Decision for dispute CAC-UDRP-106208

Case number	CAC-UDRP-106208
Time of filing	2024-02-20 10:16:09
Domain names	patekphilippe.vip

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	NIE PENG

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 owns the trademark rights on the PATEK PHILIPPE trademark at since least 1949, including but not limited to the following registrations:

- International Trademark No. 394802, registered on 21 December 1972, 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 Vietnam;
- Swiss Trademark No. 06393/1992, registered on 21 October 1992, in classes 9, 14, 16, 34.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

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 and Europe. PATEK PHILIPPE SA GENEVE is also a company name registered since 1901.

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

The Respondent appears to be an individual domiciled in Wuhan, Hubei, China.

The disputed domain name was registered on September 27, 2020.

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.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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).

First, the Complainant claims rights in the PATEK PHILIPPE mark through its global trademark registrations. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See Avast Software s. r. o. v Milen Radumilo, 102384, (CAC 2019-03-12).

Second, the Complainant claims that its PATEK PHILIPPE mark does not have any particular meaning in relation to the products covered, unless referring to the founding partners of the Complainant, and must be considered as perfectly distinctive. The disputed domain name reproduces identically and entirely the Complainant's PATEK PHILIPPE trademark which has created a likelihood of confusion for consumers. The new generic Top Level Domain (new gTLD) .vip should also be taken into account in the comparison between the disputed domain name and Complainant's trademark, the element "vip" has low distinctiveness, as it shall merely refer to a category of the Complainant's customers, and shall therefore not affect the finding of similarity between the disputed domain name and the Complainant's trademark rights. The new gTLD .vip will increase the likelihood of confusion.

Having compared the disputed domain name and Complainant's PATEK PHILIPPE mark, it appears to the Panel that the prominent part of the disputed domain name is identical to Complainant's trademark and the .vip new gTLD further confuses Internet users. See PATEK PHILIPPE SA GENEVE vs.Sagar Pawar, 106176 (CAC 2024-03-12) ("Proceedings to a side-by-side comparison of the disputed domain name and the textual component of the Complainant's trademark, it is to be noted that the disputed domain name consists of the identical verbal elements forming the trademark. The addition of the generic Top-Level Domain (new “gTLD”) “.store" does not add any distinctiveness to the disputed domain name. Consequently, the Panel has no doubt that the disputed domain name is identical or confusingly similar to the Complainant's trademark.").

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See PepsiCo, Inc. v Smith power production, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

The Complainant asserts that the Respondent has not been given authorization, in any form, to use nor to register a domain name including the PATEK PHILIPPE mark. The Respondent is passively holding the disputed domain name by not resolving it to any active website. In addition, the Respondent's choice to hide its identity further evinces that the use of the disputed domain names cannot be considered as a bona fide offering of goods or services.

Having reviewed the case, the Panel is of the view that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain name. However, the Respondent has not submitted any response to rebut the assertion.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

First, the Complainant reiterates that Complainant's PATEK PHILIPPE mark is highly distinctive and well-known globally due to its extensive trademark registrations and large network of retailers. The Complainant also alleges that it is most likely that the Respondent was aware of Complainant and its PATEK PHILIPPE mark and aims to prevent the Complainant to obtain the exact match domain name.

Second, the Complainant further asserts 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, and on the contrary the use of the new gTLD .vip may imply a fraudulent attempt of phishing.

Third, the Complainant also alleges that the Respondent is not commonly known by the disputed domain name and a search within the internet of Respondent's name leads to no possible legitimate use of the disputed domain name.

Having considered the overall circumstances and the reputation of the PATEK PHILIPPE trademark, the Panel is of the view that the Respondent very likely had prior actual knowledge of Complainant and its PATEK PHILIPPE mark before the registration of the disputed domain name, there is no justifiable reason to support that registering a confusingly similar domain name identical to a distinctive trademark constitutes good faith. Furthermore, Respondent's passive holding of the disputed domain name not only prevent the Complainant to obtain an exact match domain name but also evinces its use of the disputed domain name in bad faith. See Union des Associations Européennes de Football vs. Juerg Stadelmann, 106061 (CAC 2024-01-19).

The Panel is of the view that both the registration and use of the disputed domain name are in bad faith under paragraph 4(b)(iv) of the Policy.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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.

PRELIMINARY FINDINGS - LANGUAGE OF PROCEEDING:

The Panel notes that the language of the Registration Agreement is Chinese as confirmed by the Registrar. The Complaint was submitted in English and no Response was received within the required period of time. Pursuant to paragraph 11 of the Rules, 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.

The Complainant requests to use English as the language of proceeding, with the arguments that the disputed domain name contains generic Latin characters and English is a commonly used language in the course of international cases even though English is not Complainant's natural language. The Complainant further argues that translating the Complaint into Chinese would imply significant of time to the Complainant and also delay the proceedings.

The Panel is bilingual and well equipped to deal with the proceeding in both Chinese and English. Having considered the circumstances and with Respondent's default, the Panel is of the view that English is the most widely spoken language in the world and is neither the natural language of the Complainant nor the Respondent. The Panel believes that it would be fair to both parties to use English as the language of proceeding and it can also uphold the principle of UDRP being a swift dispute resolution process. On this basis, the Panel determines that the language requirement has been satisfied, and decides that the language of proceeding to be English.

PRINCIPAL REASONS FOR THE DECISION

Having established all three elements required under the UDRP Policy, the Panel concludes that the disputed domain name should

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. **patekphilippe.vip**: Transferred

PANELLISTS

Name	**Mr Paddy TAM**

DATE OF PANEL DECISION 2024-03-19

Publish the Decision