

## **ADMINISTRATIVE PANEL DECISION**

VICTORINOX AG v. Thomson Technologies Pty Ltd, Import Man Teau Pty. Limited

Case No. DAU2023-0008

### **1. The Parties**

The Complainant is VICTORINOX AG, Switzerland, represented by Domgate, France.

The Respondents are Thomson Technologies Pty Ltd, Australia, and Import Man Teau Pty. Limited, Australia, self-represented.

### **2. The Domain Names and Registrar**

The disputed domain names <swissarmy.au> and <swissarmy.com.au> are registered with GoDaddy.com, LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 3, 2023. On February 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. After some communications seeking clarification, on February 13, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondents are listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the "Policy" or ".auDRP"), the Rules for .au Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 14, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was March 6, 2023.

On February 15, 2023, the Respondents sent an email to the Center. On February 16, 2023, the Center sent an email regarding possible settlement to the Parties. On February 22, 2023, the Complainant sent an email to the Center stating it did not wish to suspend the proceeding and filed a Supplemental Filing. On February 22, 2023, the Respondents sent a further email to the Center. On March 7, 2023, the Center notified the commencement of panel appointment process.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on March 13, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

According to the Complaint, the Complainant has been producing the eponymous knives since 1891.

It manufactures some 28,000 “Swiss Army” knives and 32,000 other pocket tools and, according to the Complaint, 60,000 kitchen knives each day at its plant in Switzerland. It is not clear from the Complaint if it is only the “Swiss Army” knives which are marketed under the “Swiss Army” trade marks or also the pocket tools and kitchen knives. Materials in the Complaint show use in relation to “Swiss Army” compasses, “Victorinox Swiss Army” watches. In addition, to “Swiss Army” knives, the Complaint also claims the Complainant applies its “Swiss Army” trade marks to kitchen and professional knives, watches, luggage and perfume.

The Complainant has been the exclusive producer of “Swiss Army” knives since 2005 when it acquired the Wenger company. Prior to that date, both companies supplied knives to the Swiss Army. According to the Complaint, the two businesses have been combined under the “Swiss Army” brand since 2014. The Complainant produced its 500 millionth “original Swiss Army” knife in 2016.

The Complainant has annual turnover of CHF 500 million although the Complaint does not indicate what proportion of that turnover relates to the “Swiss Army” brand. In the Complaint, however, the “Swiss Army” knife is described as the Complainant’s core product.

According to the Complaint, the Complainant began selling its “Swiss Army” products in Australia in 1997. Its products are now offered for sale through 1,000 points of sale around the country.

The Complainant’s “Swiss Army” products have been extensively advertised and promoted including from its main website at “<https://www.victorinox.com/global/en/>” to which the domain name <swissarmy.com> redirects. The Complainant registered the domain name <swissarmy.com> in 1997. In Australia, it also has a dedicated website at “<https://victorinox.com.au/>”.

The Complaint includes evidence that the Complainant has registered trade marks for SWISS ARMY in many countries around the world. Many of these derive from International Registration No. 691820A, SWISS ARMY, which was registered on August 20, 1997, in respect of hand-operated tools in International Class 8.

In Australia, the Complainant’s registrations include Registered Trade Mark No. 1783408, SWISS ARMY, which has been registered with effect from June 10, 2016, in respect of “Hand-operated hand tools and implements; cutlery”. This registration derives from the International Registration and was achieved on the basis of evidence demonstrating acquired distinctiveness from use or other circumstances sufficient to overcome an objection to registration under Trade Marks Act 1995 s 41(4).

The Complainant is also the owner of Australian Registered Trade Mark No. 1394682, a rondel device featuring the words WENGER GENUINE SWISS ARMY KNIFE SINCE 183 and a representation of a Swiss Army knife. This trade mark has been registered with effect from February 16, 2010, and claims Convention priority from August 19, 2009.

According to the Registrar;

(a) the **first** disputed domain name <swissarmy.com.au> was created on March 16, 2005; and

(b) the second disputed domain name <swissarmy.au> was created on September 8, 2022.

The Registrar is unable to indicate whether either Respondent was the registrant when the disputed domain names were registered. The Registrar states “The domain name was registered to this registrant since at least 2/7/2023”.

When the Complaint was filed (and currently), both disputed domain names resolve to webpages operated by GoDaddy offering them for sale. The first disputed domain name is being offered for sale for USD 4,000; the second disputed domain name for USD 2,000.

## **5. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to divest the respondent of a disputed domain name, the complainant must demonstrate for that disputed domain name each of the following:

- (i) the disputed domain name is identical or confusingly similar to a name, trade mark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered or subsequently used in bad faith.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that the Panel deems applicable.

### **A. Consolidation of Complaints and Supplemental Filing**

The Complaint relates to disputed domain names that have been registered in the names of different entities.

Paragraph 3(c) of the Rules expressly permits a complaint to relate to more than one domain name where all the domain names are registered by the same domain name holder. Notwithstanding this express provision, panels have frequently held that the Panel’s powers under paragraph 10(e) of the Rules may permit consolidation of multiple domain name disputes, subject to satisfaction of the other requirements of Policy and Rules. In particular, paragraph 10(b) of the Rules requires the Panel to ensure that all parties are treated equally and each is given a fair opportunity to present his, her or its case.

In accordance with those requirements, panels have typically allowed joinder against multiple respondents who have registered different domain names where, amongst other things, the domain names in question, or the websites to which they resolve, appear to be under common control and consolidation would be fair and equitable to all parties. The onus of establishing that these requirements have been met falls on the party seeking consolidation.

In the present case, each of the disputed domain names is formed around the Complainant’s trade mark. The physical address of both registrants is the same, as is their telephone number and the email address – “[...]@werri.com”.

The emails received by the Center on February 15 and 22, 2023, both come from that address and are signed “Stuart Thomson”. Both emails relate to both disputed domain names. The second disputed domain name was registered during the priority allocation period for “.au” direct domain names based on existing registrations on “.com.au”, “.net.au”, and “.org.au”. In these circumstances, it appears to the Panel to be fair and equitable to all parties, and an efficient use of resources, to consolidate both disputed domain names in the one Complaint.

For ease of reference, the Panel will refer just to the “Respondent” unless it becomes necessary in a particular case to distinguish between particular Respondents or disputed domain names.

In the exercise of its powers under paragraph 10 of the Rules, the Panel will admit the Complainant’s supplemental filing. It responds to claims made in the Respondent’s email on February 15, 2023, which, in the circumstances, the Panel consider could not reasonably have been anticipated. The Panel also admits the Respondent’s supplemental filing on February 22, 2023, as it maintains the Respondent’s position in the face of the supplemental filing rather than withdrawing the earlier submission.

## **B. Identical or Confusingly Similar**

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s name, trade mark or service mark.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a name, trade mark or service mark at the date the Complaint was filed and, if so, the disputed domain name must be identical or confusingly similar to the name or mark.

The Complainant has proven that it owns the registered trade marks SWISS ARMY including the registration in Australia referred to in section 4 above.

On the question of identity or confusing similarity, what is required is simply a visual and aural comparison and assessment of the disputed domain name itself to the Complainant’s trade marks: see for example, *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd.*, WIPO Case No. [DAU2002-0001](#). This test is narrower than and thus different to the question of “likelihood of confusion” under trade mark law which can require an assessment of the nature of the goods or services protected and those for which any impugned use is involved, geographical location or timing. Such matters, if relevant however, may fall for consideration under the other elements of the Policy.

Typically and as is appropriate in this case, it is permissible to disregard the Second Level Domain, “.com.au”, and the country code Top Level Domain (“ccTLD”), “.au”, as functional component of the domain naming system. See for example auDA Overview of Panel Views on Selected auDRP Questions First Edition (“auDRP Overview 1.0”), section 1.2.

Accordingly, the Panel finds that both disputed domain names are identical to the Complainant’s trade mark and the Complainant has established the first requirement under the Policy.

## **C. Rights or Legitimate Interests**

The second requirement the Complainant must prove for each disputed domain name is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances may be situations in which a respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services (not being the offering or domain names that the respondent has acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights; or

- (iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Previous panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#).

Both disputed domain names were first registered long after the Complainant began using its trade mark and also long after the Complainant began using its trade mark in Australia.

The second disputed domain name was registered after the Complainant registered its trade mark in Australia. While the first disputed domain name was registered after the International Registration, it was registered several years before the Complainant applied to extend protection on the basis of that registration to Australia. According to the information supplied by the Registrar, the first disputed domain name was also registered before the Complainant's Australian Registered Trade Mark No. 1394682 which claims Convention priority from August 18, 2009. As already noted, however, the Respondent registered the first disputed domain name only after the Complainant began marketing and selling its "Swiss Army" knives in Australia.

Neither disputed domain name is based on either Respondent's name or Mr Thomson's.

The Complainant contends that the Respondent is not licensed by nor otherwise associated with it or its group.

Having regard to the fame of the Complainant's trade mark, the mere offering for sale of both disputed domain names and the factors just referred to, therefore, the Panel finds the Complainant has established the required *prima facie* case to satisfy this requirement.

The Respondent contends it was a distributor of the Complainant's products through TRG (USA) when that company was the global distributor of the Complainant's goods and then a distributor of Wenger travel goods through Group III (USA) when that company was a distributor of Wenger travel goods.

The Respondent further states:

"My plans are to sell the domains (as part of my business) to another company that distributes Swiss Army products. If I cannot find this buyer then I will maintain the domains and look to re commence distributing Swiss Army products through these websites."

The Complainant's supplemental filing denies these claims.

The Respondent has not provided dates when it held the distributorships. Nor has the Respondent provided any licence documentation or the like.

The Respondent's email of February 15, 2023 does include, however, a screenshot from October 27, 2011 of a Wayback Machine capture showing a website offering for sale or promoting "Wenger" travel products. This screenshot does include an image of what appears to be a "Swiss Army" knife. The headings include "Travel Accessories", "Wenger Backpacks", "Wenger Business Items", "Wenger Luggage" and Specials.

Visiting the Wayback Machine and clicking on these links, none include products under the trade mark SWISS ARMY.

Acknowledging that “Wenger” had become part of the Complainant’s corporate group in 2005, the Panel has serious doubts that the use of the Complainant’s trade mark to promote and offer for sale other products of the Complainant which it has not denominated with the trade mark can confer rights or legitimate interests under the Policy.<sup>1</sup>

Further, the landing page on the Wayback Machine indicates that there have been 125 captures between August 4, 2011, and March 11, 2023. From at least 2014 until November 2016, the first disputed domain name redirected to a website at “https://web.archive.org/web/20161101071856/https://travelgoods.com/”. The last of these captures was simply a Contact Us page. After that, the first disputed domain name resolved to a webpage provided by Go Daddy “Enquiries on this Domain Name”.

On the basis of the Responses, it appears the Respondent does not claim currently to hold a distributorship to distribute “Swiss Army” products from the Complainant’s group (if the Respondent ever did). The Wayback Machine captures and the use currently being made of the disputed domain names support that conclusion.

There is no evidence before the Panel that there is any business as claimed by the Respondent at least since 2016 – and even then, the business appears not to have involved SWISS ARMY brand products. There is also no evidence before the Panel of any efforts by the Respondent to find another company that distributes SWISS ARMY products. Acknowledging that Australian law does permit parallel importing,<sup>2</sup> there is no evidence before the Panel that would support a claim to demonstrable preparations for use in connection with a good faith offering of goods or services. A mere claim that that is something the Respondent might do in the future is not sufficient.

Likewise, simply claiming that, if the Respondent cannot find a suitable buyer (at some indeterminate point in the future), he will look to recommence distributing “Swiss Army” products does not satisfy the requirements of paragraph 4(c)(i) of the Policy. Putting to one side the issue whether the Respondent ever distributed “Swiss Army” products (as opposed to “Wenger”) products, such a vague, bare claim falls well short of *demonstrable* preparations for use in connection with a good faith offering of goods or services.

The only objective evidence is the offering for sale of both disputed domain names for sums substantially in excess of the ordinary registration fees for names in the “.au” and “.com.au” domain spaces – around AUD 19.95 per year.

In these circumstances, whatever may have been the case when the Respondent first registered the first disputed domain name, the Panel finds the Respondent has not rebutted the *prima facie* case established by the Complainant. Accordingly, the Complainant has established the second requirement under the Policy.

#### **D. Registered or Subsequently Used in Bad Faith**

In contrast to the Uniform Domain Name Dispute Resolution Policy, the Complainant must establish that the disputed domain names have been *either* registered *or* subsequently used in bad faith by the Respondent under the third requirement of the Policy. The two requirements are disjunctive.

There is no issue between the parties that the Respondent was well aware of the Complainant’s trade mark when the disputed domain names were registered.

As discussed in section 5C above, the Panel has serious doubts that the registration of the first disputed domain name in connection with the sale of “Wenger” products (as opposed to SWISS ARMY knives or other

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<sup>1</sup> See e.g. *A G Spalding and Brothers v A W Gamage (Ltd)* (1915) 32 RPC 273 (HL).

<sup>2</sup> Trade Marks Act 1995 (Cth) s 122A.

SWISS ARMY brand products) qualifies as registration in good faith under the Policy.

Whatever may have been the case when the Respondent registered the first disputed domain name, however, it is clear that the Respondent is not licensed by or otherwise associated with the Complainant now. Further, so far as the record in this proceeding discloses, the Respondent is not carrying on a business offering for sale "Swiss Army" products or with some right to offer for sale the Complainant's SWISS ARMY products. Nor has the Respondent made a credible showing of plans to do so.

In these circumstances, the offering for sale of the disputed domain names for prices considerably in excess of the ordinary registration fees constitutes use in bad faith. It appears merely to be an attempt to capitalise on the resemblance of the disputed domain names to the Complainant's trade mark.

Accordingly, the Complainant has established all three requirements under the Policy for both disputed domain names.

## **6. Decision**

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain names, <swissarmy.au> and <swissarmy.com.au>, be transferred to the Complainant.

*/Warwick A. Rothnie/*

**Warwick A. Rothnie**

Sole Panelist

Date: March 27, 2023