

ADMINISTRATIVE PANEL DECISION

Victorinox AG v. Donald McCulloch
Case No. D2023-1977

1. The Parties

The Complainant is Victorinox AG, Switzerland, represented by Kellerhals Carrard, Switzerland.

The Respondent is Donald McCulloch, Japan.

2. The Domain Name and Registrar

The disputed domain name <victorinox-abuse.org> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 3, 2023. On May 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 5, 2023, the Registrar 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 8, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on May 24, 2023.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 2, 2023. The Response was filed with the Center on May 23, 2023.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on July 17, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a public joint-stock company incorporated under Swiss law. It is known internationally as “Victorinox”. The Complainant has been the maker of the Swiss Army knife since 1884, which remains its core product. The Complainant is the owner of the VICTORINOX trademark, registered in multiple countries worldwide. For example, the Complainant is the owner of Swiss Registered Trademark Number 486100 for the word mark VICTORINOX, registered on June 21, 2001, in Classes 8, 9, 10, 14, 18, 21, 25, and 28.

The disputed domain name was registered on March 3, 2023. The website associated with the disputed domain name features a logo including a Swiss Army knife design which also states “STOP VICTORINOX” / “VIOLENCE AGAINST WOMEN”. Underneath the logo is noted “Welcome to Education Matters”.

The factual background in this case is complex and convoluted, such that it is not practical to set out every aspect here. However, in essence, the Complainant’s real estate management company is the owner of a building in Tokyo, Japan. A school with which the Respondent appears to be associated¹ tenanted part of that building for a number of years. The landlord and tenant relationship did not progress smoothly. The rent was said to be in arrears at one point and a penalty charge was also applied. Legal proceedings were instituted. The lease contract was said to have come to an end, although the tenant remained in occupation and continued to make payments. At some point, a dispute arose as to whether the payments made by the tenant constituted the payment of rent or of penalties after the alleged termination of the contract of lease. Further payments were withheld. This dispute culminated in eviction of the school and its personnel from the building concerned.

The Respondent and those associated with it are particularly aggrieved by the fact that the eviction allegedly took place during a day in which the school was in operation. The Respondent asserts that persons connected with the school were injured during the eviction. Additional allegations are made surrounding an earlier attempted eviction. An associated criminal complaint is said to have been made against officers of the Complainant, a translated copy of which has been supplied by the Respondent, which is dated February 23, 2023.

On April 9, 2023, a group calling itself “Kellerhals Carrard & Victorinox Violence Against Women Victims Supporters” wrote to the Complainant’s representatives inviting them to review the materials on the website associated with the disputed domain name. The letter went on to set out six “Parents’ Conditions”, including reversing the eviction and paying a CHF 10 million non-refundable amount for “family’s damages” commencing with a CHF 1 million “non-refundable deposit”. A further two “School & Staff Conditions” were set out, including the payment of CHF 100 million to compensate for “damages and trauma suffered by the school and its staff”. In return for fulfilment of the conditions, the letter noted that “the school and victims will cease all public legal cases worldwide and any media and social media campaign and protests”, and that the school would attempt to persuade the parents of the school pupils to do likewise.

It appears to the Panel that the website at the disputed domain name has been published on behalf of those persons behind the allegations of injury during the eviction and/or attempted eviction. Their asserted intent is to bring attention to the allegations concerned along with their various demands for restitution.

Each of the Parties has alleged that the other Party is or has been engaged in attempted extortion against the other.

¹ The Panel is not certain of the exact relationship between the school and the Respondent, although the Respondent’s name is on an email dated June 9, 2021, issued on behalf of the school to a member of staff at the Complainant, and the Panel therefore assumes that the Respondent and the school are associated/affiliated with one another.

5. Parties' Contentions

A. Complainant

In summary, the Complainant contends as follows:

Identical or confusingly similar

The disputed domain name is extremely similar to the Complainant's trademark, and the "victorinox" element is identical. The additional element "abuse" is merely descriptive and does not exclude similarity. A domain name consisting of a trademark and a negative or pejorative term (in the present case "abuse") is considered confusingly similar to the trademark for the purpose of satisfying standing under the first element. The applicable Top Level Domain, in the present case, ".org", is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Rights and legitimate interests

The Respondent does not own any trademarks rights regarding the term "victorinox", and has never been known by, nor has acted under the disputed domain name prior to registering it. The Complainant is undoubtedly linked and has been connected with the VICTORINOX mark and company name for almost 140 years.

Incorporation of a well-known trademark and company name in a domain name cannot be considered fair use such as noncommercial free speech. The disputed domain name comprises the Complainant's mark plus a derogatory term not for criticism but rather for systematic disparagement in an extortionate manner, to demand a donation of a property, and a payment of USD 100 million, otherwise the Respondent will not cease any and all media and social media campaign and protests. The disputed domain name is plainly designed to create an allegedly extortionate and disparaging media campaign.

Registered and used in bad faith

The Respondent knew or should have known of the Complainant's well-known and globally present trademarks. The registration of a domain name incorporating a well-known trademark can constitute bad faith, since it is unlikely that the registrant was unaware of the established rights in the mark at the time the disputed domain name was registered. It must be assumed that the Respondent intentionally attempted to attract Internet users to its website for commercial gain insofar as the disputed domain name is plainly designed to create an allegedly extortionate and disparaging media campaign.

The circumstances in which privacy and proxy registration services are used, including whether the Respondent is operating a trademark-abusive website, can impact a panel's assessment of bad faith. Where it appears that a respondent employs a privacy or proxy service merely to avoid being notified of a UDRP proceeding filed against it, panels tend to find that this supports an inference of bad faith. The provision of false contact information underlying a privacy or proxy service may be viewed as an indication of bad faith, as may be the use of a privacy or proxy service which is known to block or intentionally delay disclosure of the identity of the actual underlying registrant.

B. Respondent

In summary, the Respondent contends as follows:

General

The Respondent was asked to create the disputed domain name by the victims of violence, the parents of children of the school, and volunteer supporters, against the wrongful acts of the Complainant. The victims have received threats from the Complainant to stay silent. The Respondent has informed the Complainant

that it must return the children to the school building and pay damages instead of silencing and threatening the victims.

Identical or confusingly similar

The Complainant's trademark registrations are focused on certain product categories and are not related to the Respondent's campaign-related classes.

The disputed domain name is registered and is being used in good faith

The disputed domain name protests against the alleged actions of the Complainant involving an unethical real estate contract, a claim for penalty fees in place of rent, and violence caused during an eviction ordered by the Complainant which proceeded without warning. Five victims were injured and have suffered trauma. They have received hospital care and were unable to return to work. Having remained quiet to recover, the victims have gathered to stand up to the Complainant's wrongful acts. In February 2023, the victims started raising their voices and contacted worldwide women's groups and education organizations to come forward to support. The school was asked to create the disputed domain name to raise awareness and to start the social protest campaign against the Complainant. It is society's responsibility to monitor, raise awareness and take action to eliminate wrongdoing.

The disputed domain name is transparent and the associated website provides clear evidence for the allegations.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The assessment under the first element of the Policy usually proceeds in two steps. First, the Complainant must demonstrate that it has UDRP-relevant rights in a trademark, whether registered or unregistered. Secondly, any such trademark undergoes a comparison exercise with the disputed domain name, usually on a straightforward side-by-side basis, typically disregarding the Top-Level Domain on the basis that it is a technical requirement of registration. The aim of the comparison process is to assess whether the trademark is recognizable in the disputed domain name, in which case confusing similarity will generally be found, or whether they are alphanumerically identical, in which case identity will usually be found.

In the present case, the Complainant has demonstrated that it has UDRP-relevant rights in its VICTORINOX registered trademark as described in the factual background section above. Comparing this to the Second-Level Domain of the disputed domain name, it may be seen that the mark is reproduced in its entirety, followed by a hyphen and the word "abuse". Neither the hyphen, which acts here as a separator, nor the presence of an additional word along with the Complainant's trademark, whether or not that word is considered pejorative, would prevent a finding of confusing similarity (on the topic of such additional terms, including pejorative words or expressions, see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

The Respondent asserts that its activities relate to a different trademark use class from the Complainant's trademark. However, issues such as the Respondent's alleged intent to provide its own legitimate offering of goods or services, without trading off the Complainant's reputation, would be decided under the second and third elements of the Policy (see section 1.7 of the [WIPO Overview 3.0](#)).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights and that the Complainant has carried its burden with regard to the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists several ways in which the Respondent may demonstrate rights or legitimate interests in the disputed domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

The Complainant asserts that it is able to show a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, noting that the Respondent owns no corresponding trademarks and has not been known by the disputed domain name before it was registered. The Complainant also asserts that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name but rather is engaging in "systematic disparagement" in order to obtain a payment and the donation of a property under the threat of a continued media campaign. The Panel considers that this is sufficient to constitute the requisite *prima facie* case.

Once such a *prima facie* case is made out, the burden of production shifts to the respondent to bring forward appropriate submissions and/or evidence demonstrating its rights or legitimate interests in the domain name concerned (see section 2.1 of the [WIPO Overview 3.0](#)). The Respondent's case centers on its contention that it is making a legitimate noncommercial or fair use of the disputed domain name, in the exercise of free speech, in order to criticize certain actions of the Complainant, and to demand redress publicly.

Both of the Parties appear to accept the general principle that the use of a domain name for noncommercial free speech can support a legitimate interest under the Policy (see, for example, section 2.6 of the [WIPO Overview 3.0](#)). As noted in that section, in order to support such fair use, the respondent's criticism must be genuine and noncommercial and not primarily a pretext for cybersquatting, commercial activity, or tarnishment. Where the domain name concerned is not identical to the complainant's trademark but comprises the mark plus a derogatory term (e.g., "<trademarksucks.tld") panels tend to find that the respondent has a legitimate interest in using the trademark as part of the domain name of a criticism site if such use is *prima facie* noncommercial, genuinely fair, and not misleading or false.

Here, the composition of the disputed domain name contains the Complainant's mark with the word "abuse", a term that the Complainant would be unlikely to use in order to describe itself. Thus the disputed domain name signals to an Internet user that there is likely to be material that is critical of the Complainant on the associated website.

Turning to the Respondent's website content, insofar as that has been presented by the Complainant in a restricted screenshot, the Panel notes that there does not appear to be any commercial activity (this is confirmed by a visit by the Panel to the site in question). Nor does there appear to be tarnishment as it is generally understood within the framework of the Policy, namely associating the mark with unrelated unwholesome activities (an example often cited is deliberately linking a mark to pornographic content where there is no reasonable basis for any such association). This leaves the question as to whether the Respondent's activities are genuine or merely a pretext for cybersquatting.

In the present case, the Panel observes that the Parties have a long history of relations which culminated in a dispute that itself predates the registration of the disputed domain name to a considerable extent. The Respondent evidently has a grievance against the Complainant based around the manner in which the school with which the Respondent is associated was evicted from the Complainant's building. It is this that the Respondent seeks to articulate by way of the website to which the disputed domain name points. The Complainant effectively argues that the Respondent's criticism goes beyond genuine noncommercial or fair use because the Respondent's demands indicate that it is engaging in extortion and is threatening the Complainant with a continued media campaign unless these demands are met, including the payment of a substantial sum of money.

In cases of this particular variety, involving alleged noncommercial criticism and issues of freedom of speech, the question of whether an act of one of the Parties might be defamatory, for example, is not something that the Panel is in a position to assess, albeit that this would typically trigger an assessment as to whether the criticism is pretextual. As this Panel recently observed (see, *ICC Intercertus Capital Ltd. v. Domain Administrator*, See *PrivacyGuardian.org / Mag. Bernhard Dostal, Karin West*, WIPO Case No. [D2021-1789](#) under reference to *Chesterfield Valley Investors, L.L.A dba Gateway Classic Cars of St. Louis v. Brock Winters*, WIPO Case No. [D2019-1380](#)) the Policy is neither a substitute for a criminal complaint to the relevant authorities, nor a substitute for an action of defamation, either of which may be a course of action that is open to the Complainant. Rather, the job of the Panel in such a case (absent any issue of impersonation via the domain name concerned, which would not be permitted) is to determine whether the alleged noncommercial criticism (which may in part be based on opinion, and which may therefore be subject to disagreement between the parties) is genuine, in the sense of being "genuinely intended to criticize" rather than being merely a pretext for abusive cybersquatting.

Here, the history of the Parties' relations and dispute, which itself is independent of and long predates the registration of the disputed domain name, suggests that the Respondent's criticism of the Complainant is not merely a pretext for extortion or cybersquatting. The Respondent appears to hold a genuine belief that it, and those whom it represents, have been wronged by the Complainant and/or by the Complainant's representatives. As far as the Panel can tell from the Response and related annexes, which include a criminal complaint that the Respondent or one of its associates appears to have prepared for submission to the authorities, and a pre-action letter issued by an attorney in the United States of America, the Respondent itself believes that what it says is truthful and well-founded.

The Panel has greater difficulty in determining whether the Respondent's belief could be said to be reasonably held (see item (ii) in section 2.5.2 of the [WIPO Overview 3.0](#)) as this would require a full analysis of the Parties' landlord/tenant relationship, which is beyond the scope of this proceeding. For present purposes, the Panel considers that it need go no further than to note that it is satisfied that the Respondent appears to be attempting to engage in the exercise of free speech, and that the disputed domain name and associated website content therefore support the claimed fair use. There is no apparent pretext for commercial gain or other purposes inhering to the Respondent's benefit that are obvious to the Panel (noting that the Panel is not in any position to assess whether the Respondent's particular demands for financial redress in respect of perceived wrongs are reasonable in the circumstances). It is conceivable that the Respondent's activities might be curtailed by aspects of the civil or criminal law in whole or in part but the Complainant will need to explore those matters in other *fora* or with the competent authorities. In that context, the Panel notes that the present Decision does not seek to endorse or condone the alleged actions of either of the Parties, and it is not addressed to the attention of any other forum that may ultimately be seized of the matter.

In all of these circumstances, the Panel finds that the Complainant has failed to carry its burden in terms of the requirements of paragraph 4(a)(ii) of the Policy. The Complaint therefore fails.

C. Registered and Used in Bad Faith

As the Complaint has failed on the second element analysis, it is not strictly necessary to address the third element of the Policy. However, the Panel notes for completeness that the assessment of the second and third elements in this case are linked in the sense that if, as here, a panel finds that a respondent is engaging in fair use of a domain name for the purposes of genuine noncommercial criticism, and not as a pretext for cybersquatting or deceptively to impersonate the trademark owner, it would be reasonable to infer that a domain name registered for that purpose was more probably than not registered in good faith rather than in bad faith. It would also be reasonable to infer that a domain name used for that purpose was more probably than not being used in good faith.

The Panel notes the use of a privacy service in respect of the Whois details for the disputed domain name, as discussed in the Complainant's submissions. There is no evidence that the Respondent has made use of this service in order deliberately to conceal its identity with a view to delaying the proceedings, or avoiding the thrust of the Policy more generally. On the contrary, the Respondent came forward with its Response even before the date of commencement of the proceedings. There is likewise no evidence before the Panel that the underlying contact details supplied by the Respondent are false.

In all of these circumstances, the Panel finds that the Complainant has failed to carry its burden in terms of the requirements of paragraph 4(a)(iii) of the Policy, and the Complaint therefore fails on the third element analysis.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: July 31, 2023