

EXPERT DECISION

Universal Genève S.A v. Aris Merlo, Innocenti S.A.
Case No. DCH2024-0015

1. The Parties

The Claimant is Universal Genève S.A, of Switzerland, represented by IP Twins, France.

The Respondent is Aris Merlo, Innocenti S.A., of Switzerland, self represented.

2. The Domain Name

The dispute concerns the following disputed domain name <universalgeneve.ch>.

3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 25, 2024. On October 25, 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 October 28, 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. The Center sent an email communication to the Claimant on October 28, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Claimant to submit an amendment to the Request. The Claimant filed an amended Request on October 31, 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 November 1, 2024. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was November 21, 2024.

The Respondent was not willing to participate in a conciliation. Accordingly, no Conciliation conference has taken place within the deadline specified in paragraph 17(b) of the Rules of Procedure.

The Response was filed on November 21, 2024 by the Respondent. The supplemental filings were filed by the Claimant on November 22, and November 28, 2024, and filed by the Respondent on November 22, November 28, and November 29, 2024, respectively. The Panel decided to accept all the supplemental filings from both Parties.

On December 5, 2024, 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 Claimant, created 1894 in Switzerland, is a worldwide and historical company in the sector of luxury watches. The Claimant markets its products via its main website “www.universalgeneve.com” (which was first registered in 2004). The Claimant has been acquired by Breitling in 2023 and is currently launching new products.

The Claimant is the owner of numerous UNIVERSAL GENEVE trademark registrations worldwide going back to 1938, including the Swiss trademark registration No. 724157, registered on November 21, 2018 for products and services in international classes 9 and 14.

The Respondent is the producer of the well-known Italian scooters Lambretta. The trademark LAMBRETТА is also registered in international class 14 which designates watches. The disputed domain name was registered on December 27, 2017, and the related website has been inactive since then.

5. Parties' Contentions

A. The Claimant

The Claimant alleges that the Respondent is breaching the Claimant's rights under Swiss trademark law and that, under Swiss unfair competition law, the registration of a domain name identical to a protected trademark may be illegitimate even if such domain name is not used in connection with an active website, if the circumstances denote an unfair intent by the registrant.

Therefore, the Claimant contends that the Respondent has clearly violated (i) Article 3(1)(c) in connection with Article 13(1) and (2) of the Swiss Trademark Act (TMA) and (ii) Article 2 of the Swiss Unfair Competition Act (UCA).

B. The Respondent

The Respondent argues that the Claimant has been a dormant company for approximately 20 years with no operational activities. The Respondent alleges that it intended to use the disputed domain name for legitimate purposes, such as creating an educational or historical website.

The Expert notes that the Respondent may have used AI to prepare its response. This Expert does not need to determine whether Respondent actually used AI to submit its response, nor more generally to address whether it is admissible for respondents to use AI to submit their responses. However, and irrespective of whether the Response was generated using AI or not, the Expert has observed that all cited cases (including WIPO cases) in the response refer to non-existent cases, and this cannot be tolerated. Additionally, the Expert notes that the lengthy 48-page Response contains countless arguments, many of which are irrelevant and lack merit. The Expert also notes the Response refers to the UDRP instead of referring to the .CH Rules of Procedure. Accordingly, the Expert has chosen to summarize and address only the arguments that are pertinent to this case.

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 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 and international trademark registrations for its UNIVERSAL GENEVE trademarks.

Due to the use of its UNIVERSAL GENEVE trademark 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

(a) Swiss Trademark Act

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) TMA).

According to prevailing doctrine and case law, the mere registration of a domain name without actual use is not in itself considered to be a use infringing the trademark right within the meaning of Art. 13 TMA (judgment of the Federal Supreme Court of November 8, 2004, 4C.31 /2004, cons. 4.2, <riesen.ch>; judgment of the District Court Bern-Laupen of March 15, 1999, cons. 7.1, in sic! 1/2000 p. 24-25, <artprotect.ch>; Alberini/Guillet, L'incidence du contenu du site Internet dans les litiges en matière de noms de domaine, sic! 2012 305, p. 313; Rolf H. Weber, E-Commerce und Recht, Rechtliche Rahmenbedingungen elektronischer Geschäftsformen, 2nd ed, Zurich 2010, p. 137; Thouvenin/Dorigo, in: Noth/Bühler/Thouvenin [eds.], SHK Markenschutzgesetz, Bern 2009, Art. 13 N 50).

This is also recognized in practice in “.ch” and “.li” dispute resolution proceedings (*Cartier International S.A. v. Marc Baertschi*, WIPO Proceedings No. [DLI2015-0001](#), <cartier.li>; *Tropicana Products, Inc. v. Christian Hohnbaum*, WIPO Procedure No. [DCH2011-0013](#), <tropicana.ch>; *Feldschlösschen Getränke Holding AG v. John De Souza*, WIPO Procedure No. [DCH2004-0012](#), <rhäzünser.ch>; *Bewital Holding GmbH & Co. KG v. Roman Willi*, WIPO Procedure No. [DCH2018-0008](#), <belcando.ch>).

Furthermore, the doctrine is of the opinion that, in the case of domain names leading to inactive websites, an imminent infringement of trademark rights can be sanctioned in the sense of a prohibition pursuant to Art. 55(1)(a) TMA (see Mark Schweizer, 5 Jahre SWITCH-Streitbeilegungsverfahren: Fair.ch?, AJP 8/2009 971, pp. 982-985; *Freecom Technologies GmbH v. Urs Frei*, WIPO Proceedings No. [DCH2007-0012](#); *The Toro Company v. Toro User Club*, WIPO Proceedings No. [DCH2004-0014](#)). It should be noted, however, that only acts that are directly threatening can be the subject of a corresponding request, as merely hypothetical disruptions cannot be prevented with an action for injunctive relief (Roger Staub, in: Noth/Bühler/Thouvenin [eds.], SHK Markenschutzgesetz, Bern 2009, Art. 55 N 34; BSK MSchG-David, Art. 55 N 12). In the present case, the disputed domain name has already been registered for almost seven years without any concrete preparations for trademark infringements being apparent or having been presented by the Claimant. An application of 55(1)(a) TMA therefore does not appear appropriate.

(b) Unfair Competition Act

Domain names are also subject to the fairness requirement under competition law (BGE 128 III 353 E. 4). According to Art. 3(1)(d) UCA, anyone who “takes measures which are likely to cause confusion with the goods, works, services or business operations of another” is acting unfairly. Pursuant to the general clause of Art. 2 UCA, “any conduct or business practice which is deceptive or otherwise contrary to the principle of good faith and which affects the relationship between competitors or between suppliers and customers” is also unfair and unlawful.

According to prevailing doctrine and case law, the mere registration of a domain name does not create a likelihood of confusion within the meaning of Art. 3(1)(d) UCA, as there is no risk of operational misallocation (judgment Commercial Court St. Gallen of June 25, 2002, sic! 2003 348, p. 351 cons. III/3c, <breco.ch>; BSK UWG-Arpagaus, Art. 3 para. 1 lit. d N 198-199; see also *Cartier International S.A. v. Marc Baertschi*, WIPO Proceedings No. [DLI2015-0001](#)). A contrary position is taken by Alberini/Guillet (loc. cit., p. 313-314 para. 4), who also affirm a likelihood of confusion in the case of inactive domain names on the basis of the mere wording of a domain name. However, it is doubtful that entering an inactive domain name in the address bar of a browser with a subsequent error message is actually capable of creating a likelihood of confusion with another party’s products within the meaning of Art. 3(1)(d) UCA (see Mark Schweizer, 5 Jahre SWITCH-Streitbeilegungsverfahren: Fair.ch?, AJP 8/2009 971, p. 983).

Nevertheless, the doctrine (analogous to trademark law) is prepared to recognize an infringement of Art. 3(1)(d) UCA if concrete measures for the use of a domain name are proven. The intention to use must be demonstrated on the basis of other facts, such as corresponding statements by the owner or preparatory acts (BSK UWG-Arpagaus, Art. 3 para. 1 lit. d N 199). In the present case, however, there are no concrete indications of an intention to use in the present case but only general statements without evidence by the Respondent that the disputed domain name might be used to create an educational or historical website.

In any event, the registration of a specific domain name may constitute an unfair impediment within the meaning of Art. 2 UCA if the registration is intended to exploit the reputation of another’s trademark or if it is made without objectively protectable interests and thus clearly to the detriment of third parties (Rolf H. Weber, E-Commerce und Recht, Rechtliche Rahmenbedingungen elektronischer Geschäftsformen, 2nd ed, Zurich 2010, p. 159; BSK UWG-Arpagaus, Art. 3 para. 1 lit. d N 199; see also *Cartier International S.A. v. Marc Baertschi*, WIPO Proceedings No. [DLI2015-0001](#)).

In the present case, the Respondent has held the disputed domain name since 2017, without posting any content under it. By blocking the disputed domain name for almost seven years, the Claimant is prevented by the Respondent from operating its own domain name in Switzerland under the ccTLD “.ch” and from marketing its products via the corresponding website. It also cannot be ruled out that the Respondent wishes to profit in some way from the reputation of the Claimant’s well-known trademark, for example by selling the disputed domain name to the Claimant or to another interested party for a profit. In view of these circumstances, the Expert is of the opinion that the registration of the disputed domain name was made without a recognizable interest of the Respondent worthy of protection and thus with unfair intent.

The conduct of the Respondent thus clearly violates Art. 2 UCA.

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 <universalgeneve.ch> be transferred to the Claimant.

/Tobias Zuberbühler/

Tobias Zuberbühler

Expert

Dated: December 18, 2024