

EXPERT DECISION

Compagnie Générale des Etablissements Michelin v. Milan Haering Case No. DLI2024-0001

1. The Parties

The Claimant is Compagnie Générale des Etablissements Michelin, France, represented by Dreyfus & associés, France.

The Respondent is Milan Haering, Switzerland.

2. The Domain Name

The dispute concerns the following domain name <michelin.li>.

3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 18, 2024. On June 19, 2024, the Center transmitted by email to SWITCH, the “.ch” and “.li” registry, a request for verification in connection with the disputed domain name. On June 20, 2024, 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. In response to two notifications by the Center that the Request was administratively deficient, the Claimant filed amended Requests on June 30 and July 9, 2024. The Center verified that the Request together with the amended Requests 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 July 10, 2024. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was July 30, 2024.

The Respondent expressed his readiness to participate in the conciliation on August 11, 2024. The Center appointed Andrea Mondini in this matter on August 19, 2024.

In accordance with Rules of Procedure, paragraph 17, the Conciliation conference took place by telephone on August 28, 2024. The Conciliation conference did not result in a settlement between the Parties.

On August 30, 2024, the Center notified the Claimant accordingly, who on September 2, 2024 made an application for the continuation of the Dispute resolution proceedings in accordance with paragraph 19 of the Rules of procedure and paid the required fees.

On September 12, 2024, the Center appointed Lorenz Ehrler 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.

4. Factual Background

The Claimant, Compagnie Générale des Etablissements Michelin, with its seat in Clermont-Ferrand, France, is currently amongst the world's largest tyre manufacturing companies worldwide. Besides tyres for vehicles, it provides various ancillary services and/or products, most notably the Michelin tourist maps and guides and the famous restaurant guide Michelin. It employs 124,000 employees and is present in 170 countries, including in Switzerland, where it operates a subsidiary, Michelin Suisse SA.

The Claimant owns a series of trademarks, in particular:

- International trademark MICHELIN, registration number 492879, dated May 10, 1985, claiming goods in various classes, including in class 12, and designating in particular Switzerland and Liechtenstein;
- International trademark MICHELIN, registration number 348615, dated July 24, 1968, claiming goods in various classes, including in class 12, and designating in particular Switzerland and Liechtenstein;
- Swiss trademark MICHELIN, registration number 583862, dated March 5, 2009, claiming goods in various classes, including in class 12.

The Claimant also holds various domain names, in particular <michelin.com>, registered on December 1, 1993, and <michelin.ch>, registered on September 26, 1997, which both resolve to official websites of the Claimant.

The Respondent is Milan Haering.

The disputed domain name was registered on February 14, 2000. The disputed domain name does not resolve to an active website.

5. Parties' Contentions

A. The Claimant

The Claimant alleges that the disputed domain name is identical with and confusingly similar to the MICHELIN trademark and that, as a result, the Claimant's trademark rights have been infringed. In addition, the Claimant alleges that the mark MICHELIN constitutes a trademark with a high reputation within the meaning of Art. 15 of the Liechtenstein Trademark Protection Act ("LPM"). In addition to an infringement of the LPM and the Swiss Trademark Protection Act ("TPA"), the Claimant also alleges that the Respondent's conduct constitutes unfair competition and that the domain name in dispute infringes its name rights. It requests that the disputed domain name be transferred to it.

B. The Respondent

The Respondent has not submitted any response.

6. Discussion and Findings

A. The Claimant has a right in a distinctive sign under the law of Switzerland or Liechtenstein

The Claimant's request is based on a series of trademarks MICHELIN, some of which have been listed under Section 4 above. Both of the Claimant's International trademarks designating Liechtenstein are prior to the disputed domain name, which was registered in 2000. Accordingly, the Claimant owns trademarks protected in Switzerland and Liechtenstein, so that this first condition is satisfied.

In conclusion, the Claimant has demonstrated that it is the owner of a Swiss and Liechtenstein trademark.

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 or Liechtenstein

B.1 Trademark Law

Whether the Claimant's trademark is infringed depends on whether there is a likelihood of confusion between its trademark MICHELIN and the disputed domain name. There is a likelihood of confusion if the signs in question are identical or similar and are used for identical or similar goods or services (art. 3 para. 1 LPM).

The identity or similarity between the Claimant's trademark MICHELIN and the disputed domain name <michelin.li> is obvious, as the latter includes the Claimant's trademark in its entirety, the distinctive character of which is indisputable. The condition of identity/similarity between the signs is therefore met.

In addition, the disputed domain name must be used for goods or services that are identical or similar to the goods or services claimed by the Claimant's trademark (principle of specialty). The Claimant does not allege any such, because the disputed domain name <michelin.li> is actually not active, and the Claimant has neither alleged nor demonstrated that it had been active in the past. In other words, none of the goods or services claimed by the Claimant's trademark are offered under this domain name.

The mere registration or ownership of an inactive domain name does not constitute use, and therefore an infringement, within the meaning of the TPA (Joller, in Bettinger, Handbuch des Domainrechts, Köln/München 2008, p. 948, with references to case law). In other words, by registering the disputed domain name without using it for services that are identical with or similar to those claimed by the Claimant's trademark, the Respondent is not committing an infringement under Articles 3 and 13 of the LPM.

It is true that the inactivity of the website is not the only possible means of evidence for the Respondent's offering of similar goods or services. There must nevertheless be indications that the domain name is intended to be used for goods or services that are identical with or similar to those claimed by the trademark in question (cf. Buri, in SIWR III/2, Basel 2005, p. 364; BSK MSCHG-Isler, Art. 13 N 28). However, the Claimant has not put forward any evidence to that effect.

Consequently, there has been no infringement of the Claimant's trademark within the meaning of Art. 3 and Art. 13 LPM.

Finally, the Claimant alleges that the trademark MICHELIN is a trademark with a high reputation within the meaning of Art. 15 TPA and LPM and that it therefore benefits from a broader scope of protection.

In the first place, it seems quite obvious that MICHELIN is a trademark of high repute. However, this does not mean that any use of the disputed domain name would necessarily infringe the Claimant's trademark rights. Article 15 of the TPA and LPM states that the owner of a trademark with a high reputation may only prohibit the use of his trademark for all goods and services if such use threatens the distinctive character of the trademark, exploits its reputation or is detrimental to it. It is uncertain whether any use for goods or services would meet any of these conditions. Moreover, the Respondent could also use the disputed domain name for non-commercial purposes, in other words for purposes that would be beyond the scope of trademark law (see Weber, E-Commerce und Recht, 2nd ed., Zurich 2010, p. 140).

It follows that there has been no infringement of within the meaning of Art. 3, 13, and 15 of the LPM and TPA in this case. Under these circumstances, it must be examined whether the Respondent's conduct constitutes unfair competition or an infringement of the right to a name.

B.2 Unfair Competition Law

Insofar as the Claimant alleges a likelihood of confusion pursuant to the Federal Act against Unfair Competition ("UWG") in both Liechtenstein and Switzerland, it should be noted that case law and legal doctrine have confirmed that, as in trademark law, the mere registration of a domain name does not create a likelihood of confusion (BSK UWG-Arpagaus, Basel 2013, Art. 3 Abs. 1 lit. d N 198). Besides a risk of confusion, the Claimant alleges that the disputed domain name constitutes registration interference within the meaning of art. 2 UWG. An impediment by registration of a domain name exists if the registration makes access to the market more difficult for a competitor. In principle, however, this condition is not met if the competitor, as is the case with the Claimant, has numerous domain names, so that the development of its business on Internet is not seriously hindered by the presence of the disputed domain name (see Weber, *op. cit.*, p. 158). This being said, when assessing conduct, it is not sufficient to base oneself on its objective consequences. The unfairness of the conduct may result from a combination of objective and subjective factors. In particular, unfair competition may be found where there is an intention to hinder the trademark owner in the market. If the conduct is intentional, a finding of unfair competition can be made even if the conduct does not objectively constitute a serious hindrance.

In an email the Respondent sent to the Center on July 30, 2024, the Respondent alleged that he had registered the disputed domain name as an abbreviation for "Michel in Liechtenstein". This explanation, which was not supported by any type of evidence, lacks credibility and is likely to be an invention made for the purposes of these proceedings, all the more that a brief Internet search reveals that the Respondent was active in the trade with tyres. Actually, he owns a company named "Pneu-Börse Rheineck GmbH", which is currently in liquidation and which pursued the purpose of "trade in vehicle spare parts and consumables for vehicles, in particular the trade in tyres" (see the online commercial register of canton of St. Gallen).

It results from the above that the Respondent is in bad faith. In reality, when registering the disputed domain name, he must have had in mind the Claimant's trademark MICHELIN, all the more that he is himself active in the tyres business. If he has not used the disputed domain name for a website for more than 20 years, nonetheless keeping it to himself, it is difficult to imagine any goal other than to prevent the Claimant from using their trademark MICHELIN as domain name under the country code Top Level Domain ".li".

According to the doctrine, the absence of a recognisable own interest in the use of the domain name is an indication of the existence of an intention to hinder the trademark holder (Buri, *op. cit.*, Bern 2000, S. 146). Taking into account the above, the Panel comes to the conclusion that the Respondent's conduct amounts to unfair competition and therefore constitutes an infringement of law pursuant to art. (2) of the UWG.

B.3 Name Rights

The Claimant has also invoked the protection of its name. Protection of a name under Art. 29 para. 2 Swiss Civil Code ("SCC") is granted to anyone, including to legal entities, who is adversely affected by another person usurping their name. Two conditions must be met, though: in addition to the appropriation of the name by the infringer, the infringer's use of the sign must also have an adverse effect on the person entitled to the appropriated name, e.g. a risk of confusion.

There is no clear doctrine in this respect. For instance, Buri considers that the mere registration of a domain name cannot entail a risk of confusion under the law of name rights (Buri, *Die Verwechselbarkeit von Internet Domain Names*, Berne 2000, p. 129), while Joller is of the contrary view (Joller, in Bettinger, *Handbuch des Domainrechts*, Köln/München 2008, p. 908). Absent any court practice consecrating one of these scholarly views, the request cannot be admitted on the basis of this argument.

However, besides the creation of a likelihood of confusion, the interests of the name owner may also be significantly affected by his obstruction in the use of the name, for example if someone without legitimate

interests prevents him from registering signs containing his name (in which case the passive use of a domain name can suffice) (BSK ZGB-Roland Bühler, N 31 and 35).

As established under Section B.2, the Respondent had (i) no legitimate interest in the disputed domain name and (ii) manifestly registered it with the purpose of hindering the Claimant from registering it for itself.

Accordingly, the Respondent's conduct constitutes also an infringement of the Claimant's name rights under Art. 29 para. 2 SCC.

7. Expert Decision

For the above reasons, in accordance with paragraph 24 of the Rules of Procedure, the Expert orders that the domain name, < Michelin.li > be transferred to the Claimant.

/Lorenz Ehrler/

Lorenz Ehrler

Expert

Dated: September 26, 2024