

## **EXPERT DECISION**

Bitpanda GmbH v. D. H.  
Case No. DCH2022-0010

### **1. The Parties**

The Claimant is Bitpanda GmbH, of Austria, represented by Schonherr Rechtsanwälte GmbH, Austria.

The Respondent is D. H., United Kingdom.

### **2. The Domain Name**

The dispute concerns the domain name <bitpanda.ch> (the “disputed domain name”).

### **3. Procedural History**

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 17, 2022. On May 18, 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 May 19, 2022, SWITCH transmitted by email to the Center its verification response confirming that the Respondent is listed as the holder of the disputed domain name 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 his readiness to participate in a Conciliation in accordance with paragraph 15(d) of the Rules of Procedure.

On June 14, 2022, the Center notified the Claimant accordingly, who on June 17, 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 June 21, 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 is a digital assets provider and operates the trading platform Bitpanda for digital assets such as cryptocurrencies, precious metals, equities and ETFs based in Vienna, Austria, serving both private and business customers.

The Claimant is, *inter alia*, owner of the international trademark registration no 1383484 of the word mark BITPANDA in international classes 9, 36, and 42 with the registration date November 21, 2017, and priority date November 17, 2017, *inter alia* designating Switzerland.

Since February 2016, the Claimant (at that time still formally named Coinimal GmbH) conducted its business activities (digital assets management) under the name BITPANDA. As of February 9, 2016, the Claimant's domain name <bitpanda.com> resolved to its website featuring the BITPANDA platform.

The disputed domain name was registered on January 16, 2017.

The disputed domain name was used to refer to websites competing with the Claimant and its services.

#### 5. Parties' Contentions

##### A. Claimant

In summary, the Claimant asserts the following:

The Claimant uses the distinctive sign BITPANDA also in Switzerland: at the time of the registration of the disputed domain name, the Claimant already had 1,894 registered Swiss users. Today, the Claimant has around 96,000 registered Swiss users and *inter alia* an office in Zurich, Switzerland.

Over the past months the disputed domain name was used to refer to several platforms for the exchange of digital assets of third parties and thus also direct competitors of the Claimant, for example <binance.com>, <xcoins.com> or currently "https://cex.io/topup". The Respondent thus monetarizes the disputed domain name as part of a competitor's referral scheme, benefiting from misguiding Internet users searching for the Claimant's services to a competitor's website.

The Respondent engaged in a pattern of registering domains such as <bitpand.com>, <bitpada.com>, <bit-panda.com>, and <bitpanda.co.uk>, which are similar to the Claimant's domain name.

On May 14, 2019, the Respondent used the disputed domain name even to redirect to the Claimant's website under <bitpanda.com>.

The Claimant has rights in the unregistered business name BITPANDA in Switzerland and has already been using the name BITPANDA in commerce before the registration of the disputed domain name.

The Claimant owns right to the BITPANDA trademark in Switzerland, which has been registered on November 21, 2017, with priority date of November 17, 2017.

The allocation and/or use of the disputed domain name at issue infringes Claimant's right in its distinctive sign BITPANDA under the laws of Switzerland because the disputed domain name is identical to the Claimant's business name and trademark BITPANDA and thus infringes the protection of the Claimant's business name under Art. 29(2) of the Swiss Civil Code as well as Article 2 and 3 para. 1 lit. d of the Swiss federal act against unfair competition.

Furthermore, the Respondent has deliberately chosen not to respond to the warning letter sent by the Claimant on February 14, 2022.

## **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 established ownership of the international trademark registration no 1383484 of the word mark BITPANDA in international classes 9, 36, and 42 with the registration date November 21, 2017 and priority date November 17, 2017, *inter alia* designating Switzerland.

On the other hand, the Claimant has shown priority of use of the name BITPANDA for its business since 2016, including in Switzerland. According to Article 8 of the Paris Convention for the Protection of Industrial Property to which both Switzerland and Austria are bound, “[a] trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.” In this regard, the Swiss Federal Tribunal has considered, in substance, that a foreign company not registered in the Swiss commercial register enjoys the same protection as an unregistered Swiss company. The scope of such protection covers the right to a name and against unfair competition (see Decision ATF 79 II 305).

Therefore, the Expert finds that the Claimant has established a right in its distinctive sign BITPANDA in Switzerland. Accordingly, the Claimant has provided sufficient evidence of a right in a distinctive sign 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 article 29(2) of the Swiss Civil Code, someone injured by a usurpation of his name can bring an action to enjoin such use. This provision also protects the name of corporate legal persons governed by private law, and the Federal Tribunal has further held that the use of someone’s name infringes an interest worthy of protection when such appropriation of the name results in a danger of confusion or deception or when such appropriation is of nature to create in the public’s mind, by an association of ideas, a connection – which in fact does not exist (see ATF 128 III 353, recital 4, <montana.ch>).

The disputed domain name is confusingly similar to the distinctive sign BITPANDA. Claimant has shown that the Respondent used the disputed domain name to refer to several platforms for the exchange of digital assets of third parties that are direct competitors of the Claimant, and even to the Claimant’s official website

<bitpanda.com> itself. The Expert finds that such use infringes an interest worthy of protection because such appropriation of the name results in a danger of confusion or deception.

Moreover, such use constitutes an act of unfair competition under Art. 3 para. 1 lit. d of the Swiss federal act against unfair competition, which protects unregistered distinctive signs. The unfair conduct is particularly evident considering that the Respondent engaged in a pattern of registering domains such as <bitpand.com>, <bitpada.com>, <bit-panda.com>, and <bitpanda.co.uk>, which are similar to the Claimant's domain name.

The Respondent has neither pleaded nor proven any relevant grounds for defense.

The Expert therefore holds that the infringement of the right justifies the transfer of the disputed domain name.

## **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 <bitpanda.ch> be transferred to the Claimant.

**Andrea Mondini**

Expert

Dated: July 4, 2022