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Swiss law: The Emirates Airline company gets back the www.emirates.ch domain
(Article by Thomas Widmer, LALIVE, Geneva, Switzerland)

As previously reported in the AIPPI E-News (n° 28), inactive domain names cannot, under Swiss law, infringe trademark rights, save in the particular case of “well-known” trademarks. Similarly, inactive domain names cannot breach company name rights (Alberini/Guillet, *L'incidence du contenu du site internet dans les litiges en matière de noms de domaine*, in sic! 2012, 305, 313). Indeed, art. 956 of the Swiss Code of Obligations (“SCO”) only protects registered company names against use by third parties of identical or similar signs which are used in the capacity as company names also. Use of a company name for different purposes, such as a sign to identify products or services instead of a company, is not covered by art. 956 SCO (decision of the Civil Court of Canton Vaud dated 4 December 2012, n° 140/2012/PBH, para 3b; WIPO UDRP decisions DCH2008-0025, DCH2007-0006 and DCH2005-0012; F. Dessemontet, *La propriété intellectuelle et les contrats de licence*, Lausanne 2011, § 619).

However, inactive domain names may violate Swiss unfair competition law, provided that the registrant's behaviour constitutes an active disruption of the complainant's business interests and activities. This can be the case if the registrant prevents, without legitimate interest, the complainant from reflecting its trademark or (business) name as a domain name.

In this regard, one could question what if the complainant was able to reflect its trademark or (business) name under a TLD other than the “.ch” (Swiss) one? This can be, depending on the circumstances, either seen as evidence that the registration of the litigious domain name is not unfair (DCH2007-0006), or the opposite: “It is obvious that Claimant has a genuine interest in using the Domain Name for Switzerland, since it (...) uses the second level domain (...) in several countries” (DCH2011-0024).

In the WIPO UDRP www.emirates.ch case (DCH2013-0018) under scrutiny, the domain was inactive when the complaint was filed.

The WIPO expert, first, rightly confirmed that art. 956 SCO was not applicable since the complainant's “Emirates” company name was not registered in Switzerland. However, the expert stressed that the complainant could rely on art. 8 of the Paris Convention for the Protection of Industrial Property, which applies to foreign company names that are known in Switzerland thanks to a notable use or because they enjoy a worldwide reputation (decisions of the Swiss Supreme Court, 4A_92/2011, para 5.1 and 4A_253/2008, para 5.1). These companies are protected against an infringement of their personal names under Swiss law.

The WIPO expert then held that, similar to the above mentioned principles of unfair competition, preventing a third party to register a domain name under its own name constitutes an impairment of that party's right to its name.

Since the “Emirates” company name had been intensively used in Switzerland and that the registrant of the litigious domain name did not conclusively plead and prove any relevant interest in said domain name, the WIPO expert decided that the complainant's right over its personal name had been breached.

The expert thus ordered the transfer of the “www.emirates.ch” domain name in favour of the Emirates airline company.

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