

## EXPERT DECISION

Arla Foods Amba v. Z. H., L. W.  
Case No. DCH2022-0008

### 1. The Parties

The Claimant is Arla Foods Amba, Denmark, represented by BrandIT GmbH, Switzerland.

The Respondents are Z.H. and L.W.,<sup>1</sup> China.

### 2. The Domain Names

The dispute concerns the following domain names <arlafood.ch> and <lurpak.ch> (the “disputed domain names”).

### 3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 6, 2022. On May 9, 2022, the Center transmitted by email to SWITCH, the “.ch” and “.li” registry, a request for verification in connection with the disputed domain names. On May 10, 2022, SWITCH transmitted by email to the Center its verification response confirming that the Respondent is listed as the holder of the disputed domain names and providing the relevant contact details. The Center verified that 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 May 24, 2022. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was June 13, 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.

---

<sup>1</sup> According to the Rules of Procedure, paragraph 12(e), “[t]he request may relate to more than one domain name provided that all domain names are registered for the same Respondent”. Based on a number of factors, including the same physical address for both disputed domain names in the Whois records, namely the street name and the number of the building, the Claimant believes that it is procedurally efficient to permit the consolidation of the Respondents in this matter. Based on the available record, the Expert finds that the disputed domain names are subject to common control and the consolidation would be fair and equitable to all parties. Hereinafter, the Expert will refer to the Respondents as “the Respondent”.

On June 14, 2022, the Center notified the Claimant accordingly, who on June 27, 2022, 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 July 4, 2022, the Center appointed Andrea Mondini 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**

The Claimant was established in 2000 and is today one of the largest dairy companies in the world. It employs over 20,000 people across 105 countries.

The Claimant sells milk-based products among others under its brands ARLA and LURPAK in numerous European countries, including Switzerland.

The Claimant owns among others the International trademark ARLA No. 731917, registered on March 20, 2000, designating Switzerland and covering Classes 01, 05, 29, 30, 31, 3 and the International trademark LURPAK No. 1167472 registered on October 30, 2012, designating Switzerland covering 01, 05, 29, 30, 31, 32.

The disputed domain name <arlafood.ch> was registered on July 27, 2011. The disputed domain name <lurpak.ch> was registered on October 32, 2014.

The disputed domain name <arlafood.ch> resolved to a pay-per-click (“PPC”) advertising site referring also to third party companies offering dairy products. The disputed domain name <lurpak.ch> has not been used to offer any goods and/or services.

#### **5. Parties’ Contentions**

##### **A. Claimant**

In summary, the Claimant asserts the following:

The disputed domain name <arlafood.ch> is confusingly similar to the trademark ARLA, because the addition of the descriptive term “food” does not dispel confusing similarity.

The disputed domain name <lurpak.ch> is identical to the LURPAK trademark.

Both disputed domain names were registered several years after the registrations of the Claimants’ ARLA and LURPAK trademarks.

The Respondent is not a licensee of the Claimant and has not received any permission from the Claimant to use its marks.

The disputed domain name <arlafood.ch> used to resolve to a PPC website displaying links to third party dairy food products. The Respondent thereby infringed the Claimant’s trademark rights.

The disputed domain name <lurpak.ch> has not been used to offer any goods and/or services. However, in response to the Claimant’s cease and desist letter sent on January 17, 2022, the Respondent offered to sell each disputed domain name for EUR 3,500 or both disputed domain names for EUR 6,500. The Respondent thereby knowingly infringed a distinctive sign under the Swiss unfair competition act.

## **B. Respondent**

The Respondent has not submitted a response.

## **6. 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 “in particular, 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. The Claimant has a right in a distinctive sign under the law of Switzerland**

The Claimant has shown that it owns among others the International trademark ARLA No. 731917, registered on March 20, 2000, designating Switzerland covering Classes 01, 05, 29, 30, 31, 3 and the International trademark LURPAK No. 1167472 registered on October 30, 2012, designating Switzerland covering 01, 05, 29, 30, 31, 32.

Therefore, the Expert finds that the Claimant has established its exclusive right in the trademarks ARLA and LURPAK in Switzerland. Accordingly, the Claimant has provided sufficient evidence of rights distinctive signs under the law of Switzerland 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 a right in a distinctive sign which the Claimant owns under the law of Switzerland**

According to Art. 13 para 1 and para. 2(c) of the Swiss Trademark Act, 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 <arlafood.ch> is confusingly similar to the trademark ARLA and the addition of the descriptive word “food” does not suffice to avoid a finding of confusing similarity. The use of this disputed domain name to resolve to a PPC website with links to identical and/or similar dairy products offered by competitors creates a likelihood of confusion with the Claimant’s trademark (see *Bulgari S.p.A. v. Registration Private, WhoisGuardService.com / S. H., Two Stooges LLC*, WIPO Case No. [DCH2021-0005](#)). This clearly constitutes a trademark infringement under Swiss law.

The disputed domain name <lurpak.ch> is identical to the trademark LURPAK but has not been used to offer any goods and/or services. However, in response to the Claimant’s cease and desist letter, the Respondent

offer to sell the disputed domain name <lurpak.ch> for EUR 3,500 and both disputed domain names for EUR 6,500. It is established that the mere registration of a domain name and passive use of a domain name can be considered as unfair pursuant to article 2 of the Swiss Unfair Competition Act if such registration is made in order to take advantage of the reputation of a third-party sign or if the registration of the domain name is carried out without objectively protectable interests and is thus made clearly at the expense of a third party. It is established that such a violation resulting from the unfair registration of a domain name can justify the transfer of such domain name (see *Bewital Holding GmbH & Co. KG v. Roman Willi*, WIPO Case No. [DCH2018-0008](#); and *LLOYD Shoes GmbH v. CSI Group GmbH / Chris Köppel*, WIPO Case No. [DCH2015-0012](#)). The Expert concludes that the passive holding of the disputed domain name <lurpak.ch> and the offer to sell it for EUR 3,500 (EUR 6,500 for both disputed domain names) constitute a clear infringement of a right in a distinctive sign which the Claimant owns under the law of Switzerland.

The Respondent has neither pleaded nor proven any relevant grounds for defense. The Expert therefore holds that the above infringements of the Claimant's right justify the transfer of both disputed domain names to the Claimant.

## **6. Expert Decision**

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

**Andrea Mondini**

Expert

Dated: July 18, 2022