

ADMINISTRATIVE PANEL DECISION

Blancpain SA and Swatch AG v. Li Li
Case No. D2023-4545

1. The Parties

The Complainants are Blancpain SA, Switzerland, and Swatch AG, Switzerland, represented by The Swatch Group Ltd., Switzerland.

The Respondent is Li Li, China.

2. The Domain Names and Registrar

The disputed domain names <blancpainwatch.shop>, <swatchboutique.shop>, <swatchboutique.shop>, <swatchdiscount.shop>, <swatchemporium.shop>, <swatchlimited.shop>, and <swatchofficial.shop> (the “Disputed Domain Names”) are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 1, 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, 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) and contact information in the Complaint. The Center sent an email communication to the Complainants on November 13, 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 November 13, 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 November 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 7, 2023.

The Center noted that email notifications had not been sent to two of the Respondent's email addresses. The Notification of the Complaint was sent to these email addresses on December 11, 2023. The Respondent was granted until December 16, 2023, to submit a response, but the Respondent did not submit any response.

The Center appointed Lynda M. Braun as the sole panelist in this matter on January 9, 2024. 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 Blancpain SA (the "First Complainant"), founded in 1735 and acquired as a subsidiary of The Swatch Group, Ltd. in 1992, and the Complainant Swatch AG (the "Second Complainant"), founded in 1983, are both Swiss watch manufacturers and wholly-owned subsidiaries of the parent company, The Swatch Group, Ltd. (together, "the Complainants").

The First Complainant is the owner of the well-known SWATCH trademark, used on wristwatches, apparel, sunglasses, and other items. The trademark is used via the Internet and in retail stores throughout North America, Europe, the Middle East, Africa, Central and South America, Asia, and Australia. The First Complainant owns registered trademarks in the United States of America (the "United States") and jurisdictions worldwide, including, but not limited to: SWATCH (stylized), United States Trademark Registration No. 1,356,512, registered on August 27, 1985, in international class 14; SWATCH, Chinese Trademark Registration No. 232954, registered on September 15, 1985, in international class 14 (where the Respondent purportedly resides); and SWATCH, Japanese Trademark Registration No. 2184860, registered on October 31, 1989, in international class 14.

The Second Complainant is the owner of the BLANCPAIN trademark and operates a global network of boutiques in the United States, as well as jurisdictions worldwide. The Second Complainant owns registered trademarks in the United States and jurisdictions worldwide, including, but not limited to: BLANCPAIN, United States Trademark Registration No. 1,727,428, registered on October 27, 1992, in international class 14; BLANCPAIN, Chinese Trademark Registration No. G654362, registered on March 12, 1996, in international class 14 (where the Respondent purportedly resides); and BLANCPAIN, International Trademark No. 190558, registered on February 8, 1956, in international class 14.

The aforementioned trademarks will hereinafter collectively be referred to as the "BLANCPAIN and SWATCH Marks".

The First and Second Complainants own the domain names <blancpain.com> and <swatch.com>, respectively, which resolve to their official websites at "www.blancpain.com" and "www.swatch.com" and on which the Complainants prominently use the BLANCPAIN and SWATCH Marks to promote and offer their products.

The Disputed Domain Names were registered on the following dates: <blancpainwatch.shop> registered on October 11, 2023; <swatchboutique.shop>, registered on September 14, 2023; <swatchboutique.shop>, registered on August 17, 2023; <swatchdiscount.shop>, registered on September 5, 2023; <swatchemporium.shop>, registered on September 4, 2023; <swatchlimited.shop>, registered on September 22, 2023; and <swatchofficial.shop>, registered on July 27, 2023. The Disputed Domain Names were registered long after the Complainants began to use the BLANCPAIN and SWATCH Marks, and long after the Complainants had secured registrations for the BLANCPAIN and SWATCH Marks in the United States and other jurisdictions worldwide.

Six of the Disputed Domain Names, <blancpainwatch.shop>, <swatchboutique.shop>, <swatchdiscount.shop>, <swatchemporium.shop>, <swatchlimited.shop>, and <swatchoofficial.shop> resolve to a fashion shop template called “Famms” that sells men’s and women’s apparel.¹ The seventh Disputed Domain Name, <swatchboutique.shop>, initially resolved to a website called “swatchboutique” that sells women’s handbags and men’s wallets. A screenshot of the Respondent’s resolving website was submitted by the Complainants as an annex to the Complaint.²

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:

- the Disputed Domain Names are confusingly similar to the Complainants’ trademarks because the Disputed Domain Names, that contain the BLANCPAIN and SWATCH Marks in their entirety, followed by the additional terms “watch”, “boutique”, “boutique”, “discount”, “emporium”, “limited”, and “oofficial”, respectively, and then followed by the generic Top-Level Domain (“gTLD”) “.shop”, do not prevent a finding of confusing similarity;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names because the Complainants have not authorized the Respondent to register domain names containing the BLANCPAIN and SWATCH Marks, the Respondent was not making a *bona fide* offering of goods or services, and the Respondent has never been commonly known by the BLANCPAIN and SWATCH Marks, or any similar names;
- the Disputed Domain Names were registered and are being used in bad faith because, among other things, six of the Disputed Domain Names resolve to a fashion web template, and the remaining Disputed Domain Name resolves to a website that sells handbags and wallets.

The Complainants request consolidation of the Complainants, stating that it would be equitable and procedurally efficient to permit the consolidation.

The Complainants seek the transfer of the Disputed Domain Names from the Respondent to the Complainants in accordance with paragraph 4(i) of the Policy.

B. Respondent

The Respondent did not reply to the Complainants’ contentions,

¹The template is written in “lorem ipsum”, a pseudo-Latin text used in web design in place of English to emphasize design elements over content.

² As of the writing of this Decision, however, the Disputed Domain Name <swatchboutique.shop> resolves to an error landing page with no substantive content that states, in pertinent part, “What happened? You’ve requested a page on a website (swatchboutique.shop) that is on the Cloudflare network. Cloudflare is currently unable to resolve your requested domain (swatchboutique.shop).”

6. Discussion and Findings

6.1 Preliminary Issue: Consolidation of the Complainants

The Complainants submitted a request for consolidation of the Complainants in their Complaint. Pursuant to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11, the consolidation of multiple complainants filing a joint complaint against one or more respondents is subject to the discretion of the appointed panel.

In assessing whether a complaint filed by multiple complainants may be brought against one or more respondents, the appointed panel should consider 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. [WIPO Overview 3.0](#), section 4.11.1. The Panel submits that the criteria set out above are met and thus accepts consolidation in the present case as explained below.

The Panel notes that the Complainants are represented by a single authorized representative and each Complainant seeks the same remedy with respect to each of the Disputed Domain Names. Significantly, the Panel also finds that the Complainants in the present administrative proceeding are under common control since the Complainants are affiliated and are wholly-owned subsidiaries of The Swatch Group Ltd. As such, the two entities have a sufficient common legal interest in the BLANCPAIN and SWATCH Marks incorporated in the Disputed Domain Names. Further, the Complaint includes seven Disputed Domain Names, all of which are registered by the same individual, and six of them resolve to the same fashion web template. The remaining Disputed Domain Name, <swatchboutique.shop>, which initially resolved to a website that sells women's handbags and men's wallets, is a misspelling of the Disputed Domain Name <swatchboutique.shop> and was registered on the same day as the Disputed Domain Name <swatchlimited.shop>. In addition, each of the Disputed Domain Names was registered with the same Registrar using identical Whols information, and each was registered in the generic Top-Level Domain ("gTLD") ".shop".

The Panel therefore concludes that consolidation of the Complainants would be appropriate here and would not have any unfair prejudicial effect on the Respondent. Moreover, the Complainants have been the target of common conduct by the Respondent, who has engaged in bad faith registration and use of the Disputed Domain Names. Therefore, the Panel considers that it is fair and equitable under the circumstances of the case to permit consolidation as the Complainants are not only affiliated companies, but also have common legal interests.

Consequently, the Panel therefore determines, under paragraph 10(e) of the Rules, that the Complainants may be consolidated, and the Complainants may proceed with their Complaint.

6.2 Substantive Matters

Paragraph 4(a) of the Policy requires that the Complainants prove the following three elements in order to prevail in this proceeding:

- (i) the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names; and
- (iii) the Disputed Domain Names were registered and are being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Names are confusingly similar to the BLANCPAIN and SWATCH Marks as explained below.

It is uncontroverted that the Complainants have established rights in the BLANCPAIN and SWATCH Marks based on their years of use, their fame worldwide, and their registered trademarks for the BLANCPAIN and SWATCH Marks in the United States and jurisdictions worldwide. 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 trademarks and the disputed domain names. [WIPO Overview 3.0](#), section 1.7.

The registration of a mark satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. As stated in section 1.2.1 of the [WIPO Overview 3.0](#), “[w]here the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case”. Thus, the Panel finds that the Complainants satisfied the threshold requirement of having rights in the BLANCPAIN and SWATCH Marks.

The Disputed Domain Names wholly incorporate the Complainants' BLANCPAIN and SWATCH Marks, followed by the terms “watch”, “boutique”, “discount”, “emporium”, “oofficial”, “limited”, and “boutique”, respectively, and then followed by the gTLD “.shop”. Where the trademark is recognizable in the Disputed Domain Names, as the BLANCPAIN and SWATCH Marks are here, the addition of terms such as those referenced above does not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8 (“where the relevant trademark 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”). The presence of the BLANCPAIN and SWATCH Marks in the Disputed Domain Names in their entirety is sufficient to establish confusing similarity between the Disputed Domain Names and the Complainants' Marks.

Finally, the addition of a gTLD such as “.shop” in a domain name is a technical requirement. Thus, it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11.1. Thus, the Panel concludes that the Disputed Domain Names are confusingly similar to the Complainants' BLANCPAIN and SWATCH Marks.

Based on the available record, the Panel finds that 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 that 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 that the Complainants have established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Names. The Respondent has not rebutted the Complainants' *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.

The Complainants' *prima facie* case includes the fact that the Respondent is not commonly known by the Disputed Domain Names, nor have the Complainants authorized, licensed, or otherwise permitted the Respondent to use the BLANCPAIN and SWATCH Marks. The Respondent has no relationship, affiliation, connection, endorsement or association with the Complainants nor have the Complainants authorized the Respondent to use the BLANCPAIN and SWATCH Marks in any way. Further, the Panel concludes that nothing on the record before it would support a finding that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Names. Rather, the Panel finds that the Respondent is using the Disputed Domain Names for commercial gain with the intent to mislead and defraud the Complainants' customers. Moreover, since six of the Disputed Domain Names, as enumerated above, direct to a fashion web template that claim to be affiliated with the Complainants, and the seventh Disputed Domain Name initially resolved to a website selling handbags and wallets, the Respondent's use of the Disputed Domain Names do not constitute a protected noncommercial or fair use of the Disputed Domain Names.

Finally, the composition of the Disputed Domain Names, comprising the entirety of the BLANCPAIN and SWATCH Marks, together with additional terms, carry a risk of implied affiliation and cannot constitute fair use here, as they effectively suggest sponsorship or endorsement by the Complainants. See [WIPO Overview 3.0](#), section 2.5.1.

In sum, the Panel finds that the Complainants have established an unrebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Names.

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

C. Registered and Used in Bad Faith

The Panel finds that based on the record, the Complainants have demonstrated the existence of the Respondent's bad faith registration and use of the Disputed Domain Names pursuant to paragraph 4(a)(iii) of the Policy.

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 the Disputed Domain Names in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that the BLANCPAIN and SWATCH Marks are contained in their entirety in the Disputed Domain Names. The use of a domain name to intentionally attempt to attract Internet users to a respondent's website or online location by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of the registrant's website or online location for commercial gain demonstrates registration and use in bad faith. Here, the Respondent's registration and use of the Disputed Domain Names indicate that such registration and use had been done for the specific purpose of trading upon and targeting the name and reputation of the Complainants. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) ("[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain").

Moreover, the Panel concludes that the Respondent's registration of the Disputed Domain Names was an attempt to disrupt the Complainants' business by diverting Internet users who were searching for the Complainants' goods from their official website to the Respondent's fashion web template and website, as well as to prevent the Complainants from registering the Disputed Domain Names. See *Banco Bradesco S.A. v. Fernando Camacho Bohm*, WIPO Case No. [D2010-1552](#). The Respondent's use of the Disputed Domain Names was also highly likely to confuse Internet users into incorrectly believing that the Respondent was somehow authorized by or affiliated with the Complainants.

The Panel also finds that the Respondent knew that the Complainants had rights in the BLANCPAIN and SWATCH Marks when registering the Disputed Domain Names, emblematic of bad faith registration and use. It strains credulity to believe that the Respondent did not know of the Complainants or their BLANCPAIN and SWATCH Marks when registering the Disputed Domain Names. See *Myer Stores Limited v. Mr. David John Singh*, WIPO Case No. [D2001-0763](#) ("a finding of bad faith may be made where the respondent "knew or should have known" of the registration and/or use of the trademark prior to registering the domain name"). Thus, the Panel finds that in the present case, the Respondent had the Complainants' BLANCPAIN and SWATCH Marks in mind when registering and using the Disputed Domain Names.

Having reviewed the record, the Panel finds that the Respondent's registration and use of the Disputed Domain Names constitutes bad faith under the Policy due to the Respondent's use in a fashion web template and initially as a website offering handbags and wallets to unwitting customers who were searching for the Complainants' goods. In sum, the Panel concludes that the circumstances of this case, including the claim that the Disputed Domain Names had been used to deceive consumers, the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good faith use, and the implausibility of any good faith use to which the Disputed Domain Names had been put, support an inference of bad faith.

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

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 <blancpainwatch.shop>, <swatchboutique.shop>, <swatchboutique.shop>, <swatchdiscount.shop>, <swatchemporium.shop>, <swatchlimited.shop>, and <swatchofficial.shop> be transferred to the Complainants.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: January 23, 2024