

## ADMINISTRATIVE PANEL DECISION

### The Swatch Group AG and SWATCH AG v. Name Redacted Case No. D2023-1400

#### 1. The Parties

The Complainants are The Swatch Group AG and SWATCH AG, Switzerland, internally represented.

The Respondent is Name Redacted.<sup>1</sup>

#### 2. The Domain Name and Registrar

The disputed domain name <swatchgroup.com> is registered with NameSilo, LLC (the “Registrar”).

#### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 31, 2023. On March 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 31, 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, PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainants on April 3, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on April 4, 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”).

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<sup>1</sup> The Respondent appears to have used the name of a third party when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted the Respondent’s name from this Decision. However, the Panel has attached as Annex 1 to this Decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this Decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 25, 2023. A third party's communication was received on April 11, 2023, by the Center. The Center notified Commencement of Panel Appointment Process to the Parties on May 3, 2023.

The Center appointed Andrew Brown K.C. as the sole panelist in this matter on May 9, 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 Complainants are the owners of THE SWATCH GROUP and SWATCH trademarks (together the SWATCH Marks). They commenced use of the SWATCH Marks at least as early as 1983 primarily in connection with wristwatches. The Complainants also produce apparel and sunglasses.

The Complainants own many registrations for the SWATCH Marks. These are registered as an International registration, as well as in Switzerland, United States of America, China, Japan and the European Union. The registrations include class 14 for wristwatches, horological instruments and jewellery and (*inter alia*) to services in class 35 relating to the retailing and wholesaling of horological goods and jewellery. The Complainants trademarks include, United States of America SWATCH Registration No. 1356512, registered on August 27, 1985, and the International trademark SWATCH GROUP Registration No. 11187122, registered on September 18, 2013. The Complainants own registrations for the SWATCH Mark in further additional classes and countries.

The Complainants also claim that they have gained common law rights and goodwill in the SWATCH Marks and that these are well known. This is as a result of use, promotion, the presence of branded SWATCH retail stores (throughout North America, Europe, Middle East, Africa, Central and South America, Asia and Australia) and e-commerce shops at <shop.swatch.com>.

The disputed domain name was registered on March 22, 2023, and resolved to an anonymous placeholder page at the website connected to the disputed domain name.

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

##### **A. Complainants**

The Complainants asserts their rights in the SWATCH Marks. They state that the SWATCH GROUP trademark has been found to be well known: *SWATCH AG v Boomin Geong*, WIPO Case No. [D2018-2627](#) and similarly the SWATCH Mark is well known in its industry, see *Swatch Limited v Uli Kumli, Social-Media Club*, WIPO Case No. [D2016-2338](#).

The Complainants state that the disputed domain name is confusingly similar given that:

- (i) the disputed domain name includes the Complainants' trademark;
- (ii) the Complainants' trademark is readily recognizable within the disputed domain name;
- (iii) the addition of a variety of retail-related descriptive terms has been found by many panels to be insufficient to avert a finding of confusing similarity;

- (iv) the mere addition of a combination of arbitrary letters is not sufficient to eliminate confusion (in this case the addition being the letter “i”).

The Complainants also contend that the Respondent has no rights or legitimate interests in the disputed domain name. In this regard, the Complainants contend that there is no evidence that the Respondent is known by the disputed domain name; that the Respondent is not related to the Complainants; and that the Complainants have not granted any license to the Respondent.

Further, the Complainants assert that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain. In addition, the Complainants state that it is not possible to conceive of any plausible actual or contemplated use of this highly specific domain name which so clearly targets the Complainants.

Finally, the Complainants state that the Respondent has registered and is using the disputed domain name in bad faith. The grounds relied on are that the disputed domain name is solely composed of the first Complainant’s SWATCH GROUP Mark as well as the first Complainant’s name. As a result, the Complainants state that the Respondent is creating confusion to potential visitors to any website at the disputed domain name. Such Internet users will be given the impression that this is the Complainants’ official website or one that is sponsored, affiliated or endorsed by them.

The Complainants contend that the registration of a domain name that (disregarding the “i”) is identical to the Complainants’ SWATCH GROUP Mark clearly shows a targeting of the Complainants.

The Complainants contend that the Respondent’s registration of an intentionally misleading domain name is very suspicious and that it is highly probable a phishing campaign could be launched with misleading emails. Allowing the Respondent to use the disputed domain name would put the Complainants at an unacceptable risk of being affected by illegal activities.

## **B. Respondent**

The Respondent did not reply to the Complainants’ contentions.

## **6. Discussion and Findings**

### **6.1.1 Procedural Issue – Consolidation of multiple Complainants**

Factors which are relevant to consolidate multiple complainants filing against a single respondent include:

- (i) whether the complainants have a common grievance against the respondent;
- (ii) whether it would be equitable and procedurally efficient to permit the consolidation: WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) section 4.11.1.

In this case there are two Complainants, namely The Swatch Group AG and Swatch AG. The first Complainant is the parent of the second Complainant. This close legal relationship makes consolidation appropriate. Importantly, the Complaint involves a single respondent and a single domain name. Given all these factors the Panel grants the request for consolidation.

### **6.1.2 Procedural Issue – Identity of the Respondent**

On April 11, 2023, the Center received an informal communication from a third party, disclosing that it received the Written Notice, but that it has never owned the disputed domain name. The Panel finds it more likely than not that Respondent has provided false contact information. To avoid involving an unrelated third party, the Panel has ordered the redaction of the name of the Respondent.

## 6.2. Substantive issues

Pursuant to paragraph 4(a) of the Policy, a complainant must prove each of the following elements with respect to the disputed domain name in order to succeed in this proceeding:

- (i) that the disputed domain name is identical or confusingly similar to a trademark in which the Complainants have rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The Complainants have provided evidence of their rights to the SWATCH Marks in multiple jurisdictions. They have also provided evidence of extensive use of the SWATCH Marks internationally starting in 1983.

It is the Panel's view that the Complainants have clearly and sufficiently demonstrated their rights in the SWATCH Marks. The Panel is satisfied that the Complainants are well known internationally by their SWATCH Marks in relation to a core group of products including wristwatches, horological instruments and associated goods. The Panel also has taken note of earlier panel decisions making closely similar findings in *SWATCH AG v Boomin Geong*, WIPO Case No. [D2018-2627](#); *Swatch Limited v. Uli Kumli, Social-Media, Club*, WIPO Case No. [D2016-2338](#); *Swatch AG/The Swatch Group AG v. Name Redacted*, WIPO Case No. [D2022-4622](#); *Swatch AG/The Swatch Group AG v. Llanes, Lourdes*, WIPO Case No. [D2022-4344](#).

The Panel finds that the disputed domain name is confusingly similar to the Complainants' SWATCH GROUP trademark. This trademark is immediately recognizable in the disputed domain name. The disputed domain name is also confusingly similar to the Complainants' SWATCH trademark.

The Panel therefore finds that the disputed domain name is confusingly similar to the Complainants' SWATCH GROUP and SWATCH trademarks and finds in favor of the Complainants in respect of paragraph 4(a) of the Policy.

### B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish that it has rights or legitimate interests in the disputed domain name, among other circumstances, by showing any one of the following elements:

- (i) that before notice of the dispute, the Respondent used or made 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) that the Respondent has been commonly known by the disputed domain name, even if it had acquired no trademark or service mark rights; or
- (iii) that 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.

The overall burden of proof for establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name lies with the Complainant.

There is no evidence of the existence of any rights or legitimate interests on the part of the Respondent in the SWATCH GROUP or SWATCH trademarks pursuant to paragraph 4(c) of the Policy. The Complainants unquestionably have prior rights in these trademarks, which precede the Respondent's registration of the

disputed domain name by almost 40 years. The Panel is satisfied that the Complainants have never licensed or permitted the Respondent to use their SWATCH GROUP and SWATCH trademarks. The Panel is further satisfied that the Respondent has never been commonly known by the disputed domain name and that the Respondent has not made a legitimate noncommercial or fair use of the disputed domain name.

The Respondent had the opportunity to demonstrate its rights or legitimate interests in the disputed domain name but it has not replied to the Complaint.

The Panel therefore finds that the Complainants have satisfied the burden of establishing a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name and accordingly finds that paragraph 4(a)(ii) of the Policy is satisfied in favor of the Complainants.

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

The Panel is also satisfied that the disputed domain name has been registered in bad faith for the following reasons:

- (i) The Panel has already found that the Complainants' SWATCH GROUP and SWATCH trademarks are well known for a core group of products including wristwatches, horological instruments and associated goods. It is inconceivable that in registering <swatchigroup.com>, where the letter "i" bisects "swatch" and "group", that the Respondent was unaware of the Complainants' well-known trademarks. The Panel is satisfied that the Respondent was aware of the Complainants' SWATCH Mark at the time of registration;
- (ii) Paragraph 2 of the UDRP puts a burden on registrants where it states "by applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and bond to us that [...] to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of a third party [...]. It is your responsibility to determine whether your domain name infringes or violates someone else's rights." Even the most cursory trademark or other online search or any online search of existing domain names prior to the Respondent registering the disputed domain name would instantly have revealed the Complainants' and their SWATCH GROUP and SWATCH trademarks. See in this regard section 3.2.3 of the [WIPO Overview 3.0](#).

The Panel is also satisfied that the Respondent is using the disputed domain name in bad faith. The Respondent has not linked the disputed domain name to any site. At present, there is an anonymous placeholder page at the website connected to the disputed domain name.

The Panel is satisfied that the doctrine of passive holding applies in this case ([WIPO Overview 3.0](#) section 3.3).

Relevant factors for the application of this doctrine on these facts are:

- (i) The Complainants' SWATCH GROUP and SWATCH trademarks are well-known internationally and are exclusively associated with the Complainants. When confronted with the disputed domain name many Internet users would wrongly assume that the disputed domain name is owned by, connected with, licensed by or otherwise endorsed by the Complainants;
- (ii) There is no evidence of any contemplated or actual *bona fide* use of the disputed domain name. The placeholder page does not reveal any intended use;
- (iii) The implausibility of any good faith use to which the disputed domain name may be put, taken together with the Complainants' concern that the disputed domain name will be used for wrongful purposes such as passing off and/or phishing are both highly relevant.

- (iv) The Respondent had the opportunity to respond to the Complaint but has not done so. The Panel is therefore entitled to draw adverse inferences from that failure or omission.

Accordingly, the Panel finds that paragraph 4(a)(iii) of the Policy is satisfied in favor of the Complainants.

## **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, <swatchigroup.com>, be transferred to the Complainants.

*/Andrew Brown K.C./*

**Andrew Brown K.C.**

Sole Panelist

Date: May 23, 2023