

## **ADMINISTRATIVE PANEL DECISION**

Victorinox AG v. liu lili  
Case No. D2024-1564

### **1. The Parties**

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

The Respondent is liu lili, China.

### **2. The Domain Name and Registrar**

The disputed domain name <swissarmyknivesonlinestore.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English 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 April 16, 2024, 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 (Redacted for privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 17, 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 in English on April 17, 2024.

On April 17, 2024, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the disputed domain name is Chinese. On the same day, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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 in Chinese and English 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 Douglas Clark as the sole panelist in this matter on May 17, 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 is a worldwide operating family business, headquartered in Ibach, Switzerland. It produces five categories of products: (i) pocketknives, (ii) household and professional knives, (iii) watches, (iv) travel gear and (v) fragrance items.

By virtue of its acquisitions of Swiss Army Brand, Inc. (SABI) in 2002 and Wenger SA (“Wenger”) in 2005, the Complainant now owns the SWISS ARMY trademark originally registered in the name of Swiss Army Brand Ltd., a wholly owned subsidiary of SABI and variations of the SWISS ARMY KNIFE trademark originally registered in the name of Wenger.

The Complainant owns trademark registrations for SWISS ARMY and SWISS ARMY KNIFE across various jurisdictions, registered with the China National Intellectual Property Administration (“CNIPA”), the United States of America (“US”) Patent and Trademark Office (“USPTO”) and World Intellectual Property Organization (“WIPO”). These trademark registrations are set out as follows:

Trademark	Jurisdiction	Registration Number	Registration Date	International Class
SWISS ARMY	US	2806013	January 20, 2004	8
SWISS ARMY	International	691820A	August 20, 1997	8
SWISS ARMY KNIFE	China	25301524	August 21, 2018	3
SWISS ARMY KNIFE	China	25301523	April 14, 2019	14
SWISS ARMY KNIFE	China	25301521	July 14, 2020	25

The Complainant has been operating websites for sale of its goods via domain names “www.victorinox.com” and “www.swissarmy.com” since November 6, 1998 and February 28, 1997 respectively.

The Respondent is an individual based in China. The Respondent registered the disputed domain name <swissarmyknivesonlinestore.com> on April 20, 2023. The disputed domain name directs to a commercial website purportedly offering to sell the pocketknives, including ones purportedly branded as the Complainant’s Swiss Army Knives, at discounted prices.

**5. Parties’ Contentions**

**A. Complainant**

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

The Complainant contends that:

The disputed domain name is identical or confusingly similar to the Complainant’s trademarks or service mark in which the Complainant has rights.

The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The disputed domain name was registered and is being used in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Preliminary Issue: Language of the Proceeding**

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including:

- (a) The terms "swiss army" and "swiss army knife" which are the dominant compositions of the disputed domain name do not carry any specific meaning in the Chinese language;
- (b) The term "knives online store" in the disputed domain name does not carry any specific meaning in the Chinese language;
- (c) The contents found on the website associated with the disputed domain name are in English. In particular, the website's "Contact US" page refers to an address in Kansas, US, where English is the primary language; and
- (d) The Complainant would be unfairly disadvantaged in terms of time and costs if it were to bear the burden of arranging for the Complaint to be translated into Chinese.

The Respondent did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered all the matters above, and in particular that the website under the disputed domain name is wholly in English, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

### **6.2 Substantive Issues: Three Elements**

The Complainant must satisfy all three elements of paragraph 4(a) of the Policy in order to succeed in its complaint:

- (i) the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights;
- (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**

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 trademarks and the disputed domain name. ([WIPO Overview 3.0](#), section 1.7.)

The Complainant has shown rights in respect of the marks SWISS ARMY and SWISS ARMY KNIFE for the purposes of the Policy. ([WIPO Overview 3.0](#), section 1.2.1.)

The entirety of the marks is reproduced within the disputed domain name save that the singular "knife" is in its plural form "knives". Accordingly, the disputed domain name is confusingly similar to the marks for the purposes of the Policy. ([WIPO Overview 3.0](#), section 1.7.)

Although the addition of other term here, "online store", 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 marks for the purposes of the Policy. ([WIPO Overview 3.0](#), section 1.8.)

Accordingly, the Panel finds that 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.

First, the registrations by USPTO, WIPO and CNIPA to the Complainant for the trademarks SWISS ARMY and SWISS ARMY KNIFE constitute prima facie evidence of the Complainant's rights to these trademarks. The Respondent is neither sponsored, affiliated, licensed nor authorised to use the Complainant's trademarks in any manner, including in the disputed domain name.

Second, the Respondent is not commonly known by the disputed domain name, which suggests a lack of rights and legitimate interests in the disputed domain name.

Third, the Respondent's registration of the disputed domain name on April 20, 2023 came significantly after the Complainant's registration of its trademarks. Prior to the Respondent's registration of the disputed domain name, the Complainant's trademarks had enjoyed high degree of fame and reputation which the Respondent was not authorised to share.

In any event, as the Respondent has failed to 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 Complainant is deemed to have satisfied the second element. ([WIPO Overview 3.0](#), section 2.1.)

In the premises, the Panel finds that 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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. ([WIPO Overview 3.0](#), section 3.2.1.)

As stated above, the Panel notes that the disputed domain name was registered long after the Complainant's registration of the trademarks SWISS ARMY and SWISS ARMY KNIFE, and the Complainant had been selling its goods using these trademarks well before the registration of the disputed domain name. The Respondent's creation of the disputed domain name and the contents on the website which the disputed domain name directs to bear striking resemblance to the Complainant's trademarks and products, indicating a degree of knowledge of and familiarity with the Complainant's brand and business. As such, the Respondent's use of these trademarks cannot be a coincidence.

It is clear that by creating the confusion as to the source, sponsorship, affiliation or endorsement with the Complainant's trademarks, the Respondent attempts to attract, for commercial gain, potential customers to make purchases on the website to which the disputed domain name directs. The Panel finds that the Respondent registered and is using the disputed domain name in bad faith.

For the above reasons, the Panel finds that the Complainant has established the third element of the Policy.

Therefore, the Complainant has satisfied the three elements under paragraph 4(a) of the Policy.

### **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 <swissarmyknivesonlinestore.com> be transferred to the Complainant.

*/Douglas Clark/*

**Douglas Clark**

Sole Panelist

Date: June 4, 2024