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SWITZERLAND: Danone Fails to Obtain Transfer of the Domain Name *activia.ch*

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On November 9, 2009, a WIPO expert denied the transfer of the domain name *activia.ch* to Compagnie Gervais Danone (Danone), French producer of the ACTIVIA dairy products. (*Compagnie Gervais Danone v. B EX AG*, Case No. DCH2009-0014, available at www.wipo.int.)

French food products producer Danone is the owner of the ACTIVIA brand, for probiotic dairy products. It owns various International Registrations for the trademark ACTIVIA in Classes 29, 30, 32 and 38, with protection in Switzerland, and for domain names containing “*activia*.”

The domain name at issue was used by the company B EX AG, of Zurich, operating in the field of organizing exhibitions. B EX is, inter alia, the owner of the Swiss trademark ACTIVIA, registered in Classes 9, 16, 25, 35 and 41.

Danone subsequently filed a UDRP complaint with WIPO, seeking a transfer of the domain name *activia.ch* and asserting infringement of its famous trademark as well as unfair competition. The firm had already been successful in various ACTIVIA cases before WIPO regarding the domain names *www.activia.fr* (Case No. DFR2007-0030), *activia.com.es* (Case No. DES2009-0032) and *activiaconsulting.com* (Case No. D2008-1678), to name just a few.

Under paragraph 24(c) of the Rules of Procedure for Dispute Resolution Proceedings for .ch and .li Domain Names, the WIPO Panel is required to grant a request for transfer if the registration or use of the domain name constitutes a clear infringement of a right in a distinctive sign that the claimant owns under the laws of Switzerland or Liechtenstein.

The expert held that Danone owned prior rights in ACTIVIA because its trademark was registered earlier in Switzerland. While the marks in question were confusingly similar, the expert turned to the question regarding similarity of the products and services. In order to affirm an infringement, the content of the domain name must be taken into account. The expert found no similarity between the organization of exhibitions and foodstuffs. In addition, he denied that Danone’s ACTIVIA trademark was famous, holding that foreign decisions regarding the famous status of the mark and the submitted market research were not conclusive and that the mark was not yet famous in Switzerland.

With regard to the allegation of unfair competition, the expert held that there were no suggestions of an unfair exploitation of Danone’s trademark. He held, further, that B EX AG’s registration did not amount to an unfair blocking of the domain name *activia.ch* for dairy products, as Danone did not establish that it sold its products mainly via the Internet. Therefore, the transfer of the domain name was denied.

Although every effort has been made to verify the accuracy of items carried in the INTA Bulletin, readers are urged to check independently on matters of specific concern or interest.

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