Decision for dispute CAC-UDRP-106173

Case number	CAC-UDRP-106173
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Domain names	patekphilippegeneve.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	PATEK PHILIPPE SA GENEVE

Complainant representative

Organization	Cabinet Vidon, Marques & Juridique PI

Respondent

Name	Samy FERRADJI

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 been conducting its luxury watchmaking business activities under the company name PATEK PHILIPPE SA GENEVE since 1901.

The Complainant is owner of an extensive trademark portfolio with registrations for the PATEK PHILIPPE trademark in numerous jurisdictions, including but not limited to the following marks:

- International trademark No. 394802, filed on 21 December 1972, duly renewed, in classes 9 and 14, designating Austria, Bulgaria, Benelux, Czech Republic, Germany, Egypt, Spain, France, Hungary, Italy, Morocco, Monaco, Portugal, Romania, Slovakia, Slovenia, Syria, and Viet Nam;
- Swiss trademark No. 06393/1992, filed on 28 August 1992, duly renewed, in classes 9, 14, 16 and 34.

It is also owner of the domain names <patek.com> and <patekphilippe.com>, both registered since 7 March 1996 and resolving to the Complainant's official website.

FACTUAL BACKGROUND

The Complainant is a family-owned company established under the laws of Switzerland, based in Geneva. It 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 the two founders: Antoine Norbert de Patek and Jean-Adrien Philippe. Over the years, it has risen to the top of the luxury watch industry under the PATEK PHILIPPE trademark.

The Complainant offers connoisseurs high-end watches and accessories around the world. It has over 300 retail locations globally and a dozen of distributors across America, Asia, Europe.

As a result of the Complainant's extensive advertising and promotional efforts, as well as its commercial success, the PATEK PHILIPPE trademark has become one of the most renown trademarks in its field of activity.

The disputed domain name was registered on 6 December 2023 and it does not resolve to any active website. E-mail server (MX) records have been configured in relation to the disputed domain name.

Upon the CAC's verification request, the Registrar identified the underlying registrant as Samy Ferradji, an individual residing in the city of Colmar in France.

The Respondent has not contested the facts asserted by the Complainant, but he has stated that he is not the real registrant of the disputed domain name.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to its trademark, since the PATEK PHILIPPE trademark is incorporated in its entirety and the addition of the geographical term "GENEVE" is not sufficient to escape the finding of likelihood of confusion between the disputed domain name and the Complainant's trademark.

The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not known by the disputed domain name. The Complainant does not have any relationship with the Respondent. The Respondent is neither affiliated with, nor authorized by the Complainant in any way to make any use of the Complainant’s PATEK PHILIPPE trademark or to register the disputed domain name. In addition, the fact that the Respondent chose to hide his identity behind a privacy shield is a proof of a use without bona fide of the disputed domain name.

Finally, the Complainant contends that, given the distinctiveness and reputation of the PATEK PHILIPPE trademark, it is unlikely that the Respondent had no knowledge of the Complainant's mark when he had registered the disputed domain name confusingly similar to such mark. As for the use of the disputed domain name, it does not resolve to any active website but it is enabled to send e-mails potentially for fraudulent (phishing) purposes. It is obvious that any email sent from an e-mail address including @patekphilippegeneve.com could be perceived as originating from the Complainant or at least an affiliated company. Therefore, the configuration of e-mail server records cannot be considered a use in good faith of the disputed domain name.

The Complainant requests the transfer of the disputed domain name.

RESPONDENT:

The Respondent has filed a short declaration, stating that his contact details have been misused for the registration of the disputed domain name, and he has nothing to do with it or with the related website.

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).

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).

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

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to succeed in the administrative proceeding:
(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
(iii) the disputed domain name has been registered and is being used by the Respondent in bad faith.

I. THE COMPLAINANT'S RIGHTS AND THE IDENTITY OR CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S TRADEMARK

In UDRP disputes the test for identity or confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of the first element (paragraph 1.7 WIPO Overview 3.0).

UDRP panels have also consistently found that the adding, deleting, or substituting letters, numbers, punctuation, or other terms, whether descriptive, **geographical**, pejorative, meaningless, or otherwise, to the relevant trademark, recognizable within the disputed domain name, would not prevent a finding of confusing similarity under the first element (paragraph 1.8 of WIPO Overview 3.0).

UDRP panels also agree that the TLD is a technical requirement of the registration and, therefore, is to be ignored for the purpose of determination of confusing similarity between the disputed domain name and the complainant's trademark (paragraph 1.11.1 WIPO Overview 3.0).

In the present case, the Complainant has established that it has rights in the PATEK PHILIPPE trademark since 1972. The Complainant's mark, registered well before the registration of the disputed domain name, is distinctive and well-known worldwide.

The disputed domain name incorporates the entirety of the Complainant's PATEK PHILIPPE trademark and differs from such mark by merely adding the geographical term "GENEVE" (Geneva in French, corresponding to the place of establishment of the Complainant and contained in the Complainant's company name) and the TLD ".COM". The addition of such geographical term to the Complainant's mark neither affects the attractive power of such trademark, nor is sufficient to distinguish the disputed domain name from the Complainant's mark. To the contrary, the use of the geographical term clearly related to the Complainant, its activities and trademark is highly capable to confuse the Internet users and make them believe that the disputed domain name and any related service (website and/or e-mail) belong to the Complainant.

The Panel also acknowledges that the disputed domain name is identical to the Complainant's company name. The likelihood of confusion between the disputed domain name and the Complainant's company name is, therefore, evident.

Consequently, the Panel finds that the Complainant has proven the first element of paragraph 4(a) of the Policy and that the disputed domain name is confusingly similar to the Complainant's trademark.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name. If a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (see 2.1 WIPO Overview 3.0).

The Complainant contends to have no relationship whatsoever with the Respondent. The Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or to register and use the disputed domain name.

No evidence is available that the Respondent, identified by the Registrar in the individual Samy Ferradji, has been commonly known by the disputed domain name or has acquired any rights in a trademark or trade name corresponding to the disputed domain name.

The disputed domain name incorporates the Complainant's trademark plus a geographical term ("GENEVE"), which coincides with

the Complainant's place of establishment and company name, and, thus, is confusingly similar to the PATEK PHILIPPE trademark and suggests affiliation with or sponsorship by the Complainant.

UDRP panels have found that domain names identical or confusingly similar to a complainant's trademark carry a high risk of implied affiliation. A domain name consisting of a trademark plus an additional term at the second- or top-level is seen as tending to suggest sponsorship or endorsement by the trademark owner. Thus, UDRP panels have largely held that such composition cannot constitute fair use.

Although the disputed domain name does not resolve to any active website, the Complainant has shown that the Respondent had configured MX records for the disputed domain name. By connecting e-mail server to the disputed domain name and creating the false impression that it is the Complainant's server, it is implausible that there is any good faith use to which the disputed domain name may be put. The configuration of e-mail service on the disputed domain name that confuses people into thinking that it belongs to the Complainant is likely part of a fraudulent scheme (phishing), such as to obtain sensitive or confidential personal information, or to solicit payment of fraudulent invoices.

Therefore, it is highly unlikely that, before any notice of the dispute, the Respondent used or prepared to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services or is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the PATEK PHILIPPE trademark.

The Complainant has, therefore, established its prima facie case.

Upon receipt of the Registrar's verification revealing the underlying registrant of the disputed domain name, the Complainant made further Internet researches on the Respondent and has submitted the Amended Complaint, containing additional allegations and providing documentary evidence that the Respondent is owner of another domain name. The associated website(s) is(are) offering for sale luxury products, such as cosmetics and perfumery. The Complainant also asserted that the content of the latter website(s) is false and contrary to law.

In turn, the Respondent submitted a short declaration claiming that (literally cited):

"I am not the one who used that domain, as mentioned on the phone with Mrs Olga. I'm sorry for the inconvenience and the confusion. But i am not part of the administrative proceedings, i have nothing to do with the disputed domain name. Somebody used my contact informations, to register that domain name."

In absence of sufficient elements, the Panel is unable to accept as true and reject as false the declaration of the Respondent. It is also out of scope of this proceeding to determine whether the Respondent's use of another domain name or website is lawful or not. However, what is relevant for the present proceeding is that the Respondent has not invoked any of the circumstances that could demonstrate rights or legitimate interests in the disputed domain name. Instead, the Respondent has basically confirmed that he has no rights or interests in the disputed domain name.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of paragraph 4(a) of the Policy, and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

III. THE REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

The disputed domain name has been registered and is being used in bad faith for the following cumulative reasons.

By the addition of the geographical term "GENEVE" to the Complainant's trademark, the Respondent has registered a confusingly similar domain name to the Complainant's PATEK PHILIPPE trademark. Additionally, the disputed domain name coincides with the company name of the Complainant. The Complainant has sufficiently demonstrated that its trademark is renown worldwide.

UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see 3.1.4 WIPO Overview 3.0).

Given the distinctiveness and the reputation of the Complainant's prior mark acquired over the years, it is inconceivable that the Respondent could have registered the disputed domain name confusingly similar to the Complainant's trademark for a mere chance without actual knowledge of the Complainant and its mark and the intention to exploit such reputation by diverting traffic away from the Complainant's website.

Whilst the disputed domain name does not resolve to any active website, MX records have been set which suggests that it may be actively used for fraudulent e-mail purposes.

Taken into account all circumstances of this case, the Panel finds that it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate, such as by being an infringement of the Complainant's trademark under trademark law, a passing off, or an infringement of consumer protection legislation.

The Complainant has, therefore, discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (paragraph 4(a)(iii) of the Policy).

The disputed domain name is to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **patekphilippegeneve.com** : Transferred

PANELLISTS

Name	**Ivett Paulovics**

DATE OF PANEL DECISION 2024-03-13

Publish the Decision