



**URS | DETERMINATION**  
(URS Procedure 9, URS Rules 13)

**URS DISPUTE NO. 84AD16C1**

Determination FINAL

**I. PARTIES**

Complainant(s): Breitling AG (Switzerland)  
Complainant's authorized representative: IP Twins (France)

Respondent(s): Privacy service provided by Withheld for Privacy ehf (Iceland)

**II. THE DOMAIN NAME(S), REGISTRY OPERATOR AND REGISTRAR**

Domain Name: breitling.global ("Domain Name")  
Registry Operator: Identity Digital Limited  
Registrar: NameCheap Inc.

**III. PROCEDURAL HISTORY**

Complaint submitted: 6 February 2025  
Lock of the domain name(s): 24 February 2025  
Notice of Complaint: 26 February 2025  
Response Submitted: 5 March 2025  
Examiner Appointed: 10 March 2025  
Final Determination issued: 12 March 2025

**IV. EXAMINER**

Examiner's Name: Nicholas Smith

The Examiner certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as the Examiner in this administrative proceeding.

**V. RELIEF SOUGHT**

The Complainant requests that the Domain Name be suspended for the balance of the registration period.

The Respondent requests that the proceedings be dismissed.

**VI. STANDARD OF REVIEW**

Clear and convincing evidence.

## **VII. DISCUSSIONS AND FINDINGS**

### **A. Complainant:**

The Complainant is a Swiss company, founded in 1884 which is involved in manufacturing high-end chronographs, watches and related accessories under the trademark BREITLING, which it has registered in a number of jurisdictions.

The Complainant contends that:

- 1) The Domain Name is identical to the Complainant's distinctive BREITLING mark, merely adding the ".global" gTLD.
- 2) The Respondent has no rights or legitimate interest in respect of the Domain Name. The Respondent has not been authorized by the Complainant to use the BREITLING mark or register any domain name incorporating the BREITLING mark or any similar mark. The Domain Name resolves to an inactive website (holding page) maintained by the Registrar.
- 3) The Domain Name was registered and is being in bad faith. Respondent must have known of the Complainant at the registration date given the Complainant's use of the Domain Name for over 140 years and considerable reputation in the Domain Name. Respondent fails to use the Domain Name and the absence of active use of a domain name does not prevent a finding of bad faith.

### **B. Respondent:**

The Respondent does not address the claims in the Complaint under the URS but submits that the Complaint should immediately be dismissed on the basis that the Complainant's representative IP Twins is not an authorized representative of the Complainant and is attempting to engage in misrepresentation, attempted URL hijacking and fraudulent behavior.

The Respondent states that the Complainant's representative has failed to provide proof of any contract between it and the Complainant stating its role as official representatives. The Complainant's failure to provide that contract as well as its failure to accept the offer presented by the Respondent to sell the Domain Name for US\$ 6,000 is proof of their lack of mandate. Furthermore, there is no evidence on IP Twins' website that they represent the Complainant

### **C. Procedural findings:**

Having reviewed the communications records, the Examiner finds that MFSD has discharged its responsibility under the URS Procedure paragraphs 3 and 4 and URS Rules paragraph 4.

### **D. Findings of fact:**

The facts asserted by the Complainant regarding ownership of a word mark have not been supported by clear and convincing evidence and hence the Complainant has not demonstrated all 3 elements of the URS by a standard of clear and convincing evidence.



### **E. Reasoning:**

According to Paragraph 13 of the URS Rules, the Examiner shall make a Determination of a Complaint in accordance with the URS Procedure, the URS Rules and any rules and principles of law that it deems applicable.

The Respondent did not address the Complainant's contentions regarding the URS in any way. However, a Respondent's failure to address the contentions does not automatically result in a decision in favor of the Complainant. The URS Procedure requires the Complainant to succeed to establish that each of the three following conditions under Paragraph 1.2.6 of the URS Procedure are satisfied:

- That the Domain Name is identical or confusingly similar to a word mark;
- That the Respondent has no legitimate right or interest to the Domain Name;
- That the Domain Name was registered and is being used in bad faith.

#### **1. The domain name(s) is(are) identical or confusingly similar to a word mark**

Paragraph 1.2.6.1 of the URS requires Complainant to prove that *"the registered domain name is identical or confusingly similar to a word mark: (i) for which the Complainant holds a valid national or regional registration and that is in current use; or (ii) that has been validated through court proceedings; or (iii) that is specifically protected by a statute or treaty in effect at the time the URS complaint is filed (...)"*.

Paragraph 8.2 of the URS states that: *"The burden of proof shall be clear and convincing evidence."*

Paragraph 9.1 of the URS states that: *"There will be no discovery or hearing; the evidence will be the materials submitted with the Complaint and the Response, and those materials will serve as the entire record used by the Examiner to make a Determination"*.

Paragraph 9.3 of the URS states that: *"If the Complainant does not satisfy the burden of proof, the URS proceeding is terminated and full control of the domain name registration shall be returned to the Registrant."*

The Examiner notes that URS Procedure 1.2.6.1 requires Complainant to prove, by clear and convincing evidence, that the registered domain name is identical or confusingly similar to a **word mark** (emphasis added). If a complainant only provides evidence of a figurative or device mark containing the words then the examiner may dismiss the Complaint, see *Valkyrie Investments Inc. et al. v. Privacy Protection*, Forum Case No. FA2211002022329, *Silit-Werke GmbH & Co KG v. Frans Noordermeer et al*, Forum Case No. FA1611001701189 and *FUTBOL CLUB BARCELONA v. Joerg Lindemer et al*, Forum Case No. FA1409001580834.

The Examiner notes that there have been URS proceedings where the Complainant's remedy has been granted where the Complainant relies on a figurative mark only such as *Baur Versand (GmbH & Co KG) v. wang dongming*, Forum Case No. FA1602001661429 and

The Examiner considers that the case law on this question remains uncertain and, in the absence of binding precedent or a clear statement of the position adopted by a majority of Examiners adopts the former interpretation which reflects the clear wording of the URS itself, namely that the stated requirement that a Complainant provide evidence of a word mark is not satisfied by the provision of figurative or device marks with word elements. The Examiner notes that the drafters of the URS made a clear drafting decision to use the term “word mark”, as opposed to the broader term “trade mark” under the Uniform Domain Name Dispute Resolution Policy (UDRP) and it would presumably defeat the intention of the drafters to interpret “word mark” as including figurative and device marks. If a complainant wishes to rely on such marks they can file a proceeding under the UDRP, which specifically uses the term “trade mark” instead of the term “word mark”.

The Complaint provides evidence of the Complainant’s ownership of two trademarks incorporating the word BREITLING:

- International trademark No. 279322 registered on 31 January 1964, duly renewed and covering goods in international class 14 for a figurative mark consisting of the word BREITLING in stylised form
- International trademark No. 160212 registered on 10 March 1952, duly renewed and covering goods in international class 14 for a figurative mark consisting of the elements B BREITLING with the letter “B” in stylised form and the word BREITLING in block letters.

The Complaint, in Annex 5, includes a webpage said to show use of the BREITLING mark however the mark shown is the same mark as International trademark No. 160212.

The Examiner notes that paragraph 1.2.6.1 of the URS requires the Complaint be based on a word mark and paragraph 9.1 is very clear in the sense that the evidence is limited to the materials submitted with the Complaint and the Response, and that those materials are the entire record that can be used by the Examiner to make a Determination. Given those factors the Examiner finds that the Complaint did not meet the requirement of the paragraph 1.2.6.1 of the URS in the sense that the Complaint did not provide any evidence of a word mark to which the Domain Name would be identical or confusingly similar.

## **2. Respondent has no rights or legitimate interests to the domain name**

As the Complainant did not meet the requirement of the paragraph 1.2.6.1 of the URS it is not necessary to consider this requirement.

## **3. The domain name was registered and is being used in bad faith**

As the Complainant did not meet the requirement of the paragraph 1.2.6.1 of the URS it is not necessary to consider this requirement.

## **4. Abusive Complaint**

The Examiner does not accept the material in the Response regarding the authority of the Complainant’s representative to act for the Complainant. The Respondent provides no support for any of its assertions, merely relying on the failure of the Complainant to accept its settlement offer and the fact that the Complainant’s Representative’s Website does not expressly refer to its work for the Complainant.



The Complaint is filed by the same entity that has appeared for the Complainant in other disputes under the URS. Moreover, the Complaint contains the relevant certification under the URS Rules, namely that the Complainant certifies that the information contained in this Complaint is to the best of the Complainant's knowledge complete and accurate and it is not being presented for any improper purpose. Finally, the submissions in the Response that the Complainant's Representative seeks to hijack the Domain Name do not make any logical sense given that the remedy sought in the Complaint is suspension of the Domain Name, which would not result in the transfer of the Domain Name to the Complainant's representatives.

The Examiner finds that the Complaint was neither abusive nor contained material falsehoods.

## **VIII. DETERMINATION**

### **A. Demonstration of URS elements**

Not demonstrated

### **B. Complaint and remedy**

Complaint: Rejects

Domain Name: breitling.global

Unlocks and returns to the full control of the Registrant

### **C. Abuse of proceedings**

Finding of abuse of proceedings: Not finds

### **D. Publication**

Publication: Publish the Determination

## **SIGNATURE**

Name: Nicholas

Surname: Smith

Date: 12 March 2025