Decision for dispute CAC-UDRP-106198

Case number	CAC-UDRP-106198
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Domain names	patekphilippemiami.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	PATEK PHILIPPE SA GENEVE
Organization	HENRI STERN WATCH AGENCY, INC

Complainant representative

Organization	Cabinet Vidon, Marques & Juridique PI

Respondent

Name	Vadim Yakubov

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

In this proceeding the Complainants rely on various “PATEK PHILIPPE” trademark registrations, including the following:

- International trademark registration under the “Madrid” system No. 394802 “PATEK PHILIPPE” (word), registration date is December 21, 1972, and protected inter alia in Austria, Benelux, Bulgaria, Croatia, France, the Czech Republic, Hungary, Spain and Vietnam;
- Swiss trademark registration “PATEK PHILIPPE” (word) No. 06393/1992, filing date is August 28, 1992;
- US trademark registration No. 520291 “PATEK PHILIPPE” (word), filing date is January 29, 1949, registration date is January 24, 1950 and
- US trademark registration No. 764655 “PATEK PHILIPPE”, filing date is April 22, 1963, registration date is February 11, 1964

The First Complainant also refers to its domain names <patek.com> and <patekphilippe.com>.

FACTUAL BACKGROUND

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

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANTS HAVE RIGHTS

The First Complainant states that it is one of the most recognized companies in the history of Swiss watchmaking industry awarded many times for both its innovations and designs. It was founded in 1839 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, it offers connoisseurs high-end watches and accessories around the world. The company maintains over 300 retail locations globally and a dozen distributors across different continents.

The First Complainant owns various "PATEK PHILIPPE" trademarks including the international and Swiss registrations referred to above.

The Second Complainant is a subsidiary of the First Complainant in the United States of America. The Second Complainant owns various "PATEK PHILIPPE" trademarks in the US including the US registrations referred to above.

The Complainants claim that they share a common interest in acting against the Respondent since the disputed domain name affects their rights in the "PATEK PHILIPPE" trademarks. The Complainants request transfer of the disputed domain name to the First Complainant.

The Complainants allege that the disputed domain name is confusingly similar to their "PATEK PHILIPPE" trademarks. The Complainants claim that the disputed domain name reproduces the mark in its entirety plus the geographical element "Miami" and that the "PATEL PHILIPPE" mark is recognizable within the disputed domain name.

The <.com> gTLD does not affect confusing similarity analysis.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainants assert that they gave no authorization to the Respondent to use the sign "PATEK PHILIPPE", nor to register a domain name that includes their trademarks.

The Complainants state that the Respondent is not making any legitimate or fair use of the disputed domain name.

The Complainants provide screenshots of the website at the disputed domain name and note that the disputed domain name seems to be operated by a US company "WRIST AFICIONADO" that has no rights in respect of the "PATEK PHILIPPE" mark.

The Respondent is Vadim Yakubov who appears to be the founder and CEO of "WRIST AFICIONADO".

The Respondent claims to be an authorized re-seller of "PATEK PHILIPPE" goods. The Complainants allege that there are only two (2) authorized resellers of "PATEK PHILIPPE" in Miami and the Respondent and his company are not one of them.

The website at the disputed domain name says that it offers certified goods, however it is impossible to confirm that they are indeed certified.

The Complainants claim that the Respondent fails to comply with the nominative fair use criteria and the "Oki Data" test, namely:

- he fails to accurately and prominently disclose his relationship with the trademark holder;

- the Respondent is not using his site to sell only the trademarked goods as the website also offers goods of competitors such as "Rolex", "Audemars Piguet" and "Richard Mile" and

- the Respondent tries to "corner the market" in domain names that reflect the trademark preventing the Complainants to reserve the domain name associating the trademark "PATEK PHILIPPE" with a location of their activities, namely "Miami".

Therefore, the Complainants claim that the Respondent does not have rights or legitimate interests in respect of the disputed domain name.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH

The Complainants' submissions on the bad faith element can be summarized as follows:

- The Complainants claim that the Respondent knew, or at least should have known, about the Complainants' trademark rights. The "PATEK PHILIPPE" mark is very well-known. The disputed domain name refers to Miami, a city where the Complainants have business presence;
- The Complainants rely on previous UDRP decisions confirming that their marks are widely-known;
- The webpage associated with the disputed domain name contains information about the Complainants' activities and history of the trademark "PATEK PHILIPPE" and this demonstrates prior knowledge and targeting;
- The Respondent seems to have intentionally attempted to attract, for commercial gain, Internet users to his website by creating a confusion with the Complainants' trademarks. The Complainants also assert that the Respondent had registered the disputed domain name to target the Complainants' clients, so the registration of the disputed domain name was conducted in bad faith;
- The website at the disputed domain name contains information that results in confusion with the Complainants, including reproducing Complainants' colors and history of the First Complainant;
- The Complainants allege that the Respondent had used his website to mislead Internet users into believing that the website at

the disputed domain name is operated by or authorized by the Complainants. The Respondent is trying to convince Internet users that the disputed domain name is affiliated with the Complainants. Besides, the Respondent also promotes and offers for sale competitors' goods on his website;
- The Complainants also state that the disputed domain name has been fraudulently reserved by the Respondent having no link whatsoever with the Complainants and there could be no good faith use of the disputed domain name by the Respondent.

Based on the above the Complainants claim that the disputed domain name has been registered and is being used in bad faith.

PARTIES CONTENTIONS

The Complainants' contentions are summarized in the Factual Background section above.

No administratively compliant Response has been filed.

RIGHTS

The Complainants have, 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 Complainants have rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants have, 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 Complainants have, 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.

Consolidation: filing of the complaint by two Complainants.

This complaint has been filed by two Complainants: the First Complainant, a Swiss company and the Second Complainant, a US company.

The Panel accepts filing of this complaint by the two Complainants based on the following:

- Both Complainants own the "PATEK PHILIPPE" marks in different jurisdictions,
- the Second Complainant is a subsidiary of the First Complainant,
- the Respondent's conduct affects both Complainants and
- the Panel finds that it will be equitable and procedurally efficient to permit the consolidation taking into account 10 (e) of the UDRP Rules (see also "WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition" or WIPO Overview 3.0 , 1.4 and sec. 4.11).

Both complainants hereinafter referred to as "Complainants".

PRINCIPAL REASONS FOR THE DECISION

A. Identical or confusingly similar

Both Complainants provide evidence of various trademark registrations for the "Patek Philippe" mark that they own in different countries.

As confirmed by WIPO Overview 3.0: “where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case” (see sec. 1.2.1).

Therefore, the Complainants proved they have trademark rights over the “Patek Philippe” sign.

The test for confusing similarity under the UDRP is relatively straightforward and 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.

The disputed domain name fully incorporates the “PATEK PHILIPPE” mark of the Complainants plus a geographical term “Miami”.

As noted in WIPO Overview 3.0: “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, **geographical**, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element” (see sec. 1.8).

The Panel finds that the “PATEK PHILIPPE” mark of both Complainants is recognizable within the disputed domain name and the mark is clearly a dominant element in the disputed domain name. The geographical term “Miami” does not eliminate confusing similarity. Moreover, given the Complainants’ own business activities in Miami, it actually increases confusion.

The gTLD “.com” is to be disregarded under the confusing similarity test as it does nothing to eliminate confusion.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see **“Julian Barnes v. Old Barn Studios”, WIPO Case No. D2001-0121** and sec. 2.1 of WIPO Overview 3.0.

According to Whois data provided by the Complainants and the Registrar verification, the creation date of the disputed domain name is February 15, 2022. The Panel assumes that the date of creation is the date of registration of the disputed domain name by the Respondent as neither party questioned it and the Panel has no other information that would indicate any other date of registration.

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows the Panel to draw such inferences as it considers appropriate, see paragraph 14(b) of the Rules and **CAC Case No. 101284**: “A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable inferences may be drawn from the information provided by the complainant”.

The disputed domain name is used for a website that advertises and sells various luxury watches, including “PATEK PHILIPP” and other brands.

It claims to be operated by “Wrist Aficionado”, a reseller of luxury watches.

As established by UDRP case law resellers (both authorized and unauthorized) can have a legitimate interest in respect of a disputed domain name under certain circumstances, see sec. 2.8 of WIPO Overview 3.0 and “Oki Data Americas, Inc. v. ASD, Inc.”, WIPO Case No. D2001-0903, <okidataparts.com>.

Resellers’ use of domain names can, under certain circumstances, constitute “a bona fide offering of goods or services...” under 4 c. (i) of the Policy.

At the same time, while the “Oki Data” test has consistently been applied since 2001, it can be adapted to specific circumstances of a particular case and some UDRP panels adopt a more holistic approach to the "Oki Data" criteria, see sec. 2.3 of “UDRP Perspectives on Recent Jurisprudence”, (“UDRP Perspectives”) updated August 30, 2024.

The nominative fair use doctrine allows registration and use of domain names to describe the nature of respondent’s business and as noted by Gerald Levine: “The registration of domain names incorporating marks is lawful provided that the goods or services are genuine and respondents are not attempting to pass themselves off (impersonating) as the mark owner or misrepresent its relationship or independence from it” and "Respondents cannot claim nominative use of another’s mark without demonstrating that the goods or services they are offering are distinctive from those of the mark owners. The use cannot convey the false impression that the goods or services respondents offer through their websites are sponsored by complainants" (see “**The Clash of Trademarks and Domain Names on the Internet**”, Volume 1, Gerald M. Levine 2024, “Legal Corner Press”, page 93 and page 450).

The Panel reviewed both screenshots of the website at the disputed domain name provided by the Complainants and conducted its own research under its powers granted under rule 10 (a) of the UDRP Rules and reviewed the website at the disputed domain name on the date of drafting this decision.

The website states that the Respondent's company is a reseller of "Patek Philippe" and it also contains links to the actual website of the Respondent's company "Wrist Aficionado" and its social media pages.

Both the website at the disputed domain name and the website of "Wrist Aficionado"offer for sale not only the Complainants' watches but also watches of their competitors.

There is no disclaimer or any express statement that would explain that the Respondent (his company) is not an official reseller of the Complainants.

At the same time, some panels found that disclaimer's presence or absence is not a decisive factor in deciding whether the site "accurately discloses the registrant's relationship with the trademark owner" (see e.g. "Airbus SAS v. Ben Riecken", **WIPO Case No. D2023-3842**).

This Panel looks both at the four "Oki Data" factors and at multiple factors related to the registration and use of the disputed domain name under more holistic approach such as composition of the disputed domain name, content of the website as well as any other circumstances relating to the use of the domain name and the Respondent's business (see sec. 2.3 of UDRP Perspectives).

Based on the above, this Panel finds that the Respondent failed to comply with the nominative fair use test criteria.

The Panel believes the Respondent failed to accurately disclose his relationship with the trademark owner, taking into account absence of clear statements on his website, the nature of the disputed domain name (that fully incorporates their "PATEK "PHILIPPE" trademark plus a geographical element "Miami") and overall content of the website.

The Panel notes that as provided in WIPO Overview 3.0 "a respondent's use of a domain name will not be considered "fair" if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant's mark is often central to this inquiry". "Where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner" and "certain geographic terms are seen as tending to suggest sponsorship or endorsement by the trademark owner" (see sec. 2.5 and 2.5.1 of WIPO Overview 3.0).

Here the composition of the disputed domain name, in the Panel's view, suggests endorsement and impersonation.

This Panel believes that the composition of the domain name is not the only factor in deciding whether resellers have a legitimate interest.

Rather, it is one of the multiple factors and other factors are actual use of the domain name and content of the website.

Nevertheless, in this dispute the composition of the disputed domain name along with the other factors go against the Respondent and suggest a false endorsement and impersonation.

Besides, the Respondent is not using the website to sell only the trademarked goods. It is clear both from the Complainants' submissions and from Panel's own research that the website at the disputed domain name offers for sale goods of the Complainants' competitors such as "Rolex" and "Hublot". The website also contains links to the Respondent's own website where again both the Complainants' goods and goods of their competitors are offered for sale.

This practice is unfair as it goes against "nominative (fair)" use purpose and is considered as "bait and switch".

To sum up, nominative use must be fair and Respondent's use of the disputed domain name in the circumstances of this case is not fair and is not bona fide offering of goods.

Therefore, the Panel finds that the Complainants have satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered.

The Panel first notes that the failure to comply with the nominative fair use test does not always establish respondent's bad faith (see sec. 2.3 of UDRP Perspectives and "Thor Tech Inc. v. Eric Kline", **WIPO Case No. D2023-4275**).

If respondent's behavior does not fall within the scope of abusive domain name registration ("cybersquatting"), there is no bad faith.

Cybersquatting can be defined as "registration made with bad-faith intent to profit commercially from others' trademarks" (see par. 4.1 c. of the ICANN "Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy", 1999).

It is well established that bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see sec. 3.1 of WIPO Overview 3.0). Targeting with an intent to take an unfair advantage of

the complainant's mark is important in establishing bad faith under the UDRP.

As noted in UDRP Perspectives, sec. 3.3: "Targeting can be established by either direct evidence (e.g. content of the website) or circumstantial evidence such as strength of the mark and nature of a disputed domain name (e.g. mark plus a term describing Complainant's business), timing of registration of a domain name and timing of trademark registration, geographic proximity of the parties. Targeting is easier to prove where the domain name corresponds to a highly distinctive mark primarily associated with one single holder or a well-known mark".

Here direct evidence clearly indicates that the Respondent targeted the Complainants and such targeting was with an intent to profit commercially from their trademarks.

The Panel finds that the disputed domain name was registered and is being used in bad faith based on the following:

1. The nature of the disputed domain name – confusingly similar to well-known trademarks plus a geographical term and the timing of the registration of the disputed domain name – many years after the Complainants obtained protection for their trademarks and started their business. The Complainants provide evidence that their marks are well-known and enjoy strong reputation. Based on the fame and strong reputation of the "PATEK PHILIPPE" trademark the Panel finds that the Respondent registered the disputed domain name keeping in mind the Complainants' marks. The composition of the disputed domain name demonstrates an intent to target the Complainants.
2. The nature of use of the disputed domain name and the content of the website clearly demonstrate targeting. The content of the website is related to the Complainants and their goods under the "PATEK PHILIPPE" mark. The website offers goods of the Complainants and goods of their competitors for sale.
3. The Respondent registered and is using the disputed domain name to take advantage of the Complainants' trademarks. The Respondent is free to operate his business of reselling luxury watches under his own brand "Wrist Afficionado". However, the Respondent's use of the disputed domain name so strongly connected to the Complainants' business and marks that it creates an impression of affiliation or endorsement, to promote and sell both goods of the Complainants and goods of their competitors, is unfair. The Complainant registered and is using the disputed domain name to attract visitors to his website that offers both goods of the Complainants and goods of their competitors. This type of behavior fits the notion of cybersquatting and is prohibited by the Policy.
4. Based on the above, the Panel finds that Respondent's behavior falls within, at least, par. 4 b (iv) of UDRP and the Respondent by using the disputed domain name has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement and that the Respondent targeted the Complainant with an attempt to take unfair advantage of the Complainant's mark.

The Panel holds that the third requirement of the Policy has been satisfied.

Therefore, the Panel orders transfer of the disputed domain name to the First Complainant, PATEK PHILIPPE SA GENEVE.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **patekphilippemiami.com**: Transferred

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2024-09-16

Publish the Decision