

ADMINISTRATIVE PANEL DECISION

Breitling AG v. woodie voodoo
Case No. D2024-1496

1. The Parties

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

The Respondent is woodie voodoo, United States of America.

2. The Domain Name and Registrar

The disputed domain name <breitling-ss.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 9, 2024. On April 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 10, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 April 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 2, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 3, 2024.

The Center appointed Dietrich Beier as the sole panelist in this matter on May 14, 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 manufactures high-end chronographs and watches and related accessories. The Complainant was founded in 1884 by Léon Breitling and has manufactured and sold BREITLING watches since then.

The Complainant is the proprietor of several registrations for BREITLING, as word device trademarks and as word trademarks, among them International Registration No. 970173 registered on February 22, 2008, designating various goods in various countries and being in effect.

The disputed domain name was registered on April 1, 2024. The website under the disputed domain name resolves to a page being inactive and containing a security warning message which states that “This website has been reported for potential phishing”.

The letters “sso” refer to the common acronym “single sign-on”, which is an authentication method that enables users to securely authenticate with multiple applications and websites by using just one set of credentials.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name reproduces in its entirety the mark “breitling” as protected by the Complainant’s trademarks. The element “breitling” is followed by a hyphen and the descriptive element “sso” which does not minimize the risk of confusion.

The Complainant has not authorized the use of its trademarks or terms similar thereto in the disputed domain name in any manner or form. The Complainant has also not found that the Respondent is known under this name.

The Complainant and the Complainant’s trademarks are widely used and well known that it is inconceivable that the Respondent ignored the Complainant or its earlier rights.

The brand BREITLING is amongst the top ten luxury watch brands. The Complainant’s estimated sales in 2022 were CHF 860 million according to a report from Morgan Stanley and LuxeConsult. The company also ranked in 9th position in turnover and retail/whole sale values in 2023 amongst the top 50 watch brands based on Morgan Stanley and LuxeConsult’s annual “Swiss Watcher” report.

The Complainant operates a Facebook page followed by about 980 thousand users and an Instagram page followed by more than 1,6 million users.

The Complainant and its trademarks being well known have been established in many UDRP panel’s decisions, among them *Breitling SA v. tao tao*, WIPO Case No. [D2023-3302](#), and *Breitling SA v. 李红波 (Li Hong Bo)*, WIPO Case No. [D2022-0764](#).

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing 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 Complainant has shown rights in respect of a trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The addition of the element "-sso" does not prevent a finding of confusing similarity between the disputed domain name and the mark 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 name. 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 name such as those enumerated in the Policy or otherwise. This is in particular the case since the Complainant did not grant any permission or consent to the Respondent to use its trademarks. Furthermore, the Respondent has no rights or legitimate interests in the disputed domain name since there is no indication that the Respondent is commonly known by the name "breitling" or "breitling-sso" nor that the Respondent is using the disputed domain name in connection with a bona fide offering of related goods or services. Rather, the disputed domain name resolves to a malicious site warning, indicating potential use for phishing, and panels have held that use of a domain name for per se illegitimate activity can never confer rights or legitimate interests upon a respondent. [WIPO Overview 3.0](#), section 2.13.1.

C. Registered and Used in Bad Faith

Due to the long existence and intensive use of the Complainant's marks being widely known, the Respondent must have been well aware of the Complainant and its trademarks when registering the disputed domain name. The Complainant has not authorised the Respondent to make use of its mark. The Panel does not see any conceivable legitimate use that could be made by the Respondent of this disputed domain name without the Complainant's authorization. This impression is reinforced given the

warning on the website to which the disputed domain name resolves, which states that “This website has been reported for potential phishing.”

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 name 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 of the Complainant’s trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

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 name <breitling-ss.com> be transferred to the Complainant.

/Dietrich Beier/

Dietrich Beier

Sole Panelist

Date: May 27, 2024