

## **EXPERT DECISION**

Treré Innovation S.r.l. v. Domain Privacy OÜ  
Case No. DCH2025-0001

### **1. The Parties**

The Claimant is Treré Innovation S.r.l., of Italy, represented by Ivett Paulovics, Italy.

The Respondent is Domain Privacy OÜ, of Estonia.

### **2. The Domain Name**

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

### **3. Procedural History**

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 25, 2025. On February 26, 2025, the Center transmitted by email to SWITCH, the “.ch” and “.li” registry, a request for verification in connection with the disputed domain name. On February 27, 2025, 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 March 18, 2025. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was April 7, 2025.

The Respondent filed Responses on March 19, 2025 and on March 21, 2025. The Claimant submitted unsolicited Supplemental filings on March 21, 2025 and on April 11, 2025. The Respondent submitted unsolicited Supplemental filings on March 26, 2025 and on April 11, 2025.

On April 25, 2025 the Center appointed Anne-Virginie La Spada as Expert in this case. The Expert finds that she was properly appointed. In accordance with Rules of Procedure, paragraph 4, the above Expert has declared her independence of the parties.

#### **4. Factual Background**

The Claimant is an Italian family-owned company that operates in the field of sport, leisure and work apparel. The Claimant launched the brand UYN in 2017 in relation to a range of high-performance products including sports underwear, clothes, accessories and shoes (as evidenced by a catalog dated May 2017).

The Claimant is the owner of various trademarks, including international trademark registration No. 1384243 for UYN (fig.), registered on October 19, 2017, in class 25 and 35 and covering Switzerland. This international registration is based on a corresponding European Union (EU) trademark application filed on July 5, 2017 and claims the priority date of the EU application. The figurative elements of the trademark consist of a special font.

The Claimant is the owner of various domain names consisting of or including the term “uyn”, including <uynsports.com> since June 27, 2017.

The Claimant operates an e-commerce website for Swiss-based customers under the URL “www.uynsports.com/en\_ch”. Physical stores located in Switzerland distribute the Claimant’s UYN products.

The disputed domain name was first registered on September 6, 2008. There is uncertainty regarding the date of allocation of the disputed domain name to the Respondent. SWITCH indicated to the Claimant that the current holder, i.e. the Respondent, has been registered since June 5, 2021, but in communication with the Center indicated that the current holder was registered on December 30, 2022. This discrepancy is not relevant for the legal analysis of the matter, for reasons that will be set out below and the question of the exact date of allocation of the disputed domain name to the Respondent may remain open.

The Respondent has submitted documents indicating that its founder and managing board member may have acquired the disputed domain name as early as April 9, 2017 and held it until its allocation to the Respondent.

At the time of filing of the Request, the disputed domain name resolved to a parking page with sponsored links. Some of the sponsored links led to websites offering products directly competing with the Claimant’s products.

At the time of the decision, the Expert observed that the parking page to which the disputed domain name redirects also contains the following statement: “The domain uyn.ch is for sale!”.

#### **5. Parties’ Contentions**

##### **A. The Claimant**

The Claimant alleges that the Respondent registered a domain name that is identical, or at least confusingly similar, to the Claimant’s prior UYN trademark.

According to the Claimant, the disputed domain name redirects consumers to a parking page with pay-per-click links to third-party websites promoting competing products.

The Claimant argues that the disputed domain name is used to mislead internet users into believing that there is an affiliation or connection with the Claimant for commercial gain, diverting traffic away from its official website.

The Claimant considers this commercial use of the disputed domain name to create a likelihood of confusion, which constitutes trademark infringement of its prior UYN trademark rights.

Additionally, the Claimant argues that, although the disputed domain name was first registered before the registration of its UYN trademarks, the Respondent has only held it since June 5, 2021.

Furthermore, relying on an excerpt of 2016 from the Internet Archive's Wayback Machine (showing a blank page), the Claimant asserts that the infringing use began only after the Respondent acquired the disputed domain name.

The Claimant requests that the disputed domain name be transferred to them.

## **B. The Respondent**

The Respondent contends that the disputed domain name was acquired through an auction process by its founder in 2008. In a second part of its response, the Respondent represents that such acquisition was made on April 9, 2017, and that the Respondent's founder has controlled the disputed domain name continuously until its allocation to the Respondent.

The Respondent submits an invoice from Catch Tiger dated April 9, 2017, related to the acquisition of the disputed domain name by its founder via auction, and a communication from the registrar confirming that the disputed domain name has been in the account of the Respondent's founder since June 26, 2017. The Respondent contends that no evidence is available concerning the first acquisition in 2008.

The Respondent further argues that it was created to serve as a contact entity for domain registrations thus avoiding the public exposure of its founder's personal details. The Respondent is of the view that its registration as owner of the disputed domain name does not represent a transfer or change in ownership but rather an administrative measure that its founder took for privacy purposes.

The Respondent considers accordingly that its legitimate ownership of the disputed domain name significantly predates the Claimant's trademark rights under Swiss law.

The Respondent claims that the disputed domain name has been parked continuously with ParkingCrew, which automatically generates advertisements through Google's advertising network. Therefore, the Respondent represents that it neither selected nor approved the advertisements and had no control over their content. Consequently, it has never intentionally targeted or attempted to exploit the Claimant's trademark, nor has it derived substantial revenue from the pay-per-click (PPC) links.

The Respondent requests that the Claimant's request be dismissed.

## **6. Procedural issues**

Both parties submitted unsolicited additional filings, the last of which after the Response deadline.

The Rules of procedure do not address the issue of supplemental filings.

The Expert, exercising her discretion, decides to accept the additional filings of the parties as they are relevant to the case.

## **7. Discussion and Findings**

According to paragraph 24(c) of the Rules of Procedure, 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 law of Switzerland (in disputes over a domain name under the ccTLD ".ch").

The Rules of Procedure, paragraph 1, define a “right in a distinctive sign” as any right recognised by the legal system devolving from the registration or use of a sign, which protects the holder of the right from infringement of his interests as the result of registration or use of an identical or similar sign by third parties, including, but not limited to, the right in a registered business name, a personal name, a trademark, a geographical indication and the defensive rights devolving from the law on unfair competition.

According to paragraph 24(d) of the Rules of Procedure, a clear infringement of an intellectual property right exists when:

- i. 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
- ii. the respondent has not conclusively pleaded and proven any relevant grounds for defence; and
- iii. 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 is the owner of an international registration no.1384243 for the mark UYN (fig.) designating Switzerland in class 25 and 35.

The Claimant has provided sufficient evidence that it has a right in a distinctive sign protected in Switzerland, in accordance with paragraph 24(d)(i) of the Rules of Procedure.

#### **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**

According to Article 13(2) in connection with Article 3(1) of the Swiss Act on the Protection of Trademarks and Indications of Origin (“Trademark Act”), the owner of an earlier trademark may prohibit third parties from using identical or similar signs for goods or services identical or similar to those covered by the earlier trademark where there is a likelihood of confusion. When the sign is identical to the earlier trademark and is used for identical goods or services, no likelihood of confusion is required.

According to the case law of the Swiss Federal Court, the use of a domain name that is identical or similar to a protected trademark in connection with a website offering identical or similar goods constitutes trademark infringement (see, for example, the decisions of the Swiss Federal Court 4C.31/2004 <riesen.ch> and 4C.341/2005 <swiss-life.ch>).

The disputed domain name reproduces the word element of the Claimant's distinctive trademark UYN in its entirety, save for the figurative elements of the trademark consisting only of a special font. Therefore, the disputed domain name is identical or at least highly similar to the Claimant's trademark.

The Respondent has used the disputed domain name in connection with a parking page containing pay-per-click (PPC) links resolving to websites offering sports clothing and footwear (e.g., “Trail Running”), i.e. goods directly competing with – and highly similar to - the Claimant's goods. Experts have admitted that use of a domain name identical or similar to a trademark in relation to a parking page displaying commercial pay-per-click links constitutes trademark infringement when a risk of confusion arises (see Bulgari S.p.A. v. Registration Private, WhoisGuardService.com / S. H., Two Stooges LLC, WIPO Case No. DCH2021-0005).

It remains to determine whether the Claimant's trademark, registered with effect in Switzerland as of 5 July 2017 (i.e. the priority date of the basis EU application), is an earlier mark in relation to the disputed domain name, within the meaning of Article 3(1) of the Trademark Act.

The allocation date of the disputed domain name is a point of contention. According to the Claimant and SWITCH, the relevant allocation date is the date on which the Respondent was registered as owner of the disputed domain name, namely December 30, 2022 (or June 5, 2021), i.e. a date which falls after the acquisition of the Claimant's trademark rights in Switzerland. According to the Respondent, the relevant allocation date should be the date on which its founder acquired the disputed domain name, i.e. April 9, 2017, a date that predates the Claimant's rights. The Expert observes that the invoice of Catch Tiger, submitted by the Respondent to prove that its founder acquired the disputed domain name on April 9, 2017, presents an inconsistency that may undermine its credibility: it refers indeed to an address in "Tbilisi, Ukraine" (instead of "Tbilisi, Georgia), for which the Respondent did not provide a convincing explanation. That said, it appears that the Respondent's founder did control the disputed domain name since June 26, 2017, a date predating the priority date of the Claimant's mark.

The Expert is inclined to follow the position of the registry SWITCH, which reacted to the Respondent's arguments in an email to the Center stating the following: *"Under Swiss law, a transfer of a domain name is considered to be a new allocation of the domain name and therefore the registration date is the date on which the current holder was registered"*. When the Respondent became the registered owner of the domain name (in 2022 or 2021 as the case may be), a new allocation took place, regardless of the reasons that may have prompted the Respondent's founder to take this step.

That said, even if the Expert was prepared to take into account the date on which the Respondent's founder allegedly acquired the disputed domain name (i.e. April 9, 2017), this would not exclude an infringement of the Claimant's trademark rights. Indeed, under Swiss law, the mere registration of a domain name does not confer intellectual property rights to its holder, according to the prevailing *numerus clausus* of intellectual property rights (Adrien Alberini/Alain Alberini, *Le droit suisse des noms de domaine*, Zurich 2019, pages 43-44). Furthermore, bad faith (whether at the time of registration or later) is not a condition of a trademark infringement under Swiss law.

To determine whether a trademark infringement exists, it is necessary to examine how (i.e. for which goods/services) and since when a domain name was used. If use for similar goods or services commenced before the registration of a similar or identical trademark, the first user may be protected from a finding of infringement and be allowed to continue use. Indeed, Article 14(1) of the Trademark Act provides that the owner 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 the trademark application. The mere registration of a domain name does not constitute a first use (Adrien Alberini/Alain Alberini, *Le droit suisse des noms de domaine*, Zurich 2019, page 104).

In the present case, there is no evidence – and the Respondent does not allege – that it commenced the use of the disputed domain name before July 5, 2017, the priority date of the Claimant's mark. The Respondent may therefore not avail itself of the protective effect of Article 14 of the Trademark Act.

As mentioned above, the Expert finds that there is an identity, or at least a high similarity, between the products claimed in the Claimant's trademark registration and the products promoted via PPC links on the website connected to the disputed domain name, namely, sports clothing and footwear. The disputed domain name is identical to the word element UYN of the Claimant's mark, which has no perceivable meaning and is therefore distinctive for the concerned goods.

Due to the high degree of similarity between the Claimant's trademark and the disputed domain name, the Expert concludes that the use of the disputed domain name in connection with a parking page featuring links to websites offering similar goods creates a likelihood of confusion, thereby infringing upon the Claimant's rights. This is clearly a trademark infringement under Swiss law.

### **C. The Respondent has not conclusively pleaded and proven any relevant grounds for defence**

The Respondent has not submitted any evidence supporting the claim that it has a stronger right to the disputed domain name or a relevant ground for defence.

As mentioned above, the Respondent has not pleaded or proven that it (or its founder) started use of the disputed domain name before the Claimant obtained trademark rights in Switzerland. Indeed, the Respondent has not alleged or demonstrated any prior use of the disputed domain name before the registration of the Claimant's international trademark on October 19, 2017 with a priority date of July 5, 2017.

In the Expert's opinion, the Respondent's claim that the PPC links are automatically generated by the parking service provider is not a valid defence. According to Swiss law, bad faith is not a requirement for finding trademark infringement. Furthermore, the Respondent cannot ignore how the parking service it has itself subscribed to functions, and the Respondent at the least accepted the possibility of a trademark infringement.

Since the Respondent has not presented any conclusive grounds for defense that would rebut the Claimant's representations or justify its own legitimate interest, and considering the submissions, the Expert finds that the Claimant has fulfilled the conditions of paragraphs 24(c) and (d) of the Rules of procedure.

As a result, the Expert finds that the transfer of the disputed domain name to the Claimant is justified.

## **8. Expert Decision**

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

**Anne-Virginie La Spada**

Expert

Dated: May 26, 2025