

## **ADMINISTRATIVE PANEL DECISION**

Cartier International AG v. Stephen Wayne Pennells  
Case No. DAU2024-0038

### **1. The Parties**

The Complainant is Cartier International AG, Switzerland, represented by Demys Limited, United Kingdom.

The Respondent is Stephen Wayne Pennells, Australia, self-represented.

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

The disputed domain name <cartier.au> is registered with Domain Directors Pty Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 11, 2024. On December 11, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 11, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the “Policy”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 17, 2024. In accordance with the Rules, paragraph 5(a), the due date for Response was January 6, 2025. The Response was filed with the Center on December 31, 2024.

The Center appointed John Swinson as the sole panelist in this matter on January 10, 2025. 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 company from Switzerland that designs, makes, and sells luxury products, such as watches and high jewelry. The Complainant was founded by Louis-François Cartier in 1847 in Paris, France.

The Complainant operates 277 boutiques worldwide, including eight in Australia.

The parent company of the Complainant called Richemont International SA holds Australian trademark registrations for CARTIER, including Australian Trademark Registration No. 356425 which was registered on February 11, 1981. According to the Australian Trade Mark Office records, this registration was assigned from the Complainant to Richemont International SA, with the assignment being recorded on December 5, 2024. Richemont International SA also owns United States of America Trademark Registration No. 410701, with a registration date of December 12, 1944, which was also assigned from the Complainant in 2024.

The Respondent has an address in Australia, but little information is known about the Respondent. The Respondent has an Australian Business Number, but is not registered for GST in Australia.

The disputed domain name was registered on October 3, 2022.

The disputed domain name does not resolve to an active website.

The Complainant's representative emailed the Respondent in October 2024 but did not receive a reply.

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

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

In summary, the Complainant makes the following submissions:

The Complainant submits that the CARTIER brand is well-known around the world, and in particular has been publicized in the Australian media. The Respondent is more likely than not to be aware of the Complainant.

The Complainant has a trademark registration that pre-dates the registration of the disputed domain name for more than 77 years.

The disputed domain name is identical to the Complainant's CARTIER trademark.

The Respondent does not have rights or legitimate interests in the disputed domain name from its non-use.

The Complainant contends that the Respondent's registration of the disputed domain name prevents the Complainant from reflecting its CARTIER mark in the Australian domain name space. Additionally, the Respondent's registration is disruptive to the business of the Complainant.

##### **B. Respondent**

In summary, the Respondent makes the following submissions:

The Respondent submits that the disputed domain name was registered in compliance with auDA policies and without bad faith, malicious intent, or any implied connection to the Complainant.

The name "Cartier" has multiple legitimate, non-brand-related uses, and there is no evidence to support claims of consumer confusion, bad faith, or infringement of trademark rights.

As auDA policies explicitly state, domain name registrations are determined on a first-come, first-served basis, provided the registrant meets eligibility requirements.

The Complainant's failure to register the disputed domain name effectively waived its exclusive claim to the disputed domain name. Their apparent decision not to claim the disputed domain name suggests they either assessed it as non-critical or overlooked the process, which does not invalidate the lawful registration of the disputed domain name by the Respondent.

The term "Cartier" is generic and non-exclusive.

The Respondent has not used the domain in any way that implies affiliation with the Complainant. There have been no attempts to market goods, services, or content under the name "Cartier."

auDA policies explicitly allow passive holding of domain names.

## **6. Discussion and Findings**

Paragraph 4(a) of the auDRP provides that a complainant must prove each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to a name, trademark or service mark in which the complainant has rights;
- (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 or subsequently used in bad faith.

The burden of proof of each element is borne by the Complainant.

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 the Panel deems applicable.

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

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

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

For present purposes, the Complainant has proven that it has rights over a registered trademark in the United States of America for CARTIER as discussed in section 4 above.

The entirety of the CARTIER trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the trademark for the purposes of the Policy.

The Panel notes that the Complainant relies upon an Australian trademark registration. However, shortly before the Complaint was filed, the Australian Trade Mark Register was updated to record that this (and other) CARTIER trademark was assigned by the Complainant to Richemont International AG. No explanation was set out in the Complaint regarding this assignment. In reviewing prior decisions under the Uniform Domain Name Dispute Resolution Policy (UDRP), the Panel is aware that the Complainant and Richemont International AG are related entities and form part of the Richemont group. See, for example, *Richemont International AG, Montblanc-Simplo GmbH, Officine Panerai AG, and Cartier International AG v. Zhang Jie* (

张杰), *shang hai heng shi da zhong biao xiao shou you xian gong si* (上海亨时达钟表销售有限公司), WIPO Case No. [D2020-1505](#). No explanation was set out in the Complaint as to why Richemont International AG was not named as a party to the Complaint.

. In light above, the Panel finds that the Complainant has rights in the CARTIER trademark for the purposes of paragraph 4(a)(i) of the Policy. Overview of Panel Views on Selected auDRP Questions, Second Edition (“auDRP Overview 2.0”), section 1.4.

The Panel finds the first element of the Policy has been established.

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

The second requirement 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 may be situations in which a respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to the respondent of the subject matter of the dispute, the respondent’s bona fide use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with an offering of goods or services (not being the offering of domain names that you have acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the 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 domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the name, 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. Previous 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 the burden of production will shift to the respondent to rebut that prima facie case. The ultimate burden of proof, however, remains with the Complainant. See, e.g., *GlobalCenter Pty Ltd v. Global Domain Hosting Pty Ltd*, WIPO Case No. [DAU2002-0001](#).

The Respondent has not used the disputed domain name. The Respondent has provided no evidence of use or plans to use the term “Cartier”. The Respondent is not commonly known as “Cartier”.

The Respondent asserts that “Cartier” is a generic term, is a widely used surname, is the name of a mountain and of a river in Canada, and is used by The Cartier Foundation for Contemporary Art. However, CARTIER is also a registered trademark in which the Complainant has rights.

The Respondent states that “The name ‘Cartier’ can be lawfully used for purposes unrelated to luxury goods, as evidenced by its historical, geographic, and personal significance.” Regardless of whether this statement is correct, the Respondent has not demonstrated that he has made bona fide use of, or demonstrable preparations to use, the disputed domain name for such purposes, nor whether the claimed “personal significance” would be that of third parties or of the Respondent himself – in case he would suggest it is the latter, there is no evidence presented to support any such claim.

The Respondent argues that the Complainant could have registered the disputed domain name, but did not, and that the Respondent was thus entitled to register the disputed domain name on a “first-come, first-served” basis. However, the Respondent ignores the representations made by domain name registrants in paragraph 2 of the Policy that “to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party”. The “first-come, first-served” rule cannot reasonably be interpreted in such a way as the Respondent would suggest so as to ignore or somehow trump prior trademark rights. *FFD100 Pty Ltd and Strata Town Pty Ltd v. Bellcourt Strata Management Pty Ltd trading as B Strata*, WIPO Case No. [DAU2022-0033](#).

The Panel finds the second element of the Policy has been established.

### **C. Registered or Subsequently Used in Bad Faith**

Unlike the UDRP, the requirements that the disputed domain name be registered or used in bad faith are disjunctive in the auDRP. That is, it is sufficient for the Complainant to show either that the disputed domain name was registered in bad faith or has been used in bad faith.

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered or is using the disputed domain name to take advantage of its significance as a trademark (usually) owned by the complainant.

The disputed domain name is identical to the famous trademark in which the Complainant has rights. The Respondent did not assert that he was not aware of the Complainant or the CARTIER trademark when the Respondent decided to register the disputed domain name.

The Respondent asserts that he has not used the disputed domain name to imply a connection with the Complainant, that he has not offered the disputed domain name for sale, and that auDA policies explicitly allow for passive holdings of domain names.

These all may be true in their own respect, but the Respondent seems to overlook Paragraph 4(b)(ii) of the Policy which states that the following circumstance is evidence of registration and use of a domain name in bad faith: “you have registered the domain name in order to prevent the owner of a name, trademark or service mark from reflecting that name or mark in a corresponding domain name”.

Panels generally have found that registration of a domain name that consists solely of the complainant’s trademark (once the second-level and/or the top-level domain extensions are ignored) has the effect of preventing the complainant from reflecting its trademark in a domain name – and hence is evidence of bad faith. *Miltenyi Biotec GmbH v. Rachel A. Liu-Williams*, WIPO Case No. [DAU2015-0033](#).

auDRP panels have found that a passive holding of the domain name without any active attempt to sell or to contact the complainant about the domain name, does not, as such, prevent a finding of bad faith. The panel will examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Here, these circumstances include that the Complainant has rights in a very well-known trademark; and the Respondent provided no evidence of any actual or contemplated good faith use – by him – of the disputed domain name since registration of it. *Twilio Inc. v. Timothy John Apps*, WIPO Case No. [DAU2022-0002](#).

The Panel finds the third element of the Policy has been established.

### **D. Appropriate Order**

The Complainant has met all three requirements under the Policy.

Paragraph 4(i) of the Policy states that “[t]he remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the

transfer of your domain name registration to the complainant (provided that the complainant is otherwise eligible to hold that domain name).”

The Complaint as filed requested that the disputed domain name be transferred to the Complainant, Cartier International AG. The Complainant Cartier International AG is a Swiss entity and (as far as the Panel can determine) it is not clear if it is registered to do business in Australia.

The .au Domain Administration Rules: Licensing Policy No. 2019-0 (“Licensing Policy”), require an Australian presence.

The Complainant does not own any Australian Trade Mark registrations or applications for CARTIER (they appear to have been assigned shortly before the Complaint was filed, as set out above), and so cannot establish an Australian presence on this basis.

The Complainant may have an Australian presence as per the Licensing Policy (in particular paragraphs 2.4.3), but no evidence was presented to the Panel in this regard. Alternatively, if the Complainant does not have an Australian presence, the Complainant could have sought cancellation rather than transfer of the disputed domain name.

Given the findings in the Complainant’s favour on all three policy elements, the Panel considers that the appropriate remedy would be a transfer to the Complainant; this would however be subject to the discretion of the registry and/or registrar as to the Licensing Rules. If the Complainant cannot establish an Australian presence, then an appropriate remedy may be for the disputed domain name to be cancelled. See *LovePop, Inc. v. KCG PTY LTD*, WIPO Case No. [DAU2021-0037](#); *Allergan, Inc. and Allergan Australia Pty Ltd v. Denise Costa*, WIPO Case No. [DAU2021-0038](#); and *A2 Hosting, Inc. v. ASOP Investments Pty Ltd*, WIPO Case No. [DAU2023-0019](#).

## 7. Decision

For all 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 <cartier.au> be cancelled or transferred to the Complainant in the discretion of the registry and/or registrar.

/John Swinson/

**John Swinson**

Sole Panelist

Date: January 24, 2025