

## **ADMINISTRATIVE PANEL DECISION**

Omega SA, Swatch AG v. Store Omega SHOP, Store Omega Products, Luke Shawn Dossantoz  
Case No. D2023-4812

### **1. The Parties**

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

The Respondents are Store Omega SHOP, Store Omega Products, and Luke Shawn Dossantoz, United States of America (the "US").

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

The disputed domain names <omegaswatch.org> and <swatchomega.org> are registered with Hostinger Operations, UAB (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 20, 2023. On November 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names.

The Center sent an email communication to the Complainants on November 24, 2023 with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant 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 Complainant filed an amended Complaint on November 29, 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 December 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 3, 2024. The Respondent Store Omega SHOP, Store Omega Products sent email communications to the Center on December 22, 2023 and January 8, 2024.

The Center appointed Taras Kyslyy as the sole panelist in this matter on January 15, 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, OMEGA SA, (the “Complainant 1”) is a watch brand for luxury watches and has served as the Official Timekeeper of the Olympic Games since 1932. The Complainant 1 has selected famous brand ambassadors around the world such as George Clooney, Nicole Kidman, Cindy Crawford, Eddie Redmayne, Daniel Craig, Kaia Gerber, Presley Gerber, Rory McIlroy, Sergio Garcia, Michael Phelps, Chad Le Clos, Liu Shishi, Michelle Wie, Dongyu Zhou, Buzz Aldrin, and Thomas Stafford.

The Complainant 1 owns numerous registrations for its OMEGA trademark in various jurisdictions, including, for instance International Registration No. 132141, registered on August 11, 1947.

The Complainant, Swatch AG, (the “Complainant 2”) commenced the use of the SWATCH mark in connection with the wristwatches. Complainant 2 also has produced or produces apparel, sunglasses, and other items. Since the inception of the SWATCH mark, the Complainant 2 has continually used it in commerce. The Complainant 2’s website “www.swatch.com” is used to promote the SWATCH brand and its products and services on the internet. The Complainant 2 also has fully owned, branded retail stores throughout North America, Europe, the Middle East, Africa, Central and South America, Asia, and Australia, as well as a growing number of e-commerce shops available for the brand SWATCH at “www.shop.swatch.com”.

The Complainant 2 has numerous registrations of its SWATCH trademark in various jurisdictions, including, for instance International Registration No. 506123, registered on September 9, 1986.

The Complainant 1 and the Complainant 2 are wholly-owned subsidiaries of The Swatch Group Ltd.

The disputed domain name <omegaswatch.org> was registered on July 27, 2023. The disputed domain name <swatchomega.org> was registered on October 15, 2023. The disputed domain names resolved to similarly designed websites prominently featuring the Complainants’ trademarks and falsely pretending to be the Complainants’ official website offering for sale products claimed to be of the Complainants’. At the time of this decision the disputed domain names do not resolve to any active websites.

The Complainants sent cease and desist letters further ignored by the Respondents.

#### **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 identical or confusingly similar to the Complainants’ trademarks. The disputed domain names comprise merely of both of the Complainants’ trademarks without any distinguishing elements. More, the addition of technically required generic Top Level Domain (“gTLD”) extensions such as “.org” may be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark

The Complainants also contend that the Respondents have no rights or legitimate interests in the disputed domain names. 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 its 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. The Respondents ignored cease and desist letters by the Complainants.

Finally, the Complainants contend that the disputed domain names were registered and are being used in bad faith. The Respondents have opened online stores impersonating Complainants and claiming to sell said watches for discounted prices, which they could not actually have. Not only are the Respondents using trademark and trade name infringing disputed domain names, but the Respondent also create confusion by wrongly making visitors of its websites believe to be endorsed and/or otherwise affiliated with Complainants by using Complainants' official logos prominently displayed on its websites. It is therefore the Respondents' sole intention to mislead Internet users, to fraud consumers, and to siphon off the Complainants' success and commercial goodwill. Passing-off and defrauding consumers constitutes a bad-faith registration and usage of a domain name. By registering the disputed domain names encompassing the Complainants' trademarks without any distinguishing elements, the Respondents are depriving the Complainants of the chance to reflect their trademarks adequately on the Internet which is an indication of a bad faith registration and usage.

## **B. Respondents**

The Respondents did not reply to the Complainant's contentions.

In its email communications the Respondent Store Omega SHOP, Store Omega Products informed that it is a Freelance Company and it is its job to purchase domains and build the websites. When a dispute concerning a domain is brought, it refers it to their client if he or she wishes to pursue a counterclaim. In the case of the disputed domain name <omegaswatch.org> the Respondent's client decided not to pursue any counterclaim. Hence, acknowledging the fault and renouncing to the disputed domain name. The disputed domain name has been taken down and no attempt to recover has been done. The Respondent requested to close this case and take no further action on the matter.

## **6. Discussion and Findings**

### **A. Consolidation: Multiple Complainants**

The Complainants requested the Panel to hear the present dispute brought by two complainants as a consolidated Complaint.

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. [WIPO Overview 3.0](#), section 4.11.1.

The Complainants assert they are related corporate entities and have a common legal interest sufficient to justify consolidation.

The Panel finds there is no reason to require each of the Complainants to submit an almost identical complaint against the Respondent with nearly identical facts, legal arguments and requested relief. Moreover, the Respondent will not suffer any prejudice, and consolidation will not affect the Respondent's rights in responding to the Complaint.

Taking into account the above the Panel rules in favor of consolidation and grants the request to consolidate.

## **B. Consolidation: Multiple Respondents**

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the 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 of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards common control, the Panel notes that the disputed domain names consisting solely of the Complainants' trademarks (in reverse order in the different domain names which does not seem coincidental) resolved to similarly designed websites, were registered within the same Registrar, and used the same hosting provider.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

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

## **C. 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 name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainants have shown rights in respect of a trademarks or service marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the Complainants' marks are reproduced within the disputed domain names. Accordingly, the disputed domain names are identical to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The gTLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Thus, the Panel disregards the gTLD ".org" for the purposes of the confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

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

## **D. 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.

The available evidence does not confirm that the Respondent is commonly known by the disputed domain names, which could demonstrate its rights or legitimate interests (see, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones, TheDotCafe*, WIPO Case No. [D2008-0642](#)).

The Complainants did not license or otherwise agree for use of its prior registered trademarks by the Respondent, thus no actual or contemplated *bona fide* or legitimate use of the disputed domain name could be reasonably claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#)).

Resellers, distributors using a domain name containing complainant’s trademark to undertake sales related to the complainant’s goods, may be making a *bona fide* offering of goods and thus have a legitimate interest in such domain name. Outlined in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (the “Oki Data Test”), the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods at issue;
- (ii) the respondent must use the site to sell only the trademarked goods;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with trademark holder; and
- (iv) the respondent must not try to “corner the market” in domain names reflecting trademark.

The Panel finds that the Respondent failed to satisfy at least the first, third, and fourth of the above requirements, presumably not actually offering the goods at issue due to specific terms of its sales by the Complainants, did not in any way disclose its actual relationship with the Complainants, precluded the Complainants to reflect its trademarks in respective domain names, and thus failed to pass the Oki Data Test. The Respondent’s use of the disputed domain name misleads consumers into thinking that the website is operated by or affiliated with the Complainant. As such, the Respondent’s use of the disputed domain name cannot be considered *bona fide*. [WIPO Overview 3.0](#), section 2.8.1.

Also, resellers or distributors using a domain name identical to a complainant’s trademark to undertake sales related to the complainant’s goods are not making a *bona fide* offering of goods and thus have no legitimate interest in such domain name. The Panel finds this applies in the present case, considering the risk of the misrepresentation by the disputed domain names identical to the Complainants trademarks. [WIPO Overview 3.0](#), section 2.8.2.

The Respondent has no right or legitimate interests in the disputed domain names resolving to an inactive website at the time of this decision (see, e.g., *Philip Morris USA Inc. v. Daniele Tomatore*, WIPO Case No. [D2016-1302](#)).

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

## E. 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.

In the present case, the Panel notes that the webpages at the disputed domain names are identical to the Complainants' trademarks and host online shops mocking the Complainants. The Respondent's use of the disputed domain names to purport to sell the Complainant's products shows that at the time of the registration of the disputed domain names the Respondent clearly knew and targeted Complainants' prior registered and famous trademarks, which confirms the bad faith (see, e.g., *The Gap, Inc. v. Deng Youqian*, WIPO Case No. [D2009-0113](#)).

The mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Panel is convinced that the Complainants' trademarks are well established through long and widespread use and the Complainants have acquired a significant reputation and level of goodwill in its trademarks both in Switzerland and internationally. Thus, the Panel finds that the disputed domain names identical to the Complainants' trademarks were registered in bad faith. [WIPO Overview 3.0](#), section 3.1.4.

According to paragraph 4(b)(iv) of the Policy the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith: by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location. In this case, the disputed domain names were resolving to websites featuring the Complainants' trademarks and falsely pretended to be official Complainants' local website to intentionally attract Internet users by creating likelihood of confusion with the Complainants' trademarks as to the source of the website and its products. The Panel finds the above confirms the disputed domain names were registered and used in bad faith.

Although at the time of this decision the disputed domain names resolve to inactive webpages, its previous bad faith use and lack of explanation of possible good faith use from the Respondent makes any good faith use of the disputed domain names implausible. Thus, the current passive holding of the disputed domain names does not prevent a finding of bad faith. [WIPO Overview 3.0](#), section 3.3.

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 <omegaswatch.org> and <swatchomega.org> be transferred to the Complainants.

*/Taras Kyslyy/*

**Taras Kyslyy**

Sole Panelist

Date: January 29, 2024