Decision for dispute CAC-UDRP-101810

Case number	CAC-UDRP-101810
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Domain names	migros-ch.site

Case administrator

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

Complainant

Organization	MIGROS-GENOSSENSCHAFTS-BUND

Complainant representative

Organization	SILKA Law AB

Respondent

Name	Mary Hines

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

The Complainant, Migros Genossenschafts-bund (hereinafter referred to as "Migros"), is one of the biggest retail company of Switzerland.

The Complainant has submitted evidence, which the Panel accepts, showing that it is the registered owner of the following trademarks in several classes and domain names bearing the “MIGROS“ phrase.

Currently, Migros is the owner of various trademark registrations such as:

The Swiss trademark n° P-405500 dated 13.02.1993 designating goods and services in classes 1-9, 11, 12, 14-32 and 34.

The Swiss trademark n° 2P-415060 dated 27.09.1994 designating the services in classes 35-42.

The EU trademark n° 003466265 dated 29.10.2003 designating the services in class 35.

The American trademark n° 85299137 dated 19.04.2011 designating "retail store services featuring foods, beverages, personal care products and household cleaning preparations".

The Complainant has been extensively using the “MIGROS” denomination on all internet environments including and not limited to the company’s official websites – among which are www.migros.com, www.migros.ch; www.migrosbank.com.

FACTUAL BACKGROUND

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

PART I

The Disputed Domain Name is identical or confusingly similar to a trademark in which the Complainant has rights.

Migros Genossenschafts-bund (hereinafter referred to as the Complainant), is the Swiss based umbrella organization of the regional Migros Cooperatives which is known throughout Switzerland. Migros Genossenschafts-bund was founded by Gottlieb Duttweiler in 1925 in Zurich and has now evolved into a Community of ten regional Cooperatives. Nowadays, the Migros Group, however, is not only related to the food industry. In 2015, the Migros Group opened more than 250 stores and maintained its mission of ‘contributing to employment’ with its 4,500 new employees.

The Complainant owns several trademarks consisting of or containing the words “MIGROS” and “MIGROS BANK” (hereinafter referred to as "trademarks”). The use of the Disputed Domain Name makes it clear that the Respondent is aware of Migros.

The Complainant also owns various registrations for domain names that include its registered trademarks, including <www.migros.com>, <www.migros.ch>, among others. Complainant uses these domain names to connect to websites through which it informs potential customers about its products and services. The Complainant has previously successfully challenged several MIGROS domain names through the UDRP process on the following WIPO cases: D2016-2547, D2016-0687, D2015-2375, D2015-1630, D2015-1197, D2015-1012, D2015-0921, D2015-0974, D2015-0564, D2015-0326D2000-1171, D2008-0092, DCH2008-0016, DCH2010-0020, DCH2010-0021, D2015-0564, D2015-0326

The Disputed Domain Name was registered on November 28, 2017 which incorporates the Complainant’s well-known trademark in its entirety. The addition of the generic Top-Level Domain (gTLD) does not add any distinctiveness to the Disputed Domain Name. The combination with the word “ch” which serves as country identifier and a hyphen. These elements do not prevent the confusing similarity of the Disputed Domain Name with the Complainant’s trademarks. Where the Disputed Domain Name is compared with the Complainant’s registered "MIGROS" trademark, “MIGROS” is still the most distinctive word. The new gTLD .site shall also be ignored. Compare with CAC Case No.101711 where it was stated that the addition of a gTLD” does not distinguish the domain name. The following should apply in the current case and the Disputed Domain Name should be considered as identical to the registered trademark "MIGROS".

PART II

The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

First of all, there is no bona fide offering of goods or services where the Disputed Domain Name incorporates a trademark which is not owned by the Respondent, nor is the Respondent known by the name “MIGROS”. The addition of the country code “ch” in the Disputed Domain Name strengthens the impression of a legitimate connection between the website to which the Disputed Domain Name resolves and the Complainant. The Complainant has not found that the Respondent is commonly known by the Disputed Domain Name. The Complainant has conducted searches on the Respondent´s name and haven’t found anything that would justify the Disputed Domain Name registration either by company name or trademark registrations. The Respondent has not provided the Complainant with any evidence of its use of, or demonstrable preparations to use the Disputed Domain Name in connection with a bona fide offering of goods or services. The tendency of domain names is to induce consumers into visiting the related website under the misapprehension that the websites are

endorsed by the Complainant. Relying on consumer confusion concerning a well-established trademark is not a route to establishing a claim for rights or legitimate interests.

The Respondent has made no effort to use the Disputed Domain Name for any purpose that might explain its choice in a manner consistent with having rights or legitimate interest in the name “MIGROS”. When accessing the site, the Complainant is supposedly giving away gift cards to celebrate its anniversary (text via Mobile / Whatsapp). The site is accessible via a mobile device but has been closed down when accessing from e.g. a laptop. When entering the terms in Google search engine, the first returned results point to the Complainant‘s official website. The Respondent could easily perform a similar search before registering the Disputed Domain Name and would have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks for a significant period of time.

There is no evidence that the Respondent has a history of using, or preparing to use, the Disputed Domain Name in connection with a bona fide offering of goods and services. It is clear that the Complainant has become a distinctive identifier associated with the term “MIGROS” and that the intention of the Disputed Domain Name is to take advantage of an association with the business of the Complainant.

The Disputed Domain Name is pointing to a site that bears the resemblance of a “MIGROS” endorsed site. It adopts the same colour scheme (orange, yellow, white). The Disputed Domain Name was used to set up a website in order to deceive members of the public into believing that they can safely enter into a questionnaire and then receive a gift card. The website is deceptively similar in layout, colour and content. The Complainant took all measures to try and have the site removed and the following day the website was suspended, however the access from a mobile device is still possible. Due to the historical use of the site there is always a risk that the site will be activated again. Clearly, the Respondent is not known by the Disputed Domain Name, nor does the Respondent claim to have made legitimate, non-commercial use of the Disputed Domain Name.

PART III

The Disputed Domain Name was registered and is being used in bad faith.

The fact that the Respondent reproduced the Complainant’s website by adopting the Complainant’s logo and overall look was with the intention to deceive internet users into believing the website was in fact operated by the Complainant. Compare with WIPO decision D2017-0066 where the same circumstances were at hand. The Respondent created a website nearly identical with the Complainant whose core business was banking. The Panel stated that: “The Respondent did not make a fair or non-commercial use of the Disputed Domain Name. On the opposite, the Respondent used a privacy shield service to register the Disputed Domain Name and then used it to resolve to an obviously infringing website copying the official Complainant’s website and reproducing the Complainant’s trademarks.” Same circumstances are at hand in the present case. By holding its registration of the Disputed Domain Name, under the circumstances explained herein the conclusion of acting in bad faith (including a sham offering of vouchers) can under no circumstances be use in good faith. Compare with WIPO Case No. D2016-2474 involving fake gift cards where the Panel stated that: “The Panel, therefore, has no difficulty in finding that by using the disputed domain name, Respondent intentionally attempted to attract, for commercial gain, Internet users to his own website, by creating a likelihood of confusion with Complainant’s H&M trademark as to the source, sponsorship, affiliation or endorsement of Respondent’s website or of a product or services thereon.” Such circumstances, however, shall be evidence of registration and making use of the Disputed Domain Name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

Additionally, the Respondent registered the Disputed Domain Name using a privacy service. While this is not, of itself, indicative of bad faith, the use of a privacy service to shield the Respondent's identity can further support an inference of bad faith where there is evidence of other improper behaviour on the part of the Respondent [e.g. Bryant Tyson v. Fundacion Private Whois/ Domain IP Holding Corp., WIPO Case No. D2013-0529].

To summarize, the confusingly similar nature of the Disputed Domain Name to the Complainant's trademarks, together with the word “site" demonstrates lack of good faith. Consequently, the Respondent should be considered to have registered and

to be using the Disputed Domain Name in 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.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

a) The domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

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

c) The domain Name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. Identical or confusingly similar

The Policy simply requires the Complainant to demonstrate that the Disputed Domain Name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registrations of the "MIGROS" trademarks worldwide.

The Panel further finds that the Disputed Domain Name is confusingly similar to the Complainant's "MIGROS" trademarks. The Disputed Domain Name incorporates the Complainant's "MIGROS" trademark in its entirety with the addition of the “ch” code. The Panel concludes that the addition of a two letter country code referring to Switzerland, does not eliminate the

confusing similarity between the Complainant's “MIGROS” trademarks and the Disputed Domain Name.

In similar UDRP cases (See, e.g., Sanofi-Aventis v. Gideon Kimbrell, WIPO Case No. D2010-1559; Turkcell Iletisim Hizmetleri A.S. v. Vural Kavak, WIPO Case No. D2010-0010; Greenbrier IA, Inc. v. Moniker Privacy Services/Jim Lyons, WIPO Case No. D2010-0017 and Zodiac Marine & Pool, Avon Inflatables Ltd and Zodiac of North America Inc. v. Mr. Tim Green, WIPO Case No. D2010-0024), the respective UDRP panels found that adding descriptive words does not remove the likelihood of confusion between a trademark and a domain Name incorporating said trademark. Therefore adding the “CH” phrase would not remove the identity or confusing similarity. Indeed, the Panel finds that the addition of the “ch” phrase increases the likelihood of confusion since it refers to Switzerland, where the Complainant is based.

Moreover, the Panel finds that the addition of the "site" suffix is irrelevant when determining whether the Disputed Domain Name is confusingly similar to the Complainant's trademark.

The Panel is of the opinion that the internet users will fall into false impression that the Disputed Domain Name is one of official domain names of the Complainant. The Panel recognizes the Complainant's rights and concludes that the Disputed Domain Name is confusingly similar with the Complainant's trademarks. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

B. No rights or legitimate interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

It is open to a Respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to you [the Respondent] of the dispute, your use of, or demonstrable preparations to use, the domain Name or a Name corresponding to the domain Name in connection with a bona fide offering of goods or services; or

(ii) you [the Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you [the Respondent] are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the Respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the Disputed Domain Name, the Complainant will have failed to discharge its burden of proof and the Complaint will fail. The burden is on the Complainant to demonstrate a prima facie case that the Respondent does not have rights or legitimate interests in the Disputed Domain Name. Once the Complainant has made out a prima facie case, then the Respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the Disputed Domain Name.

In the absence of a response, the Panel accepts the Complainant's allegations as true and that the Respondent is not an authorized business partner and therefore has no authorization to use the "MIGROS" trademark in the Disputed Domain Name, considering that there exists no evidence proving that the Respondent is using the “MIGROS” trademark under reasonable grounds.

The Panel also accepts that the Respondent is not commonly known by the Disputed Domain Name, the Respondent has acquired no trademark or service mark rights, and the Respondent is not an authorized dealer or representative of the Complainant.

In light of the evidence provided by the Complainant, notably that the Complainant has not granted the Respondent any right

or license to use the “MIGROS” trademarks, the Panel finds that the Complainant has established a prima facie case that the Respondent does not have rights or legitimate interests in the Disputed Domain Name for the purposes of the Policy.

Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the Disputed Domain Name, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and used in bad faith

The Panel notes that the Complainant must prove both that the Disputed Domain Name was registered in bad faith and that it is being used in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances that, if found by a panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration 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; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

By consideration of the foregoing, the Panel is of the opinion that due to the earlier rights of the Complainant on the trademark “MIGROS” trademark registered worldwide, the Respondent, located in the United States of America, was aware of the Complainant and its globally well-known “MIGROS” trademark at the time of the registration of the Disputed Domain Name. (See e.g. Ebay Inc. v. Wangming, WIPO Case No. D2006-1107; General Electric Company v. CPIC NET and Hussain Syed, WIPO Case No. D2001-0087; Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226.) The Panel believes that the awareness of the Complainant's trademark at the time of the registration of the Disputed Domain Name is to be considered an inference of registration in bad faith.

Further, since the Respondent uses the Complainant's “MIGROS” trademark with the addition of the “ch” phrase which is a globally-used shortcut for Switzerland, the nature of this minor addition tends to reinforce consumers' conclusion that the websites to which the Disputed Domain Name resolve are somehow linked with the Complainant under its "MIGROS" trademarks, or otherwise strengthens the risk of association with the Complainant's trademark.

In addition, by not submitting any response, the Respondent has failed to invoke any circumstances that could demonstrate that it did not register and use the Disputed Domain Name in bad faith.

Yet, the Panel could not confirm the claimed infringing use of the "MIGROS" trademarks on the Disputed Domain Name by the Respondent neither from the Disputed Domain Name nor from the evidences submitted by the Complainant.

When faced with a lack of evidence of actual use of the Disputed Domain Dame, where the Respondent has clearly

registered the Disputed Domain Dame in bad faith, where the Respondent has not responded to the Complaint or to any of multiple attempted communications, and based on the strength of Complainant's mark, Complainant's registration of that trademark within the jurisdiction where the Respondent is located and where the Respondent registered the Disputed Domain Name, and the identical use of the Complainant's entire trademark by the Respondent in the Disputed Domain Name, the Panel finds that bad faith use can be inferred from the circumstances. The Panel thus concludes that looking at all the circumstances, the Complainant has established that the Respondent registered and used the Disputed Domain Name in bad faith and has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

Therefore, in the light of the above-mentioned circumstances of the present case, the Panel finds that the Disputed Domain Name is or has been used in bad faith and that the Complainant has established the third element under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MIGROS-CH.SITE**: Transferred

PANELLISTS

Name	**Mrs Selma Ünlü**

DATE OF PANEL DECISION 2018-02-05

Publish the Decision