

EXPERT DECISION

Fashion Nova, LLC v. GoldDay Corporation, R. S.
Case No. DCH2022-0020

1. The Parties

The Claimant is Fashion Nova, LLC, of United States of America (“United States”), represented by Ferdinand IP, LLC, United States.

The Respondent is GoldDay Corporation, R. S., of the United States.

2. The Domain Name.

The dispute concerns the following domain name <fashionnova.ch>.

3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 30, 2022. On January 3, 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 January 4, 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 Claimant filed an amended Request on January 10, 2023. 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 January 11, 2023. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was January 31, 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 February 7, 2023, the Center notified the Claimant accordingly, who on February 14, 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 February 27, 2022 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.

3. Factual Background

The Complainant is a company incorporated in the United States founded in 2006 that operates a fashion business in retail stores and online. The Complainant holds a Swiss national trademark FASHIONNOVA, Reg. No. 787533, registered on October 5, 2022, in Classes 9, 14, 18, and 25, and other International Registrations designating Switzerland, *inter alia*:

- FASHION NOVA, Reg. No. 1350364, registered on April 3, 2017, in Class 35;
- FASHION NOVA, Reg. No. 1351799, registered on April 17, 2017, in Class 25

The Claimant further holds the domain name <fashionnova.com> under which its official website is available. The Claimant advertises and sells its services through its <fashionnova.com> domain name.

The disputed domain name was registered on November 17, 2017, and resolves to a pay-per-click (“PPC”) website for which information about the purchase of the disputed domain name can be inquired.

4. Parties’ Contentions

A. The Claimant

The Claimant is the owner of the FASHION NOVA mark in various countries, including Switzerland. The disputed domain name is confusingly similar to the Claimant’s trademark. The Respondent’s allocation and use of the disputed domain name is a violation of trademark law, right to name, and unfair competition under Swiss law. The Claimant alleges that it has satisfied all elements of paragraph 24 of the Rules of Procedure.

B. The Respondent

The Respondent did not reply 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 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 law of Switzerland

As outlined above, the Claimant owns various trademark registrations designating Switzerland for its trademark FASHION NOVA. Due to the use of its trademark FASHION NOVA in business transactions, the Claimant can also invoke the unfair competition use of its protected sign under the Swiss Unfair Competition Act.

Thus, the Expert holds that the Claimant established its Right in a distinctive sign in Switzerland.

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 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 is identical to the Claimant's trademark. The disputed domain name resolves to a PPC website with links to identical and/or similar products offered by competitors which creates a likelihood of confusion with the Claimant's trademark. This commercial use is therefore affirmed and a likelihood of confusion is given between the disputed domain name and the Claimant's trademark, resulting in an infringement of the Claimant's trademark in accordance with Art. 13 (2) b) of the Swiss Trademark Act.

Based on the facts of the case, the Expert additionally has no doubt that the disputed domain name was registered by the Respondent to merely prevent the Claimant from using the disputed domain name, which, as a result, suffered an impairment of its economic interests. The Respondent's behavior shows the typical pattern of cybersquatting. Such behavior constitutes bad faith and can be qualified as unfair and in breach of Art. 2 (1) of the Swiss Unfair Competition Act. The Respondent did not provide any reasonable explanation why he registered the disputed domain name and to the Expert's best knowledge, no such grounds can be seen. On the other hand, the registration of the disputed domain name puts the Claimant at a considerable disadvantage: the disputed domain name cannot be used by the Claimant to offer its services via this domain name. 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 disputed domain name <fashionnova.ch> be transferred to the Claimant.

Daniel Kraus

Expert

Date: March 13, 2023