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Swiss court prevents the implementation of a WIPO domain name decision  
(Article by Thomas Widmer, LALIVE, Geneva, Switzerland)

Domain names with the “.ch” extension are governed by specific rules which provide that transfer requests submitted to the WIPO Arbitration and Mediation Center shall be granted if the registration 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 Zurich-based company Comparis.ch AG is one of the biggest providers of internet comparison services in Switzerland. It holds several “Comparis” Swiss and international trademarks and has frequently had recourse to the WIPO Arbitration and Mediation Center to obtain the transfer of domain names which Comparis.ch AG believes are in breach of its trademarks.

By way of example, Comparis.ch AG's complaints have been admitted as regards “compais.ch” (DCH2008-0029), “comparsi.ch” (DCH2010-0037) and “compare.ch” (DCH 2009-0030), but denied for “comparer.ch” (DCH2011-0040).

By decision dated 6 March 2011 (DCH2010-0031), a WIPO sole panelist ordered the transfer of the “comparez.ch” (i.e. the imperative form of the verb “to compare”, in French) domain name in favor of Comparis.ch AG, on the following grounds:

First, Comparis.ch AG held valid Swiss trademarks comprising the “comparis” word registered in relation with, *inter alia*, internet comparison services. Second, the services offered under the “comparez.ch” domain name were similar to those services and third, there was a risk of confusion between the complainant's trademarks and the respondent's domain name since internet users would not — except for the French speaking ones — understand “comparez” as the imperative form of the verb “to compare”, and would rather pronounce both signs in a similar way.

Whereas the issuance of such a decision would have meant the end of the story for the large majority of the domain disputes decided by the WIPO Arbitration and Mediation Center, the respondent initiated legal proceedings before the Court of Commerce of the Canton of Zurich (the “Court”) requesting a ruling that the respondent had not, by registering and then using the litigious “comparez.ch” domain name, breached the complainant's rights.

The respondent's claim was granted on 10 April 2013 with the effect that the WIPO decision DCH2010-0031 will not be implemented — and thus that the “comparez.ch” domain name will not be transferred to Comparis.ch AG.

In a nutshell, the Court considered that as the “comparez.ch” website was in French, it was primarily directed to French speaking internet users and that the “compar” root shared by both “comparis” and “comparez” was descriptive in relation with internet comparison services.

The Court also held that even if the distinctive force of the “comparis” trademarks had been increased through intensive use in Switzerland, that was not sufficient to extend the scope of protection of said trademarks to a descriptive word such as “comparez”.

The Court reasoned that the “compar” root must remain available for third parties regardless of the level of recognition of the “comparis” trademarks in Switzerland, i.e. that “compar” could not be monopolized in relation to internet comparison services even if it had acquired a secondary meaning.

Such an “absolute need of availability” (“besoin absolu de disponibilité” in French, “absolutes Freihaltebedürfnis” in German) has been admitted by Swiss courts as regards the “Post” word in relation with postal services and the star ranking system in relation with accommodation services, but denied for the “M” capital letter with respect to chocolates as well as for the “Radio Suisse Romande” (literally “French-speaking part of Switzerland radio”) combination regarding radio broadcasting — see decision of the Swiss Supreme Court dated 30 November 2009, 4A\_434/2009.

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