Panel Decision for dispute CAC-ADREU-007628

Case number	CAC-ADREU-007628
Time of filing	2018-07-13 11:06:47
Domain names	pictetgroup.eu

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Banque Pictet & Cie SA

Respondent

Name	Dariane Pictet

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of other proceedings.

FACTUAL BACKGROUND

The Complainant is a wealth and asset manager based in Switzerland known as the Pictet Group. It was founded in Geneva in 1805 and is now established in 26 of the most important financial centres internationally and employs more than 3,700 people. It manages around CHF 390 billion.

The Complainant owns a large number of registered trade marks including its primary mark, the trade name and word mark, PICTET, in class 36, registered in many jurisdictions. It has registered marks in over 29 nations.

In particular, the Complainant is the registered proprietor of the Swiss national mark, no. P-478932, for the word mark, filed in August 17, 2000, in Class 36. The Complainant has also registered an International trade mark, consisting of the word mark, in Class 36, No. IR 748934 which designates several European countries.

The Complainant owns the domain name <pictet.com> and <pictetgroup.com> and <grouppictet.com>, among others.

Because of the Complainant's extensive use in trade and its reputation in the financial world internationally, the PICTET name and mark is a well-known mark and enjoys extensive goodwill. When used in a finance-related context, the PICTET mark references and identifies the Complainant and its financial services.

The Respondent presents him/herself as an individual with the surname name, Picet, based in London. The disputed domain name was registered by the Respondent on January 22, 2018. The disputed domain name does not resolve to any website.

A. COMPLAINANT

Factual and Legal Grounds

I. Factual Background:
The Pictet Group is one of the leading wealth and asset managers in Europe. It was created in Geneva in 1805.

The Pictet Group is now established in 26 of the most important financial centers across the world, and employs more than 3700 people.

It manages around CHF 390 billion.

The Complainant is notably the owner of the domain name <pictet.com>, as well as many others domain names containing the element "pictet", such as <pictetgroup.com> and <grouppictet.com>.

Because of the Complainant's extensive reputation in the financial world and of its international presence, the PICTET brand has become well-known and enjoys an important goodwill. When used in a finance-related context, the PICTET trademark is therefore immediately associated with the Complainant and its financial and monetary services.

The Complainant owns a large number of trademark registrations consisting of or including the name PICTET in class 36 in numerous jurisdictions.

In particular, the Complainant owns the Swiss trademark no. P-478932 PICTET filed in August 17, 2000 in Class 36 for "Financial and monetary affairs".

The Complainant also owns an International trademark PICTET in Class 36 for "Financial and monetary affairs" (IR 748934) with designation of several European countries.

According to the <whois.eurid.eu> database [www.whois.eurid.eu], the domain name <pictetgroup.eu > was registered on January 22, 2018, i.e. well after the Complainant secured registrations for its PICTET trademark around the world.

As the <whois.eurid.eu> database only provides the e-mail address of the Respondent "dariane.pictet@yandex.com" as contact information, the Complainant requested a personal data disclosure and obtained the required information from the EURid whois database, such as the name, address and telephone number of the registered owner of the domain name <pictetgroup.eu>.

After having been informed of these elements, the Complainant contacted Ms. Dariane Pictet, who happens to be the daughter of a former partner of the Banque PICTET. She confirmed to the Complainant that she did not reserve the domain name <pictetgroup.eu> nor did she create the e-mail address "dariane.pictet@yandex.com".

It has to be noted that the Complainant obtained the revocation of the domain name <pictetwealth.eu> in a precedent proceeding against the same registered Respondent (see panel decision No. 07418). The former Panel decision ruled in favor of the Complainant on the grounds that the Respondent had no rights or legitimate interests in the disputed domain name, and that a likely risk of confusion subsided in linking the Complainant's trademark PICTET to the word "wealth". Furthermore, – and since Mrs. Dariane Pictet rebuted having registered the domain name herself – the Panel found the Respondent to have registered the domain name in bad faith.

Finally, the disputed domain name does not resolve to any website.

There has been no contact between the Complainant and the Respondent before the submission of the present Complaint.

II. Legal Background

Under Article 21(1) of Regulation (EC) 874/2004 (“the Regulation”) and Paragraph B1(b) (10) of the ADR Rules, the disputed domain name is subject to revocation if it is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law, such as the rights mentioned in Article 10(1), and where it (a) has been registered by its holder without rights or legitimate interests in the name or (b) has been registered or is being used in bad faith.

a) The disputed domain name is identical or confusingly similar to a name in respect of which a right or rights are recognized or established by national and/or Community law

The rights mentioned in Article 10 (1) of the Regulation shall be understood to include: registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works.

As mentioned above, the Complainant has established rights regarding its trademark "Pictet" in several European countries and under national law in Switzerland.

A comparison between the trademark and the disputed domain name itself must be made to determine whether there is a confusing similarity. According to the jurisprudence, "In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name. An addition of common, dictionary, descriptive, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test typically involves a straightforward visual and aural comparison of the trademark with the domain name" (See ADR Case No. 07151 "Bayerische Motoren Werke AG (BMW AG)".

The disputed domain name wholly incorporates the Complainant’s registered PICTET trademark, which may be sufficient to establish confusing similarity (See WIPO Cases, Playboy Enterprises International, Inc. v. Zeynel Demirtas, WIPO Case No. D2007-0768, Hitachi, Ltd. v. Arthur Wrangle, supra. Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903; Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525; Eauto, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc., WIPO Case No. D2000-0047; Bayerische Motoren Werke AG v. bmwcar.com, WIPO Case No. D2002-0615.

This is all the more true since the trademark is highly recognizable. In the disputed domain name, the PICTET trademark stands out and leads the public to think that the Infringing domain name is somehow connected to the owner of the registered trademark.

The adjunction of "group" further creates confusion with the prior PICTET trademark. In fact, the PICTET trademark associated with the mention “group” leads the public to think that the Infringing domain name is connected to the owner of the registered trademark. Indeed, the word "group" is very often associated with banks in the banking world and the Complainant refers to itself as the "Group Pictet". Even the domain name for the main webpage of the Complainant is [https://www.group.pictet/fr].

The extension ".eu" should be disregarded as irrelevant for the purpose of the comparison as it is a required extension for the registration of a domain name (See ADR cases No. 07280 "CONFÉDÉRATION NATIONALE DU CRÉDIT MUTUEL", No. 6442 "SWAROVSKI", No. 4477 "WALTHER-PRAEZISION", No. 475 "HELSINKI", No. 387 "GNC", No. 596 "RESTAURANT".

Therefore, under Article 21 (1) of the Regulation the Infringing domain name is confusingly similar to a trademark owned by the Complainant.

b) The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Respondent is not licensee of the Complainant, nor has the Complainant granted to the Respondent an authorization to use the disputed domain name. Moreover, there is no indication that the disputed domain name corresponds to the Respondents’ name. In fact, Ms. Dariane Pictet, who happens to be the daughter of a former Partner of the Banque Pictet, confirmed that she did not reserve the Infringing domain name and that she has nothing to do with it.
Hence, Ms. Dariane Pictet did not create the e-mail address "dariane.pictet@yandex.com", which is the Respondent's e-mail address on the <whois.eurid.eu> database.

In addition, the Respondent does not use the Infringing domain name in connection with a website. Indeed, there is no website available at the disputed domain name. The fact that there is no website available shows that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. The Respondent has not made any demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services, since there is no website at the domain name providing contrary evidence.

Therefore, under Article 21 (1) (a), (2) of the Regulation the Respondent has no rights or legitimate interests in the disputed domain name.

c) The disputed domain name was registered and is being used in bad faith

As mentioned above, there is no website related to the disputed domain name. According to constant jurisprudence, passive holding of a domain name can result as a use in bad faith of the domain name (See ADR case no.07211 "CONFÉDÉRATION NATIONALE DU CRÉDIT MUTUEL").

In the present case, the Respondent has registered the disputed domain name long after the Complainant’s use and registration of its trademark PICTET in various regions of the world. The mark PICTET is not a dictionary word and has no particular meaning.

Furthermore, as demonstrated above, the Complainant is one of the most important European asset management groups (see Annexes 2 and 4). The Complainant is established in 26 important financial centers across the world.

In addition, the fact that the Respondent used the name of the daughter of a former Partner of the Banque Pictet to register the disputed domain name and to create the related contact email address on the EURid database shows that the Respondent reserved the disputed domain name in bad faith. The Complainant cannot think of another reason that would lead the Respondent to choose the first name "Dariane" and the second name "Pictet" to register the disputed domain name and to create the contact email address.

Therefore, given the well-known character of the trademark PICTET and its distinctive character, it is highly likely that Respondent had knowledge of the Complainant's mark when he registered the disputed domain name.

The fact that the disputed domain name is not being used shows that it was registered for the purpose of selling or otherwise transferring the disputed domain name. It contends that Respondent, by his inaction, is attempting to disrupt Complainant's business by misleading potential customers and giving them the impression that the Complainant is not operating. It thus is creating confusion with the Complainant's trademark as to source, sponsorship, affiliation or endorsement of the Respondent's website.

There is no plausible reason for the Respondent's choice of the disputed domain name other than the will to profit unfairly from the confusion with the Complainant's trademark PICTET.

In fact, any future use of the disputed domain name would mainly cause confusion with the Complainant and its trademark, especially regarding the fact that the Complainant's trademark is famous and has been used for a very long time in the banking and wealth management business (See WIPO Cases, CBS Broadcasting, Inc. v. LA-Twilight-Zone, WIPO Case No. D2000-0397).

The lack of website related to the disputed domain name, coupled with the choice to use the element "Pictet" with connection to the descriptive term "group" should be considered as elements proving its bad faith. The identity of Ms. Dariane Pictet was indeed misused by the Respondent.

In addition and as mentioned above, the Complainant has obtained the revocation of the disputed domain name against the same Respondent in a previous procedure.

Respondent's behavior therefore demonstrated bad faith as required under to Article 21 (1) (b), (3) of the Regulation.

B. RESPONDENT

The Respondent says the Complainant does not have any exclusive legal right to the name PICTET. The name PICTET is associated with a family and anyone with the surname PICTET is entitled to use the name PICTET.

DISCUSSION AND FINDINGS

Article 22(1)(a) of Commission Regulation (EC) No 874/2004 of 28 April 2004 ("the Policy Regulation") allows a party to initiate an ADR procedure where a registration is speculative or abusive, as defined in Art. 21. This provides for revocation where a domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by national or Community law and where registered without rights or legitimate interest and registered or used in bad faith. This is reflected in §11 of the ADR Rules. The Policy Regulation Art. 21(2) provides examples of how legitimate interest may be demonstrated, and Art. 21(3) provides examples of bad faith.

Rights

The Complainant clearly has Rights in its international and national marks and unregistered rights arising from its worldwide use of the name and marks in trade. The Panel finds the Complainant has the requisite rights and that the word mark is a famous or well-known mark. In common law countries, these rights will also be protected by the law of passing-off.

The word mark is highly distinctive yet used in its entirety in the disputed domain name. See Playboy Enterprises International, Inc. v. Zeynel Demirtas , WIPO Case No. D2007-0768, and Bayerische Motoren Werke AG v. bmwcar.com, WIPO Case No. D2002-0615. The word group is generic and would not usually add anything to the similarity analysis, but here it is relevant as discussed below in relation to the second factor. The suffix is irrelevant for the analysis, see Case No. 6442, Swarovski. The Complainant's submissions are accepted on this issue. The Panel finds the disputed domain name is confusingly similar to the name and mark in which the Complainant has rights.

Legitimate Interests
Turning now to legitimate interests, we must determine if any of the factors in §B11(e) of the ADR Rules apply:

“Any of the following.. shall demonstrate the Respondent’s rights or legitimate interests to the domain name for purposes of Paragraph B11(d)(1)(ii):

(1) prior to any notice of the dispute, the Respondent has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so;

(2) the Respondent, being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a right recognized or established by national and/or Community law;

(3) the Respondent is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognized or established by national law and/or Community law. ”

Here both (2) and (3) are in issue. The Policy Regulation, like the UDRP, reflects harmonised norms from international trade mark laws and (2) above reflects the "own name defence." This is common to most trade mark law regimes and permits individuals to use their own names in trade even where there is an established mark or brand, with the important proviso that they must do so honestly and without attempting to leverage the earlier mark. The key issue in this case therefore, is whether, (assuming for now that the Respondent’s legal surname is Picet), the Respondent would be entitled to this "own name defence." It is now clear in EU law (following Article 1(13) of Regulation 2015/2424), that this is a defence that is only applicable to individuals and not to companies. The Respondent is not a company. However, the disputed domain name references a corporate name by the inclusion of the work group.

Further, certainly in common law jurisdictions, the requirement of honesty requires that any use be fair in relation to the rights of others. This overlaps with factor (3) as to whether the use is fair and legitimate. Here we find the simple answer is clearly, no. Even if all other matters were equal, the fair and legitimate use of the own name of an individual, would not require the selection of the same formulation of a corporate name used by the well-known earlier mark, nor would the selection of the word group be natural for an individual. Many other formulations could have been selected. The choice here demonstrates a desire to free-ride on, and leverage, the reputation of the Complainant.

We also note for completeness, that the Respondent does not use the disputed domain name in connection with a website and the fact that there is no website available also suggests the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name. The Respondent has not provided any evidence of demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services. The Complainant has made a compelling prima facie case on this limb and the Respondent has failed to rebut it.

Bad Faith
This also leads us to the final issue of bad faith. The same reasoning that was relevant to legitimate and fair use, is again relevant here. The Panel notes that the evidence shows that Ms. Dariane Pictet, the daughter of a former partner of the Complainant, has confirmed to the Complainant in writing that she did not register the disputed domain name or create the email address used by the Respondent and therefore she is not the Respondent. Who then is the Respondent? We have no proof that they bear the surname. We also note that the Complainant submits that it obtained revocation of the domain name <pictetwealth.eu> in an earlier proceeding against the same Respondent by panel decision No. 07418 (the Panel found the Respondent registered the domain name in bad faith due to lack of proof of the legal surname). The fact that no proof of identity has been provided, plus the denial of the family member bearing the name, suggests that whoever the Respondent is, they are not a family member and are not acting in good faith and are not entitled to the own name defence. Indeed, this and the fact of the previous proceeding, mean actual and express knowledge and a clear intention to profit. This is paradigm bad faith. See CBS Broadcasting, Inc. v. LA-Twilight-Zone, WIPO Case No. D2000-0397.

The Complainant has discharged its burden of proof.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the Complaint is allowed.

the domain name PICTETGROUP.EU be revoked

PANELISTS

Name	**Ms. Victoria McEvedy**

DATE OF PANEL DECISION 2018-07-12

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

Summary

I. Disputed domain name: Pictetgroup.eu

II. Country of the Complainant: Switzerland, country of the Respondent: Unknown

III. Date of registration of the domain name: 22 January 2018

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:

1. Word mark registered in Switzerland as a national mark;
2. National marks in 29 countries under international registration in class 36.
3. Common law mark in common law jurisdictions.
4. Portfolio or family of marks with variations.
5. geographical indication: No
6. designation of origin: Yes
7. unregistered trademark: Yes
8. business identifier: Yes
9. company name: Yes
10. family name: Yes
11. title of protected literary or artistic work: No

12. other: No

V. Response submitted: Yes

VI. Domain name is confusingly similar/neither identical nor confusingly similar to the protected rights of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No
2. Why: Failure to prove legal surname and that was ground relied on in Response. Formulation not consistent with own name fair usage. No use and no fair or legitimate use.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes.
2. Why: Suspected impersonation. Lack of proof of identity. Prior proceedings and knowledge and intent.

IX. Other substantial facts the Panel considers relevant: As above.

X. Dispute Result: Revocation of the disputed domain name.

XI. Procedural factors the Panel considers relevant: -

XII. [If transfer to Complainant] Is Complainant eligible? -