered in the commercial register of the Canton of Zurich whose distinctive terms consist of Swiss Life. As a result, they both enjoy exclusive rights in their corporate name in accordance with Art. 956 of the Swiss Code of Obligations.

The Claimants further argue that the intentional use and exploitation of the Complainants' SWISS LIFE brand and the trust in the services provided thereunder leads to an unfair and illegitimate exploitation of the Complainants' reputation under Article 2 and 3 let. d Swiss Federal Law Against Unfair Competition ("UCA"). It also violates the Claimants' personality rights vested in their tradename and company names respectively (See Art. 28 ff. Swiss Civil Code).

Taking into account the well-known character of the SWISS LIFE trademark and the fact that the Claimants did not give any authorization to the Respondent to use their trademark or register the disputed domain name, the Claimants are of the view that the Respondent cannot have any rights or legitimate interests in the disputed domain name.

Finally, the Claimants affirm that the disputed domain name was registered and is being used in bad faith. Taking into account the Respondent's absence of evidence of any actual or contemplated good faith use of the disputed domain name, its passive holding, the well-known status of the SWISS LIFE trademark and the close to identity of the disputed domain name, there is no doubt that the Respondent was well aware of the Claimants' trademarks and corporate name when he decided to register the disputed domain name, that will further create a confusion towards users as potentially reminding them of the "SWISS LIFE IMMOPULSE" trademark in order to refer to the Claimants' real estate service.

B. The Respondent

The Respondent did not reply to the Claimants' contentions.

6. Discussion and Findings

In accordance with paragraph 24(c) of the Rules of Procedure, the Expert shall grant the Request if the allocation or use of the disputed domain name constitutes a clear infringement of a right in a distinctive sign which the Claimants own under the laws of Switzerland or Liechtenstein.

Paragraph 24(d) of the Rules of Procedure further adds that in particular, a clear infringement of an intellectual property right exists when:

- (i) both the existence and the infringement of the claimed Right in a distinctive sign clearly result from the wording of the law or from an acknowledged interpretation of the law and from the presented facts and are proven by the evidence submitted; and
- (ii) the Respondent has not conclusively pleaded and proven any relevant grounds for defense; and
- (iii) the infringement of the right justifies the transfer or deletion of the disputed domain name, depending on the remedy requested in the request.

A. The Claimant has a right in a distinctive sign under the law of Switzerland

In the present case, the Claimants both demonstrate to enjoy exclusive rights in their corporate name in accordance with Art. 956 of the Swiss Code of Obligations.

The Second Claimant further demonstrates to enjoy exclusive trademark rights in the trademark SWISS LIFE, whose well-known character within the meaning of Art. 15 of the Swiss Trademark Act has been acknowledged by the Swiss Supreme Court in 2007 (BGE 4C.341/2005).

B. The allocation or use of the domain name constitutes a clear infringement of a Right in a distinctive sign which the Claimants own under the law of Switzerland

In the present case, the Expert has no difficulty in holding that the allocation or use of the disputed domain name constitutes a clear infringement of these rights.

Taking into account the well-known character of the SWISS LIFE trademark, there is no doubt that the Respondent, located in Switzerland, was well aware of the Claimants' corporate name and trademark rights when he decided to register the disputed domain name <immoswisslife.ch>, all the more since he is located in Switzerland.

The disputed domain name <immoswisslife.ch> entirely incorporates the Second Claimant's trademark. The addition of the term "immo" is descriptive and will be understood by Internet users as referring to the Claimants' real estate services, which they carry out under the trademark Swiss Life Immopulse.

Although one may not be in a position to assess whether the disputed domain name will be used in relation with identical or similar goods or services as the ones for which the Claimants' trademark has been registered in the absence of any related active website (Art. 3 and 13 of the Swiss Trademark Act), Art. 15.2 of the Swiss Trademark Act protects well-known trademark holders against the undue exploitation of the reputation of their trademark. Such undoubtedly is the case here.

The passive registration of a domain name consisting in its distinctive terms of a well-known further falls under the Swiss Unfair Competition Act, more particularly under Art. 2 of the Unfair Competition Act, as it clearly distorts the competition in an unfair manner.

The Respondent did not come forward with any written explanation to rebut these findings nor explanations to the reason why it would have chosen a domain name consisting of the Claimants' trademark. Taking into account the worldwide reputation enjoyed by the Claimants, their corporate name and trademark, the Expert cannot conceive any plausible explanation as to the allocation and use of the domain name, other than in bad faith.

As a result, the infringement of Art. 956 of the Swiss Code of Obligations, Art. 15 of the Swiss Trademark Act and Art. 2 of the Swiss Unfair Competition Act is clear and leaves no room for discussion.

Consequently, the overall circumstances of the case thus make it clear that the requirements of paragraph 24 of the Rules of Procedure have been fulfilled.

7. Expert Decision

For the above reasons, in accordance with paragraph 24 of the Rules of Procedure, the Expert orders that the disputed domain name <immoswisslife.ch> be transferred to the Claimants.

Philippe Gilliéron

Expert

Dated: May 5, 2023