

Decision for dispute CAC-UDRP-107207

Case number	CAC-UDRP-107207
Time of filing	2025-01-02 10:45:41
Domain names	patekphilippe-geneve.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	PATEK PHILIPPE SA GENEVE
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Complainant representative

Organization	Cabinet Vidon, Marques & Juridique PI
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Respondent

Organization	Hoang Van Ha
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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 is the owner of numerous registrations for the trademark "PATEK PHILIPPE", including the international trademark No 394802, registered on December 21, 1972, for goods and services in classes 9, 14, 16 and 34.

The disputed domain name was registered by the Respondent on March 14, 2024.

FACTUAL BACKGROUND

The Complainant states that it is one of the most recognized companies in the history of Swiss watchmaking industry. The Complainant points out that it maintains over 300 retail locations globally and a dozen distributors across the world.

The Complainant submits that it has registered the domain names <patek.com> and <patekphilippe.com>, leading to its official website, since March 7, 1996.

The Complainant underlines that its trademark is depicted at the top of its main webpage, in association with the French name of its city of origin, namely GENEVE.

The Complainant considers that the disputed domain name is confusingly similar to the Complainant's trademark because it exactly reproduces the trademark "PATEK PHILIPPE", with the mere addition of the French name of its city of origin "GENEVE".

The Complainant contends that the addition of the top-level domain ".COM" should be disregarded in the confusing similarity test.

The Complainant argues that the addition of the word "GENEVE" is not sufficient to prevent the likelihood of confusion between the disputed domain name and the Complainant's trademark.

The Complainant submits that it owns trademark rights on the sign "PATEK PHILIPPE" at least since 1949 and on the sign "PATEK" at least since 1958.

The Complainant states that it has given no authorization to the Respondent, in any form, to use the sign "PATEK PHILIPPE", nor to register a domain name including its trademarks.

The Complainant notes that the Respondent is not making any legitimate use of the disputed domain name, because the disputed domain name does not lead to any active website, but to a parking page.

For the above reasons, the Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant underlines that the Respondent knew, or at least should have known, about the Complainant's trademark rights, due to its worldwide scope of activities and renown.

The Complainant notes that the notoriety of its trademarks has been acknowledged in several UDRP decisions.

The Complainant considers that the Respondent did know that the Complainant owns rights on the "PATEK PHILIPPE" trademark, as it cannot be a coincidence that the terms included in the disputed domain name correspond to the main Complainant's trademark and to its city of origin.

The Complainant believes that the Respondent has registered the disputed domain name to target the Complainant's customers. The Complainant adds that the mere fact that the disputed domain name reproduces the Complainant's distinctive trademark, is an indication of bad faith.

The Complainant argues that the Respondent merely registered the disputed domain name with the aim of preventing the Complainant to obtain the same domain name.

The Complainant adds that there is the risk that the Respondent sets up and configures email addresses, and this use would increase the implausibility of the Respondent's good faith.

The Complainant notes that the Respondent has previously been the Respondent in several successful UDRP procedures.

The Complainant considers that the described circumstances demonstrate that the Respondent has registered and has been using the disputed domain name in bad faith.

PARTIES CONTENTIONS

The Complainant, relying on the arguments summarised above, 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, 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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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 in bad faith.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark or service mark rights.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership, among others, of the registered trademark "PATEK PHILIPPE", identified in section "Identification of rights" above.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant's trademark.

The disputed domain name differs from the Complainant's trademark "PATEK PHILIPPE" only by the addition of the hyphen, followed by the word "GENEVE" (which corresponds to the Complainant's city of origin), and by the presence of the top-level domain ".COM".

It is a common view that where a trademark is the distinctive part of a domain name, the domain name is considered to be confusingly similar to the trademark (see, for example, WIPO case No. D2017-1266).

In the present case, the addition of the word "GENEVE" has no impact on the distinctive part "PATEK PHILIPPE". It is well established that where the relevant trademark is recognizable within the domain name, the addition of other terms would not prevent a finding of confusing similarity.

It is well accepted that the hyphen is not relevant in the confusing similarity test (see, for example, WIPO case No. D2016-0676).

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark "PATEK PHILIPPE".

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the respondent has rights or legitimate interests in a domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations 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
- (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 non-commercial or fair use of the [disputed] domain name, without intent for

commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name.

In particular, the Complainant states that:

- it owns trademark rights on the sign "PATEK PHILIPPE" at least since 1949 and on the sign "PATEK" at least since 1958;
- it has given no authorization to the Respondent, in any form, to use the sign "PATEK PHILIPPE", nor to register a domain name including its trademarks;
- the Respondent is not making any legitimate use of the disputed domain name, because the disputed domain name does not lead to any active website, but to a parking page.

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the disputed domain name.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy or other evidence of rights or legitimate interests in the disputed domain name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain name, nor any use in connection with a bona fide offering of goods or services. Indeed, the disputed domain name resolves to a parking page.

The Panel considers that, on the balance of probability, the Respondent knew the Complainant's trademark and registered the disputed domain name with knowledge of the Complainant's rights. Indeed, it is not conceivable that the Respondent did not have the Complainant's trademark in mind, when registering and using the disputed domain name. Under these circumstances, it cannot be concluded that the Respondent is making a "fair" use of the disputed domain name.

Taking into account that the Complainant's trademark registrations long predate the registration of the disputed domain name, that the Complainant has not authorized the Respondent to register the disputed domain name or to use the Complainant's trademark in any form, that the Respondent is not commonly known by the disputed domain name, that the disputed domain name resolves to a parking page, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

- (i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] 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 [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or
- (ii) [the Respondent] [has] registered the [disputed] 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 [the Respondent] [has] engaged in a pattern of such conduct; or
- (iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] 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 [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain name was registered in bad faith and that it has been used in bad faith.

Taking into account the fact that the trademark "PATEK PHILIPPE" is distinctive and well-known, as also recognized by other panels (see CAC Case No. 106173), the Panel agrees that it is inconceivable that the Respondent was not aware of the Complainant's rights in the Complainant's trademark when registering the disputed domain name.

Other panels considered that knowledge of a corresponding mark at the time of the domain name's registration can suggest bad

faith (see WIPO Case No. D2017-0100). The Panel shares this view.

Another evidence of bad faith is given by the fact that the Respondent registered other domain names containing well-known trademarks, thus being engaged in a pattern of abusive conduct.

The Panel observes that if the Respondent had legitimate purposes in registering and using the disputed domain name it would have filed a response in this proceeding.

The Panel, having taken into account the Respondent's knowledge of the Complainant's trademarks at the time of the disputed domain name's registration, the fact that the disputed domain name resolves to a parking page, the fact that the Respondent has been involved in several other UDRP proceedings and the lack of reply to the complaint, considers that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. patekphilippe-geneve.com: Transferred

PANELLISTS

Name	Michele Antonini
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DATE OF PANEL DECISION **2025-02-02**

Publish the Decision
