Decision for dispute CAC-UDRP-101917

Case number	CAC-UDRP-101917
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Domain names	avastcustomersupport.com

Case administrator

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

Complainant

Organization	Avast Software s.r.o.

Complainant representative

Organization	Rudolf Leška, advokát

Respondent

Organization	adisoftronics

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the registrant, among other registrations, of the international trademark registration No. 1011270, "AVAST!", registered on April 15, 2009, for goods and services in class 9.

The Disputed domain name was registered by the Respondent on December 10, 2015.

FACTUAL BACKGROUND

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

The Complainant states 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 points out that it is well known on the market globally as a reliable company with a long tradition from 1988. The Complainant underlines the fact that the AVAST software has more than 400 million users.

The Complainant adds that it is also the owner of the domain name <avast.com> and that the Complainant's logo is

protected by copyright in the United States of America.

The Complainant submits that it distributes its products, inter alia, via its website www.avast.com where a customer can find product information and can directly download AVAST software.

The Complainant clarifies that on its website it also offers customer support relating to the AVAST software.

The Complainant argues that the Disputed domain name was registered with the knowledge of the trademarks rights of the Complainant.

The Complainant submits that the website under the Disputed domain name is supposed to be used by the Respondent to offer paid service regarding the Complainant's AVAST software to the Complainant´s customers such as downloading, updating, upgrading of software, as expressly stated on the Respondent´s website.

The Complainant argues that the Disputed domain name is confusingly similar to the Complainant's family of AVAST trade and service marks, that the Respondent has no rights or legitimate interests in respect of the Disputed domain name, which, according to the Complainant, has been registered and is being used in bad faith.

The Complainant observes that the word "AVAST" is at the core of Complainant's family of marks and it means to stop or to cease in old English.

The Complainant considers that its trademarks are highly distinctive and the AVAST trademark is a globally known brand with reputation selling on the 7th rank among antivirus software globally.

The Complainant argues that, based on a large number of the users of the Complainant´s solution, it can be assumed that the word "AVAST" is automatically connected with the Complainant by an ordinary customer.

The Complainant submits that it is well established that the specific top level of a domain such as ".com", ".org", ".tv" or ".net" does not affect the domain name for the purpose of determining the identity or similarity of domain name and a trademark.

The Complainant underlines that the word "AVAST" is the distinctive part in the Disputed domain name.

The Complainant argues that it is the first dominant part to which an attention of the public is concentrated.

The Complainant adds that the additional part "customersupport" is descriptive in nature meaning providing help to the customers and is not able to change overall impression and does not eliminate the confusing similarity with the trademarks of the Complainant.

The Complainant underlines that this argument is even stronger in a situation where Complainant itself provides customer support directly on its official website www.avast.com.

The Complainant argues that the composition of the Disputed domain name makes the confusion more likely as it makes an impression that the website is operated by the Complainant with the intention to provide support to its own customers.

The Complainant submits that 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.

The Complainant adds that numerous prior panels have held that the fact that a domain name wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other words to such marks.

The Complainant argues that in terms of possibilities, it is likely that an ordinary consumer would believe that the Disputed domain name is owned by the Complainant and would use the Respondent's website and pay for the services only due to its misleading character assuming that the support is provided directly by the Complainant.

The Complainant observes that the Respondent is placing the official Complainant's logo on every page in a much bigger size than is commonly used by the Complainant and argues that this would contribute to the confusion of the public.

The Complainant argues that no evidence suggests that the Respondent has been commonly known within the consumers by the Disputed domain name or by the distinctive part “AVAST” included in the disputed domain name.

The Complainant is not aware of any ownership of any identical or similar trademark nor use of any identical or similar brand by the Respondent before the registration of the Disputed domain name.

The Complainant states that it did not grant any license or authorization to register or use the Disputed domain name by the Respondent.

The Complainant argues that the use of the Complainant’s logo on every page of the disputed website in the absence of any Complainant’s authorization represents unlawful conduct, namely trademark and copyright infringement.

The Complainant underlines that the use of a domain name for an illegal activity can never confer rights or legitimate interests on a respondent.

The Complainant asserts that the Respondent did not use the Disputed domain name or a name corresponding to the Disputed domain name in connection with a bona fide offering of goods or services because the Respondent has used the trademark to bait Internet users and then switch them to his competing service.

Moreover, the Complainant contends that the Respondent does not accurately disclose its relationship with the Complainant, because the disclaimer is placed at the very bottom of the pages in very small letters.

The Complainant takes the view that such disclaimer might not be entirely legible for the average Internet users and would barely get into his or her attention given that it appears at the bottom of the website. The Complainant believes that the average Internet user would not notice the disclaimer as he or she usually do not read and analyze every page before contacting the Respondent and ordering the service. The Complainant infers that in such a case the existence of the disclaimer cannot as such compensate a lack of good faith.

The Complainant points out that the Respondent placed the Complainant´s logo on every page of the website with the description “Avast Customer Service” and misleadingly states that the service is provided by the qualified skilled tech team and that if someone has fake Avast software the Respondent's service is not for them. The Complainant considers that this fact implies that the service would be provided by the Complainant.

The Complainant submits that the Respondent was seeking to create a false impression of association with the Complainant, which does not constitute a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name.

The Complainant contends that the Respondent was clearly aware of the registration and the use of the Complainant´s trademarks before the registration of the domain name as follows from the Respondent's explicit references on his website to the official Claimant’s website, logo and his AVAST Antivirus Software. The Complainant adds that this argument is supported by the fact that the Respondent's disclaimer refers to the Complainant´s website. The Complainant infers that rather than curtail customers' confusion, the unnoticeable disclaimer at the bottom of the Respondent´s website merely confirms the Respondent's knowledge and bad faith.

The Complainant underlines that Panels have consistently found that the mere registration of a domain name that is

confusingly similar (in particular, domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

The Complainant contends that the Disputed domain name is used by the Respondent to reach the Complainant's customers and offer them the identical service as is offered by the Complainant on its website and by the Complainant's official partners and this fact could suggest that the Respondent operates as an affiliate or a partner of the Complainant.

The Complainant argues that the Respondent's statement that the service is provided by the “qualified skilled tech team” in the context of the Respondent's website and the use of the logo gives a misleading impression that the Respondent is certified by the Complainant to provide the service. The Complainant points out that the quality of the service provided by the Respondent is not under the Complainant's control and for this reason the Respondent's service can very easily harm good reputation built by the Complainant for years.

The Complainant argues that the Respondent uses the Complainant's trademark in the Disputed domain name and in the website connected to it solely for the commercial gain to misleadingly divert the Complainant's customers and to tarnish the trademarks at issue by creating a likelihood of confusion with the Complainant´s marks.

In light of the above, the Complainant requests the transfer in its favor of the Disputed domain name.

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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the Disputed domain name, the Complainant has to demonstrate that:

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

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

(iii) The Disputed domain name has been registered and is being used in bad faith.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the Disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark or service mark.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the Disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "AVAST!", identified in section "Identification of rights" above.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the Disputed domain name itself to the Complainant’s trademark.

The Disputed domain name differs from the Complainant’s trademark "AVAST!" only by the lack of the exclamation point at the end of the word "avast", by the addition of the words "customer" and "support" and by the addition of the top-level domain ".com".

It is well established that where the relevant trademark is recognizable within the domain name, the addition of other non-distinctive terms does not prevent a finding of confusing similarity (see, for example, WIPO case No. D2008-2002). In particular, other panels have considered the words "customer" and "support" as descriptive and likely to increase the possibility of confusion amongst consumers (see, for example, CAC case No. 101661).

It is a common view that where a trademark is the distinctive part of a domain name, the domain name is considered to be confusingly similar to the trademark (see, for example, WIPO case No. D2017-1266).

Other panels took the view that an exclamation mark may be disregarded for the purposes of comparison under the first element (see, for example, WIPO case No. D2017-2229).

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the Disputed domain name is confusingly similar to the Complainant's trademark "AVAST!".

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the Disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the Disputed domain name:

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

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

(iii) [the Respondent] [is] making a legitimate non-commercial or fair use of the [Disputed] domain name, without intent for

commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”.

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the Disputed domain name.

In particular, the Complainant states that:

- the Respondent is not affiliated to the Complainant;

- the Respondent does not have any business with the Complainant;

- the Respondent has not been authorized to make any use of the Complainant's trademarks or logo;

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the Disputed domain name.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under the Policy, paragraph 4(c) or other evidence of rights or legitimate interests in the Disputed domain name.

The Respondent does not appear to be commonly known by the name "AVASTCUSTOMERSUPPORT" or by a similar name.

The Respondent has used the Disputed domain name to operate a website to offer a support service to Avast customers.

The consensus view of UDRP panels about the assessment of fair use by resellers, distributors or service providers of domain names containing third parties' trademarks is summarized in the so-called "Oki Data test".

According to the “Oki Data test”, if the following cumulative requirements are applied in the specific conditions of a UDRP case, the use of a third party's trademark may be considered a bona fide offering of goods or services:
(i) the respondent must actually be offering the goods or services at issue;
(ii) the respondent must use the site to sell only the trademarked goods or services;
(iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and
(iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.
The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant’s trademark.

In the current case, at least the condition at point (iii) is not applicable. Indeed, the Panel agrees with the Complainant's argument that the disclaimer, in small characters, might not be entirely legible for the average Internet users and would barely get into his or her attention given that it appears at the bottom of the website. Therefore, the Respondent's website does not accurately or prominently disclose the relationship with the Complainant.

For this reason, the Respondent does not appear to make any legitimate non-commercial or fair use of the Disputed domain

name, nor any use in connection with a bona fide offering of goods or services.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the Disputed domain name has been both registered and used in bad faith by the Respondent.

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, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [Disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [Disputed] 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 [Disputed] domain name; or

(ii) [the Respondent] [has] registered the [Disputed] 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 [Disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [Disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the Disputed domain name was registered in bad faith and that it has been used in bad faith.

The Panel accepts the Complainant's view that the mere registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity, as it is the case of the Disputed domain name, can by itself create a presumption of bad faith. Indeed, this is a common view of UDRP panelists (see, for example, WIPO Case No. D2017-1095).

In addition, the Panel notes that Complainant’s mark is well-known and highly distinctive. Furthermore, the content of the website is clearly designed as a customer support page related to the Complainant. For these reasons and in the absence of any allegations and explanations from the Respondent indicating the contrary, the Panel is convinced that the Respondent actually knew that the Disputed domain name was highly similar to the Complainant’s trademark when registering the Disputed Domain Name. Registration of a confusingly similar domain name in awareness of a reputed trademark and in the absence of rights or legitimate interests amounts to registration in bad faith (see, for example, CAC Case No. 101661).

The Panel observes that if the Respondent had legitimate purposes in registering and using the Disputed domain name it would have filed a Response in this proceeding.

The Panel, for all the above-mentioned reasons, considers that the Disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the Disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AVASTCUSTOMERSUPPORT.COM**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2018-04-27

Publish the Decision