

EXPERT DECISION

Petrus v. W. I., I.T.E.N Est.

Case No. DLI2024-0003

1. The Parties

The Claimant is Petrus, France, represented by SELAS Lexington Avocats, France.

The Respondent is W. I., I.T.E.N Est., Liechtenstein.

2. The Domain Names

The dispute concerns the following domain names <chateau-petrus.li>, and <chateaupetrus.li>.

3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 23, 2024. On December 24, 2024, the Center transmitted by email to SWITCH, the ".ch" and ".li" registry, a request for verification in connection with the disputed domain names. On December 27, 2024, SWITCH transmitted by email to the Center its verification response confirming that the Respondent is listed as the holder of the disputed domain names 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 January 7, 2025. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was January 27, 2025.

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

On February 5, 2025, the Center notified the Claimant accordingly, who on February 10, 2025, 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 February 13, 2025, 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.

4. Factual Background

The Claimant is a French winery, commonly referred to as Château Petrus.

The Claimant owns numerous trademark registrations in several jurisdictions, including:

TRADEMARK	JURISDICTION	REGISTRATION NUMBER	REGISTRATION DATE	INTERNATIONAL CLASS
PETRUS	International Registration covering in particular Switzerland and Liechtenstein	535376	February 23, 1989	33
PETRUS POMEROL Grand Vin (figurative)	International Registration covering in particular Switzerland and Liechtenstein	620471	May 26, 1994	33

The Claimant holds several domain names containing the term “petrus”, among them <chateaupetrus.eu>, <chateau-petrus.eu>, <chateaupetrus.fr>, and <chateau-petrus.fr> which hosts its main website.

The Respondent did not file a Response.

The disputed domain names were registered on July 28, 2024.

The disputed domain names do not resolve to an active website.

5. Parties' Contentions

A. The Claimant

The Claimant contends as follows:

Château Petrus is one of the most prestigious wineries in the world and its trademark PETRUS has been recognized as a well-known trademark.

The allocation and use of the disputed domain names infringes the Claimant's rights in distinctive signs under the laws of Switzerland and Liechtenstein, notably of article (art.) 13 of the Swiss Trademark Protection Act (“TPA”).

The disputed domain names are confusingly similar to its PETRUS trademark, because they incorporate this trademark in its entirety, and the addition of the term “chateau” is not sufficient to prevent a finding of confusing similarity, considering that the Claimant and its wines are commonly referred to as “Château Petrus”.

The Claimant alleges that Swiss and Liechtenstein laws provide remedies if the registrant aims to block the rightful owner from using the respective domain names.

The Respondent has no rights or legitimate interests in respect of the disputed domain names. The trademark PETRUS has been extensively used to identify the Claimant and its prestigious wines. The Respondent has not been authorized by the Claimant to use this trademark. The Claimant sent a warning letter to the Respondent, but it did not receive a response.

The disputed domain names were registered in bad faith because it is obvious that the Respondent had knowledge of both the Claimant and its well-known trademark PETRUS at the time it registered the disputed domain names. "Château Petrus" cannot designate anyone else than the Claimant's estate.

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 Liechtenstein.

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 or Liechtenstein

The Claimant has shown that it owns trademarks protected in Switzerland and Liechtenstein the Expert finds that the first condition is satisfied.

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 PETRUS and the disputed domain names. 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. 13 paragraphs 1 and 2, and art. 3 para. 1 TPA).

Because the disputed domain names include the Claimant's trademark in its entirety, and the Claimant is commonly referred to as "Château Petrus", there is confusing similarity between the Claimant's trademark PETRUS and the disputed domain names, the condition of similarity between the signs is therefore met.

For there to be trademark infringement, the disputed domain names must be used for goods or services that are identical or similar to the goods or services claimed by the Claimant's trademark. The Claimant does not allege any such use, because the disputed domain names are not actively being used, and the Claimant has neither alleged nor demonstrated that they had been actively used in the past. In other words, none of the goods claimed by the Claimant's trademark are offered under the disputed domain names.

The mere registration or ownership of an inactive domain name does not constitute trademark use, and therefore an infringement, within the meaning of the TPA (decision of the Swiss Federal Court of 8 November 2004, 4C312004, “riesen.ch”). In other words, by registering the disputed domain names without using them for goods that are identical or similar to those claimed by the Claimant’s trademark, the Respondent is not committing a trademark infringement under art. 3 and 13 TPA.

The Claimant stated that it fears that the disputed domain names may be used to create confusion and/or for fraudulent purposes. However, the Claimant has not provided any evidence showing that the disputed domain names are intended to be used for goods that are identical or similar to those claimed by the trademark at issue (see Mondini/Zollinger Löw, in SIWR III/2, Basel 2019, p. 181).

Therefore, there has been no infringement of the Claimant’s trademark within the meaning of art. 3 and art. 13 TPA.

Finally, the Claimant alleges that the trademark PETRUS is a well-known trademark. However, this does not mean that any use of the disputed domain names would necessarily infringe the Claimant’s trademark rights. Article 15 of the TPA provides 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 potential use for goods or services would meet any of these conditions. Moreover, the Respondent could also use the disputed domain names for noncommercial 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 trademark infringement within the meaning of Art. 3, 13, and/or 15 TPA in this case.

B.2 Unfair Competition Law

The Claimant also alleges that Swiss and Liechtenstein laws provide remedies if a registrant aims to block the rightful owner from using the respective domain name. Indeed, according to an acknowledged interpretation of the law, registering without a legitimate interest a domain name corresponding to a third party’s distinctive sign in order to hinder the rightful owner from adopting such a domain name constitutes an unfair impediment which infringes Art. 2 of the Swiss Unfair Competition Act (“UCA”), even if the registrant does not actively use the respective domain name (see Mondini/Zollinger Löw, in SIWR III/2, Basel 2019, p. 186 with reference to several Swiss court decisions).

In the present case, considering that the Claimant’s wines are known as “Château Petrus”, it is obvious that the Respondent had both the Claimant and its well-known trademark PETRUS in mind when it registered the disputed domain names. The fact that the Respondent registered two domain names under the country code Top-Level Domain “.li” in the same format as used by the Claimant e.g. under the country code Top-Level Domains “.fr” and “.eu” (i.e. with and without hyphen) and moreover did not reply to the Claimant’s warning letter, strongly indicates that the Respondent registered the disputed domain names without legitimate interests in order to hinder the Claimant from registering such domain names for Liechtenstein.

The Panel therefore concludes that the Respondent’s conduct constitutes a clear infringement of a distinctive sign pursuant to art. (2) UCA. The Respondent has not provided any grounds for defense, and the infringement justifies the transfer of the disputed domain names.

7. Expert Decision

For the above reasons, in accordance with paragraph 24 of the Rules of Procedure, the Expert orders that the domain names, <chateau-petrus.li> and <chateaupetrus.li> be transferred to the Claimant.

/Andrea Mondini/
Andrea Mondini
Expert
Dated: February 18, 2025