

EXPERT DECISION

ZO Skin Health, Inc. v. M. H., aesthetic visions GmbH
Case No. DCH2023-0019

1. The Parties

The Claimant is ZO Skin Health, Inc., United States of America, represented by ZwillGen PLLC, United States of America.

The Respondent is M. H., aesthetic visions GmbH, Germany.

2. The Domain Name

The dispute concerns the disputed domain name <zoskinhealth.ch>.

3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 15, 2023. On August 16, 2023, the Center transmitted by email to SWITCH, the “.ch” and “.li” registry, a request for verification in connection with the disputed domain name. On August 17, 2023, 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 a notification by the Center that the Request was administratively deficient, the Claimant filed an amended Request on August 18, 2023. 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 September 1, 2023. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was September 21, 2023.

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 September 26, 2023, the Center notified the Claimant accordingly, who on October 11, 2023, 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 October 18, 2023, the Center appointed Andrea Mondini 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.

On November 1, 2023, the Claimant informed the Center that its trademarks ZO SKIN HEALTH and ZO (logo) have been registered in Switzerland and submitted copies of the extracts of the Swiss trademark register. The Expert finds that this late submission is to be considered under the circumstances of the present case.

4. Factual Background

The Claimant is a company based in the United States of America offering skin care products and solutions in several countries. On June 19, 2023, the Claimant established its affiliate ZO Skin Health Switzerland GmbH in Switzerland.

The Claimant owns the European Union Trademark Registration ZO SKIN HEALTH (no. 008708711), which was registered on May 27, 2010.

In Switzerland, the Claimant filed a trademark application for ZO SKIN HEALTH on July 26, 2023, which was still pending when the Request was filed. This trademark has been registered on October 30, 2023 as no. 805276 (word mark).

The disputed domain name was registered on March 10, 2014, and is currently inactive.

5. Parties' Contentions

A. Claimant

In summary, the Claimant asserts the following:

The element "zo" in the Claimant's distinctive name derives from the initials of its founder, the world-renowned dermatologist Dr. Zein Obagi. The Claimant holds a trademark in the European Union for the ZO SKIN HEALTH mark. This constitutes a "well-known" or "notorious" mark under Article 6bis of the Paris Convention for the Protection of Industrial Property (the "Paris Convention"). The Claimant (ZO)'s products have been sold in Switzerland through a German distributor, Novia Esthetic, since 2019. The volume of ZO products sold in Switzerland through Novia Esthetic can be seen in the invoices from 2019 to 2022 submitted by the Claimant.

The Claimant has filed trademark applications for the ZO SKIN HEALTH mark and the ZO logo in Switzerland on July 26, 2023, and these trademarks were registered on October 31, 2023. The Claimant's business is incorporated in Switzerland as ZO Skin Health Switzerland GmbH.

The Claimant's trade name is inherently distinctive in character and is consistently used in Switzerland and has reached a high degree of recognition there based on its significant volume of sales over the past several years. Based on articles 8 and 2(1) of the Paris Convention, the Claimant's trade name is thus entitled to the same protection as comparable domestic signs (Decision of the Swiss Federal Supreme Court of November 8, 2004, 4C.31/2004, consid. 7.1). By contrast, the Respondent has no rights or legitimate interests in the ZO SKIN HEALTH mark or business name.

The Respondent interferes with the Claimant's rights. The Respondent is using the disputed domain name in bad faith. Although the disputed domain name appears to be offline at the time of this request's filing, the Claimant claims that it was resolving to a website with a login page for call center provider, "VICIDial," which had no affiliation with the Claimant. According to the Claimant, this appeared to be some kind of scam website, meaning that the Respondent attempted to profit off of ZO Skin Health's good name and defraud or mislead consumers.

The Respondent's use of the Claimant's name in the disputed domain name also violates the Unfair Competition Act ("UCA") by interfering with the relationship between ZO Skin Health and its customers. By using the Claimant's name and mark in a domain name that leads to a suspicious-looking and/or inactive webpage, the Respondent has likely caused concern among the Claimant's Swiss customers about the legitimacy of the Claimant's business.

B. Respondent

The Respondent has not submitted a response.

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 "in particular, 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 revocation 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 shown, that its trademark ZO SKIN HEALTH, which was filed on July 26, 2023, has been registered on October 30, 2023 (no. 805276; word mark). Accordingly, the Claimant has provided sufficient evidence of rights in distinctive signs under the law of Switzerland in accordance with paragraph 24(d)(i) of the Rules of Procedure.

The Claimant further alleged that its trademark ZO SKIN HEALTH would constitute a "well-known" or "notorious" mark under Article 6bis of the Paris Convention. However, the protection under Article 6bis of the Paris Convention constitutes an exception to the trademark registration requirement and as such may only be restrictively granted to marks that have achieved an above-average notoriety in Switzerland (Swiss Federal Supreme Court of February 19, 2001, 4P.291/2000). The Expert concludes that the Claimant has not succeeded in showing that its mark would be "well known" or "notorious" in Switzerland.

Art. 3 para. 1 lit d UCA confers protection to older unregistered distinctive signs against confusingly similar signs. This protection is based on priority of use. The Claimant submitted invoices from 2019 to 2022 allegedly showing sales in Switzerland for a total amount of over EUR 30,000. However, those invoices cannot establish prior use in Switzerland because (i) they were issued several years after the registration of the disputed domain name and (ii) do not even show that they related to products sold under the mark ZO SKIN HEALTH.

The Claimant has shown that its affiliate owns rights in the name of the company ZO Skin Health Switzerland GmbH, which was established on June 19, 2023 (Art. 956 para. 2 Swiss Code of Obligations "CO"). The Expert finds that the Claimant has only established that its affiliate (but not the Claimant itself) owns rights in the company name ZO Skin Health Switzerland GmbH 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's trademark ZO SKIN HEALTH was filed on July 26, 2023 and has been registered on October 30, 2023 (no. 805276; word mark), i.e. after the domain name was registered on March 10, 2014. According to Art. 14 para. 1 of the Swiss Trademark Act, the proprietor of a trademark may not prohibit another person from continuing to use a sign to the same extent as already previously used prior to the filing of a trademark application. Therefore, because in the present case the disputed domain name was registered before the filing date of the Claimant's trademark, the Expert concludes that the allocation or use of the disputed domain name (which is inactive) does not constitute a clear infringement of the Claimant's trademark ZO SKIN HEALTH under the Swiss Trademark Act.

The Claimant has established that its subsidiary owns rights in the company name ZO Skin Health Switzerland GmbH in Switzerland. However, under Swiss law that subsidiary is a separate legal entity. The rights in the company name are held by that subsidiary, not by the Claimant.

In any event, even if the Claimant were allowed to assert the benefit of that company name, according to the jurisprudence of the Swiss Federal Court, under Art. 956 para. 2 CO a company name is only protected against the use of that name "as a company name" ("*firmermässiger Gebrauch*"); as a rule, the use as a domain name does not constitute use as a company name (see Mondini/Zollinger-Löw, Domain-Namen, SIWR III/2, no. 658 with references to the case law of the Swiss Federal Court). Furthermore, in the present case no use of the disputed domain name has been shown at all. In addition, the Complainant's affiliate was established on June 19, 2023, i.e., more than nine years after the disputed domain name was registered on March 10, 2014. Therefore, the Expert concludes that the allocation or use of the disputed domain name does not constitute a clear infringement of the company name of ZO Skin Health Switzerland GmbH.

The Claimant further asserts that based on articles 8 and 2(1) of the Paris Convention foreign trade names are entitled to the same protection as Swiss distinctive signs irrespective of a registration. In other words, the Paris Convention only affords protection if there is an infringement of those signs under Swiss law. However, because as discussed above there is no such infringement in the present case, the Paris Convention is of no avail to Claimant (same as in the decision of the Swiss Federal Supreme Court of November 8, 2004, 4C.31/2004, consid. 7.1).

The disputed domain name is currently inactive. The Claimant alleges that the disputed domain name until recently resolved to a scam website. However, there is no evidence for this allegation in the record.

Furthermore, considering that the Claimant waited more than nine years since the registration of the disputed domain name before filing the Complaint, the issue of forfeiture arises under Swiss law.

The Expert therefore concludes that the allocation or use of the disputed domain name does not constitute a clear infringement of a right in a distinctive sign which the Claimant owns under the law of Switzerland.

6. Expert Decision

For the above reasons, the Request is denied.

/Andrea Mondini/

Andrea Mondini

Expert

Dated: November 2, 2023