

EXPERT DECISION

Carify AG v. Y.F.

Case No. DCH2024-0005

1. The Parties

The Claimant is Carify AG, of Switzerland, represented internally.

The Respondent is Y.F., of Switzerland, represented by sigma legal SA, Geneva.

2. The Domain Name

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

3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 1, 2024. On July 3, 2024, 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 4, 2024, SWITCH transmitted by email to the Center its verification response, disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Unknown) and contact information in the Request.

In response to an invitation to amend by the Center, the Claimant filed an amended Request on July 17, 2024. The Center verified that the Request, together with the 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 July 18, 2024. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was August 7, 2024.

The Respondent filed a Response on August 7, 2024. No Conciliation conference has taken place within the deadline specified in paragraph 17(b) of the Rules of Procedure.

On August 14, 2024, 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 Swiss company founded in 2019. It is headquartered in Härkingen, Switzerland, and provides car subscriptions over its platform “www.carify.com”.

The Claimant owns the Swiss trademark registration no. 748874 for the word mark CARIFY in classes 12, 35 and 36 which was filed on January 26, 2020, and registered on June 29, 2020.

The disputed domain name was registered on April 13, 2018.

According to the evidence submitted with the Request, the disputed domain name is being redirected to a car sharing provider of which the Respondent has sole signature rights and is the economic beneficiary.

5. Parties' Contentions

A. The Claimant

The Claimant contends that it is the owner of the trademark CARIFY in Switzerland and that by using the disputed domain name to offer car sharing services that compete with the Claimant's services, the Respondent infringes such trademark rights and violates Art. 3 of the Swiss Unfair Competition Act (“UCA”).

B. The Respondent

The Respondent contends in essence that the trademark CARIFY is descriptive for the claimed products and services and is therefore invalid, and even if it were valid, it would be a weak trademark with a narrow scope of protection. As a consequence, there is no similarity between the products and services for which this trademark is registered and those for which the disputed domain name is used. There is no likelihood of confusion because the landing page associated to the disputed domain name states that it belongs to 2EM Car Sharing Sàrl.

The Respondent further contends that the disputed domain name was registered almost two years before Claimant's trademark CARIFY was filed, and more than one year before Claimant was registered. The Respondent contends that it started using the disputed domain name immediately after its registration, i.e. even before the Complainant's trademark was filed. Therefore, the Respondent in any event benefits from the right to continue prior use of this distinctive sign (Art. 14 Swiss Trademark Act, “STA”).

The Respondent contends that in the absence of prior rights in a distinctive sign and of a likelihood of confusion there is no violation of unfair competition law either.

The Respondent also submitted copies of emails it received from the Claimant in 2020, in which the Claimant did not complain about infringement of its rights, but sought to purchase the disputed domain name.

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 defence; 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 shown, that its Swiss trademark CARIFY, which was filed on January 26, 2020, has been registered on June 29, 2020. The Respondent alleges that this trademark is descriptive and therefore invalid. The Expert finds that this trademark is sufficiently distinctive for the goods and services claimed because the term CARIFY does not have a dictionary meaning in any of the Swiss official languages or English describing the claimed goods or services. Indeed, the Swiss Institute for Intellectual Property, after having conducted an examination on absolute grounds, registered this trademark.

Accordingly, the Claimant has provided sufficient evidence of rights in distinctive signs 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

The Claimant's Swiss trademark CARIFY was filed on January 26, 2020, and has been registered on June 29, 2020, i.e. after the disputed domain name was registered on April 13, 2018. According to Art. 14 para. 1 STA, the proprietor of a trademark may not prohibit another person from continuing to use a sign to the same extent as already previously used prior to the filing of a trademark application. Therefore, because in the present case the disputed domain name was registered before the filing date of the Claimant's trademark, the Expert concludes that the allocation or use of the disputed domain name does not constitute a clear infringement of the Claimant's trademark CARIFY under the Swiss Trademark Act.

The Claimant further invokes a violation of Swiss unfair competition law. Art. 3 para. 1 lit d UCA confers protection to unregistered distinctive signs against confusingly similar signs. This protection is based on priority of use (see e.g. Marbach/Ducrey/Wild, Immaterialgüter- und Wettbewerbsrecht, 4th ed., p. 265). In the present case, the disputed domain name was registered almost two years before Claimant's trademark CARIFY was filed, and more than one year before Claimant was established as a company. In the absence of the Claimant's priority of use, the allocation or use of the disputed domain name does not constitute a clear infringement of the sign CARIFY under Swiss unfair competition law.

The Expert therefore concludes that the allocation or use of the disputed domain name does not constitute a clear infringement of a right in a distinctive sign which the Claimant owns under the law of Switzerland.

7. Expert Decision

For the above reasons, the Request is denied.

Andrea Mondini

Expert

Dated: August 22, 2024