

ADMINISTRATIVE PANEL DECISION

Tissot SA and Swatch AG v. Marshall Victoria; Client Care, Web Commerce Communications Limited; Harvey Lane
Case No. D2024-1082

1. The Parties

The Complainants are Tissot SA, Switzerland (the “First Complainant”), and Swatch AG, Switzerland (the “Second Complainant”), internally represented.

The Respondents are Marshall Victoria, United States of America (“United States”); Client Care, Web Commerce Communications Limited, Malaysia; and Harvey Lane, United States.

2. The Domain Names and Registrars

The disputed domain names <swatchargentina.com>, <swatch-australia.com>, <swatchbelgium.com>, <swatch-canada.com>, <swatchchile.com>, <swatch-costarica.com>, <swatchgreece.com>, <swatchhungary.com>, <swatchireland.com>, <swatch-japan.com>, <swatchmalaysia.com>, <swatch-peru.com>, <swatchportugal.com>, <swatchromania.com>, <swatchesingapore.com>, <swatcheslovenija.com>, <swatchesrbija.com>, <swatchesuomi.com>, <swatchswitzerland.com>, <swatch-turkey.com>, <swatchuae.com>, <tissotaustralia.com>, <tissotcanada.com>, <tissotchile.com>, <tissotcolombia.com>, <tissotfranceonlinestore.com>, <tissotfrancesoldes.com>, <tissotgreece.com>, <tissothungary.com>, <tissotireland.com>, <tissotisrael.com>, <tissotmalaysia.com>, <tissotmexico.com>, <tissotoutletsusa.com>, <tissotphilippines.com>, <tissotportugal.com>, <tissotprxhungary.com>, <tissotprxromania.com>, <tissotromania.com>, <tissotsingapores.com>, <tissotsouthafrica.com>, <tissot-suomi.com>, <tissotsuomi.com>, <tissotuk.com>, <tissotwatchesindia.com>, <tissotwatchesireland.com>, <tissotwatchesouthafrica.com>, and <tissotwatchesuae.com> are registered with Alibaba.com Singapore E-Commerce Private Limited, and the disputed domain names <tissotuae.com>, and <swatchphilippines.com> are registered with Key-Systems GmbH (jointly the “Registrars”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 11, 2024. On March 12, 13, 22, and 26, 2024, the Center transmitted by email to the Registrars a request for registrar verification in connection with the disputed domain names. On March 13, 14, 15, and 27, 2024, the Registrars transmitted by email to the Center their verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (individual/entity of unknown nature; owner of Disputed Domains) and contact information in the Complaint. The Center sent an

email communication to the Complainant on March 15 and 27, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrars, 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 and/or that all domain names are under common control. The Complainant filed a first and second amended Complaints on March 18, and April 4, 2024.

The Center verified that the Complaint together with the amended Complaints 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 April 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 28, 2024. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on April 29, 2024.

The Center appointed Kaya Köklü as the sole panelist in this matter on May 2, 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 dispute involves two Complainants, both subsidiary companies of The Swatch Group Ltd. Both of them are internationally known manufacturers, sellers, and retailers of wristwatches.

The First Complainant is the registered owner of the TISSOT trademark, which is registered in a large number of jurisdictions. Among others, the First Complainant is the owner of the International Trademark Registration No. 532550, registered on December 14, 1988, for TISSOT, covering protection inter alia for watches of all kinds.

The First Complainant further owns and operates its main website at "www.tissotwatches.com".

The Second Complainant is the registered owner of the SWATCH trademark, which is also registered in a large number of jurisdictions. Among others, the Second Complainant is the owner of the International Trademark Registration No. 506123, registered on September 9, 1986, for SWATCH, covering protection inter alia for watches.

The Second Complainant owns and operates its main website at "www.swatch.com".

The Respondents are reportedly located in the United States and Malaysia respectively.

The disputed domain names <swatch-japan.com>, <swatchesingapore.com>, <swatchswitzerland.com>, <swatch-turkey.com>, <swatchbelgium.com>, <swatchargentina.com>, <swatch-australia.com>, <swatch-canada.com>, <swatchchile.com>, <swatchgreece.com>, <swatchhungary.com>, <swatchireland.com>, <swatch-peru.com>, <swatchphilippines.com>, <swatchportugal.com>, <swatchromania.com>, <swatchsuomi.com>, <swatchuae.com>, <swatchmalaysia.com>, <swatcheslovenija.com>, <swatch-costarica.com>, and <swatchesrbija.com> were registered on September 13, 2023.

The disputed domain names <tissotaustralia.com>, <tissotcanada.com>, <tissotuk.com>, <tissotromania.com>, <tissotchile.com>, <tissotcolombia.com>, <tissotgreece.com>, <tissothungary.com>, <tissotireland.com>, <tissotmalaysia.com>, <tissotmexico.com>, <tissotphilippines.com>,

<tissotportugal.com>, <tissotsouthafrica.com>, <tissotsuomi.com>, <tissotuae.com>, and <tissotfrancesoldes.com> were registered on September 20, 2023.

The disputed domain name <tissotsingapores.com> was registered on November 29, 2023.

The disputed domain name <tissotoutletsusa.com> was registered on January 2, 2024.

The disputed domain names <tissot-suomi.com>, <tissotprxhungary.com>, and <tissotprxromania.com> were registered on January 6, 2024.

The disputed domain names <tissotfranceonlinestore.com>, <tissotwatchesireland.com>, and <tissotwatchessouthafrica.com> were registered on January 10, 2024.

The disputed domain name <tissotwatchesuae.com> was registered on January 21, 2024.

The disputed domain names <tissotwatchesindia.com>, and <tissotisrael.com> were registered on February 2, 2024.

The screenshots, as provided by the Complainants, indicate that majority of the disputed domain names resolved to similar websites, either purportedly offering the Complainants' SWATCH wristwatches at discounted prices or purportedly offering the Complainant's TISSOT wristwatches at discounted prices. These associated websites created the look and feel as if they were operated by the Complainants, displaying the Complainants' TISSOT or SWATCH trademarks, and official product pictures of the Complainants without any visible and accurate disclaimers describing the (lack of) relationship between the Parties. The remaining disputed domain names were inactive.

At the time of the Decision, some of the disputed domain names are still associated to active websites, while majority of them does not resolve to active websites anymore.

5. Parties' Contentions

A. Complainants

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

B. Respondents

The Respondents did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1. Consolidation of Complainants

The Complaint demonstrates that the First and Second Complainants are affiliated companies both fully owned subsidiaries of The Swatch Group Ltd, therefore a common legal interest is present. Additionally, as noted below, the Respondents appear to have engaged in conduct targeting trademarks held by the related Complainants. As such, the Complainants have a common grievance against the Respondents. Furthermore, both Complainants are represented in this administrative proceeding by the same representative. Moreover, the Respondents have not rebutted a consolidation of the Complainants. Accordingly, the Panel finds that the Complaints can be consolidated based on a common grievance and interests of both Complainants. The Panel is convinced that it is fair and equitable in the circumstances of

the case to order the consolidation as requested (see section 4.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

Consequently, the Panel accepts the consolidation of the First and Second Complainants in this administrative proceeding and, for the ease of reference, will jointly refer to them as "the Complainant" in the following, whenever appropriate.

6.2. Consolidation of 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 registrants of disputed domain names 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.

In light of the criteria set out above, the Panel finds that the Complainant has provided evidence that all disputed domain names are under common control for the following reasons:

- 48 out of 50 disputed domain names were registered by the same Respondent Client Care, Web Commerce Communications Limited with the same Registrar, and the remaining two disputed domain names <swatchphilippines.com> and <tissotuae.com> were registered by the Respondents Harvey Lane and Marshall Victoria respectively but with the same other Registrar.
- the disputed domain name <swatchphilippines.com> has the same registration date as 21 other disputed domain names, while the disputed domain name <tissotuae.com> has the same registration date as 16 other disputed domain names.
- the disputed domain names were all registered rather recently between September 2023 and February 2024.
- the disputed domain name <swatchphilippines.com> previously resolved to a website purportedly offering for sale the Complainant's SWATCH watches, with a look and feel virtually identical to the active Swatch websites owned by the Respondent Client Care, Web Commerce Communications; while the disputed domain name <tissotuae.com> previously resolved to a website purportedly offering for sale the Complainant's TISSOT watches, with a look and feel virtually identical to the active Tissot websites owned by the Respondent Client Care, Web Commerce Communications.

The Panel concludes that the Respondents are more likely than not somehow connected. Hence, the Panel accepts that all disputed domain names are under common control.

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 registrants of disputed domain names (referred to below as "the Respondent", whenever appropriate) in a single proceeding.

6.3. Substantive Issues

According to paragraph 15(a) of the Rules, the Panel shall decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

- (i) the disputed domain names are identical or confusingly similar to a trademark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

Paragraph 4(a) of the Policy states that a complainant bears the burden of proving that all these requirements are fulfilled, even if a respondent has not substantively replied to the complainant's contentions. *Stanworth Development Limited v. E Net Marketing Ltd.*, WIPO Case No. [D2007-1228](#).

However, concerning the uncontested information provided by a complainant, the Panel may, where relevant, accept the provided reasonable factual allegations in a complaint as true. [WIPO Overview 3.0](#), section 4.3.

It is further noted that the Panel has taken note of the [WIPO Overview 3.0](#) and, where appropriate, will decide consistent with the consensus views captured therein.

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.

The Complainant has shown rights in respect of the TISSOT and SWATCH trademarks respectively for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the TISSOT mark or SWATCH mark is reproduced within the respective disputed domain names. Accordingly, the disputed domain names are confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, such as "outlets", "onlinestore" or "soldes" and/or geographic indications, 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 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 Panel particularly notes that the nature of the disputed domain names, comprising the Complainant's TISSOT or SWATCH trademarks together with a term or terms related to geographic locations and/or the Complainant's business, and the content and design of the active websites, featuring the Complainant's TISSOT or SWATCH trademarks and purportedly offering presumably counterfeit goods, indicates the Respondent's awareness of the Complainant and its trademarks and its illicit intent to take unfair advantage of such, which does not support a finding of any rights or legitimate interests.

Panels have held that the use of domain names for illegal activity, here claimed sale of presumably counterfeit goods, impersonation, and/or other types of fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Some of the disputed domain names have never resolved to active websites which also does not support a finding of any rights or legitimate interests under the circumstances of this case.

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 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.

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 Respondent must have had the Complainant and its TISSOT and SWATCH trademarks in mind when registering the disputed domain names, particularly considering the composition of the disputed domain names and content of the active websites associated with the disputed domain names. It is obvious to the Panel, that the Respondent has deliberately chosen the disputed domain names, which are confusingly similar to the Complainant's TISSOT or SWATCH trademarks, to target and impersonate the Complainant in order to generate traffic to its own websites. Consequently, the Panel is convinced that the Respondent has registered the disputed domain names in bad faith.

As regards bad faith use, the Panel notes that majority of the disputed domain names previously resolved to websites which attempted to impersonate the Complainants and offered for sale presumably counterfeits goods. In this regard, the overall content and design of the associated websites, including the prominent use of the Complainant's TISSOT or SWATCH trademarks, as well as the inherently misleading nature of these disputed domain names is, in view of the Panel, sufficient evidence that the Respondent has intentionally tried to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant.

Panels have held that the use of a domain name for illegal activity, here claimed sale of presumably counterfeit goods, impersonation and/or other types of fraud, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

The fact that some of the disputed domain names have never resolved to active websites or currently do not resolve to active websites does not prevent a finding of bad faith. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's TISSOT and SWATCH trademarks, and the composition of the disputed domain names, and finds that in the circumstances of this case the passive holding of some of the disputed domain names does not prevent a finding of bad faith under the Policy.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy.

Consequently, 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 <swatchargentina.com>, <swatch-australia.com>, <swatchbelgium.com>, <swatch-canada.com>, <swatchchile.com>, <swatch-costarica.com>, <swatchgreece.com>, <swatchhungary.com>, <swatchireland.com>, <swatch-japan.com>, <swatchmalaysia.com>, <swatch-peru.com>, <swatchphilippines.com>, <swatchportugal.com>, <swatchromania.com>, <swatchsingapore.com>, <swatchslovenija.com>, <swatchsrbija.com>, <swatchesuomi.com>, <swatchswitzerland.com>, <swatch-turkey.com>, <swatchuae.com>, <tissotaustralia.com>, <tissotcanada.com>, <tissotchile.com>, <tissotcolombia.com>, <tissotfranceonlinestore.com>, <tissotfrancesoldes.com>, <tissotgreece.com>, <tissothungary.com>, <tissotireland.com>, <tissotisrael.com>, <tissotmalaysia.com>, <tissotmexico.com>, <tissotoutletsusa.com>, <tissotphilippines.com>, <tissotportugal.com>, <tissotprxhungary.com>, <tissotprxromania.com>, <tissotromania.com>, <tissotsingapores.com>, <tissotsouthafrica.com>, <tissot-suomi.com>, <tissotsuomi.com>, <tissotuae.com>, <tissotuk.com>, <tissotwatchesindia.com>, <tissotwatchesireland.com>, <tissotwatchesouthafrica.com>, and <tissotwatchesuae.com> be transferred to the Complainant.

/Kaya Köklü/

Kaya Köklü

Sole Panelist

Date: May 16, 2024