Decision for dispute CAC-UDRP-101568

Case number	**CAC-UDRP-101568**
Time of filing	**2017-06-14 09:46:06**
Domain names	**avastzone.com**

Case administrator

Name	**Aneta Jelenová (Case admin)**

Complainant

Organization	**Avast Software s. r. o.**

Complainant representative

Organization	**Rudolf Leška, advokát**

Respondent

Name	**Victor Chernyshov**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

In this proceeding, the Complainant relies on the following trademarks:
- avast! (word) International Registration No. 1011270
- AVAST (word) European Union Registration No. 010253672.
The Complainant also refers to unregistered (common law) trademark rights in the product name "AVAST SafeZone Browser" and US figurative trademark application No. 87236956.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant contends that it is one of the largest security software companies in the world using next-gen technologies to fight cyber attacks in real time. The Complainant is well known on the market globally with a long tradition from 1988. Its popularity on the market and high quality is supported by the fact that AVAST software has more than 400 million users.

The Complainant owns a number of trademarks and trademark applications that include the AVAST element.
The Complainant also claims that it owns common law and statutory rights in the non-registered product name "AVAST

SafeZone Browser" first used in commerce not later than in March 2011.

The disputed domain name <avastzone.com> was registered by the Respondent on March 20, 2017.

The Complainant states that the disputed domain name is confusingly similar to the Complainant's family of AVAST trade and service marks.

The "avast" is the distinctive part in the disputed domain name and the "zone" element has a purely descriptive character. According to the Complainant the Respondent has no rights or legitimate interests in respect of the <avastzone.com> domain name which has been registered and is being used in bad faith.

In particular, the Complainant notes that the Respondent knew or should have known of the registration and the use of the Complainant's trademarks before the registration of the disputed domain name.

Trademark use and registrations predate the registration of the disputed domain name.

According to the Complainant the disputed domain name is used solely for the illicit distribution of the AVAST software where the Complainant did not provide an authorization for such distribution of its software protected by copyright.
The Complainant states that the disputed domain name has no other purpose than misleadingly diverting the potential customers to illegal distribution of the AVAST software.

The disputed domain name thus also disrupts the business of the Complainant and tarnish the trademarks at issue. Although the Respondent uses slightly visible disclaimer on the webpage claiming the webpage to be "unofficial promo website", the use of the overall Complainant's trade dress, copyrighted logo and trademarks intentionally attempts to attract the internet users to illegally distributed Complainant's software quality and genuineness of which is out of control of the Complainant.

Furthermore, the Complainant believes that the use of a proxy service by the Respondent is by itself an indicator of bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

The language of the Registration Agreement is Russian and the Complainant requested that this proceeding should be conducted in English.

The Panel agrees with the Complainant, taking into account the circumstances of the case, including the fact that the web site under the disputed domain name has an English language version, the fact that the Respondent has been given a fair chance to object but has not done so and considering previous UDRP decisions (e.g. Instagram, LLC v. lu xixi, PRIVATE, WIPO Case No. D2015-1168 and Sanofi and AVENTISUB II Inc. v. Nikolay Fedotov, WIPO Case No. D2013-2121), and determines in accordance with paragraph 11(a) of the UDRP Rules that the language of the proceeding shall be English.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or confusingly similar with Complainant's trademark

The Complainant is the owner of the AVAST trademark registrations.
The Complainant relies on trademark registrations, a US trademark application and unregistered "common law" trademark rights.

The Panel finds that the Complainant has proven trademark rights on a basis of its registered AVAST trademarks and it is not necessary for the purpose of this proceeding to consider whether the Complainant's has rights in the unregistered marks.

As confirmed by WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition
("WIPO Overview 3.0"), see paragraph 1.2.1: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".
The Panel would nevertheless like to add that a pending trademark application would not by itself establish trademark rights within the meaning of UDRP (see par. 1.1.4 of the WIPO Overview 3.0).

The disputed domain name consists of the AVAST element and the word "zone". The "zone" element can be considered descriptive and is not distinctive per se.

It is well accepted that where the relevant trademark is recognizable within the disputed domain name, the addition of descriptive terms would not prevent a finding of confusing similarity under the first element (see par. 1.8 of WIPO Overview 3.0).

The Panel notes that the only difference between the disputed domain name and the Complainant's trademarks is the addition of the word "zone" which does not change overall impression and does not eliminate the confusing similarity.

The gTLD suffix ".com" is to be generally disregarded under the confusing similarity test.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and
(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see Julian Barnes v. Old Barn Studios, WIPO Case No. D2001-0121; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110 and CAC Case No. 101284.

The Complainant states that the Respondent is not known by the names comprised in the disputed domain name nor owes any identical or similar trademark or has ever used any identical or similar brand before the registration and that there are no business relations between the Respondent and the Complainant.

The Complainant did not grant any license or authorization to register or use the disputed domain name by the Respondent. The Complainant claims that the offer to download the Complainant's software represents illegal unauthorized conduct as does the use of the Complainant's logo and the Respondent cannot rely on nominative fair use of the Complainant's mark. The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows all reasonable inferences of fact in the allegations of the complaint to be deemed true (see paragraph 14(b) of the Rules and Vertical Solutions Management, Inc. v. webnet-marketing, inc., FA 95095, National Arbitration Forum).

To reach the right decision, a panel is allowed to undertake limited factual research into matters of public record if it deems this necessary.

Under paragraph 10(a) of the Rules the Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and the Rules and the Panel shall be able to independently visit the Internet in order to obtain additional light in a default proceeding (see Société des Produits Nestlé SA v. Telmex Management Services, WIPO Case No. D2002-0070; InfoSpace.com, Inc. v. Hari Prakash, WIPO Case No. D2000-0076).

The Panel notes that the web site under the disputed domain name on the date of the decision (July 24th, 2017) appears to offer for download "AVAST" antivirus software (owned by the Complainant). The web site also contains links to the Complainant's web site with Privacy Policy and License Agreement documents. The same is true for the Russian language version of the Respondent's web site.

There is no information on the web site that could somehow explain the nature of this web site and relations between the Respondent and the Complainant. The web site does not contain any contact information of the Respondent.

While the panels allowed under certain circumstances nominative fair use of a trademark in a domain name by resellers or distributors (even extending it to unauthorized resellers/distributors or service providers) – "the Oki data test" (see Oki Data Americas, Inc. v. ASD, Inc., WIPO case No. D2001-0903), the Panel finds that this is not the case here.

Use of Complainant's copyrighted logo, overall trade dress along with the offer for download the Complainant's software in the absence of Complainant's authorization and in violation of Software End User License Agreement negate any potential justification (especially in the absence of any response and explanations of the Respondent and in the absence of any details on the Respondent's web site).

The Panel also notes that the use of a domain name for illegal activity (i.e. copyright infringement) can never confer rights or legitimate interests on a respondent (see par. 2.13.1 of the WIPO Overview 3.0).

The Panel, therefore, finds that the Complainant satisfied the second requirement of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.
These circumstances are non-exhaustive and other factors can also be considered in deciding whether the disputed domain name is registered and used in bad faith.

A range of considerations apply in assessing Respondent's bad faith, i.e. the nature of the domain name, the content of any website to which the domain name directs, a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the domain name, or other indicia generally suggesting that the respondent had somehow targeted the Complainant (see par. 3.2.1 of the WIPO Overview 3.0).

The Panel finds that at least one element described in paragraph 4(b) of the Policy is present here, namely 4(b) (iv) and by

using the domain name the Respondent is attempting to attract for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the affiliation or endorsement of the Respondent's website.

Factors finding in favor of this conclusion are inter alia similarity between the Complainant's official web site and the web site under the disputed domain name (in particular, use of Complainant's logo by the Respondent) as well as the content of the web site, including links to Complainant's site, reputation and goodwill of Complainant's marks and a clear indication that the Respondent was aware of Complainant's marks (see e.g. CAC Case No. 100837 and CAC Case No. 101022).

The Complainant refers to a disclaimer used by the Respondent claiming the web site to be "unofficial promo website", and argues that such disclaimer is insufficient to avoid confusion.

The Panel notes that on the date of the decision (July 24th, 2017) there is no disclaimer on the web site under the disputed domain name.

In any case, where the overall circumstances of a case point to the Respondent's bad faith, the mere existence of a disclaimer cannot cure such bad faith (see par. 3.7 of the WIPO Overview 3.0).
Besides, a small disclaimer at the bottom of the page may lead to the conclusion that the Respondent was seeking to create a false impression of association with the Complainant (see e.g. Carrefour v. Whois Agent, Whois Privacy Protection Service Inc. / Andres Saavedra, WIPO Case No. D2016-0608; Thirty & Co. v. Jake Marcum, Marcum Creative, LLC, WIPO Case No. D2016-1212 – "Rather than curtail consumer confusion, the nearly undetectable disclaimer at the bottom of Respondent's webpage merely confirms Respondent's knowledge and bad faith disregard of Complainant's rights").

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **AVASTZONE.COM**: Transferred

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2017-07-24

Publish the Decision