

## **ADMINISTRATIVE PANEL DECISION**

Breitling SA v. tao tao  
Case No. D2023-3302

### **1. The Parties**

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

The Respondent is tao tao, China.

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

The disputed domain name <breitlingreplicawatch.com> is registered with Gname 015 Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English 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 3, 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 (Undisclosed Respondent/Unknown) 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. On the same day, the Center transmitted another email communication to the Parties in English and Chinese regarding the language of the proceeding. The Complainant filed an amended Complaint in English on August 9, 2023 including its request that English be the language of the proceeding.

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 in Chinese and English of the amended Complaint, and the proceedings commenced on August 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 18, 2023.


The Center appointed Francine Tan as the sole panelist in this matter on September 28, 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, Breitling SA, is a Swiss company which was founded in 1884. It manufactures high-end chronographs, watches and related accessories and is known for its precision-made chronometers designed for aviators. The Complainant states that it has stores and distributors all over the world and maintains a reputation as one of the best high-end luxury watchmakers.

The Complainant states that it has trade mark rights worldwide in the term “Breitling”, including but not limited to the following:

(i) International trade mark registration No. 279322 for  registered on January 31, 1964; and

(ii) International trade mark registration No. 160212 for  BREITLING registered on March 10, 1952.

The Complainant’s official websites include “www.breitling.com”.

The disputed domain name <breitlingreplicawatch.com> was registered on April 16, 2023. As at the time of filing of the Complaint, the disputed domain name led to an inactive website with a blank landing page.

#### 5. Parties’ Contentions

##### A. Complainant

- (i) The disputed domain name is confusingly similar to its BREITLING trade mark in which it has rights. The disputed domain name wholly incorporates the BREITLING mark. The only difference lies in the addition of the terms “replica” and “watch” as well as the generic Top-Level Domain (“gTLD”) “.com”.
- (ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name. It has not acquired trade mark rights in the term “Breitling” and is not commonly known by the disputed domain name. The Complainant has not licensed or permitted the Respondent to use any of its trade marks or register the disputed domain name.
- (iii) The disputed domain name was registered and is being used in bad faith. A quick trade mark search would have revealed to the Respondent the existence of the Complainant and its BREITLING trade marks. The Complainant’s BREITLING trade mark is well known and although the disputed domain name leads to an inactive website, it does not prevent a finding of bad faith registration and use.

##### B. Respondent

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

#### 6. Discussion and Findings

##### 6.1 Preliminary Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. The Complainant requested that the language of the proceeding be English for these reasons:

- (i) The Complainant is not able to communicate in Chinese.
- (ii) The disputed domain name contains the English terms “replica” and “watch”.
- (iii) The Complainant would be put to significant expense if the Complaint has to be translated into Chinese and the proceeding would thereby be delayed.

The Respondent did not comment on the language of the proceeding.

Paragraph 11(a) of the Rules provides that:

“Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.”

The intention of paragraph 11(a) is to allow panels some flexibility and discretion to consider the entire circumstances of each case, to ensure fairness between the parties, while at the same time not affecting the importance for the proceeding to be administered in an expeditious manner. (See section 4.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).)

Having considered the relevant factors and interests of the respective Parties, the Panel determines that it would be appropriate for English be the language of the proceeding. The Panel is persuaded that the Respondent would not be prejudiced as it is probably familiar with and understands the English language, taking into account its selection of the language of the disputed domain name which comprises the Complainant’s BREITLING trade mark and the English terms “replica” and “watch”. The Respondent had, moreover, been notified by the Center, in both Chinese and English of the commencement of the proceeding, the language of the proceeding, and the relevant deadline for filing its comment on the language of the proceeding and the Response. It could have rejected the Complainant’s language request and conveyed to the Center any difficulty it may have in corresponding in English and it could have chosen to file its Response in Chinese, but it did not do so. In the circumstances, the Panel does not find any justification for, nor would it be procedurally efficient, having the Complainant translate the Complaint into Chinese.

## **6.2 Substantive Issues: Three Elements**

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

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights.

A registered trade mark provides a clear indication that the rights in the mark shown on the trade mark registration certificate belong to the stated owner. The Complainant has provided evidence that it owns the BREITLING trade mark and has rights therein as a result of very long use.

The disputed domain name contains the Complainant’s BREITLING trade mark in its entirety with the addition of the terms, “replica” and “watch”. The Complainant’s BREITLING mark is immediately recognizable in the disputed domain name. It is well established by earlier UDRP panel decisions that where a complainant’s trade mark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See [WIPO Overview 3.0](#), section 1.8.

Further, it is a well-established principle that the gTLD in a domain name is a standard registration requirement and is to be disregarded under the first element confusing similarity test ([WIPO Overview 3.0](#), section 1.11.1).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the BREITLING trade mark in which the Complainant has rights. Paragraph 4(a)(i) of the Policy is satisfied.

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

The Complainant provided evidence that it owned rights in the BREITLING trade mark long before the date that the disputed domain name was registered. It is also evident that the Complainant is not affiliated with nor has it licensed or otherwise permitted the Respondent to use the Complainant's BREITLING trade mark. There is no evidence that the Respondent is commonly known by the disputed domain name.

Once a complainant establishes a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name in dispute, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the domain name ([WIPO Overview 3.0](#), section 2.1). The Complainant's *prima facie* case has not been rebutted by the Respondent.

The Panel therefore concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

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

The Panel is persuaded in this case that the Respondent targeted the Complainant and its well-established BREITLING trade mark. A tell-tale sign is the incorporation of the terms "replica watch" in the composition of the disputed domain name. There is no other reason for the Respondent to have registered the disputed domain name except for the sole purpose of riding off the reputation and goodwill of the Complainant and its trade mark and to lure Internet users to its website where it might offer replica copies of the Complainant's BREITLING watch designs.

Panels in earlier UDRP cases have found that the non-use of a domain name (including a blank page) would not prevent a finding of bad faith under the doctrine of passive holding. As is stated in Section 3.3 of the [WIPO Overview 3.0](#):

"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."

The Panel makes the following observations in this case:

- (a) the Complainant's BREITLING mark is highly reputable and distinctive;
- (b) the Respondent failed to submit a Response; and
- (c) any good faith use of the disputed domain name is simply not plausible.

The BREITLING mark is so famous as a luxury watch brand that it would be extremely difficult to believe any claim that the Respondent's choice of the disputed domain name was wholly innocent and coincidental. The disputed domain name is so obviously connected with the reputable BREITLING brand of watches that its use suggests opportunistic bad faith. See, e.g., *Sanofi-Aventis v. Nevis Domains LLC*, WIPO Case No. [D2006-0303](#); and *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#).

The Panel therefore concludes that the Respondent has registered and used the disputed domain name in bad faith. Accordingly, paragraph 4(a)(iii) of the Policy is 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 <breitlingreplicawatch.com> be transferred to the Complainant.

*/Francine Tan/*

**Francine Tan**

Sole Panelist

Date: October 11, 2023