

EXPERT DECISION

VEKA Aktiengesellschaft v. E. S., Multiservice GmbH
Case No. DCH2024-0004

1. The Parties

The Claimant is VEKA Aktiengesellschaft, Germany, represented by PRINS Intellectual Property AG, Switzerland.

The Respondent is E. S., Multiservice GmbH, Switzerland.

2. The Domain Names

The dispute concerns the domain names <veka-fenster.ch> and <vekafenster.ch>.

3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 4, 2024. On June 7, 2024, the Center transmitted by email to SWITCH, the “.ch” and “.li” registry, a request for verification in connection with the disputed domain names. On June 10, 2024, SWITCH transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent (unknown) and contact information in the Complaint. The Center sent a request deficiency notification to the Claimant on June 10, 2024, providing the registrant and contact information disclosed by the Registrar, and requesting the Claimant to submit an amendment to the Complaint. The Claimant filed an amended Request on June 15, 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 June 17, 2024. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was July 7, 2024.

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 July 8, 2024, the Center notified the Claimant accordingly, who on the same day, 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 July 12, 2024, the Center appointed Tobias Zuberbühler as Expert in this case. The Expert finds that he 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 is a German manufacturer of plastic profile systems for the production of windows and doors that has been active worldwide for decades. The Claimant markets its products via its main website “www.veka.com” and has been active in Switzerland for many years with its website “www.veka.ch”.

The Claimant is the owner of numerous VEKA trademark registrations worldwide, including the International trademark registration No. 572118 (designating Switzerland), registered on June 6, 1991 for products and services in various different classes.

The Respondent registered the disputed domain names on March 24, 2011. The disputed domain names redirect to a website in German promoting cheap windows and displaying the Claimant’s VEKA logo.

5. Parties’ Contentions

A. The Claimant

The Claimant alleges that the Respondent has been using the VEKA trademark and logo on its website and, by adding the descriptive word “fenster” (“windows” in German), is falsely suggesting that the Respondent is linked to the Claimant.

Therefore, the Claimant contends that the Respondent has clearly violated (i) Article 3(1)(c) in connection with Article 13(1) of the Swiss Trademark Act (TMA), (ii) Article 8 of the Paris Convention in connection with Article 29 of the Swiss Civil Code (protecting the Claimant’s trade name “Veka”), and (iii) the Claimant’s rights under Article 2 and Articles 3(1)(d) & 3(1)(e) of the Swiss Unfair Competition Act (UCA).

B. The Respondent

The Respondent has not replied to the Claimant’s contentions. Pursuant to paragraph 23 of the Rules of Procedure, the Expert shall decide on the request on the basis of the case file.

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 VEKA trademarks.

Due to the use of its VEKA 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 names constitutes a clear infringement of a right in a distinctive sign which the Claimant owns under the laws 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) TMA).

The disputed domain names comprise the Claimant's VEKA trademark, with the addition of "-fenster" and "fenster" (as mentioned above, the German word for "window[s]"). The website in German associated with the disputed domain names has been promoting cheap windows and displaying the Claimant's VEKA logo.

Such commercial use creates a high likelihood of confusion between the disputed domain names and the Claimant's trademark, resulting in an infringement of the Claimant's trademark rights in accordance with Article 3(1)(c) in connection with Article 13(2)(b) TMA as well as a violation of Article 2 and Articles 3(1)(d) & 3(1)(e) UCA. In addition, the use of the Claimant's company/trade name on Respondent's website violates the Claimant's name rights under Article 29 of the Swiss Civil Code in connection with Article 8 of the Paris Convention.

The Respondent has not provided any reasonable explanation why the disputed domain names were registered, and, to the Expert's best knowledge, no such grounds can be seen.

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 names in accordance with paragraph 24(d)(iii) of the Rules of Procedure.

7. Expert Decision

For the above reasons, in accordance with paragraph 24 of the Rules of Procedure, the Expert orders that the domain names <veka-fenster.ch> and <vekafenster.ch> be transferred to the Claimant.

/Tobias Zuberbühler/

Tobias Zuberbühler

Expert

Dated: July 26, 2024