

## **ADMINISTRATIVE PANEL DECISION**

Blancpain SA; Omega SA; and Swatch AG v. hu luo, lewansi; Oris Vomitiende, SWATCH X; lin mumu; jace8 steven; chen chen; and Dirk Scheidt  
Case No. D2023-4521

### **1. The Parties**

The Complainants are Blancpain SA; Omega SA; and Swatch AG, all located in Switzerland, represented internally.

The Respondents are hu luo, lewansi, China; Oris Vomitiende, SWATCH X, France; lin mumu, China; jace8 steven, China; chen chen, China; and Dirk Scheidt, Germany.

### **2. The Domain Names and Registrars**

The disputed domain names <blancpain-swatch.co>, <ja-swatch.shop>, <jp-swatch.shop>, <omega-swatch.ink>, <omega-swatch-jp.co>, <omega-swatch-jp.com>, <omegaswatch.online>, <swatch-brand.shop>, <swatch-jp.cc>, <swatchomega-jp.shop>, <swatch-shop.shop>, <swatch-vip.store>, and <sw-watch.shop> are registered with GoDaddy.com, LLC.

The disputed domain names <blancpain-tokyo.shop> and <omega-tokyo.online> are registered with PDR Ltd. d/b/a PublicDomainRegistry.com.

The disputed domain names <swatch-esp.com> and <swatchesp.com> are registered with Tucows Inc.

The disputed domain names <swatch-ja.cc> and <swatch-j.com> are registered with NameCheap, Inc.

(GoDaddy.com, LLC, PDR Ltd. d/b/a PublicDomainRegistry.com, Tucows Inc., and NameCheap, Inc. are hereinafter referred to as the “Registrar”.)

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 31, 2023. On November 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 2 and November 3, 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 (Redacted for privacy, Domains By

Proxy LLC, DomainsByProxy.com / Contact Privacy Inc. Customer 0168669719 / Contact Privacy Inc. Customer 0168720192) and contact information in the Complaint.

The Center sent an email communication to the Complainants on November 3, 2023, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainants to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity. The Complainants filed an amended Complaint on November 8, 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 Respondents of the Complaint, and the proceedings commenced on November 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 5, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on December 6, 2023.

The Center appointed Mihaela Maravela as the sole panelist in this matter on December 12, 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 dispute involves three Complainants, all subsidiary companies of The Swatch Group Ltd, a world leading watch company that employes about 36,000 people in 50 countries.

The Complainant Omega SA was founded in 1848 and is a well-known watch brand company. It has served as the Official Timekeeper of the Olympic Games since 1932. Further, Omega SA is the producer of the "Speedmaster" watch, the first watch ever worn on the moon. The Complainant Omega SA has registered several trademarks consisting of or including OMEGA or MOONWATCH, such as the International Trademark No. 132141 for OMEGA (word), registered as of August 11, 1947, for goods in classes 4, 8, and 14; or the International Trademark No. 1180215 for MOONWATCH (word), registered as of August 16, 2013, for goods in class 14.

The Complainant Swatch AG commenced as early as 1983 the use of the SWATCH trademark in connection with wristwatches. It has also produced or produces apparel, sunglasses, and other items. The Complainant Swatch AG has registered several trademarks consisting of or including SWATCH, such as the International Trademark No. 506123 for SWATCH (word), registered as of September 9, 1986, for goods in class 14. The Complainant Swatch AG uses the domain name <swatch.com> to promote the SWATCH brand and its products and services on the Internet.

The Complainant Blancpain SA was founded in 1735 and is the world's oldest watch brand. It operates a worldwide network of boutiques. It has registered several trademarks consisting of or including BLANCPAIN, such as the International Trademark No. 190558 for BLANCPAIN (word), registered as of February 8, 1956, for goods in class 14. The Complainant Blancpain SA uses the domain name <blancpain.com> to promote the BLANCPAIN brand and its products and services on the Internet.

All disputed domain names were registered between mid-August 2023 to mid-October 2023. At the date of filing the Complaint, the majority of the disputed domain names resolved to online shops purporting to sell SWATCH or OMEGA watches at discounted prices and displaying virtually similar websites to the

Complainants as well as the Complainants' trademarks OMEGA, SWATCH, BLANCPAIN, MOONSWATCH or a combination thereof. Few disputed domain names resolved to a homepage stating that the shop is closed.

At the date of this Decision, the disputed domain names <swatch-j.com>, <blancpain-tokyo.shop>, <sw-watch.shop>, <swatch-shop.shop>, <ja-swatch.shop>, <jp-swatch.shop>, <swatch-brand.shop>, <swatch-vip.store>, and <swatchomega-jp.shop> resolve to an error page. The disputed domain names <omega-tokyo.online>, <swatch-esp.com>, and <swatchesp.com> resolve to pages stating "This site can't be reached". The disputed domain names <omega-swatch-jp.co>, <omega-swatch.ink>, <omega-swatch-jp.com>, <blancpain-swatch.co>, and <swatch-jp.cc> display a message "CLOSED" followed by "SORRY, THE SHOP YOU ARE LOOKING IS CLOSED RIGHT NOW, PLEASE TRY AGAIN LATER." The disputed domain names <omegaswatch.online> and <swatch-ja.cc> respectively resolve to an Arabic and Japanese online shops which appeared to offer SWATCH products for sale at discounted prices, displaying the Complainants' trademarks or referring to Swiss watches.

## 5. Parties' Contentions

### A. Complainants

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainants contend that some of the disputed domain names incorporate the entirety of the Complainants' trademarks in combination with random added letters but without any distinguishing elements. Thus, the Complainants' trademarks are readily recognizable within such disputed domain names. Other disputed domain names incorporate the entirety of the Complainants' trademarks without any distinguishing elements or are a mere combination of two of the Complainants' trademarks. The hyphens used in part of the disputed domain names are mere punctuations, thus too minor to prevent a confusing similarity with the Complainants' trademarks under the Policy.

As regards the second element, the Complainants argue that there are no signs that the Respondents have been commonly known by the disputed domain names, and the Respondents are not in any way related to the Complainants or their business activities nor have the Complainants granted a license or authorized the Respondents to use their trademarks or apply for registration of the disputed domain names. The Respondents are using the disputed domain names to impersonate the Complainants and to lure consumers into buying counterfeited products or paying for products that are never delivered. Such usage of a domain name can never constitute a fair use under the Policy.

With respect to the third element, the Complainants argue that in March 2022, the Complainants Omega SA and Swatch AG officially announced a joint collaboration and launched the Bioceramic "MoonSwatch" collection, a collection of watches combining the famous OMEGA MOONWATCH with the famous brand SWATCH and that the Respondents have leapt at the opportunity and opened online stores impersonating the Complainants and claiming to sell said watches for discounted prices. These products, which are highly demanded, are produced in limited quantities, and sold only in the Complainants' physical stores. They are neither distributed through authorized retailer network nor the Complainants' online stores. The Respondents create confusion by wrongly making visitors of their websites believe to be endorsed and/or otherwise affiliated with the Complainants by using the Complainants' official logos prominently displayed on their websites, by including misleading statements including copyrights such as "SWATCH AG", and, further, by slavishly copying the Complainants' copyright protected material. Numerous customers reported to the Complainants that either the ordered products were of counterfeit nature, or no products were delivered after payment. The Complainants also argue that the Respondents operate a large network of similar deceiving websites targeting also other famous brands and some of such domain names are part of active UDRP cases.

## **B. Respondents**

The Respondents did not reply to the Complainants' contentions.

## **6. Discussion and Findings**

### **6.1. Preliminary Issue**

No communication has been received from the Respondents in this case. However, given that the Complaint was sent to the relevant addresses disclosed by the Registrar, the Panel considers that this satisfies the requirement in paragraph 2(a) of the Rules to "employ reasonably available means calculated to achieve actual notice". Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainants as per paragraph 15(a) of the Rules.

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

### **6.2. Procedural Issue: Consolidation of Multiple Complainants**

The Complaint was filed by three Complainants, who allege that they are all sister companies, being wholly-owned subsidiaries of The Swatch Group Ltd, and given the close legal relationship between the Complainants, consolidation is appropriate.

According to section 4.11.1 of the [WIPO Overview 3.0](#), "In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation". It is well accepted that a single complaint may be brought under the Policy by multiple complainants where the multiple complainants have a common grievance against the respondent and one example of a common grievance entitling consolidation of complainants is where the complainants share an interest in trademarks allegedly affected by the respondent's registration of the disputed domain name.

In this case, as all the Complainants are subsidiary companies of The Swatch Group Ltd, the Panel is of the view that a common legal interest is present. Also, all Complainants are represented by a single representative and the same remedy is sought by all Complainants. Moreover, some of the disputed domain names include combined trademarks of the Complainants (i.e., <blancpain-swatch.co>, <omega-swatch.ink>, <omega-swatch-jp.co>, <omega-swatch-jp.com>, <omegaswatch.online>, and <swatchomega-jp.shop>). In addition, the Complainants have an ongoing collaboration of a range of watches involving a combination of their trademarks and the use of their trademarks on most of the websites at the disputed domain names are identical and therefore affects their respective rights and interests in a similar fashion. The Respondents have not objected to the Complainants' consolidation request. Under the circumstances of the case, the Panel accepts that consolidation is procedurally efficient, fair, and equitable to all Parties, and will accept all three Complainants as party to the proceedings and will refer to them as the Complainant hereinafter.

### **6.3. Procedural Issue: Consolidation of Multiple Respondents**

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the disputed domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against

the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See [WIPO Overview 3.0](#), section 4.11.2.

As regards common control, the Panel finds that the consolidation of the disputed domain name is justified as, *inter alia*: (i) the disputed domain names are similar in construction, as the majority of them incorporate the Complainant's trademarks SWATCH, OMEGA, or BLANCPAIN or a combination of two of these trademarks with the addition of geographical terms or other term(s) or letter(s) and hyphen(s) in most of the disputed domain names, (ii) most of the disputed domain names comprise of a pattern where the OMEGA and/or SWATCH and/or BLANCPAIN trademarks are combined with additional terms or generic Top-Level Domains ("gTLDs") suggesting the sale of goods such as "shop", "store" and/or otherwise suggesting a purported online presence of the Complainant such as "online", (iii) most of the websites to which the disputed domain names resolved are virtually identical or highly similar to Complainant's official websites and display the Complainant's trademarks, (iv) currently most of the websites at the disputed domain names are inactive or display warning messages or that the online shops are closed, (v) the postal addresses for most of the Respondents are incomplete in view of the courier's inability to deliver the Center's written communications to the contact details disclosed by the Registrar for the registrants.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party and the Respondents have been given an opportunity to object to consolidation through the submission of pleadings to the Complaint but have not rebutted the consolidation.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred hereinafter as "the Respondent") in a single proceeding.

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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain names. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the trademarks are recognizable within the disputed domain names. The majority of the disputed domain names incorporate the trademarks SWATCH, OMEGA, or BLANCPAIN of the Complainant in their entirety. The disputed domain names also include one or two added term(s) and hyphens in few instances, which does not in the view of the Panel prevent the Complainant's trademark from being recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "tokyo", "esp", "ja", "jp", "shop", "brand", and "vip", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The disputed domain name <sw-watch.shop> consists of the obvious misspelling of the SWATCH trademark of the Complainant. This misspelling in the disputed domain name, also referred to as typosquatting, does not prevent a finding of confusing similarity (see [WIPO Overview 3.0](#), section 1.9).

Based on the available record, the Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

There is no evidence that the Respondent is using the disputed domain names in connection with a *bona fide* offering of goods or services.

Rather, according to the unrebutted evidence provided by the Complainant, at the date of filing the Complaint, most of the websites at the disputed domain names allegedly offered for sale the Complainant’s branded goods, reproducing the Complainant’s trademark and logo, as well as product images from the Complainant’s websites at discounted prices while some were inactive. Under these circumstances, it is reasonable to infer that the products offered on the websites at the disputed domain names were most likely counterfeits of the Complainant’s products. Even if the products were genuine, the lack of a prominent and accurate disclaimer on the website at the disputed domain names as to their relationship with the trademark owner or the lack thereof, would falsely suggest to Internet users that the websites to which the disputed domain names resolve are owned by the Complainant or at least affiliated to the Complainant, contrary to the fact (see the “Okidata test” outlined in *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)). The same conclusion applies for the disputed domain names that are used in a similar fashion at the date of the Decision (i.e., <omegaswatch.online> and <swatch-ja.cc>).

With respect to the rest of the disputed domain names, that did not resolve and do not resolve at the date of this Decision to active websites, there is no evidence that the Respondent is using those disputed domain names in connection with a *bona fide* offering of goods or services, nor does the Respondent appear to engage in any legitimate noncommercial or fair use of those disputed domain names within the meaning of paragraphs 4(c)(i) and (iii) of the Policy. Also, there is no evidence that the Respondent is commonly known by the disputed domain names within the meaning of paragraph 4(c)(ii) of the Policy. The Panel notes that one of the Respondent’s name appears to include SWATCH X. However, the Respondent did not claim it is commonly known by the disputed domain names within the meaning of paragraph 4(c)(ii) of the Policy. Moreover, the Panel considers that the Respondent cannot claim to have been “commonly known” by the disputed domain names under the above-mentioned paragraph of the Policy, as the circumstances of the case indicate that the Respondent most likely adopted the name “SWATCH X” specifically to take advantage

of the Complainant's rights, as discussed in Section 6C below.

Furthermore, the nature of the disputed domain names, that include the Complainant's trademark in its entirety, together in majority of cases with a term or terms related to a geographical location or the Complainant's business, carries a risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

According to the unrebutted assertions of the Complainant, its trademarks were widely used in commerce well before the registration of the disputed domain names. The disputed domain names are confusingly similar with the Complainant's trademarks. Under these circumstances, it is most likely that the Respondent was aware of the Complainant's trademark at the registration dates of the disputed domain names. The Respondent provided no explanations for why it registered the disputed domain names. Moreover, at the time of the filing of the Complaint, most of the disputed domain names resolved to websites reproducing the Complainant's trademarks and purportedly offering for sale the Complainant's products at discounted prices while others were inactive. Under these circumstances, it is reasonable to infer that the Respondent has registered the disputed domain names with knowledge of the Complainant's trademarks, and to target those trademarks.

The disputed domain names are also being used in bad faith. The unauthorised impersonation of the Complainant's website relating to the OMEGA and SWATCH collaboration for MOONSWATCH and allegedly offering for sale these products at discounted prices, which as per the Complainant, are sold only in the physical stores of the Complainant is clear indication of use for illegal activity. Either the products sold are counterfeit or no products are being delivered after payment, which according to uncontested evidence from the Complainant seems to have been the case. The websites at the disputed domain names appear to deliberately mislead Internet users that they are connected to, authorised by, or affiliated with the Complainant. Most of the disputed domain names resolved to websites mimicking the Complainant's websites, displaying the Complainant's trademark, logo, and product images, ostensibly offering the Complainant's products at discounted prices without any accurate and prominent disclaimers on the websites regarding the relationship between the Respondent and the Complainant. In these circumstances, the Panel concludes that the Respondent has intentionally attempted to attract, for commercial gain, by misleading Internet users into believing that the Respondent's websites and the products offered for sale and sold on them are those of or authorised or endorsed by the Complainant.

Panels have held that the use of a domain name for illegal activity, such as the sale of counterfeit goods or impersonation/passing off, or other types of fraud constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under paragraph 4(b)(iv) of the Policy.

Furthermore, the fact that some of the disputed domain names may have been inactive or are currently inactive does not prevent a finding of bad faith especially in the circumstances of this case, given that the Complainant's trademarks are well known and the other disputed domain names registered by the Respondent are used in bad faith. [WIPO Overview 3.0](#), section 3.3. The Respondent's bad faith registration and use of the disputed domain names can also be inferred from the warnings found at the date of the Decision on the websites at most of the disputed domain names, such as "your connection is not private".

Moreover, the Respondent has not participated in the proceeding and has failed to rebut the Complainant's contentions or provide any evidence of actual or contemplated good-faith use, and indeed none would seem plausible.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

## **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 names <blancpain-swatch.co>, <blancpain-tokyo.shop>, <ja-swatch.shop>, <jp-swatch.shop>, <omega-swatch.ink>, <omega-swatch-jp.co>, <omega-swatch-jp.com>, <omegaswatch.online>, <omega-tokyo.online>, <swatch-brand.shop>, <swatch-esp.com>, <swatchesp.com>, <swatch-ja.cc>, <swatch-j.com>, <swatch-jp.cc>, <swatchomega-jp.shop>, <swatch-shop.shop>, <swatch-vip.store>, and <sw-watch.shop> be transferred to the Complainant.

*/Mihaela Maravela/*

**Mihaela Maravela**

Sole Panelist

Date: December 20, 2023