Decision for dispute CAC-UDRP-106195

Case number	CAC-UDRP-106195
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Domain names	patekphillippe.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	PATEK PHILIPPE SA GENEVE

Complainant representative

Organization	Cabinet Vidon, Marques & Juridique PI

Respondent

Organization	DOMAIN FOR SALE CHECK AFTERNIC.COM

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has filed various corresponding trademarks worldwide, including amongst many others:

- International trademark registration for “PATEK PHILIPPE” No. 394802 in classes 9 and 14, owned by PATEK PHILIPPE SA GENEVE, filed on 21 December 1972, designating Austria, Bulgaria, Benelux, Czech Republic, Germany, Egypt, Spain, France, Hungary, Italy, Morocco, Monaco, Portugal, Romania, Slovakia, Slovenia, Syria, and Viet Nam;

- Swiss trademark registration for “PATEK PHILIPPE” No. 06393/1992 in classes 9, 14, 16 and 34, owned by PATEK PHILIPPE SA GENEVE, filed on 28 August 1992; and

- Hong Kong trademark registration for "PATEK PHILIPPE" No. 19710972 in class 14, owned by PATEK PHILIPPE SA GENEVE, filed on February 11, 1971.

The Complainant has registered the domain names <patek.com> and <patekphilippe.com>, leading to the PATEK PHILIPPE Official website, since March 7, 1996.

The Complainant also own rights to PATEK PHILIPPE SA GENEVE as a company name, the company being registered since 1901.

FACTUAL BACKGROUND

The Complainant, PATEK PHILIPPE SA GENEVE is one of the most recognized companies in the history of Swiss watchmaking industry, being many times awarded for both its innovations and designs.

The manufacture was founded in 1839 and the name “PATEK PHILIPPE” has its origin in the name of two of the founders: Antoine Norbert de Patek and Jean-Adrien Philippe, and has risen to the top of the luxury watch industry under the “PATEK PHILIPPE” trademark.

As one of the last independent, family-owned watch manufacturers in Geneva, the Complainant offers connoisseurs high-end watches and accessories around the world.

The company maintains over 300 retail locations globally and a dozen distributors across America, Asia (notably in Hong-Kong), Europe, etc.

The trademark “PATEK PHILIPPE”, used to designate the Complainant’s goods, is worldwide famous.

It results from all the above mentioned that PATEK PHILIPPE SA GENEVE has become, under the brand “PATEK PHILIPPE”, a leading brand in the field of High-End Watchmaking industry.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT:

This Complaint is based on the following grounds:

- The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

As it may be noticed from the Whois information, The disputed domain name <patekphillippe.com> is composed of:

- A root reproducing nearly identically, except for the adding of one more letter “L” the entire combination of words trademarks “PATEK PHILIPPE”.
- Associated with the Top Level Domain “.com”

It shall first be reminded that, as per constant Case Law, and as specific within WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), the Top Level Domain “is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.”

To illustrate this item, one may quote the Case n° D2015-0565, in relation to the domain name <sapteq.com>, within which it has been acknowledged that “the mere addition of the gTLD “.com” is insufficient to differentiate a disputed domain name from a mark as it is a technical requirement of registration.”

Also, it results that the elements to be taken into account in the course of the first UDRP criteria, namely determining whether the domain name is confusingly similar to a trademark or service mark in which the Complainant has rights, is the domain name’s root “patekphillippe”, compared to the Complainant’s trademarks “PATEK PHILIPPE”.

Concerning the root <patekphillippe>, it shall be noted that, as per constant Case Law, a domain name which wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for the purpose of the UDRP. Furthermore, the addition of letter in a trademark is not of the nature of discarding a likelihood of confusion. In fact, the addition of a letter (and notably as at stake to duplicate a letter) characterize typosquatting acts.

For example, in the decision Case N°CAC-UDRP-105843, according to which: “The Panel is of the opinion that the addition of the letters R and T do not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy. The addition of the letters is a model example of typo squatting, targeting internet users who make typos whilst looking for the Complainant.”

This assertion is even more true here insofar the element “PHILIPPE” may have many alternative spellings. In addition, the pronunciation of the disputed domain name will be strictly identical to the Complainant's trademark.

Yet, the Complainant believes that a consumer confronted with the contested domain name will certainly believe it is owned by the Complainant, considering the phonetic identity, the optical similarity and the conceptual identity.

Furthermore, with regard to the use of the Complainant’s entire name, in decision n° CAC-UDRP-105732 relating to the <lesechos.com> domain name, the Panel found that “The Panel follows in this respect the view established by numerous other decisions that a domain name which wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for the purposes of the UDRP”.

Consequently, the reservation of a domain name which root is composed of both these elements merely aims to create confusion and pretend to be somehow affiliated with the Complainant's. The domain name's root <patekphillippe> reproduces identically and entirely the complainant's trademarks "PATEK PHILIPPE", name under which the trademark is known and used by the relevant public at an international level. Therefore, it creates a likelihood of confusion for consumers.

This likelihood of confusion is emphasized by the circumstance that the Complainant's trademark elements "PATEK PHILIPPE" does not have any particular meaning in relation to the products covered, unless referring to the founding partners of the Complainant, and must, therefore, be considered as distinctive. It should also be added that this trademark enjoys a great reputation worldwide and is well known by consumers internationally, in the field of fine watchmaking. Consequently, its reproduction can even less be a coincidence, and also characterizes the reproduction or at least the imitation of the Complainant's trademarks.

It shall therefore be taken into account that the domain name is highly confusingly similar to trademarks, domain name and company name in which the Complainant has rights.

- The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Complainant owns trademark rights on the sign "PATEK PHILIPPE" at least since 1949.

The Complainant has given no authorization to the Respondent, in any form, to use the sign "PATEK PHILIPPE", nor to register a domain name including Complainant´s trademarks.

It shall also be noted that the Respondent is not making any legitimate use of the disputed domain name. Indeed, the latter does not lead to any active website, but rather to an inaccessible web page that does not provide any content at all.

The CAC has recently acknowledged that the default of active website with true content cannot be considered as a legitimate interest of the domain name or fair use of the disputed domain name. As an example, the Czech Arbitration Court recently decided, in the decision CAC-UDRP-105767 about <zadigetvoltaire-outlet.com>, that: "In addition, the disputed domain name redirects to an inactive page. The Panel agrees that such use is not a legitimate use […]. For the foregoing reasons, it shall be concluded that the Respondent has no right nor legitimate interest in respect of the disputed domain name […].

- The disputed domain name was registered and is being used in bad faith

The domain name <patekphillippe.com> has been registered and is being used in bad faith, which may be demonstrated through the fact that the Respondent knew, or at least should have known, about the Complainant's trademark rights, due to its wide scope of activities and well known character.

The sign "PATEK PHILIPPE" is widely protected as a trademark, and notably in Hong Kong, and from the elements within the Complainant's website, it is also widely used, due to the large network of retailers including in Hong Kong where there are 11 authorized retailers.

One may therefore infer that the Complainant's trademarks were known, or at least should have been known by the Respondent, due to the fact that the "PATEK PHILIPPE" trademarks are widely filed, registered and used including in the territory of the Respondent. Moreover, "PATEK PHILIPPE" appears to be an unusual patronymic name as this sign has no link with the goods and is therefore highly distinctive.

It has been acknowledged within WIPO Arbitration Center's and Czech Arbitration Court´s Case Law that the fact that the Respondent knew or should have known about the Complainant's rights may constitute bad faith.

The outcome of the above mentioned is that the Respondent merely registered the domain name <patekphillippe.com> with the aim of preventing the Complainant to obtain the domain name, almost identical to its trademark and in association with the common and generic extension <.com>.

Moreover, the disputed domain name currently does not resolve to an active website but to a parking website. Indeed, while the webpage associated with the domain name <patekphillippe.com> doesn't depict any information on activities of the Respondent, it shall be noticed that the Respondent seems to have intentionally attempted to attract, for commercial gain, Internet users to its website by creating a confusion with the Complainant's trademark. In other words, the Complainant believes that the Respondent has registered the disputed domain name to target the Complainant's clientele, so the registration of the disputed domain name was conducted in bad faith.

In that sense, it shall be noted that the absence of use in connection with an active website would not prevent a finding of bad faith under the doctrine of passive holding.

Factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). (See section 3.3 of the WIPO Overview 3.0.).

The Complainant argues that the following aspects are present in this case:

- the complainant's trademark "PATEK PHILIPPE" is coined, and yet enjoys a high degree of distinctiveness. Indeed, the Complainant's trademark is reproduced in its website and enjoys a well-known reputation in the field of fine watchmaking all over the world.
- the disputed domain was registered since 16 March 2023 and appears never to have been used. In fact, a search on the Wayback Machine, a website that allows one to retrieve screenshots of website archives, even mentions that the URL <patekphillippe.com> has never been archived. Yet, the Complainant believes that the respondent will certainly fail to submit evidence of good-faith use.

The Complainant asserts that, in this type of situation, namely the registration of a fraudulent domain name, it is not uncommon for the registrant to also create a fraudulent e-mail address linked to the website through an “MX server”.

Therefore, in the case of <patekphillippe.com>, even though no e-mail address using the contested domain name has been created and made available to the users of the contested domain name yet, this kind of manoeuvre would be very easy to set up and configure by the Respondent. Consequently, all risks cannot be ruled out. Those circumstances only increase the implausibility of the Respondent’s good faith.

It can also be noticed from website afternic.com that the contested domain name is offered for sale at a starting price of $968. However, current registration costs of such a domain name are way lower than this offer.

In this context, the Complainant strongly believes that the domain name has been registered with the aim of making a profit by reselling the domain name. Such an act should be taken as evidence that the domain name has been registered in bad faith.

Last but not least, the Complainant found that the Respondent Isaac Goldstein, DOMAIN FOR SALE CHECK AFTERNIC.COM, has previously been the Respondent in numerous UDRP procedures. A pattern can be noticed: the contested domain names are reproducing famous trademarks or at least trademarks known by the public at large, are registered within the same registrar (DropCatch.com) by the same Respondent e.g. Isaac Goldstein, DOMAIN FOR SALE CHECK AFTERNIC.COM, residing in Hong Kong. For all these cases, Panels decided to transfer the domain name to their respective legitimate owners. Aforementioned decisions are dated between 2010 and 2023, meaning the Respondent is registering illegitimate domain name since more than 10 years.

The above is confirmed in the FORUM decision in the case FA1011001360860 “Wells Fargo & Company v. Isaac Goldstein snapnames@isaacgoldstein.com a/k/a Isaac Goldstein” dated January 10, 2011: “Respondent has previously been the respondent in multiple other UDRP proceedings in which the disputed domain names were transferred to the respective complainants. See, e.g., Wells Fargo & Co. v. Goldstein, FA 1321448 (Nat. Arb. Forum June 9, 2010); Zevex, Inc. v. Goldstein, FA 1323005 (Nat. Arb. Forum June 15, 2010); Gedex Inc. v. Goldstein, FA 1332191 (Nat. Arb. Forum Aug. 11, 2010). The Panel finds that such a history of adverse UDRP decisions is evidence that Respondent has a pattern of registering domain names which misappropriate third-party trademarks. The Panel concludes that this pattern demonstrates bad faith registration and use pursuant to Policy ¶ 4(b)(ii)”.

As noted, the FORUM itself has found the Registrant is a serial cyber squatter, leaving no doubt the current contested domain name was registered under bad faith.

Considering the above, it shall necessarily be retained that the domain name has been fraudulently reserved by a third party having no link whatsoever with the Complainant.

For all the foregoing reasons, the Complainant alleges that the disputed domain name was registered and is used in bad faith.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

This is a case of typo squatting adding an extra "l" in "phillippe" in the trademark PATEK PHILIPPE and domain name <patekphilippe.com>. The PATEK PHILIPPE trademark is a well-known trademark and in respect of the well-established practice that the specific top level of a domain name such as “.com” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar, it is found that <patekphilippe.com> and <patekpillippe.com> are to be considered confusingly similar.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in

bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

Given the circumstances of the case, including the provided information of the use and well-known character of the Complainant's trademark PATEK PHILIPPE and the distinctive nature of this mark, it is inconceivable to the Panel in the current circumstances that the Respondent registered the disputed domain name without prior knowledge of the Complainant and the Complainant's mark. The Panel, therefore, finds that the disputed domain name was registered in bad faith.

The disputed domain name does not currently resolve to an active website. In this case the Complainant has however evidenced that the Respondent has used the domain name to create confusion with Complainant's trademarks for commercial gain by using the confusingly similar domain name to resolve to a website offering the domain name for sale for a price exceeding the registration costs.

It is inconceivable and not contradicted by the Respondent that the Respondent can use the disputed domain name for good faith use of the disputed domain name. The Panel notes in this connection that passive holding of a domain name does not prevent a finding of bad faith use under paragraph 4(a)(iii) of the Policy.

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1. The three essential issues under the paragraph 4(a) of the Policy are whether:

   i. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

   ii. the Respondent has no rights or legitimate interests with respect to the disputed domain name; and

   iii. the disputed domain name has been registered and is being used in bad faith.

   2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning the disputed domain name, namely the WHOIS databases.

   3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

   4. The Panel therefore came to the following conclusions:

   a) The Complainant states and proves that the disputed domain name is confusingly similar to its trademarks and its domain names. Indeed, the trademark is partially incorporated in the disputed domain name.

   The disputed domain name is therefore deemed confusingly similar.

   b) The Respondent is not generally known by the disputed domain name and have not acquired any trademark or service mark rights in the name or mark, nor is there any authorization for the Respondent by the Complainant to use or register the disputed domain name.
   The disputed domain name is not being used actively. Therefore, the Panel did not find any legitimate use nor rights on the Respondent to the trademark PATEK PHILLIPPE.

The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the disputed domain name.

c) It is clear that the Complainant's trademarks and website(s) were used by the Complainant long time before the disputed domain name was registered. There is no present use of the disputed domain name but it is evidenced that the disputed domain name is used to resolve to a website offering the domain name for sale for a price exceeding the cost of the registration. The Respondent has repeatedly been involved in, and lost, domain name disputes based on a similar pattern as this case concerning typo squatting of well-known trademarks. It is concluded that the Respondent makes bad faith use of the disputed domain name.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **patekphillippe.com**: Transferred

PANELLISTS

Name	**Lars Karnoe**

DATE OF PANEL DECISION 2024-02-22

Publish the Decision