

Decision for dispute CAC-UDRP-107187

Case number	CAC-UDRP-107187
Time of filing	2024-12-20 10:07:14
Domain names	patekphilippenewyork.com

Case administrator

Name	Olga Dvořáková (Case admin)
------	-----------------------------

Complainant

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

Complainant representative

Organization	Cabinet Vidon, Marques & Juridique PI
--------------	---------------------------------------

Respondent

Organization	Wrist Aficionado
--------------	------------------

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 First Complainant, Patek Philippe SA Geneve has a very large international portfolio of registered trademarks including:

- An International registration for the word mark, "PATEK PHILIPPE" No. 394802 in classes 9 and 14, filed on 21 December 1972, designating Austria, Bulgaria, Benelux, Czech Republic, Germany, Egypt, Spain, France, Hungary, Italy, Morocco, Monaco, Portugal, Romania, Slovakia, Slovenia, Syria, and Vietnam.
- A national Swiss registration for the word mark "PATEK PHILIPPE" No. 06393/1992 in classes 9, 14, 16 and 34, owned by PATEK PHILIPPE SA, filed on 28 August 1992.

The Second Complainant, Henri Stern Watch Agency, Inc is a US subsidiary of the first complainant and the registered owner of the following registered trademarks in the USA: the word mark "PATEK PHILIPPE" No. 520291 in class 14, filed on 29 January 1949, No. 764655 in class 14, filed on 22 April 1963 and No. 6983438 in class 14, filed on 28 September 2021.

The Complainants say the name and mark "PATEK PHILIPPE", is a famous mark.

The First Complainant has registered the domain names <patek.com> and <patekphilippe.com>, leading to the official website, on 7 March 1996. The internet archive shows that the trademarks and those websites have been continuously used at least since 1998.

The First Complainant also owns rights in the name PATEK PHILIPPE SA GENEVE as a company name, the company being registered since 1901.

FACTUAL BACKGROUND

The First Complainant is a famous company for Swiss watchmaking. It was founded in 1839. The name “PATEK PHILIPPE” came from the combination of the names of the two founders: Antoine Norbert de Patek and Jean-Adrien Philippe.

It is at the very top of the luxury watch industry under “PATEK PHILIPPE” trademark. It is one of the last independent, family-owned watch manufacturers in Geneva, and offers connoisseurs high-end watches and accessories. The company maintains over 300 retail locations globally and a dozen distributors across America, Asia, Europe, Pacific and more.

They say there are only 4 authorized retailers of their watches in New York (Bucherer TimeMachine, Tiffany & Co., Watches of Switzerland, Hudson Yards, and Wempe Jewelers).

The disputed domain name <patekphilippenewyork.com> resolves to a US company trading as “WRIST AFICIONADO” and it claims to be an authorized re-seller of PATEK PHILIPPE’s watches as well as other leading brands.

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).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has not, 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 not, 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

There is no question that the First Complainant’s name and both Complainants’ registered marks are famous.

The disputed domain name is composed of the word mark in its entirety with the addition with geographic term “New York” and the TLD is a .com. The use of the whole mark in a domain name raises issues of impersonation. The choice of the .com while technically

irrelevant at this limb of the Policy, can compound the impression that a site is official. The disputed domain name by the addition of the geographical term “newyork” does not prevent a likelihood of confusion. The Panel finds the Complainants’ have rights in a name and marks that is similar to the disputed domain name.

This case is really about the Second Limb of the Policy. The Respondent is a reseller and the question is whether the Respondent making fair and legitimate use. This is an issue that arises even on the face of the case. Under the UDRP (the Policy) at Paragraph 4(c) the Respondent can show any of:

- “(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

However, Paragraph 4(c) is not exhaustive and includes the language, “[a]ny of the following circumstances, in particular but without limitation...”

Although the Respondent has not come forward, the Panel must consider the test. According to the WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, a respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy. Here though, it is clear to anyone who click through and lands on “WRIST AFICIONADO” that they are a reseller and are not the First Complainant or the Second. They also state on that page that they are a re-seller. It appears clear they buy and resell second hand or pre-owned watches. There is no evidence in the proceeding to suggest the watches sold are not genuine and we will proceed on the basis that they are selling genuine watches under their names. This is called in US trade mark law, nominative fair use. As a famous judge once put it how do you resell a second-hand Tiffany bracelet without using the word, Tiffany? That use is descriptive and nominative—calling something by its name in order to identify it. It is not trade mark use as such –provided that it is fair and respects the legitimate interests of the trade mark owner. This is because no trade mark owner has the right to monopolise the resale of second hand or previously lawfully sold goods. This is the limit to and/or exhaustion of the rights of a trade mark owner. This balances the rights of owners against those of retailers, second hand dealers and consumers and distributors. The rule also protects descriptive uses necessary to indicate the kind, quality or purpose of goods, provided the use is exercised in accordance with honest practices — which encompasses a duty to act fairly in relation to the legitimate interests of the trade mark owner.

The same rule has found its way into the domain name norms and the WIPO Overview 3.0, section 2.8 summarizes the consensus views of UDRP panels in assessing claims of nominative (fair) use by resellers or distributors in the following manner: *“Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the “Ok! Data test”, the following cumulative requirements will be applied in the specific conditions of a UDRP case:*

- *the respondent must actually be offering the goods or services at issue;*
- *the respondent must use the site to sell only the trademarked goods or services;*
- *the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and*
- *the respondent must not try to “corner the market” in domain names that reflect the trademark.”*

As to the factors here:

- *the Respondent is actually offering the goods at issue;*
- *the Respondent does not use the site to sell only the trademarked goods or services;*
- *the site accurately and prominently discloses that it is a reseller and that the watches are second hand;*
- *the Respondent does not try to “corner the market” in domain names that reflect the trademark.*

This test is highly fact sensitive. According to the Complainants, the Respondent fails to comply with these as the Respondent is not an authorized retailer of the Complainants. But that is not the test. It applies to unofficial as well as official resellers. It is well established in UDRP jurisprudence, that the OKI DATA rule applies to unauthorized or unofficial resellers and repairers just as it does to official agents, per WIPO Case D2001- 1292 (Volvo Trademark Holdings AB) (OKI DATA principles apply as long as he operates a business genuinely revolving around the owners’ goods and services) and WIPO Case D2007 -1524 (nascartours) (OKI DATA applies to authorized and unauthorized sellers). See also Bettinger, 2nd Ed. P1387 IIIE.310.

As to the second factor, this criteria is too narrow and has no mirror in the offline law and the name of the site associated makes it clear that many brands are sold and there is nothing wrong in it, this Panel does not accept this is a valid factor. The OKI Data criteria must be applied in a sensible way. It is permissible for the sites to sell also other products. Just as a second-hand store does not have to sell only one brand.

The Panel has viewed the screenshots of the website to which the disputed domain name resolves. It does not misrepresent itself or its relationships. No one could be confused. They sell a range of brands and this is legitimate use. It says things like “find and sell” and “sell

your watch.” It says clearly “wristaficionado.com is a reseller of Patek.”

The Panel’s view is that average internet users, are savvy enough to understand this is a retailer selling a range of pre-owned watches and they are not confused. There is information on the Complainant’s brand and the other brands sold, but it does not suggest it is it or part of it nor authorised by it. There is no impersonation. The website by its name and contents and the statements and site generally makes the facts clear. No one can be confused. The Panel finds that the OKI DATA criteria are broadly met and the Respondent is making fair and legitimate use.

As to bad faith, the Complainants believe that the Respondent has registered the disputed domain name in bad faith as it causes confusion.

Under Paragraph 4(b) of the Policy, the following can evidence Bad Faith:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(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 Panel has found it does not cause confusion as the position is clear once the site is reached. The Complainants say that the same colour graphics are used somewhere. It says the site is referring to goods that are watches, which is core activity of the Complainants and so the Respondent has used its website to mislead Internet users into believing that the websites at the disputed domain names are operated by or authorized by the Complainant. But the Respondent is not trying to convince the user that the domain is affiliated with the Complainants. The Panel does not find confusion or bad faith for the reasons given above.

The Complainant has not met its burden on the second or third limbs of the Policy and the complaint is not accepted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **patekphilippenewyork.com**: Remaining with the Respondent

PANELLISTS

Name	Victoria McEvedy
------	-------------------------

DATE OF PANEL DECISION	2025-01-31
------------------------	------------

Publish the Decision
