

## **ADMINISTRATIVE PANEL DECISION**

Chopard Internacional SA v. Ryan Kitto

Case No. DAI2024-0065

### **1. The Parties**

The Complainant is Chopard Internacional SA, Switzerland, represented by SafeBrands, France.

The Respondent is Ryan Kitto, United States of America ("United States").

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

The disputed domain name <chopard.ai> is registered with 1API GmbH (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 12, 2024. On September 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 16, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 19, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on September 23, 2024.

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 September 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 17, 2024. The Respondent sent email communications to the Center on September 27, 2024, October 1, 3, and 4, 2024.

The Center appointed Marilena Comanescu as the sole panelist in this matter on October 23, 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, a Swiss company founded in 1860, is a manufacturer of luxury watch and jewelry. Since more than 150 years, the Complainant has become one of the leading names in the high-class watch and jewelry industry and has acquired a strong reputation on the name CHOPARD, in being notably the main sponsorship of international prestigious events such as the Cannes Film Festival, for which the Complainant has designed the famous trophy called "Palme d'or".

The Complainant owns worldwide trademark registrations for or including CHOPARD, such as the following:

- the International trademark registration number 624432 for CHOPARD (word), registered on August 15, 1994, for goods in International class 14, and designating numerous jurisdictions worldwide;
- the International trademark registration number 637876 for CHOPARD (stylised), registered on June 7, 1995, for goods in International classes 21 and 24, and designating numerous jurisdictions worldwide; and
- the International trademark registration number 829615 for CHOPARD GRAN TURISMO (words), registered on July 5, 2004, for goods in International class 14, and designating numerous jurisdictions worldwide including the United States.

The Complainant is the owner of numerous domain names incorporating the mark CHOPARD, such as <chopard.com> registered on November 22, 1995; <chopard.fr> registered on May 6, 1999; <chopard.asia> registered on February 22, 2008; and <chopard.info> registered since June 20, 2012.

The disputed domain name was registered on April 27, 2023, and, at the time of filing the Complaint, it redirected to the webpage of the registrar Godaddy/Afternic mentioning that the disputed domain name may be available for sale.

According to Annex 14 to the Complaint, on April 29, 2024, before commencing the present proceedings, the Complainant received an email from a third party, claiming to act on behalf of the Respondent, and, offering the disputed domain name for sale. After an exchange of emails with the Complainant and its representative, according to Annex 11 to the Complaint, the third party denied the Complainant's offer to refund the costs directly related to the registration of the disputed domain name and claimed the amount of USD 15,000 for the transfer of the disputed domain name to the Complainant.

When being notified by the Center with regard to the commencement of the proceeding, the third party responded (on September 27, 2024 and October 18, 2024) that he is not the owner of the disputed domain name and that he "has no longer anything to do with this".

The Respondent sent several email communications between September 27, and October 4, 2024, mainly stating that he is willing to transfer the disputed domain name to the Complainant.

#### **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 its trademark enjoys an extremely high worldwide reputation; the Complainant holds registered trade names and signposts in the signs CHOPARD and CHOPARD INTERNATIONAL (where “international” is non distinctive), since at least 1994; the disputed domain name is identical to its trademark because it reproduces identically the sign CHOPARD alone under the country code Top-Level Domain for Anguilla; the Respondent has no rights or legitimate interests in the disputed domain name; the Respondent registered the disputed domain name in bad faith mainly because of the choice of the disputed domain name which is strictly identical to the Complainant’s distinctive and widely known mark used for over 150 years, and the use of privacy shield in order to prevent an efficient enforcement of legitimate trademark rights by the Complainant; the Respondent is using the disputed domain name in bad faith with the only purpose to sell it to the Complainant and generate undue income since, on April 29, 2024, the Respondent has contacted the Complainant in order to sell the disputed domain name to it, or rather to exchange it against the Complainant’s goods, namely CHOPARD watches; and at the time of filing the Complaint, the disputed domain name resolved to a webpage mentioning that it is for sale and therefore it appears that the Respondent is still looking for potential buyers.

## **B. Respondent**

The Respondent did not substantially reply to the Complainant’s contentions; however he sent several email communications claiming his willingness to transfer the disputed domain name to the Complainant and alleging that he did not realize he was doing something illegal or wrong.

Further, in its email communication of October 3, 2024, the Respondent claimed he “disabled his ownership” in the disputed domain name. However, when the Panel verified the Whois and visited the website under the disputed domain name, the name of the Respondent was still listed as registrant for the disputed domain name and the webpage to which the disputed domain name resolved was still displaying the message that the disputed domain name “is registered, but may still be available”.

## **6. Discussion and Findings**

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

### **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 name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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.

The disputed domain name incorporates the Complainant’s highly distinctive trademark in its entirety, it was offered for sale to the Complainant directly, and, at the time of filing the Complaint, it was offered for public sale on a third party website. These facts, together with the other circumstances in this case, do not amount to a bona fide or legitimate use.

The composition of the disputed domain name carries a high risk of implied affiliation, being identical to the Complainant’s mark and highly similar to its trade name and domain names. UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

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.

In the present case, the Panel notes that the disputed domain name was registered in bad faith, with knowledge of the Complainant and its trademark particularly because it reproduces exactly the Complainant’s mark, domain name, and company name, the use of which predate the registration of the disputed domain name by more than 29 years and is well-known worldwide.

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.

Paragraph 4(b)(i) of the Policy provides the circumstance when the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent’s documented out-of-pocket costs directly related to the domain name. The Panel finds that, registering a domain name identical to the Complainant’s distinctive and world famous trademark and offering it for sale to the Complainant directly, and to the public at large, is evidence of bad faith behavior. [WIPO Overview 3.0](#), section 3.1.1.

At the time of filing the Complaint, the disputed domain name was not connected to an active website.

UDRP panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant’s trademark; the composition of the disputed domain name which reproduces exactly the Complainant’s trademark; the Respondent’s and third party’s email communications and conduct in the present proceeding; the implausibility of any good faith use to which the disputed domain name may be put, 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. [WIPO Overview 3.0](#), section 3.3.

Previous UDRP panels have found that the mere registration of a domain name that is identical or confusingly similar to a widely known trademark can, by itself, constitute a presumption of bad faith for the purpose of Policy. [WIPO Overview 3.0](#)., section 3.1.4.

The Panel finds 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 name, <chopard.ai>, be transferred to the Complainant.

*/Marilena Comanescu/*

**Marilena Comanescu**

Sole Panelist

Date: November 1, 2024