

ADMINISTRATIVE PANEL DECISION

VICTORINOX AG V. JOVINCENT ERIX

CASE NO. D2024-1562

1. The Parties

The Complainant is Victorinox AG, Switzerland, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Jovinent Erix, Cambodia.

2. The Domain Name and Registrar

The disputed domain name <swissarmyindonesia.com> 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 April 12, 2024. On April 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (Registration Private, Domains By Proxy, LLC DomainsByProxy.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 19, 2024, 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 amended Complaint on April 20, 2024.

The Center verified that the Complaint together with the amended 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 April 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 13, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 14, 2024.

The Center appointed Miguel B. O'Farrell as the sole panelist in this matter on May 23, 2024. 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, Victorinox AG, is a worldwide operating family business with its headquarter in Ibach, Switzerland. The founder of the company Karl Elsner set up a cutlery business in 1884 and, a few years later, designed the iconic original Swiss Army Knife. In addition to the world-famous pocketknives, the Complainant produces household and professional knives, watches, travel gear and fragrances. The Complainant's products are available online, in own stores and through subsidiaries and distributors in more than 120 countries.

The Complainant owns trademark registrations for SWISS ARMY in several jurisdictions, including the following:

- Cambodia Trademark Registration No. KH/1995/5426 SWISS ARMY, registered on January 7, 1995, in class 14;
- International Trademark Registration No.691820A SWISS ARMY, registered on August 20, 1997 in class 8;
- United Kingdom Trademark Registration No.UK00002043590 SWISS ARMY, registered on October 29, 1999, in class 8; and
- United States of America Trademark Registration No.2806013 SWISS ARMY, registered on January 20, 2004, in class 8.

In addition, the Complainant has operated from its websites "www.victorinox.com" since November 6, 1998 and "www.swissarmy.com" since February 28, 1997.

The disputed domain name <swissarmyindonesia.com> was registered on November 5, 2022, and at the time of filing the Complaint, it resolved to a blog-style webpage in Indonesian with information about watches, including the Complainant's watches and watches of its alleged competitor's.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends the SWISS ARMY trademark with 140 years of history is one of the most recognized brands in the world.

The Complainant distributes its products under the SWISS ARMY trademark in Indonesia since 1958, which is well before the Respondent registered the disputed domain name.

The Respondent is not affiliated with the Complainant in any way and has not been authorized by the Complainant to use the Complainant's trademark in any manner.

The Respondent has registered and uses the disputed domain name to create confusion to Internet users and thereby derive traffic to its own website for commercial gain.

Finally, the Complainant requests the Panel to issue a decision ordering that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with 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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "Indonesian" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The ".com" generic Top-Level Domain ("gTLD") is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11.1 of [WIPO Overview 3.0](#).

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of

proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Panel is satisfied that the Respondent must have been aware of the Complainant's trademark SWISS ARMY mentioned in section 4 above (Factual Background) when it registered the disputed domain name on November 5, 2022. By that time, the Complainant had long ago registered and intensely used the trademark SWISS ARMY including in Cambodia.

The Panel also finds that by registering the disputed domain name which includes the Complainant's trademark SWISS ARMY in its entirety the Respondent was targeting the Complainant and its business. The addition of the geographical term "indonesia" only contributes to confuse Internet users and leads them to think that the Respondent's website belongs to or is endorsed by the Complainant with the intention to capitalize on the fame of the Complainant's trademark for its own benefit.

Further, the fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name, the nature of the disputed domain name, and the use of the disputed domain name to resolve to a blog-style website for watches including Complainant's and its alleged competitor watches, are indicative of bad faith (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)). The Panel finds that the Respondent registered and is using the disputed domain name in bad faith.

The Panel finds that the requirements of paragraph 4(a)(iii) of the Policy have been fulfilled.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <swissarmyindonesia.com> be transferred to the Complainant.

/Miguel B. O'Farrell/

Miguel B. O'Farrell

Sole Panelist

May 25, 2024