

## EXPERT DECISION

TMH International AG v. T.K.  
Case No. DCH2023-0017

### 1. The Parties

The Claimant is TMH International AG, of Switzerland, represented by Wild Schnyder AG, Switzerland.

The Respondent is T.K., of Ukraine.

### 2. The Domain Name

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

### 3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 25, 2023. On July 25, 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 26, 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 August 8, 2023. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was August 28, 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 29, 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 specified in paragraph 19 of the Rules of procedure and paid the required fees.

On September 6, 2023, the Center appointed Daniel Kraus 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 Swiss subsidiary of Transmashholding (TMH), a leading railway rolling stock manufacturer. TMH is the largest manufacturer of locomotives and rail equipment in the Russian Federation and after merging with LocoTech service the fourth largest engineering company in the field of transport technology globally. The Claimant was founded in 2007 carrying the name Bombardier Transportation Transmashholding AG. In 2009, the company name changed to Transmashholding AG, and in 2017 the company name was changed to TMH International AG.

The Claimant holds the following trademarks with the element TMH International, both in classes 9, 12 and 37:

- Swiss Registration no. 724133, TMH INTERNATIONAL, registered on July 4, 2018; and
- International Registration no. 1445294, TMH INTERNATIONAL registered on November 21, 2018.

It was originally the Claimant that registered the disputed domain name, on December 11, 2017. The disputed domain name was operated by the Claimant and administered by the Claimant's IT company "Wyss EDV AG" until September 2022, and renewal invoices were always paid. However, for still unexplained reasons, the disputed domain name was taken over by the Respondent, who, according to SWITCH, registered it on January 17, 2023.

#### **5. Parties' Contentions**

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

The Claimant contends that it has a right in a distinctive sign under the laws of Switzerland, that the allocation and the use of the disputed domain name infringes its right in a distinctive sign under the laws of Switzerland, in particular from the point of view of its right to its name and of unfair competition.

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

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

#### **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 "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 laws of Switzerland**

The Claimants have established ownership of active Swiss trademarks, in particular

- Swiss Registration no. 724133 TMH INTERNATIONAL, registered on July 4, 2018; and
- International Registration no. 1445294 TMH INTERNATIONAL registered on November 21, 2018.

Due to the use of their trademark TMH INTERNATIONAL in business transactions, the Claimant can also invoke the unfair use of its protected sign under the Swiss Unfair Competition Act (“UCA”) as well as the right to its name. Therefore, the Expert finds that the Claimant has established its exclusive right in its distinctive signs in Switzerland.

### **B. The allocation or use of the domain name constitutes a clear infringement of the Claimant’s right**

Because domain names identify persons, products, or services via the respective websites, Swiss Federal Supreme Court practice recognizes that domain names are comparable to personal names, business names, and trademarks and therefore can be regarded as distinctive signs (ATF 126 III 239, 244, <berneroberland.ch>). Swiss practice further acknowledges a likelihood of confusion if the (commercial) use of a domain name similar to a name (or mark) creates the risk of a wrong association of the website (ATF 128 III 401, 402, <luzern.ch>). Whereas in earlier decisions the Swiss Federal Tribunal held that the content of a website under the corresponding trademark was to be disregarded (see sic! 2003, p. 822 <t-online.ch>; ATF 128 III 401, 403 et seq. <luzern.ch>), this jurisprudence was modified, and the principle of specialty applicable to trademarks implies that the content of a website under the corresponding trademark needs to be taken in consideration under trademark law (see the decision of principle sic! 2005, p. 283 <riesen.ch> and the later decisions based on it).

In the present case, the website to which the disputed domain name reverts leads to a website on anonymous erotic encounters. This has obviously nothing to do with the products and services covered by the Claimant’s trademarks; however, the case needs to be examined from the point of view of the protection offered by other rights.

Indeed, the holder of a valid trademark or company name may seek cumulative protection under the UCA. Such holder may in particular seek specific protection under the UCA when the behavior in question is covered by the specific purposes and scope of the UCA. Under Article 3 lit. d) of the UCA, anyone taking measures aimed at causing confusion with products, works, services or enterprise of a product or service provider, is acting unfairly.

The Respondent is not a representative of the Claimant. The Claimant faces disadvantages as it cannot use the disputed domain name to market its products and services under the corresponding trademark. By registering the disputed domain name, which is almost identical to the Claimant’s International and Swiss trademark registrations, the Respondent has created a likelihood of confusion for Internet users between the Claimant’s products and services and the disputed domain name. It is apparent that the Respondent is trying to take advantage of the Claimant’s goodwill and brand recognition. Hence, the Respondent’s behavior violates the Claimant’s right in a distinctive sign under Article 3 lit. d) UCA.

Moreover, the Expert considers that the Respondent’s conduct aiming at using the Claimant’s distinctive sign for erotic material exploiting thereby the reputation of the Claimant’s trademark is unfair and unlawful within the meaning of Article 2 UCA.

Hence, the Respondent’s infringement of the Claimant’s trademark rights under Articles 2 and 3 lit. d) UCA clearly suffices and justifies the transfer of the disputed domain name to the Claimant.

The Respondent has not submitted a response to the Claimant’s Request. The Expert finds that the Claimant has thus met its burden of proof under the Rules, paragraph 24(d) (ii) and (iii).

## 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, <tmhinternational.ch>, be transferred to the Claimant.

*/Daniel Kraus/*

**Daniel Kraus**

Expert

Dated: September 19, 2023