

EXPERT DECISION

Digitec Galaxus AG v. A. D. S.
Case No. DCH2022-0007

1. The Parties

The Claimant is Digitec Galaxus AG, Switzerland, represented by SILKA AB, Sweden.

The Respondent is A. D. S., United States of America.

2. The Domain Name.

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

3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 20, 2022. On April 21, 2022, the Center transmitted by email to SWITCH, the “.ch” and “.li” registry, a request for verification in connection with the disputed domain name. On April 22, 2022, 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 Complaint. The Center sent a Request Deficiency Notification to the Claimant on April 28, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Request. The Complainant filed an amendment to Request on April 29, 2022.

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 April 29, 2022. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was May 19, 2022.

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

On May 20, 2022, the Center notified the Claimant accordingly, who on the same date 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 June 1, 2022, the Center appointed Daniel Kraus 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.

3. Factual Background

The Claimant in this proceeding is Digitec Galaxus AG, a Swiss online retailer company founded in 2001. The Claimant operates under two online shops: “www.digitec.ch” and “www.galaxus.ch”. Whereas “www.digitec.ch” is one of the Swiss online market leader in the fields of IT, consumer electronics and telecommunication, the website “www.galaxus.ch” is one of the largest Swiss online shop with a growing range of products for daily needs.

The Claimant has ten stores in German and French speaking parts of Switzerland and more than 2,000 employees. It generated CHF 2.122 billion in sales in 2021. The Claimant has recently started to expand its activities into the European Union, particularly to Germany.

A majority of the shares now belong to Migros, a famous Swiss distributor.

The Claimant is the owner of a several trademarks registrations consisting of DIGITEC, including the following Swiss Trademarks:

- Swiss Trademark Registration n° 486055 DIGITEC (word mark), registered on June 20, 2001, in international classes 9, 37, 38, and 42.
- Swiss Trademark Registration n° 625516 DIGITEC (word mark), registered on February 6, 2012, in international class 35.

The disputed domain name was registered on February 22, 2021, and resolves to an inactive website at the time of the Decision. At the time the Request was filed, it resolved to a website offering for sale similar products as the Claimant.

4. Parties' Contentions

A. The Claimant

The Claimant contends that Claimant and its DIGITEC trademark are undoubtedly extremely popular in Switzerland, and that they could be even considered as well-known trademarks. The Claimant further contends that the allocation and/or use of the disputed domain name infringes the Claimant's right in a distinctive sign under the Swiss Trademark Law and the Swiss Unfair Competition Law, as the disputed domain name includes the Claimant's DIGITEC trademark. Besides, for a number of months, it resolved to a website offering the same type of products offered by the Claimant through its online site “www.digitec.ch”. In view of the situation, the Claimant sent two cease-and-desist letters to the Respondent, as well as a subsequent reminder, neither of which was answered. However, on a date subsequent to that of the cease-and-desist letters and its reminder, the website at the disputed domain name was removed.

B. The Respondent

The Respondent did not reply to the Claimant's contentions.

5. Discussion and Findings

According to the Rules of Procedure, paragraph 24(c), “the Expert shall grant the request if the allocation or use of the domain name constitutes a clear infringement of a right in a distinctive sign which the Claimant owns under the laws of Switzerland”.

The Rules of Procedure, paragraph 24(d) specify that “a clear infringement of an intellectual property right exists when:

- 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
- the respondent has not conclusively pleaded and proven any relevant grounds for defense; and
- the infringement of the right justifies the transfer or revocation of the domain name, depending on the remedy requested in the request”.

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

The Claimant has established ownership of active Swiss trademarks, in particular:

- Swiss Trademark Registration n° 486055 DIGITEC (word mark), registered on June 20, 2001, in international classes 9, 37, 38 and 42;
- Swiss Trademark Registration n° 625516 DIGITEC (word mark), registered on February 6, 2012, in international class 35.

Therefore, the Expert finds that the Claimant has established its exclusive right in its distinctive sign in Switzerland. Accordingly, the Claimant has provided sufficient evidence of Swiss trademark rights in accordance with paragraph 24(d)(i) of the Rules of Procedure.

B. The allocation or use of the domain name constitutes a clear infringement of the Claimant’s’ right

According to Article 13, paragraph 1 and paragraph 2(c) of the Federal Act on the Protection of Trademarks and indication of Source (Trademark Protection Act (TmPA)), a trademark right confers on the proprietor the exclusive right to use the trademark to identify the goods or services for which it is claimed, and to prohibit others from offering or providing services under a sign that is identical or confusingly similar to its trademark.

According to Swiss supreme court rulings, the use of domain names that are identical or confusingly similar to a trademark on websites offering the same or similar goods constitutes trademark infringement (see e.g. decisions of the Swiss Federal Supreme Court 4C.31/2004, <riesen.ch> and 4C.341/2005 <swiss-life.ch>).

The disputed domain name <digitecshop.ch> is almost identical to the trademark DIGITEC as it incorporates the trademark DIGITEC in its entirety in combination with a descriptive term “shop”, which leads to an overall confusing similarity with the Claimant’s trademark; the addition of the country code Top-Level Domain “.ch” does not prevent a finding of confusing similarity. Its use by the Respondent to sell similar products as the Claimant constitutes a trademark infringement under Swiss law.

Given that the transfer of the disputed domain name is already justified on the basis of the clear trademark infringement, any potential infringement of the Federal Act against Unfair competition (UCA) does not need to be examined.

6. Expert Decision

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

Daniel Kraus

Expert

Dated: June 15, 2022