Decision for dispute CAC-UDRP-107185

Case number	CAC-UDRP-107185
Time of filing	2024-12-18 10:25:21
Domain names	patekphilippeboutique.com, patekphilippeboutiqueboston.com, patekphilippenyc.com, patekphilippenewyorkcity.com, pateknewyork.com, patekboston.com , patekphilippeboston.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	David G WALKER

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 names.

IDENTIFICATION OF RIGHTS

The Complainant Patek Philippe SA Geneve owns inter alia the following word mark registrations: International Reg. No. 208381 PATEK, registered on March 22, 1958 in classes 09 and 14; and International Reg. No. 394802 PATEK PHILIPPE, registered on December 21, 1972 in classes 09, 14, 16 and 34.

The Complainant Henri Stern Watch Agency, Inc., owns inter alia the following word mark registrations with the United States Intellectual Property Office: Reg. No. 520291 PATEK PHILIPPE, registered on January 24, 1950 in International Class 14 and Reg. No. 764655, PATEK PHILIPPE registered on February 11, 1964 in International Class 14.

FACTUAL BACKGROUND

Founded in 1839, the name “PATEK PHILIPPE” has its origin in the names of two of the founders: Antoine Norbert de Patek and Jean-Adrien Philippe. As one of the last independent, family-owned watch manufacturers in Geneva, the Complainant Patek Philippe

SA Geneve offers connoisseurs high-end watches and accessories around the world. The Complainant Henri Stern Watch Agency, Inc. is a subsidiary of Patek Philippe SA Geneve in the United States of America, with outlets in Boston and New York.

The disputed domain names were all registered on February 4, 2018.

PARTIES CONTENTIONS

The Complainants contend that the requirements of the Policy have been met and that the disputed domain names should be transferred to the Complainant Patek Philippe SA Geneve, for the following reasons.

The trademark PATEK PHILIPPE, used to designate the Complainants' goods, is famous worldwide.

The disputed domain names <patekphilippeboutique.com>, <patekphilippeboutiqueboston.com>, <patekphilippenyc.com>, <patekphilippenewyorkcity.com>, <pateknewyork.com>, <patekboston.com> and <patekphilippeboston.com> are confusingly similar to the Complainants' PATEK and PATEK PHILIPPE marks.

The Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainants own trademark rights in PATEK PHILIPPE since at least 1949 and as a company name since 1901.

The Respondent is not in any way affiliated with the Complainants, who have given no authorization to the Respondent in any form, to use the sign PATEK PHILIPPE, nor to register domain names including their trademarks. The successful registration of the disputed domain names by the Respondent does not confer any additional rights or legitimate interests in using the Complainants' trademark as its own domain name.

The Respondent is not making any legitimate use of the disputed domain names. All seven disputed domain names resolve to the website "https://shrevecrumpandlow.com", which is operated by the American jeweller Shreve Crump & Low. The website offers for sale, amongst others, pre-owned watches branded PATEK PHILIPPE, claiming to be certified. However, it is impossible for the Respondent to confirm the assertions on the certified goods as they are not authorized by the rightful owner, Patek Philippe SA Geneve.

The Respondent fails to comply with the requirements outlined in the "Oki Data test" insofar as the Respondent is not an authorized retailer of the Complainants; does not accurately or prominently disclose the Respondent's relationship with the Complainants, in particular that it is not an authorized seller of the Complainants nor has any particular connection with the Complainants, and does not use the website to sell only the Complainants' trademarked goods and services. Rather, it advertises products from the Complainants' competitors such as Audemars Piguet and Rolex and contains prominent links to the competitors' products gallery where the Respondent offers other goods in competition with the Complainants. Finally, the Respondent tries to "corner the market" in domain names that reflect the trademark, preventing the Complainants from reserving domain names associating the trademark PATEK PHILIPPE with a location of their activities, i.e. Boston or New York.

The registrar's verification has demonstrated that the named Respondent is Mr David G WALKER, with the email address <shreve@shrevecrumpandlow.com>. The Respondent's name refers to the former owner and president of Shreve Crump & Low, who passed away on October 25, 2021. This information confirms that the named Respondent has no legitimate interests in respect of the disputed domain names.

The disputed domain names were registered and are being used in bad faith. The Complainants' trademarks were known, or at least should have been known, by any actor in the field of fine watchmaking, due to the fact that the PATEK PHILIPPE trademarks are widely filed, registered and famous. It is the Complainants' opinion that the Respondent did not file a PATEK PHILIPPE trademark application in the USA because, undoubtedly, he had perfect knowledge of the Complainants' activities. By adopting domain names featuring the Complainants' PATEK PHILIPPE trademark, the Respondent is creating confusion with the Complainants' trademark to attract Internet users to its website and is then offering for sale to those visitors not only the Complainants' goods but also those of the Complainants' competitors.

It has also to be noted that the information as to the registrant of the disputed domain names is false insofar as David Walker passed away in 2021. The disputed domain names are probably reserved in the name of the company Shreve Crump & Low in view of the contact's email address and the information has not been updated since 2021. The lack of update of the information related to the registrant confirms the bad faith of the Respondent in the use of the domain names.

No administratively compliant Response has been filed.

RIGHTS

The Complainants have, to the satisfaction of the Panel, shown the disputed domain names are 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

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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 names (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 names have been registered and are 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

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that a Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(2) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(3) the disputed domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences as it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint. However, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See WIPO Jurisprudential Overview 3.0 in paragraph 4.3; see also eGalaxy Multimedia Inc. v. ON HOLD By Owner Ready To Expire, FA 157287 (Forum June 26, 2003) (“Because Complainant did not produce clear evidence to support its subjective allegations [. . .] the Panel finds it appropriate to dismiss the Complaint”).

As to the first element, the Complainants have shown that they have rights in the PATEK and PATEK PHILIPPE trademarks through International and United States registrations. The Panel finds each of the disputed domain names <patekphilippeboutique.com>, <patekphilippeboutiqueboston.com>, <patekphilippenyc.com>, <patekphilippenewyorkcity.com>, <pateknewyork.com>, <patekboston.com> and <patekphilippeboston.com> to be confusingly similar to the Complainants’ PATEK and PATEK PHILIPPE marks, differing only by the addition to one or other of the marks of one or more of the words and abbreviation “boutique”, “boston”, “nyc”, “newyorkcity” and “new york”. These differences do nothing to distinguish the disputed domain names from the marks. The inconsequential generic top-level domain “.com” may be ignored. The Complainants have established this element.

As to the second element, paragraph 4(c) of the Policy sets out three illustrative circumstances as examples which, if established by the Respondent, shall demonstrate rights to or legitimate interests in a disputed domain name for the purposes of paragraph 4(a)(ii) of the Policy, i.e.

(i) before any notice to the Respondent of the dispute, the use by the Respondent of, or demonstrable preparations to use, the domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or

(ii) the Respondent (as an individual, business or other organization) has been commonly known by the disputed domain name, even if the Respondent has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

The Panel notes that the disputed domain names were all registered in the name of the Respondent on February 4, 2018, long after the Complainants registered their famous PATEK and PATEK PHILIPPE trademarks. They all resolve to an active website at “https://shrevecrumpandlow.com”, operated by the American jeweller Shreve Crump & Low, offering for sale, inter alia, “certified pre-owned” PATEK PHILIPPE watches, as well as watches under the brands GREUBEL FORSEY, PIAGET, GIRARD-PERREGAUX, H.MOSER

& CIE., JAEGER-LE-COULTRE and PARMIGIANI. There is no evidence that the Respondent is known by any of the disputed domain names.

The Panel notes that the decision in Oki Data Americas, Inc. v. ASD, Inc., D2001-0903 (WIPO Nov. 6, 2001) held that a reseller has a limited right to use the trademarks of others only when all the following criteria are met:

(i) Respondent must actually be offering the goods or services at issue;

(ii) Respondent must use the site to sell only the trademarked goods;

(iii) the site must accurately disclose Respondent's relationship with the trademark owner; it may not, for example, falsely suggest that it is the trademark owner, or that the website is the official site, if, in fact, it is only one of many sales agents; and

(iv) Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.

Assuming that the Respondent is offering the genuine goods of the Complainants, the Respondent's use of the disputed domain names does not satisfy the requirements of the Oki Data test in that the website offers goods of the Complainants' competitors as well as those of the Complainants; fails to disclose that the Respondent has no relationship with the Complainants, and deprives the Complainants of reflecting their own marks in a domain name relating to their outlets in Boston and New York.

These circumstances, together with the Complainants' assertions, are sufficient to constitute a prima facie showing of the absence of rights or legitimate interests in respect of the disputed domain names on the part of the Respondent. The evidentiary burden therefore shifts to the Respondent to show that it does have rights or legitimate interests in the disputed domain names. See JUUL Labs, Inc. v. Dryx Emerson / KMF Events LTD, FA1906001849706 (Forum July 17, 2019). The Respondent has made no attempt to do so.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainants have established this element.

As to the third element, paragraph 4(b) of the Policy sets out four illustrative circumstances, which, though not exclusive, shall be evidence of the registration and use of a domain name in bad faith for purposes of paragraph 4(a)(iii) of the Policy, including:

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

The circumstances set out above in relation to the second element satisfy the Panel that the Respondent was fully aware of the famous PATEK and PATEK PHILIPPE marks when the Respondent registered the disputed domain names and that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainants' marks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and of the goods promoted on that website. This demonstrates registration and use in bad faith to attract users for commercial gain under Policy paragraph 4(b)(iv). The Complainants have established this element.

The Panel has decided that the disputed domain names shall be transferred 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. **patekphilippeboutique.com**: Transferred
2. **patekphilippeboutiqueboston.com**: Transferred
3. **patekphilippenyc.com**: Transferred
4. **patekphilippenewyorkcity.com**: Transferred
5. **pateknewyork.com**: Transferred
6. **patekboston.com** : Transferred
7. **patekphilippeboston.com**: Transferred

PANELLISTS

Name	**Alan Limbury**

DATE OF PANEL DECISION 2025-01-16