

## **ADMINISTRATIVE PANEL DECISION**

Breitling SA v. Ralf Zimmermann  
Case No. D2023-3303

### **1. The Parties**

The Complainant is Breitling SA, Switzerland, represented by IP Twins, France.

The Respondent is Ralf Zimmermann, Switzerland.

### **2. The Domain Name and Registrar**

The disputed domain name <breitlingreplica.watch> (“the Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 1, 2023. On August 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 2, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 7, 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 August 9, 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 August 11, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 31, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 4, 2023.

The Center appointed Jacques de Werra as the sole panelist in this matter on September 11, 2023. The Panel finds that it was properly constituted. 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.

#### **4. Factual Background**

The Complainant is a Swiss company founded in 1884 which manufactures high-end chronographs, watches, and related accessories which are sold in stores and distributors on all continents. The Complainant is also active through its official websites, and in particular “www.breitling.com”.

The Complainant owns numerous trademark rights worldwide covering the word BREITLING. In particular, the Complainant is the owner of the following trademarks (“the Trademark”):

- International Trademark BREITLING (device) n° 160212, registered on March 10, 1952 and covering goods in international class 14;
- International Trademark BREITLING (device) n° 279322, registered on January 31, 1964 and covering goods in international class 14.

The Disputed Domain Name was registered on July 31, 2022. It is not actively used.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant submits that the Disputed Domain Name is similar to the point of confusion to the Trademark. Indeed, the Disputed Domain Name reproduces the Trademark in its entirety. The only difference lies in the addition of the term “replica” in the Disputed Domain Name. It is established case law that the addition of a generic term to a well-known trademark in a domain name does nothing to diminish the likelihood of confusion arising from that domain name. The use of lower-case letter format on the one hand and the addition of the Top-Level Domain (“TLD”) “.watch” on the other hand, are not significant in determining whether the Disputed Domain Name is identical or confusingly similar to the Trademark of the Complainant. Therefore, the Complainant contends that the Disputed Domain Name is identical or highly similar to the Complainant's Trademark.

The Complainant further claims that the Respondent is not commonly known by the Disputed Domain Name and that the Respondent has not acquired any trademark or service mark related to the BREITLING word. The Complainant has conducted trademark searches and found no trademark containing the BREITLING word or right owned by any other than the Complainant. There is no evidence that the Respondent has been commonly known by the Disputed Domain Name as an individual, business, or other organization. This statement is reinforced by the fact that the Complainant has filed this complaint soon after the registration of the Disputed Domain Name, intending to not allow the Respondent to be commonly known by the Disputed Domain Name. Secondly, the Respondent reproduces the Complainant's Trademark without any license or authorization from the Complainant's company, which is a strong evidence of the lack of legitimate interest. Thirdly, the Respondent's use of the Disputed Domain Name or preparation to use it demonstrate no intent to use it in connection with a *bona fide* offering of goods or services. On the contrary, the Disputed Domain Name directs to an error page. The Disputed Domain Name is inherently likely to mislead Internet users, and there is no evidence that the Respondent has been making a legitimate noncommercial or fair use of the Disputed Domain Name. In addition, in light on the worldwide renown of the Complainant's Trademark, the Complainant sees no plausible use of the Disputed Domain Name that would be legitimate fair and noncommercial. Fourthly, since the adoption and extensive use by the Complainant of the Trademark predates the first registration of the Disputed Domain Name, the burden is on the Respondent to establish

the Respondent's rights or legitimate interests the Respondent may have or have had in the Disputed Domain Name. None of the circumstances which set out how a respondent can prove his rights or legitimate interests are present in this case. In light of all these elements, the Respondent should be considered as having no rights or legitimate interests in respect of the Disputed Domain Name.

Ultimately, the Complainant states that the Complainant and its Trademarks are so widely well-known that it is inconceivable that the Respondent ignored the Complainant's earlier rights on the BREITLING word. The notoriety of the Complainant is evidenced on the Internet with the Complainant's Facebook page being followed by more than 850,000 users and the Complainant's Instagram account being followed by more than 1.4 million users. Moreover, a simple search on an online search engine yields results related to the Complainant whereby the first result is the Complainant official website. Given the high similarity of the Disputed Domain Name to the Trademark as well as the notoriety of the Complainant, it is clear that, at the very least, the Respondent knew or should have known that, when registering and using the Disputed Domain Name, he would do so in violation of the Complainant's earlier rights. Secondly, the Complainant submits that it is very likely that the Respondent chose the Disputed Domain Name because of its identity with or similarity to the Trademark in which the Complainant has rights and legitimate interests. This was most likely done in the hope and expectation that Internet users searching for the Complainant's services would instead come across the Respondent's site. Such a domain name does not provide a legitimate interest, nor does it make for a use of the domain name in good faith under the Policy. Thirdly, the Complainant sees no possible way whatsoever that the Respondent would use the Disputed Domain Name in connection with a *bona fide* offer of products or services. Indeed, any use of the Trademark would amount to trademark infringement and damage to the repute of the Trademark. The sole detention of the Disputed Domain Name by the Respondent in an attempt to prevent the Complainant from reflecting its trademark and company name in a domain name is a strong evidence of bad faith. Furthermore, any actual use of the Disputed Domain Name by the Respondent would *de facto* amount to bad faith active use. Fourthly, the Complainant's Trademark significantly predates the registration date of the Disputed Domain Name. Fifthly, the current use of the Disputed Domain Name may not be considered a good faith use. By simply maintaining the Disputed Domain Name, the Respondent is preventing the Complainant from reflecting its Trademark in the corresponding domain name. In addition, the Disputed Domain Name resolves to a blank page. The non-use of a domain name (including a blank or "coming soon" page) does not prevent a finding of bad faith under the doctrine of passive holding. It is not necessary for the Respondent's conduct to fall precisely within any of the examples of bad faith registration and use which are set out at paragraph 4(b) of the Policy. These are only examples, and do not limit the circumstances which might constitute bad faith registration and use of the Disputed Domain Name.

In light of all these elements, the Complainant contends that the Disputed Domain Name was registered and is being used in bad faith by the Respondent. The combination of all the elements listed and detailed above unequivocally show that the Respondent has acted in bad faith when registering and using the Disputed Domain Name.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that the complainant must prove each of the following three elements in order to succeed in a UDRP proceeding. Thus, for the Complainant to succeed, it must prove all of the three elements under the Policy:

(i) the Respondent's 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 Respondent's Disputed Domain Name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

The Complainant must establish that the Respondent's Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Panel notes that the Complainant has established that it is the owner of the Trademark which corresponds to the Complainant's corporate name. It notes in this respect that the Trademark has a high degree of global distinctiveness and recognition, whereby this has not been disputed by the Respondent. See *e.g.*, *Breitling SA v. Will Wang*, WIPO Case No. [D2018-0829](#).

The Panel also notes that the Trademark on which the Complainant relies in this case contain design elements. These design elements however do not constitute the dominant portion of the Trademark so that these elements would overtake the textual elements of the Trademark in prominence. As a result, the Panel finds that the Trademark satisfies the requirement that the Complainant shows "rights in a mark" for further assessment as to confusing similarity. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.10.

The Panel notes that the Disputed Domain Name fully includes the Trademark to which the term "replica" is added. This does not prevent a finding that the Disputed Domain Name is confusingly similar to the Complainant's Trademark. See [WIPO Overview 3.0](#), section 1.8.

As a result, based on the rights of the Complainant on the Trademark and on the confusing similarity between the Trademark and the Disputed Domain Name, the Panel finds that the conditions of paragraph 4(a)(i) of the Policy are met.

### **B. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights to or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

(i) before any notice to it 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 has been commonly known by the domain name, even if it 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.

Although a complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, previous UDRP panels have consistently ruled that paragraph 4(c) of the Policy shifts the burden to the respondent to come forward with evidence of a right or legitimate interest in the domain name, once the complainant has made a *prima facie* showing. See *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#).

The Panel finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Complainant's earlier use and registration of the Trademark clearly predate the registration date of the Disputed Domain Name by the Respondent. The Complainant did not license nor authorize the Respondent to use the Trademark. Neither is there any evidence showing that the Respondent is commonly known by the Disputed Domain Name. The absence of

active use of the Disputed Domain Name does not constitute a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the Disputed Domain Name within the meaning of paragraphs 4(c)(i) and 4(c)(iii) of the Policy.

Having established a *prima facie* case, the burden of production shifts to the Respondent to show that he has rights or legitimate interests in the Disputed Domain Name, which has not been established given that the Respondent has not participated to the proceedings.

The Panel is consequently satisfied that the Complainant has established that the second requirement of paragraph 4(a) of the Policy is met.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of registration and use of a domain name in bad faith:

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

(ii) circumstances indicating that the respondent 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 the respondent has engaged in a pattern of such conduct;

(iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the respondent intentionally is using the domain name in an attempt to attract, for commercial gain, Internet users to its website 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 website or location or of a product or service on its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant is seeking to profit from and exploit the trademark of another. See *<Match.com>, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. [D2004-0230](#).

In this case, the Panel finds on the basis of the allegations of the Complainant (to which the Respondent has not reacted) that the Respondent registered and used the Disputed Domain Name in bad faith. In this respect, the Panel finds that the current inactive status of the Disputed Domain Name does not prevent a finding of bad faith under the Policy. [WIPO Overview 3.0](#), section 3.3, provides in this respect that “[f]rom the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or ‘coming soon’ page) would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.”

By applying these factors in this case, the Panel finds that (i) the Complainant's Trademark is very well

known and that the Respondent must have been aware of it at the time of the registration of the Disputed Domain Name; (ii) the Respondent has not replied to the Complaint; (iii) the Respondent has sought to conceal its identity through the use of a privacy service; and (iv) it is impossible to think of any good faith use to which the Disputed Domain Name could be put. In this respect, the bad faith of the Respondent is further established as a result of the choice of the TLD of the Disputed Domain Name (".watch") which corresponds exactly to the type of the well-known products marketed by the Complainant under the Trademark. See section 1.11.2 of the [WIPO Overview 3.0](#) ("in cases where the TLD corresponds to the complainant's area of trade so as to signal an abusive intent to confuse Internet users, panels have found this relevant to assessment under the third element").

On this basis, the Panel concludes that the Respondent has registered and is using the Disputed Domain Names in bad faith and therefore finds that the third element of paragraph 4(a) of the Policy has been satisfied.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <breitlingreplica.watch>, be transferred to the Complainant.

*/Jacques de Werra/*

**Jacques de Werra**

Sole Panelist

Date: September 26, 2023