

EXPERT DECISION

Migros-Genossenschafts-Bund v. A. S., Work Side lane
Case No. DCH2023-0009

1. The Parties

The Claimant is Migros-Genossenschafts-Bund, of Switzerland, represented by SILKA AB, Sweden.

The Respondent is A. S., Work Side lane, of the United States of America.

2. The Domain Name

The dispute concerns the domain name <migrosbankswitzerland.ch>.

3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 10, 2023. On April 11, 2023, 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 12, 2023, SWITCH transmitted by email to the Center its verification response. In response to a notification by the Center that the Request was administratively deficient, the Claimant filed an amendment to the Request on April 14, 2023. 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 14, 2023. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was May 4, 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 May 5, 2023, the Center notified the Claimant accordingly, who on May 10, 2023, 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 May 23, 2023, the Center appointed Tobias Zuberbühler as Expert in this case. The Expert finds that he was properly appointed. In accordance with the Rules of Procedure, paragraph 4, the above Expert has declared his independence of the parties.

3. Factual Background

The Claimant, Migros-Genossenschafts-Bund ("MGB"), is a cooperative association. Migros Bank is one of the top five mortgage banks in Switzerland and a 100% subsidiary of the MGB.

The Claimant and its subsidiaries have used marks comprised of the term MIGROSBANK in connection with various goods and services. The Claimant owns several registrations for its MIGROSBANK marks, including Swiss Registration No. 414500 for MIGROSBANK (word mark), registered on January 12, 1995; and Swiss Registration No. 623618 for MIGROSBANK (design mark), registered on December 12, 2011.

The Respondent registered the disputed domain name on March 30, 2023. The website associated with the disputed domain name currently features online banking services and pretends to be affiliated with Migros Bank. There is also a login page for Internet banking where potential customers can enter sensitive information such as login details and pass codes.

4. Parties' Contentions

A. The Claimant

The Claimant alleges that the disputed domain name is highly similar to the Claimant's MIGROSBANK trademark and is used for services which are identical or at least highly similar to the Claimant's services.

Therefore, the Claimant contends that the Respondent has clearly violated Article 3 section 1 lit. c of the Swiss Trademark Act as well as Articles 2 and 3(d) of the Swiss Unfair Competition Act.

B. The Respondent

The Respondent has not replied to the Claimant's contentions. Pursuant to paragraph 23(b) of the Rules of Procedure, the Expert is therefore entitled to draw such inferences as he considers appropriate.

5. Discussion and Findings

According to paragraph 24 of the Rules of Procedure, the Expert shall grant the Request if 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 laws of Switzerland.

Paragraph 24(d) of the Rules of Procedure specifies that such 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 disputed domain name, depending on the remedy requested in the request.

A. The Claimant has a Right in a distinctive sign under the laws of Switzerland

As outlined above, the Claimant owns various Swiss trademark registrations for its trademark MIGROSBANK.

Due to the use of its trademark MIGROSBANK in business transactions, the Claimant can also invoke the unfair use of its protected sign under the UCA.

Thus, the Expert holds that the Claimant has established rights in a distinctive sign in Switzerland.

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 laws of Switzerland

The owner of a trademark has the exclusive right to use the trademark to designate the goods and/or services for which it is registered. In particular, the trademark owner may prohibit others from using a sign that is similar to its trademark and is used for the same or similar goods, so that a likelihood of confusion arises (Art. 13(1) and (2) in conjunction with Art. 3(1)(c) of the Swiss Trademark Act).

The disputed domain name entirely comprises the Claimant's MIGROSBANK trademark, with the addition of the geographical term "switzerland". The website associated with the disputed domain name currently features online banking services and pretends to be affiliated with the Claimant. There is also a login page for Internet banking where potential customers can enter sensitive information such as login details and pass codes. Such commercial (and potentially criminal) use creates a high likelihood of confusion between the disputed domain name and the Claimant's trademark, resulting in an infringement of the Claimant's trademark rights in accordance with Article 3(1)(c) in connection with Article 13(2)(b) of the Swiss Trademark Act as well as a violation of Article 2 and Article 3(d) of the Swiss Unfair Competition Act.

The Respondent has not provided any reasonable explanation why he registered the disputed domain name and, to the Expert's best knowledge, no such grounds can be seen.

The Expert finds that the Request is well founded and that the Respondent's infringements of the Claimant's rights justify a transfer of the disputed domain name to the Claimant according to paragraph 24(d)(iii) 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 domain name <migrosbankswitzerland.ch> be transferred to the Claimant.

Tobias Zuberbühler

Expert

Dated: May 25, 2023