Decision for dispute CAC-UDRP-106181

Case number	CAC-UDRP-106181
Time of filing	2024-01-30 11:13:28
Domain names	patek-philippe.store

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

Name	Wen Jun Yan

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 Complainants 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 December 21, 1972, designating Austria, Bulgaria, Benelux, Czech Republic, Germany, Egypt, Spain, France, Hungary, Italy, Morocco, Monaco, Portugal, Romania, Slovakia, Slovenia, Syria, and Vietnam;
- Swiss trademark registration for “PATEK PHILIPPE” No. 06393/1992 in classes 9, 14, 16 and 34, owned by PATEK PHILIPPE SA GENEVE, filed on August 28, 1992.

The Panel also notes the Complainant’s evidence of its extensive portfolio of registered trademarks in over 80 countries, with the trademark “PATEK” or “PATEK PHILIPPE” registered in 1958. The Complainant asserts that it owns trademark rights on the sign “PATEK PHILIPPE” at least since 1949.

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

FACTUAL BACKGROUND

The Complainant is one of the most recognized companies in the 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 “PATEK PHILIPPE” trademark.

The Complainant is also a company name, the company being registered since 1901.

The Complainant has become, under the brand “PATEK PHILIPPE”, a leading brand in the field of High-End Watchmaking industry. The trademark “PATEK PHILIPPE”, is used to designate the Complainant’s goods and is famous worldwide.

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 Asia and Europe.

The disputed domain name <patek-philippe.store> was registered on March 18, 2021.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

The Respondent failed to file any administratively compliant response.

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).

The Complainant contends that the disputed domain name is identical to its trademark “PATEK PHILIPPE”.

When part of a domain name is identical to a well-known trademark, it increases the likelihood of confusion or association between the domain name holder and the trademark owner. It is, therefore, sufficient to establish identity or confusing similarity for the purposes of the Policy. See Oki Data Americas, Inc. v. ASD, Inc, WIPO Case No. D2001-0902; Dr. Ing. h.c. F. Porsche AG v Vasiliy Terkin, WIPO Case No D2003-003-0888.

The disputed domain name clearly incorporates the Complainant’s trademark “PATEK PHILIPPE” in its entirety. The Panel considers that the addition of the hyphen “-“ in between the word “PATEK” and “PHILIPPE” makes no difference to the overall impression the disputed domain name will create.

The Panel accepts that this increases the likelihood of confusion or association between the holder of the disputed domain name and the Complainant.

The Complainant further contends that the addition of the new gTLD “.store” does not change the overall impression of the designation as being connected to the Complainant’s trademark. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain names associated.

It is now a well-established principle in the domain name space that generic top-level domains such as “.com”, “.org” or “.net” including “.store” do not affect the domain name for the purpose of determining whether it is identical or confusingly similar. See F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., WIPO Case No. D2006-0451; IM Production v Charles Emeka (2022) CAC 104923.

Accordingly, the Panel finds that the disputed domain name is identical to the Complainant’s trademark and that paragraph 4(a)(i) of the Policy is satisfied.

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).

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name.

If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP. See Croatia Airlines d.d. v. Modern Empire Internet Ltd, WIPO Case No. D2003-0455.

The Complainant makes the following assertions:

- It has not given authorization to the Respondent, in any form, to use the sign “PATEK PHILIPPE” nor to register a domain name that included its trademarks.
- The Respondent is not making any legitimate use of the disputed domain name, including not having any active website but rather the disputed domain name is directed to a webpage showing that the disputed domain name is for sale.
- The Respondent has chosen to hide his identity.

The Complainant notes that the disputed domain name was registered on March 18, 2021. The Complaint was filed on January 29, 2024. This is approximately 34 months after the disputed domain name was registered. The Panel considers it curious that the Complainant has led no evidence as to the delay in bringing its case nor explained the delay in its Amended Complaint. The Respondent, on the other hand, has not filed any administratively compliant response either.

The Complainant points out that the disputed domain name is being offered for sale, which supports the contention that this as an indication of the Respondent's lack of rights or legitimate interest.

The Panel considers that general solicitation to sell a disputed domain name provides evidence of a respondent’s lack of rights and legitimate interests in a domain name. See Enterprise Holdings, Inc v Webmaster & Support, Forum Case No. 1562569.

Despite the unexplained delay in bringing its case, the Panel is prepared to consider the following matters in favour of the Complainant: the long-standing rights of the Complainant to its trademarks and its famous reputation worldwide; the lack of any administratively compliant response from the Respondent; the lack of evidence of any legitimate use of the disputed domain name; the disputed domain name being offered for sale; and the use of identical terms “PATEK” and “PHILIPPE” in the disputed domain name.

The Respondent has not filed any administratively compliant response to the Amended Complaint.

Accordingly, the Panel finds the Respondent has no right or legitimate interests in the disputed domain name.

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).

There are two elements that must be satisfied – registration and use in bad faith.

Registration in bad faith

The evidence also shows that the Complainant’s trademark “PATEK PHILIPPE” is a well-known and famous trademark.

Given the distinctiveness of the Complainant's trademark and reputation, and the Respondent’s failure to respond to the proceedings, the Panel accepts the uncontradicted evidence of the Complainant’s well-known and famous trademark.

The Panel considers that it is reasonable to infer that the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark.

Accordingly, it is inconceivable that the Respondent might have registered the disputed domain name identical to or incorporating the Complainant’s trademark “PATEK PHILIPPE” into the disputed domain name without knowing of it.

Use in bad faith

The Panel has already referred to the uncontradicted facts set out in the Amended Complaint and accepts the evidence and contention that the disputed domain name is offered for sale for USD$580.

The Panel observes that the Respondent has not demonstrated any activity in respect of the disputed domain name but rather it has offered the disputed domain name for sale.

Accordingly, it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would be lawful and legitimate.

The Panel accepts the uncontradicted evidence that the Respondent's incorporation of the Complainant's well-known and famous trademark “PATEK PHILIPPE” into the disputed domain name coupled with its offer to sell the disputed domain name supports the Complainant’s contention of registration and use in bad faith. See Citigroup, Inc v Kevin Goodman, Forum Case No 1623939.

The Panel has already alluded to the unexplained delay by the Complainant in bringing its case against the Respondent approximately 34 months after the disputed domain name was registered. While the Panel consider that the doctrine of laches, as an equitable doctrine, can be used as a defence when a party has unreasonably delayed in making its claim, such a defence should

be raised by a respondent in an administratively compliant response.

The Panel is unable to consider any matters in this case that could support such a defence. In any event, the Panel does not consider a delay of approximately 34 months, despite being unexplained, as being an unreasonable delay in the circumstances of this case. The Panel, however, considers that it would be prudent for a complainant to proffer an explanation rather than inadvertently failing to deal with it altogether.

The Panel, therefore, concludes that the Respondent's holding of the disputed domain name in this case satisfies the requirement that the disputed domain name is being used in bad faith by the Respondent.

Accordingly, the Panel finds that the registration of the disputed domain name and its use was in bad faith.

PROCEDURAL FACTORS

Language of proceedings request

Rule 11(a) of the UDRP rules states:

Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

In conducting the administrative proceeding, the Panel is required to ensure under Rule 10 of the UDRP rules that the Parties are treated with equality and be given a fair opportunity to present its case.

The Respondents have not filed any administratively compliant response to the Complainant's Amended Complaint.

The Complainant requests that English should be the language of the proceeding rather than Chinese, for the following reasons:

- Translating the Complaint into Chinese does not guarantee equal footing for the Complainant vis-à-vis the Respondent, and such translation does not ensure the expeditious conduct of the proceeding
- Chinese is barely spoken outside of China whereas English is widely spoken. English is a commonly used language in the course of international cases
- The Respondent is likely to understand English since he or she has put the domain name for sale on a European platform dedicated to do so, name SEDO based in Germany
- The disputed domain name itself is reproducing Latin, and not Chinese characters

On balance, the Panel considers that the proceedings can proceed in the English language given the disputed domain name uses the famous trademarks "PATEK PHILIPPE". It is likely that Respondent can understand the English language, and such a process is unlikely to be onerous on the Respondent.

In the circumstances, the Panel accepts the Complainant's request and considers that it is appropriate to proceed to determine the proceeding in the English language.

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieve actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC's responsibility to achieve actual notice to the Respondent.

On February 23, 2024 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

Neither the written notice of the Complaint nor the advice of delivery was returned to the CAC.

The e-mail sent (in both English and Chinese) to <postmaster@patek-philippe.store> was returned back as undelivered. The e-mail notice was also sent to <wayne423@162.com> but the CAC never received any proof of delivery or notification of undelivery.

No further e-mail address could be found on the disputed site.

The Respondent never accessed the online platform.

Given the reasonable measures employed by CAC as set out in the above non-standard communication, 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

The Complainant owns the registered trademark “PATEK PHILIIPE” and several domain names that includes its trademark which is used in connection with its goods or services for a considerable time. It is a well-known and famous trademark.

The Respondent registered the disputed domain name on March 18, 2021 and commenced this case on January 29, 2024, approximately 34 months after the disputed domain name was registered.

The disputed domain name incorporates the Complainant’s well-known trademark “PATEK PHILIPPE” in its entirety, with a hyphen “-“ separating the terms “PATEK” and “PHILIPPE”, with the new gTLD “.store” added to it.

The Complainant challenges the Respondent's registration of the disputed domain name under paragraph 4(a)(i) of the Policy and seeks relief that the disputed domain name be transferred to the Complainant.

The Respondent has failed to file any administratively compliant response.

For the reasons articulated in the Panel’s reasons above, the Complainant has satisfied the Panel of the following:

- The disputed domain name is identical to the Complainant’s well-known and famous trademark “PATEK PHILIPPE”.
- The Respondent has no rights or legitimate interests in respect of the disputed domain name.
- The disputed domain name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **patek-philippe.store**: Transferred

PANELLISTS

Name	**William Lye OAM KC**

DATE OF PANEL DECISION 2024-03-08

Publish the Decision