

ADMINISTRATIVE PANEL DECISION

**Patek Philippe SA Genève, Henri Stern Watch Agency, Inc. v. Ajay Singh,
Omar Sader
Case No. D2023-2226**

1. The Parties

The Complainants are Patek Philippe SA Genève, Switzerland, and Henri Stern Watch Agency, Inc., United States of America (“United States”), represented by Cabinet Vidon Marques & Juridique PI, France.

The Respondents are Ajay Singh, United States, and Omar Sader, United States, represented by The Concept Law Group, P.A., United States.

2. The Domain Names and Registrar

The disputed domain names <patek-maison.com> and <patekmaison.com> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 23, 2023. On May 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On May 25, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 29, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on June 2, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 25, 2023. The Response was filed with the Center on June 25, 2023.

The Center appointed Warwick A. Rothnie, Isabelle Leroux, and Diane Cabell as panelists in this matter on July 20, 2023. The Panel finds that it was properly constituted. Each member of the Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

On July 4, 2023, the Complainant submitted a supplemental filing pursuant to paragraph 6(d) of the Rules.

4. Factual Background

The Complainants are wholly owned subsidiaries of Patek Philippe Holding SA, which is the parent company of the corporate group currently carrying on the watch-making business first established in Geneva, Switzerland by Messrs Patek and Philippe in 1839.

The First Complainant is the group operating company with responsibilities amongst other things for the manufacture of the watches and other time pieces. The Second Complainant is incorporated in the United States and is the exclusive distributor of the Complainants' products in that country.

According to materials in the Complaint, the Complainants' watches and time pieces are all hand-made. They sell for very high prices and there is a strong collectors' demand even for pieces decades old. The Complainants' products are made available to the public through over 300 retail locations around the world including in Europe, North America, Asia, and Australasia.

The First Complainant has been the holder of the domain name <patek.com> since March 7, 1996. Extracts from the Wayback Machine show use of the Complainants' trademark on websites resolving to that domain name since 1998.

The Complaint includes evidence that the Complainants own numerous registered trademarks for PATEK PHILIPPE or PATEK around the world. For present purposes, it is sufficient to note:

- (a) United States Registered Trademark No. 520,291, PATEK PHILIPPE, which has been registered in the Principal Register in respect of watches in International Class 14 since January 24, 1950;
- (b) International Registration No. 208381, PATEK, which has been registered since March 22, 1958 in respect of apparatus and articles for measuring time, time pieces and jewellery in International Classes 9 and 14. This registration designated, amongst others, Austria, Benelux, Germany, Spain, France, Hungary, and Italy.

Although details have not been included in the Complaint, the Complainants also have two registered trademarks for PATEK in the United States, Nos 6,952,804 and 6,983,437. Both are registered in the Principal Register in respect of watches and time keeping devices and, in the case of No. 6,952,804, maintenance and repair services. They have been registered since, respectively, January 17 and February 21, 2023.

Both disputed domain names were registered on November 29, 2020.

The first disputed domain name, <patek-maison.com>, redirects to the website at "www.patekmaison.com".

The website at "www.patekmaison.com" appears to be offering for sale perfumes and fragrances by or under the trademark PATEK MAISON. The products on offer are being promoted for sale at prices starting from USD 195 or higher.

Mr Amit Bhatia, of Texas in the United States, has registered several trademarks for PATEK MAISON including:

- (1) United States Registered Trademark No. 6,775,922, which has been registered in the Principal Register since June 28, 2022 in respect of perfumes and perfume products in International Class 3. The application for registration was filed on December 10, 2020 and claims a first use in commerce on April 5, 2022; and
- (2) European Union Trade Mark (EUTM) No. 1639473, which has been registered since September 23, 2021 in respect of perfumes and perfume products in International Class 3 also.

The Response also includes evidence that Mr. Bahtia has corresponding registrations in Costa Rica, Mexico, and the United Arab Emirates.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (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.

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

A. Consolidation of Complaints

Although the disputed domain names are registered in the names of different persons, the Panel finds it is appropriate to consolidate both disputed domain names in one proceeding.

In the Response, the first Respondent describes the second Respondent as the IT consultant employed or used by the first Respondent to set up his, or his companies', information technology.

Further, as noted above, the disputed domain name <patek-maison.com> redirects to the website at the disputed domain name <patekmaison.com>. Further still, each of the disputed domain names is formed around the sign "Patek", each was registered on the same day and each gives the same physical address for the registrant. The Panel also notes that the Complaint has been notified to both Respondents at the addresses which the Registrar has confirmed as their contact details and no contrary submission has been received from the second Respondent. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.

For ease of reference, the Panel will refer just to the "Respondent" unless it becomes necessary in a particular case to distinguish between particular Respondents or disputed domain names.

B. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain names are identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain names must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of registered trademarks for both PATEK and PATEK PHILIPPE.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of confusion” under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g., [WIPO Overview 3.0](#), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level Domain “.com” (“gTLD”) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11. Moreover, the inclusion of a hyphen in the first disputed domain name may be disregarded as insubstantial and a conventional way of including a “space” in a domain name.

Disregarding the “.com” gTLD, therefore, the disputed domain names consist of the Complainant’s registered trademark and the term “maison”. “Maison” is at the least the French word for house and is also frequently used in commerce to indicate a group, or studio or atelier, particularly where it is intended to convey impressions of luxury or prestige. As this requirement under the Policy is essentially a standing requirement, the addition of this term does not preclude a finding of confusing similarity. See e.g., [WIPO Overview 3.0](#), section 1.8. Apart from anything else, at the very least the Complainant’s trademark, PATEK, remains visually and aurally recognisable within the disputed domain names.

Accordingly, the Panel finds that the Complainant has established that the disputed domain names are confusingly similar to the Complainant’s trademark and the requirement under the first limb of the Policy is satisfied.

C. Rights or Legitimate Interests

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

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 disputed 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 noncommercial 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.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Respondent registered the disputed domain names well after the Complainants began using their

trademarks and also well after the Complainants had registered the International Registration No. 208381 and United States Registered Trademark No. 520,291.

It is not in dispute between the Parties that the Complainants have not authorised the Respondent to use or register the disputed domain names or that neither the Respondent nor Mr. Bhatia is associated with the Complainants in any way.

The products being offered for sale through the Respondent's website are not products of, or made under licence from, the Complainants.

The disputed domain names have not been derived from either Respondent's name.

The first Respondent states that he has been conducting in Miami, Florida in the United States a business under the name "Perfume Price".

In November 2020, he decided, with Mr. Bhatia, to launch a new perfume brand under the name "Patek Maison" through a yet to be formed entity, Xuri Beauty, independently of the Perfume Price business. According to the Response, Mr. Bhatia took responsibility for branding the product range including registering the trademarks and the first Respondent took responsibility for developing the website, which included the use of the second Respondent's services. As Xuri Beauty had not yet been formed, they used the first Respondent's business address for the disputed domain names.

According to the Response, Xuri Beauty has been incorporated now as a Delaware corporation. However, neither the trademark registrations nor the disputed domain names have been transferred to it. Also, the Panel notes, the website to which the disputed domain names resolve does not identify Xuri Beauty's involvement or appear to provide any contact details apart from <support@patekmaison.com>.

The Response does not offer any explanation about how the Respondent and Mr. Bhatia arrived at the name "Patek Maison" for their business. There must certainly be at least a suspicion that, as the Complainants contend, the name has been chosen to trade on the fame and reputation of the Complainants' trademarks.

The Respondent does claim there are other businesses using "Patek" in the United States. In support of this claim, the Response includes evidence of United States Registered Trademark No. 2,806,360, PATEK, which has been registered in respect of electric drills and power tools in International Class 7 since January 20, 2004 and a pending application, Serial No. 90727616, PATEK PACKAGING, in respect of plastic packaging products in International Classes 16 and 21 and related retail services in International Class 35 and which was filed on May 21, 2021.

Nothing else is known about either of the businesses behind those two trademarks. However, it is not at all clear to the Panel how the existence of these trademarks, one of which is not registered yet, assists the Respondent's claim to rights or legitimate interests as there is no suggestion that the Respondent claims any association with either or both of them.

As noted above, the Respondent does appear to be offering for sale through the website to which the disputed domain names resolve perfume products under the trademark, PATEK MAISON. In addition, so far as the record in this proceeding shows, an associate or business partner of the Respondent has a registered trademark for that sign in respect of those goods in a number of jurisdictions including the United States and the European Union.

Those registrations have been achieved in the face of the Complainants' International Registration for PATEK and United States Registered Trademark for PATEK PHILIPPE.

Ordinarily, a prior registered trademark would be sufficient to defeat an allegation that the Respondent lacked rights or legitimate interests. That is not automatically the case, however, where the trademark registration has been obtained after the Complainants' rights. See e.g., [WIPO Overview 3.0](#), section 2.12.

In the present case, there is a basis for speculating that the Respondent and Mr. Bhatia adopted the name “Patek Maison” and registered the disputed domain names to take advantage of the Complainants’ trademark especially given the Respondent’s failure to explain the derivation of the “Patek Maison” name. However, the goods involved are different to the goods for which the Complainants have registered and used their trademarks. While the Complaint does include some evidence of some watch or timepiece brands also supplying perfume products, the goods are apparently sufficiently different that the relevant Trademark Offices have allowed registration of the PATEK MAISON trademark in Mr. Bhatia’s name.

The Panel accepts that a trademark registration could be invalidated by a showing of conflict with prior registered rights or, for example, being obtained in bad faith. The facts and circumstances resulting in such revocations are typically subject to careful consideration on the merits by the appropriate authorities in the jurisdiction or jurisdictions concerned. Especially having regard to the limitations of proceedings under the Policy, therefore, the Panel considers it should be cautious to go behind the registrations of the trademarks relied on by the Respondent except in the clearest of cases. The jurisdictions in which Mr. Bhatia has registered the PATEK MAISON trademark are readily accessible to the Complainants and have agencies (including the Courts) with powers and procedures more appropriate for the issues arising in this proceeding.

Having regard to the circumstances of this case and noting the apparent lack of opposition action, the Panel does not consider that this is a case where – at least on the facts presented – the registration of the trademarks on which the Respondent relies can properly be disregarded.

Accordingly, the Panel considers that on the record in this case the Complainants have failed to establish the second element under the Policy.

D. Registered and Used in Bad Faith

In the circumstances, there is no value in considering whether the third requirement under the Policy has been satisfied as the Complaint must fail in any event.

6. Dissenting Opinion

Panelist Leroux respectfully disagrees with the decision of the Majority of the Panel and submits the following Dissenting Opinion under paragraph 15 of the Rules.

Panelist Leroux respectfully considers that the use of a domain name in connection with a *bona fide* business of trading in domain names may, in appropriate circumstances, confer rights or legitimate interests under the Policy. However, this case falls in a grey area in where, although different opinions may be acceptable under the Policy, taking into consideration all relevant circumstances, in a balance of probabilities, this balance points to the transfer of the disputed domain names to the Complainants, for the reasons below.

This Panelist respectfully considers that there are several key circumstances not taken into account or into consideration by the Majority Panelists, which are relevant to the decision of this case. These key relevant circumstances include the following:

- (i) the Complainants’ trademark rights for the PATEK or PATEK PHILIPPE marks are registered in many jurisdictions around the world, including both European Union (cited in the “Factual Background” of this Decision), and the United States, where the Respondent is located according to the Registrar verification and the Response.
- (ii) the Complainants have continuously used the PATEK or PATEK PHILIPPE marks for over 160 years (since 1837 or at the latest 1953). This circumstance was alleged in the Complaint, and has been recognized in various prior decisions under the Policy;

- (iii) the Complainants use the PATEK or PATEK PHILIPPE marks extensively and internationally, over the Internet and in many jurisdictions, including the relevant countries for this case, the United States (where the Respondent is located). The Complainants operate globally having shops and distributors in all five continents, and, specifically, in the European Union and in the United States.
- (iv) the Complainants have established that some luxury watches brands are also offering for sale and sale perfumes and Isabelle Leroux Panelist found easily the following examples CARTIER, MONTBLANC, FRANCK MULLER, CHANEL, HUGO BOSS, DKNY, etc., showing the close relationship between watches and perfumes.
- (v) the word “patek” is not included in any dictionary, not having any particular meaning in any living language. It is a rare name of Latin origin, it’s not included in any dictionary, which does not, therefore, possess any particular meaning to the public;
- (vi) any search over the Internet reveals the Complainants, their reputed PATEK mark, and their websites; and any search over the United States Patent and European Union Trademark Offices, or any other trademark database, reveals the Complainants’ trademarks.
- (vii) The Respondent cannot claim that he had no previous knowledge of the Complainants and their trademark and certainly not prior to his acquisition of the disputed domain names. This allegation is simply unbelievable, and, additionally, implies, in Panelist Leroux’s view, that the Respondent conducted no search to avoid the acquisition/registration of a trademark-abusive domain name, prior to the acquisition of the disputed domain names, because any search would have revealed, in a noticeable way, the Complainants and their prior rights.

Prior decisions have consistently considered that respondents who (deliberately) fail to search and/or screen registrations against available online databases would be responsible for any resulting abusive registrations under the concept of “willful blindness”. This is clearly the case here. See section 3.2.3 of the [WIPO Overview 3.0](#).

The Respondent cannot credibly claim to have been unaware of the Complainants’ trademark.

He knew or should have known that the disputed domain names are confusingly similar to the Complainants’ reputed trademarks PATEK or PATEK PHILIPPE and they are almost identical to the Complainants’ domain names used for decades worldwide. And, the addition by the Respondent of “maison” in the disputed domain names, commonly used by companies as a luxury indicator/symbol reinforces the Panelist Leroux’s belief that the Respondent was deliberately looking to create confusion with the Complainants’ marks and website.

The notion of “knew or should have known” is normally applied to cases with similar circumstances, related to widely known trademarks. See section 3.2.2 of the [WIPO Overview 3.0](#). Under these circumstances, Panelist Leroux considers that, in a balance of probabilities, the Respondent knew or should have known about the existence of the well-known mark PATEK mark, and had it in mind when it registered the disputed domain names.

In conclusion, Panelist Leroux considers that all the cumulative circumstances of this case indicate, in a balance of probabilities, that the Respondent has no rights or legitimate interests in respect of the disputed domain names and targeted the Complainants and their reputed trademarks in bad faith to unfairly profit from its reputation.

Therefore, in summary, Panelist Leroux considers that Complaint meets all three elements of paragraph 4(a) of the Policy, and finds that the disputed domain names should have been transferred to the Complainants.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Warwick A. Rothnie/

Warwick A. Rothnie

Presiding Panelist

/Isabelle Leroux (Dissenting)/

Isabelle Leroux (Dissenting)

Panelist

/Diane Cabell/

Diane Cabell

Panelist

Date: August 3, 2023