

EXPERT DECISION

Alois Dallmayr Kaffee oHG, and Alois Dallmayr KG v. S. A.
Case No. DCH2023-0015

1. The Parties

The Claimants are Alois Dallmayr Kaffee oHG, and Alois Dallmayr KG, of Germany, represented by TIMES Attorneys, Switzerland.

The Respondent is S. A., of Georgia.

2. The Domain Name

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

3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 13, 2023. On July 14, 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 July 17, 2023, 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 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 July 21, 2023. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was August 10, 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 August 15, 2023, the Center notified the Claimant accordingly, who on August 17, 2023, 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 August 24, 2023, the Center appointed Tobias Zuberbühler 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 Claimants (also known as “Alois Dallmayr”, or “Dallmayr”) are one of the largest delicatessen businesses in Europe, with a tradition of more than 300 years. The holding company of the business is Alois Dallmayr KG; Alois Dallmayr Kaffee oHG is a wholly owned subsidiary of Alois Dallmayr KG.

The Claimants own several registrations for their trademarks, including the International Trademark Reg. No. 514060, DALLMAYR (word mark), registered on July 28, 1987; and Swiss Registration No. 653305, DALLMAYR BARISTA (word mark), registered on October 1, 2014.

The Respondent registered the disputed domain name on December 23, 2022. The disputed domain name has been automatically redirecting to changing websites containing, *inter alia*, pornographic content.

5. Parties' Contentions

A. The Claimants

The Claimants allege that the Respondent has engaged in so-called typosquatting, by adding the letter “e” to the Claimants’ well-known DALLMAYR trademark.

Therefore, the Claimants contend that the Respondent has clearly violated (i) the Claimants’ trademark rights under Article 3 section 1 lit. c and e in connection with Article 13 of the Swiss Trademark Act; (ii) the Claimants’ rights in the unregistered business name DALLMAYR in Switzerland (Article 8 of the Paris Convention for the Protection of Industrial Property); (iii) the Claimants’ personality rights and rights to the name DALLMAYR. Moreover, the Claimants argue that the use of the disputed domain name constitutes an act of unfair competition under Article 3 para. 1 lit. d and e and Art. 2 of the Swiss Federal Unfair Competition Act (“UCA”).

B. The Respondent

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

6. 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 Claimants own 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 Claimants have a right in a distinctive sign under the laws of Switzerland

As outlined above, the Claimants own various Swiss and international trademark registrations for their DALLMAYR trademarks.

Due to the use of their trademark DALLMAYR in business transactions, the Claimants can also invoke the unfair use of their protected sign under the UCA.

Thus, the Expert holds that the Claimants have 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 Claimants own 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 comprises the Claimants' DALLMAYR trademark, with the insertion of the letter "e" ("Dallmayer" vs "Dallmayr"). The website associated with the disputed domain name has been automatically redirecting to various different websites.

The Respondent has thus clearly engaged in so-called "typosquatting", *i.e.* in registering and using domain names with subtle changes in the spelling of (typically well-known) trademarks. Swiss legal doctrine and experts in previous .ch dispute resolution proceedings have consistently acknowledged and held that typosquatting violates Article 13(1) TMA and/or Article 3(d) of the Swiss Unfair Competition Act (Mark Schweizer, 5 Jahre SWITCH-Streitbeilegungsverfahren: Fair.ch?, AJP 8/2009 971, 980, referring to various .ch-decisions in fn. 76; for other decisions see *comparis.ch AG v. Cifagro enterprise u.a.*, WIPO Case No. [DCH2012-0031](#); *Scout24 Holding GmbH and Scout24 International Management AG v. IP Matters Corp.*, WIPO Case No. [DCH2012-0008](#); and *Conforama Holding v. Dubin Sergey*, WIPO Case No. [DCH2013-0024](#)).

The Respondent thus clearly infringes the Claimants' trademark rights and violates unfair competition law.

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 Claimants' rights justify a transfer of the disputed domain name in accordance with paragraph 24(d)(iii) of the Rules of Procedure.

7. Expert Decision

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

Tobias Zuberbühler

Expert

Dated: August 25, 2023