

EXPERT DECISION

Belfius Bank S.A. / Belfius Bank N.V. v. K. D.
Case No. DCH2022-0013

1. The Parties

The Claimant is Belfius Bank S.A. / Belfius Bank N.V., Belgium, internally represented.

The Respondent is K. D., Belgium.

2. The Domain Name

The dispute concerns the following domain name <belfiusmobile.ch>.

3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 19, 2022. On July 19, 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 July 20, 2022, 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. The Center verified that 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 July 25, 2022. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was August 14, 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. No Conciliation conference has taken place within the deadline specified in paragraph 17(b) of the Rules of Procedure.

On August 17, 2022, the Center notified the Claimant accordingly, who on August 26, 2022, 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 September 13, 2022, the Center appointed Daniel Kraus 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

Belfius is a bank with seat in Belgium. It is the owner of several trademarks in the European Union ("EU"), in particular in the Benelux, including in particular the following:

- Benelux trademark registration No. 914650 for word mark BELFIUS filed on January 23, 2012, in classes 9, 16, 35, 36, 41, and 45;
- Benelux trademark registration No. 915963 for figurative mark BELFIUS filed on March 2, 2012, in classes 9, 16, 35, 36, 41, and 45;
- Benelux trademark registration No. 915962 for figurative mark BELFIUS filed on March 2, 2012, in classes 9, 16, 35, 36, 41, and 45;
- EU trademark registration No. 010581205 for word mark BELFIUS filed on January 23, 2012, in classes 9, 16, 35, 36, 41, and 45.

The Claimant is also the registrant of several domain names incorporating "belfius", including the domain name <belfius.be> registered on January 23, 2012, and resolving to its official website where the Claimant offers banking and insurance services, and <belfius.com>, registered on January 20, 2012.

According to the case file before the Panel, at the moment of registration of the disputed domain name in 2021, the Claimant had no trademark protection in Switzerland. An application for protection was filed by the Claimant in June 2022 only (Swiss trademark application No. 08114/2022 for word mark BELFIUS filed on June 17, 2022, in classes 9, 16, 35, 36, 41, and 45).

In December 2021, the Claimant discovered that the Respondent had registered the disputed domain name <belfiusmobile.ch> without its consent. The Claimant sent a cease and desist letter by mail to the Registrar on December 27, 2021 (not 2022 as mentioned in the Complaint) and a reminder on December 31, 2021 (not 2022). These emails remained unanswered. After receiving the contact information of the Respondent from Switch Domain Info, the Claimant sent a registered letter to the communicated address on July 14, 2022, to inform the Respondent of the alleged infringement of the Claimant's rights and to request the transfer of the domain name. The Respondent has not given any answer to said registered email.

5. Parties' Contentions

A. The Claimant

The Claimant contends it has a right in a distinctive sign under the law of Switzerland or Liechtenstein. It considers BELFIUS as a unique sign developed especially for the Claimant's business, composed of "Bel" as in Belgium, "fi" as in finance and the English word "us". The Claimant contends that it holds a right to a name in Switzerland pursuant to Article 29 of the Swiss Civil Code.

With more than 5.000 employees, over 500 agencies and almost 4 million clients, as well as 100% government shareholdership, the Claimant contends it is a renowned Belgian bank and financial services provider known under the name BELFIUS, with a solid reputation in Belgium and beyond. Although the activities of the Claimant are mainly focused on the Belgian territory, the Claimant asserts that it also has customers in Switzerland and other European countries. In addition, the Claimant declares that Belfius' name and logo are also present in Switzerland, amongst others in the context of sports events, as the

Claimant sponsors several sports teams playing on an international level, featuring the Belfius' name and logo prominently on the player's outfits.

The Claimant also asserts that the exposure of the trademark is also shown by a Google search set to Switzerland, where the keyword "Belfius" leads directly to web pages by or about the Claimant. Furthermore, according to the Claimant, the fact that it uses the name "Belfius" in the email address of its employees, which consists of a name or department followed by "@belfius.be" also demonstrates the Claimant's rights in the distinctive sign "Belfius", devolving from its registration and/or use.

The Claimant further contends that the allocation and/or use of the domain name at issue infringes its right in a distinctive sign under the law of Switzerland or Liechtenstein, as the Respondent has no rights or legitimate interests in respect of the domain name and the domain name constitutes a violation of the right to a name of the Claimant.

B. The Respondent

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

6. Discussion and Findings

According to the Rules of Procedure, paragraph 24(c), "the 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 laws of Switzerland".

The Rules of Procedure, paragraph 24(d) specify 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 defense; and
- the infringement of the right justifies the transfer or revocation of the domain name, depending on the remedy requested in the request".

A. The Claimant has no right in a distinctive sign under the law of Switzerland

It is clear from the facts as described above that the Claimant did not benefit from the protection of a Swiss trademark at the time of registration of the disputed domain name, as it had not filed its trademark at that point in time. Besides, the Claimant has not supported evidence to the case file of that would support the existence of an (un)registered or well-known mark.

Neither did the Claimant benefit from the protection of a business name under article 956 of the Code of Obligations, as the Claimant is not registered with the Swiss commercial register.

The Claimant contends it benefits from the protection of the right to its name. However, said contention is not correct. Indeed, such protection may be inferred from article 8 of the Paris Convention for the protection of Industrial Property (CUP), as implemented in article 29 of the Swiss Civil Code (CC). However, in all cases in which such protection was granted to foreign companies (that were not registered with the commercial register), said foreign companies had proven activities in Switzerland. That was the case in *GLOBALE Rückversicherungs-AG contre J. M.*, WIPO Case No. [DCH2009-0018](#), case in which the claimant had its seat in Zug. That is also the case in the classic Case Law of the Swiss Federal Court, including cases 90 II 315 and 116 II 463. In the present case, the Claimant contends that it has some clients in

Switzerland, that a research on Google lets the name Belfius appear, but does not provide sufficient elements to demonstrate an economic activity in Switzerland, neither, *a minima*, the existence of an advertising campaign that would have documented an intention to enter the Swiss market.

In view of the above, the Expert concludes that the Claimant has not demonstrated it fulfils the conditions to benefit from the protection of its name under article 29 CC, nor from the protection of any other type of distinctive sign.

B. The claim for protection under the Unfair Competition Act (“UCA”)

The last question to examine is whether a protection may derive from the prohibition of unfair competition under the Unfair Competition Act (UCA).

Case law admits that domain names are (also) subject to the requirement of fairness under competition law (BGE 128 II 353, E. 4). Whoever "takes measures that are likely to cause confusion with the goods, works, services or business operations of another" acts unfairly according to Art. 3 lit. d UCA. Besides, "any deceptive or in any other way contrary to the principle of good faith conduct or business conduct which influences the relationship between competitors or between suppliers and customers" is unfair and unlawful according to the general clause of Art. 2 UCA.

According to prevailing doctrine and case law, the mere registration of a domain name does not yet create a likelihood of confusion within the meaning of Art. 3 para. 1 lit. d UCA, since there is not yet any danger of operational misattribution (judgment HGer SG of June 25, 2002, sic! 2003 348, p. 351 E. III/3c, <breco.ch>; BSK UWG-Arpagaus, Art. 3 para. 1 lit. d N 198-199; cf. also *Cembra Money Bank AG v. Canan Siddik, Canankredit*, WIPO Case No. [DCH2015-0010](#), <cembracredit.ch>, 6.B.c; *Cartier International S. A. contre Marc Baertschi*, WIPO Case No. [DLI2015-0001](#), <cartier.li>, C.4).

The dominant doctrine recognizes a violation of Art. 3 para. 1 lit. d UCA only if concrete measures for the use of a domain name are proven. For this purpose, the intention to use the domain name must be established on the basis of other facts, such as corresponding statements by the holder or preparatory acts (BSK UWG-Arpagaus, Art. 3 para. 1 lit. d N 199). Only Alberini/Guillet (*L'incidence du contenu du site Internet dans les litiges en matière de noms de domaine*, pp. 313-314, para. 4) admit a likelihood of confusion in the case of inactive domain names based on the pure wording of the domain name. In the Expert's opinion, however, it is doubtful whether entering an inactive domain name in the address line of a browser followed by an error message is likely to cause a risk of confusion with another's products within the meaning of art. 3 para. 1 lit. d UCA (cf. Mark Schweizer, *5 Jahre SWITCH-Streitbelegungsverfahren: Fair.ch?*, AJP 8/2009 971, p. 983, *Cembra Money Bank AG v. Canan Siddik, Canankredit*, WIPO Case No. [DCH2015-0010](#)).

In the present case, the disputed domain name merely leads to an error page mentioning, in Dutch, that the site is not accessible. Although it has to be admitted that the Respondent would most probably not have registered the disputed domain name had he not known of the Claimant's (foreign) trademarks and domain names, the Complainant has not established any further facts that would lead to admitting a behavior that would fall under the specific (art. 3 para. 1 lit. d UCA) or general (art. 2 UCA) prohibitions of the UCA.

Thus, the Expert finds that a transfer of the disputed domain name to the Complainant under the UCA is not justified.

In summary, the Claimant does not meet the requirements of paragraph 24(c) and (d) of the Rules of Procedure.

7. Expert Decision

For the above reasons, the Request is denied.

Daniel Kraus
Expert
September 27, 2022