

## **EXPERT DECISION**

Scan Global Logistics A/S v. T. K.  
Case No. DCH2022-0019

### **1. The Parties**

The Claimant is Scan Global Logistics A/S, Denmark, represented by Patrade A/S, Denmark.

The Respondent is T. K., India.

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

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

### **3. Procedural History**

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 21, 2022. On December 23, 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 December 27, 2022, SWITCH transmitted by email to the Center its verification response confirming that the Respondent is listed as the holder of the domain name and providing the relevant contact details. The Claimant filed an amended Request on January 17, 2023 with an additional piece of evidence. The Center verified that the Request and amended 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 January 18, 2023. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was February 7, 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 February 9, 2023, the Center notified the Claimant accordingly, who on the same day made an application for the continuation of the Dispute resolution proceedings in accordance with paragraph 19 of the Rules of procedure and paid the required fees.

On February 17, 2023, the Center appointed Anne-Virginie La Spada as Expert in this case. The Expert finds that she was properly appointed. In accordance with Rules of Procedure, paragraph 4, the above Expert has declared her independence of the parties.

### **3. Factual Background**

The Claimant is a Danish corporation that operates in the freight forwarding industries.

The Claimant is the owner of the following trademark rights covering Switzerland:

- International trademark registration No. 1516772 for SCAN GLOBAL LOGISTICS, registered on September 18, 2019, in classes 35, 36, and 39;
- International trademark registration No. 962852 for SCAN GLOBAL LOGISTICS & design, registered on December 14, 2007, in classes 35, 36, and 39.

The Claimant is the owner of various domain names consisting of the term “scangl” and a generic Top-Level Domain (“gTLD”) or country code Top-Level Domain (“ccTLD”), including <scangl.com>, <scangl.fr>, and <scangl.eu>.

The disputed domain name was registered on November 16, 2021.

On October 12, 2022, the disputed domain name was offered for sale to the Claimant. The sender of this email, who does not have the same name as the Respondent, wrote: “Since you have all other European domains for this keyword except .ch, you may have direct interest in acquiring it.” The sender indicated in a subsequent email dated October 21, 2022, that the asking price for the disputed domain name was EUR 2,100.

At the time of filing of the Request, the disputed domain name resolved to a parking page with sponsored links. At the time of the decision, the parking page website also contained the following statement: “You can purchase the domain name scangl.ch from the owner for 2,700 EUR”.

### **4. Parties' Contentions**

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

The Claimant alleges that the Respondent has registered a domain name that is very similar to its prior trademarks and domain names.

It alleges that the allocation of the disputed domain name <scangl.ch> is an infringement of the Claimant's trademark rights to SCAN GLOBAL LOGISTICS according to the Swiss Federal Act on the Protection of Trademarks and Indications of Source, Article 13.

Moreover, according to the Claimant, the Respondent has no legitimate interest in the disputed domain name as it has no trademark rights or activity on the website.

Lastly, the Claimant contends that the registration of the disputed domain name was abusive because the disputed domain name was acquired for the sole purpose of selling it to the Claimant. The price of EUR 2,100 suggests furthermore that the Respondent sought to turn a profit by exploiting the Claimant's trademark.

The Claimant requests that the disputed domain name be transferred to it.

#### **B. The Respondent**

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

## 5. Discussion and Findings

According to paragraph 24(c) of the Rules of Procedure, 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 law of Switzerland (in disputes over a domain name under the ccTLD “.ch”).

The Rules of Procedure, paragraph 1, define a “right in a distinctive sign” as any right recognised by the legal system devolving from the registration or use of a sign, which protects the holder of the right from infringement of his interests as the result of registration or use of an identical or similar sign by third parties, including, but not limited to, the right in a registered business name, a personal name, a trademark, a geographical indication and the defensive rights devolving from the law on unfair competition.

According to paragraph 24(d) of the Rules of Procedure, 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 defence; and
- iii. 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 is the owner of international registrations for the word mark SCAN GLOBAL LOGISTICS and the combined mark SCAN GLOBAL LOGISTICS & design covering Switzerland (international registrations no. 1516772 and no. 962852). The Claimant therefore owns trademark rights in Switzerland.

The Claimant is also the owner of numerous domain names containing the term “scangl” since 2008. Although Swiss law does not attach specific intellectual property rights to a domain name, the ownership and use of an earlier domain name in Switzerland may be relevant from the point of view of unfair competition law.

The Claimant has provided sufficient evidence that it has a right in a distinctive sign protected in Switzerland, in accordance with paragraph 24(d)(i) of the Rules of Procedure.

### **B. The allocation or use of the disputed domain name constitutes a clear infringement of a Right in a distinctive sign which the Claimant owns under the law of Switzerland**

The Claimant contends that the disputed domain name was acquired for the sole purpose of selling it to the Claimant and therefore that the registration was abusive under the law of Switzerland. Furthermore, it contends that the allocation of the disputed domain name <scangl.ch> is an infringement of the Claimant’s trademark rights to SCAN GLOBAL LOGISTICS according to the Swiss Federal Act on the Protection of Trademarks and Indications of Source, Article 13.

Under Swiss trademark law, trademarks are protected as a rule only in relation to goods or services identical or similar to those covered in the registration, according to the so-called “specialty principle”. Accordingly, the mere registration of a domain name identical or similar to a registered trademark does not, in principle, amount to trademark infringement (decision of the Swiss Supreme Court of November 8, 2004, 4C.31/2004, “riesen.ch”; *LLOYD Shoes GmbH v. CSI Group GmbH / Chris Köppel*, WIPO Case No. [DCH2015-0012](#); and *Cartier International S. A. contre Marc Baertschi*, WIPO Case No. [DLI2015-0001](#)). This also applies when a domain name identical or similar to a registered trademark is used in connection with a website proposing goods or services that are not similar to those covered by the trademark registration.

In the present case, the disputed domain name is used in connection with a parking page featuring sponsored links. It does not appear (and the Claimant does not allege) that the sponsored links proposed on the parking page to which the disputed domain name resolves are identical or similar to the services covered by the Claimant's trademark registrations. Accordingly, it is not established that the disputed domain name is used in connection with services identical or similar to those covered by the Claimant's trademarks.

That said, under unfair competition law, the registration of a domain name that is identical or similar to a protected trademark may be illicit even if such domain name is not used in connection with an active website, or if it is used in connection with dissimilar goods or services, if the circumstances denote an unfair intent on the part of the registrant of the domain name. Indeed, according to Article 2 of the Unfair Competition Act ("UCA"), "any conduct or business practice that is misleading or which otherwise violates the principle of good faith such that it influences the relationship between competitors or between suppliers and customers is unfair and unlawful".

The registration of a domain name reproducing a third party's trademark may constitute an act of unfair competition when it objectively causes an obstacle to the commercial activity of the trademark holder and/or when the intention to cause such an obstacle is manifest (*AdunoKaution AG, Aduno Finance AG contre SC, SwissCaution SA*, WIPO Case No. [DCH2015-0019](#); and *AXA SA contre SC, SwissCaution SA, Onkelinx Sophie / SC, SwissCaution SA, Yann Goyonvarc'h*, WIPO Case No. [DCH2016-0002](#)). The attempt to resell a domain name reproducing a distinctive sign to the legitimate holder of that sign at a price higher than the cost of registration may indicate an unfair intention and amount to an act of unfair competition, justifying the transfer of the domain name (see *Cartier International S. A. contre Marc Baertschi*, WIPO Case No. [DLI2015-0001](#); and *Arla Foods Amba v. Z. H., L. W.*, WIPO Case No. [DCH2022-0008](#)).

In the present case, the disputed domain name is similar to the Claimant's trademark SCAN GLOBAL LOGISTICS. Indeed, the disputed domain name combines the first and predominant word of the trademark, namely "SCAN", with the letters "g" and "l", which can easily be understood as the abbreviation for the words "GLOBAL LOGISTICS" also present in the trademark. Moreover, the structure of the disputed domain name is identical to the structure of numerous domain names owned by the Claimant (namely "scangl" + gTLD or ccTLD). The sender of the email offering to sell the disputed domain name to the Claimant mentioned the existence of the Claimant's other domain names as an argument for the desirability of the disputed domain name. A coincidental resemblance with the Claimant's trademark and domain names appears therefore to be out of the question.

The Expert notes that the sender of the email offering the disputed domain name for sale did not use the same name as the named Respondent. However, based on the available record, it seems more likely than not that the sender is the Respondent, or at least that he was acting under instructions of the Respondent. There is no reason to believe, in any case, that the sender of the email is a different person than the Respondent or that this email could have been sent without the knowledge of the Respondent. Moreover, it is noted that the Respondent did not respond to the Request and did not dispute, in particular, to be the sender of the email, even though the Request was delivered at the address indicated in the Whois details.

In the present case, the Expert finds that the Claimant has established that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling the disputed domain name to the Claimant for a price considerably higher than the cost of registration, namely EUR 2,100.

The Expert accordingly accepts that the Respondent has registered the disputed domain name with the intention of interfering with the Claimant's business, and that this constitutes an act of unfair competition within the meaning of Article 2 UCA.

Since the Respondent has not put forward any conclusive grounds for defense that would rebut the Claimant's representations or justify his own legitimate interest, and having regard to the submissions, the Expert finds that the Claimant has fulfilled paragraph 24(c) and (d) of the Rules of Procedure.

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

**Anne-Virginie La Spada**

Expert

Dated: March 6, 2023