

EXPERT DECISION

Ringier AG v. STO Procent Lucjan Misiag
Case No. DCH2022-0004

1. The Parties

The Claimant is Ringier AG, Switzerland, represented internally.

The Respondent is STO Procent Lucjan Misiag, Poland.

2. The Domain Name

The dispute concerns the following domain name <blixk.ch> (the “Disputed Domain Name”).

3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 17, 2022. On March 17, 2022, the Center transmitted by email to SWITCH, the “.ch” and “.li” registry, a request for verification in connection with the Disputed Domain Name. On March 18, 2022, SWITCH 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on March 21, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Request. The Complainant filed an amended Complaint on March 22, 2022.

The Center verified that the Request together with the amendment to the 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 March 24, 2022. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was April 13, 2022.

The Respondent has neither filed a Response nor expressed its readiness to participate in a Conciliation in accordance with paragraph 15(d) of the Rules of Procedure.

On April 20, 2022, the Center notified the Claimant accordingly, who on the same date 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 April 26, 2022, the Center appointed Jacques de Werra 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 is a major media company with its seat in Zürich, Switzerland. The Claimant is the owner and user of many trademarks containing the word “Blick” (in multiple variations). The first BLICK trademark was registered by the Claimant in Switzerland under Reg. No. 2P-313021 on January 14, 1982, for publications (in class 16). The Claimant has registered other Swiss BLICK trademarks covering various goods and services including electronic publications (class 9) and publications (class 16) (all these Swiss trademarks are collectively referred as the “Trademark”). The Claimant has also registered other BLICK trademarks in many countries beyond Switzerland.

The Claimant is the owner of the domain name <blick.ch>, which it registered in 1996. Under this domain name, the Claimant operates one of the most popular media portals in Switzerland. It provides its readers with stories from the areas of news, politics, people and sports and it generates over 800 million page impressions and over 60 million visits each month.

The Disputed Domain Name was first registered on April 2, 2007. Based on the case file, it appears that the Respondent registered it on August 28, 2018.

The Claimant learned about the Respondent’s website through an email from a customer in mid-February 2022. The customer informed the Claimant that (s)he had come across a malicious copy of the Claimant’s website “www.blick.ch”, namely the Disputed Domain Name, on which fake media content imitating the media content available on the official website of the Claimant was (back then) made available under the name of the Claimant featuring the BLICK trademark. The customer was (back then) redirected (partly automated, partly only after manually clicking on the displayed text) via several third-party websites, followed by a supposed article from the official website of the Claimant (“www.blick.ch”), which allegedly reported about making fast money with BitCoin (in another test also with Ethereum) and great promises of success. According to the customer, the fake websites are built dynamically, in some of customer’s tests, it was even stated that “Blick reporters” tested the BitCoin method themselves and made a lot of profit within minutes.

The Disputed Domain Name presently resolves to parking pages with pay-per-click (“PPC”) links to websites offering a range of goods and services or redirected to a variety of third-party websites.

5. Parties’ Contentions

A. The Claimant

The Claimant claims in essence that the Respondent’s use of the Disputed Domain Name violates Swiss law, namely Article 13 of the Swiss Trade Mark Protection Act (“STA”) as well as Article 2 and 3 para. 1 lit. d of the Swiss Unfair Competition Act (“SUCA”).

The Claimant claims that the Disputed Domain Name is confusingly similar to the Trademark that it owns. The only difference between the Trademark of the Claimant and the Disputed Domain Name is the fourth letter of the respective words “BLICK” vs. “BLIXK”, namely “C” (Claimant) vs. “X” (Respondent). Visually, the difference is therefore minimal. Phonetically, the terms “BLICK” and “BLIXK” are highly similar, both bearing a strong end syllable. Conceptually, “BLIXK” – which has no recognizable meaning – is likely to be perceived as a mistyped version of the word “BLICK”. Consequently, the replacement of the letter “C” with the letter “X” does not sufficiently differentiate the Disputed Domain Name from the Trademark and from the official domain name of the Claimant.

By choosing the ccTLD “.ch”, the Respondent explicitly targets the Swiss public. However, the word “BLIXK” bears no meaning under any of the Swiss national languages, and thus it is clear that the Respondent’s sole intent, by having chosen the Disputed Domain Name, is to improperly associate itself with the well-known Trademark of the Claimant. There is a risk that users who wish to visit the Claimant’s website may mistake the domain name and unintentionally access the Respondent’s website. In this context, it must be noted that the letters “X” and “C” are right next to each other on computer keyboards, which is a fact which the Respondent deliberately and unfairly exploits.

The Claimant further claims that the creation of a likelihood of confusion by exploiting typos of Internet users when entering a domain name in order to direct users to one’s own website (“typosquatting”) generally not only infringes the rights of trademark owners, but also constitutes an act of unfair competition. The Disputed Domain Name represents a case of “typosquatting”, with the purpose of attracting, for commercial gain, Internet users to the Respondent’s website, by creating a likelihood of confusion with Claimant’s Trademark and domain name. The Respondent’s bad faith is manifested by the fact that the Respondent has been a party to several domain name disputes with WIPO, in which all (typosquatting) domain names were ultimately transferred to the respective claimant (e.g. *Raiffeisen Schweiz Genossenschaft v. Lucjan Misiag*, WIPO Case No. [DCH2019-0011](#); *Raiffeisen Schweiz Genossenschaft v. Lucjan Misiag*, WIPO Case No. [DCH2016-0018](#)).

The Claimant also alleges that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and there is no evidence that the Respondent registered the Disputed Domain Name for purposes other than “typosquatting”. Specifically, there is no evidence that the Disputed Domain Name is used in connection with a *bona fide* offering of goods or services, that Respondent as an individual, business, or other organization, is commonly known by the disputed domain name, nor that the Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Name.

B. The Respondent

The Respondent did not reply to the Claimant’s contentions.

6. Discussion and Findings

A. Language of the proceedings

Paragraph 7(a) of the Rules of Procedure provides that the procedure shall be conducted at the Claimant’s choice in English, German, French or Italian.

In this case, the Claimant has requested that the language of proceedings be English, and has consequently submitted the Complaint and the amended Complaint in English. On this basis, the language of the proceeding shall be English.

B. Decision on the merits

According to the Rules of Procedure, paragraph 24(c), “[t]he Expert shall grant the request if 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 (in disputes over a domain name under the ccTLD “.ch”).

The Rules of Procedure, paragraph 24(d) provide that “a 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 defence; and
- the infringement of the right justifies the transfer or deletion of the domain name, depending on the remedy requested in the request”.

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

The Claimant has established its ownership of the Trademark protected in Switzerland. The Expert holds therefore that the Claimant has established its exclusive right in a distinctive sign (*i.e.* the Trademark) in Switzerland.

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

The Claimant alleges that the use of the Disputed Domain Name constitutes a violation of the Trademark within the meaning of Article 13 STA on the ground that the Disputed Domain Name is confusingly similar with the Trademark. In this case, it is clear that the Disputed Domain Name is confusingly similar with the Trademark because there is only one letter of difference between the Trademark and the Disputed Domain Name and because of the resulting similarity between them (visually and phonetically).

The protection granted under Article 13 STA further presupposes that the Trademark shall be used (without authorization) in connection with identical or similar goods or services (as claimed in the Trademark) which can generate a risk of confusion. In this case, the Disputed Domain Name was actively used without authorization from the Claimant in connection with media content as resulting from the fake media content that was accessible and which featured the Trademark in order to mislead Internet visitors into cryptocurrency investments. The Disputed Domain Name was consequently used in connection with goods or services that are identical or similar to those claimed in the Trademark (knowing that the Claimant has registered the Trademark for various goods and services, including for electronic publications (class 9) and for publications (class 16)). On this basis, the use of the Disputed Domain Name constitutes a clear infringement of a right in a distinctive sign owned by the Claimant under Swiss trademark law.

In view of this clear infringement, there is no need to assess whether, as claimed by the Claimant, the Respondent has committed an act of unfair competition, by committing a violation of the SUCA, specifically of article 3 para. 1 let. d SUCA and of the general clause of article 2 SUCA.

The Respondent, although given the opportunity, has not participated in the proceedings and has not provided any explanations that could potentially have justified the allocation or use of the Disputed Domain Name. On this basis, the Expert finds that the Respondent has not conclusively pleaded and proven any relevant grounds for defence (pursuant to paragraph 24(d)(ii) of the Rules of Procedure).

It is established that a violation of Swiss trademark law resulting from the infringing use of a domain name can justify the transfer of a domain name in accordance with Paragraph 24(d)(iii) of the Rules of procedure. In this case, the violation of Swiss trademark law resulting from the infringing use of the Disputed Domain Name can justify the transfer of such domain name, pursuant to the remedy requested by the Claimant.

On this basis, the Expert finds that the use of the Disputed Domain Name constitutes a clear infringement of the Claimant's right which justifies the transfer of the Disputed Domain Name to the Claimant.

The Expert notes that a few years have elapsed since the registration of the Disputed Domain Name in 2007 and since the registration of the Disputed Domain Name by the Respondent in 2018. This consequently raises the question of the potential objection of laches (*péremption*; *Verwirkung*) which must be analyzed even if it has not been raised by the Parties (here by the Respondent). See S. Brauchbar, *Die Verwirkung im Kennzeichenrecht; unter Berücksichtigung der Regelung in der Europäischen Union*, Basel 2001, p. 49. Laches implies that the right owner has tolerated the violation of its rights for a long period of time without opposing it and that the author of the violation has in the meantime acquired a position worthy of protection

so that the right owner would lose its right to claim legal protection against the violation of its right (see Swiss Federal Court, judgment 4A_638/2009, c. 3.2 not published in ATF 136 III 225; judgment 4C.371/2005 c. 3.1 and the judgments cited, in SJ 2007 I p. 7 and in sic! 2006 p. 500).

In this case, the conditions for admitting laches are not met because it is not established that the Claimant would have tolerated the violation of its rights for a long period of time without opposing it as a result of the registration of the Disputed Domain Name by the Respondent. The Claimant has indeed alleged without being contradicted by the Respondent that it has learnt about the registration of the Disputed Domain Name only very recently after having received an email of warning from a customer (in February 2022). In addition, the Respondent has not established that he would have in the meantime acquired a position worthy of protection with respect to the Disputed Domain Name. On this basis, the Expert holds that the objection of laches cannot be applicable in this case.

7. Expert Decision

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

Jacques de Werra

Expert

Dated: May 9, 2022