Decision for dispute CAC-UDRP-101949

Case number	**CAC-UDRP-101949**
Time of filing	**2018-04-03 09:51:08**
Domain names	**avastcomsetup.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	**Domains By Proxy, LLC**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings between the parties to this dispute or relating to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks including the following trademarks:

- Registered international word mark AVAST! no. 1011270 for goods and services in the classes 9, including software (Czech application with designation for AU - DK - EE - FI - GB - GR - IE - JP - LT - SE - TR and by virtue of Article 9sexies of the Madrid Protocol also for the following countries: AT - BG - BX - CN - CY - DE - FR - HU - IT - LV - PL - PT - RO – RU - SI - SK – VN) with registration date April 15, 2009;

- Registered international word mark AVAST no. 839439 for goods and services in the classes 9 and 42, including software (German registration with designation for AU - DK - EE - FI - GB - GR - IE - JP - LT - SE – TR - US and by virtue of Article 9sexies of the Madrid Protocol also for the following countries: AT - BG - BX – CH - CN - CY - FR - HU - IT – KZ - LV - PL - RO – RU - SI - SK) with registration date June 22, 2004;

- Registered EU word trademark “AVAST” no. 010253672 for goods and services in the classes 9, 16, 42 with priority from August 25, 2011.

FACTUAL BACKGROUND

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

The Complainant is one of the largest security software companies in the world using next-gen technologies to fight cyberattacks in real time. The Complainant is well-known on the market globally as a reliable company 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 (previously Panya International s.r.o.) is a legal successor of the company which was earlier named Avast Software s.r.o. (previously Avast Software a.s.). By virtue of law, rights and obligations of the previous Avast Software s.r.o. company passed on its successor – the Complainant. Therefore, it is not an obstacle to this Complainant that the Complainant has not yet been registered as an owner of some of the trademarks and the domain name <avast.com>.

The distinctive Complainant's logo ("blob design") has been registered as a copyrighted work in the United States and Complainant owns all rights in and to this work of art.

The Complainant distributes its products i.a. via its website www.avast.com where a customer can find product information and can directly download AVAST software. On this website the Complainant also offers customer support relating to AVAST software.

This dispute concerns the Disputed Domain Name <avastcomsetup.com> registered on May 2, 2017. It follows that the Disputed Domain Name was registered with the knowledge of all older above mentioned trademarks of the Complainant. The website under the Disputed Domain Name is supposed to be used by the Respondent to offer paid service concerning the Complainant's AVAST software to the Complainant's customers. The provided services are specified under the Disputed Domain Name on page "Terms And Conditions" as follows: "Avast Com Setup's Support Services, which are Avast Com Setup's chat and phone based Software Troubleshooting Services as set forth on the Avast Com Setup website. The Services include virus diagnosis, virus removal, PC tune-up, Internet login protection, email account setup, software installation, printed setup, printer support, and general computer trouble shooting services."

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

A. The Disputed Domain Name is confusingly similar to the Complainant's trademarks

Word "AVAST" is at the core of Complainant's family of marks. It means to stop or to cease in old English. Due to long history of the Complainant, large number of the customers and its commercial activities, the Complainant's trademarks are highly distinctive and the AVAST trademark is a globally known brand with reputation selling on the 7th rank among antivirus software globally.

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

"AVAST" is the distinctive part in the Disputed Domain Name. It is the first dominant part to which an attention of the public is concentrated. An additional part "comsetup" is descriptive in nature consisting of two parts "com-" and "-setup". While the first part corresponds to level of a domain the second part means arrangement, disposition or configuration which exactly describes the services relating to AVAST software provided under the Disputed Domain Name. Therefore, this additional part is not able to change overall impression and does not eliminate the confusing similarity with the older trademarks of the Complainant and this is even truer in a situation where Complainant itself provides customer support directly on its official website www.avast.com. Quite on the contrary, it 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.

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. Similarly, 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.

On balance, there is high presumption that an ordinary consumer will believe that the Disputed Ddomain Name registered by the Respondent is owned by the Complainant and will access the website and pay for the services only due to its misleading character assuming that the support is provided directly by the Complainant.

Moreover, the Respondent contributes to the confusion of the public by placing the official well-known logo of the Complainant on every page identically as is used by the Complainant on its websites presumably in order to abuse this very famous logo in his favor.

The Respondent also mimics the overall trade dress of the Complainant.

On the basis of the above mentioned there can be no question but that the Disputed Domain Name is confusingly similar to the Complainant's family of marks "AVAST" for purposes of the Policy.

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

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 before the beginning of this dispute nor 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 did not grant any license or authorization to register or use the Disputed Domain Name by the Respondent. The use of the Complainant's logo on every page of the website resolving from the Disputed Domain Name, in the absence of Complainant's authorization represents illegal unauthorized conduct of the Respondent.

Before the dispute 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 not provided the trademarked service but has used the trademark to bait Internet users and then switch them to his competing service. Moreover, the Respondent does not accurately disclose its relationship with the Complainant. The Respondent placed the Complainant's logo on every page of the website and misleadingly states that the support staff are certified technicians. This implies that the service is provided by the Complainant. The relationship with the Complainant is only indicated in the disclaimer placed at the bottom of the pages in small letters stating that: "Avast Com Setup is an independent support provider on On-Demand Remote Technical Services For Avast products. Use Of Avast Name, logo, trademarks & Product Images is only for reference and in no way intended to suggest that Avast Com Setup has any business association with Avast. Avast trademarks, Names, logo and Images are the property of their respective owners, Avast Com Setup disclaims any ownership in such conditions." Such disclaimer might not be entirely legible for the average Internet users and will barely get into their attention given that it is depicted at the bottom of the website. The average Internet user will not notice the disclaimer as it usually does not read and analyze every page before contacting the Respondent and ordering the service. In such a case the existence of the disclaimer cannot by itself cure the lack of bona fide. Moreover, the use of the logo usually excludes any possibility of bona fide reference to Complainant's services (in case of bona fide nominative fair use of a trademark, only textual reference is usually acceptable).

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.

C. The Disputed Domain Name has been registered and is being used in bad faith

There is no indication that the Disputed Domain Name was registered and is used in bona fide. The Respondent was clearly aware of the registration and the use of the Complainant's trademarks before the registration of the Disputed Domain Name as follows from the Respondent's explicit references on his website to the official Complainant's website, logo and his AVAST Antivirus Software. This is supported by the fact that the Respondent's disclaimer refers to the Complainant's trademarks and logo. Therefore, 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 disregard of Complainant's rights.

Panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names comprising typos or 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.

Furthermore, the Disputed Domain Name is used by the Respondent to reach the Complainant's customers and offer them the identical (and therefore competing) service as is offered by the Complainant on its website and by the Complainant's official partners. This could suggest (incorrectly) that the Respondent operates as an affiliate or a partner of the Complainant.

This is supported by the Respondent's statement on the website that the service is provided by "certified technicians", as per the content of the website resolving from the Disputed Domain Name. Additionally, the website uses the logo of the Complainant and gives misleading impression that the Respondent is certified by Complainant to provide the service. The quality of the service provided by the Respondent is not under the Complainant's control and therefore his service can very easily harm good reputation built by the Complainant for years.

The Respondent uses the Complainant's trademark solely for the commercial gain to misleadingly divert the Complainant's consumers and to tarnish the trademarks at issue by creating the likelihood of confusion with the Complainant's marks.

Factors finding in favour of the conclusion that the Disputed Domain Name has been registered and is being used in bad faith are mainly similarity between the Complainant's official website and the website under the Disputed Domain Name (in particular, use of Complainant's logo by the Respondent) as well as the content of the website, 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.

RESPONDENT: 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

As per paragraph 4(a) of the Policy, for the Complaint to succeed in relation to the Disputed Domain Name, the Complainant must prove the following:

(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.

Since in this case, the Respondent failed to produce a Response, the Panel may treat as uncontested the Complainant's factual assertions. The Panel will now turn to review each of these elements.

A. Identical or Confusingly Similar

The Complainant, through evidence on record, has established its rights in the trademark "AVAST", since at least 2004. Moreover, the Complainant provided evidence showing the trademark is widely-known and has achieved recognition through its use.

Carrying out the analysis, we now turn to determine if the Disputed Domain Name is confusingly similar to the Complainant's trademarks. For this, the Panel notes that the Disputed Domain Name incorporates the entirety of the trademark, namely "AVAST", with the addition of "comsetup". This additional text is composed of two parts, namely "com" and "setup", both of which are commonly used in relation to software and the Internet—these being two fields closely related to the Complainant. This fact reinforces the conclusion that the additional text is therefore of secondary importance to the main element of the Disputed Domain Name, namely "AVAST". Based on this, and the evidence on record, the Panel finds that the addition of this additional text is not enough to dispel the confusing similarity between the Disputed Domain Name and the Complainant's trademark, as elucidated under paragraph 1.8 of WIPO Overview 3.0.

The Panel therefore finds that the Complaint has satisfied the first element set under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Complainant alleges that the Respondent is not affiliated to the Complainant nor has the Complainant authorized the Respondent in any way. Furthermore, the Complainant states that no license has been granted to the Respondent in order to allow the use of the Complainant's trademark. In the Panel's view, these allegations are enough to establish a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name as per paragraph 2.1 of WIPO 3.0 Overview.

Furthermore, as per the evidence on record, the Respondent is utilizing the Complainant's trademark in the Disputed Domain Name and prominently across the content of the website that resolves from the Disputed Domain Name. This gives the appearance that the Disputed Domain Name is directly related to the Complainant. This is further supported by the content of the disclaimer contained in the website that resolves from the Disputed Domain Name, which specifically states: "[t]he use of any third party trademarks, logos, or brand names is for informational purposes only…". From this the Panel can infer that the Respondent was aware of the potential for misrepresentation – a fact that is not ameliorated by the existence of the disclaimer, for the purposes of this dispute. This leads the Panel to conclude that the misrepresentation in question amounts to impersonation/passing off in the terms described under paragraph 2.13.1 of WIPO Overview 3.0, and this can never confer rights or legitimate interests on a respondent.

All in all, and given that there is no available evidence on record that would otherwise allow the Panel to find any rights or legitimate interests for the Respondent in the Disputed Domain Name, coupled with the misrepresentation as stated above,

the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and therefore the Complainant has fulfilled the second requirement set under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The evidence on record, specifically the explicit references – on the website resolving from the Disputed Domain Name – to the official Complainant's trademark, website and logo indicate that the Respondent was more than likely aware of the Complainant and targeted the Complainant's trademarks when registering the Disputed Domain Name for commercial gain by benefiting from the likelihood of confusion. This alone, being that the Complainant's trademark is widely-known creates a presumption of bad faith, as per paragraph 3.1.4 of WIPO Overview 3.0. The Panel therefore finds that the registration and use of the Disputed Domain Name has been in bad faith, as it encompasses the breadth of the conducts contained in the indicative list under paragraph 4(b)(iv) of the Policy.

Accordingly, the Panel finds that the Complainant has satisfied the last element required under paragraph 4(a)(iii) of the Policy.

D. Decision

For the aforestated reasons and in accordance with the provisions contained under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transferal of the Disputed Domain Name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AVASTCOMSETUP.COM**: Transferred

PANELLISTS

Name	**Rodolfo Carlos Rivas Rea**

DATE OF PANEL DECISION 2018-05-08

Publish the Decision