Decision for dispute CAC-UDRP-101962

Case number	**CAC-UDRP-101962**
Time of filing	**2018-04-20 09:37:17**
Domain names	**avastcenter.com, avastio.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

Name	**Victor Chernyshov**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other proceedings commenced or decided in relation to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the holder of trademark rights for the word mark AVAST, registered in numerous jurisdictions, including Russia (e.g. international registration No. 838439 since June 22, 2004, duly renewed, and covering products in classes 9 and 42; and Russian registration No. 627412 since August 22, 2017, covering products in classes 9 and 42).

FACTUAL BACKGROUND

The Complainant, Avast Software s.r.o., is a Czech multinational cybersecurity software company headquartered in the Czech Republic. The Complainant has more than 400 million customers using its products and the largest market share among anti-malware application vendors worldwide. The Complainant possesses a market share of more than one fifth of the global antivirus market. The Complainant has more than 1,600 employees across its headquarters in the Czech Republic and its offices in Europe, North America and Asia.

The Complainant is the owner of the registered word mark AVAST in several classes in numerous countries all over the world, including Russia.

The disputed domain names <avastcenter.com> and <avastio.com> have been registered by the Respondent on May 10,

2017 and May 26, 2017 respectively, using a proxy service. The disputed domain name <avastcenter.com> currently does not resolve to an active website. The disputed domain name used to resolve to a website containing the Complainant's trademark and logo and displaying a large icon to "DOWNLOAD FOR FREE" the Complainant's Antivirus Avast software. The disputed domain name <avastio.com> resolves to a webpage comprising of a single line of English text stating "Avast-world's FIRST free antivirus".

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant considers the disputed domain names to be confusingly similar to trademarks in which it has rights. The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain names. According to the Complainant, the Respondent does not use the disputed domain names in connection with any legitimate use. Also, according to the Complainant, the Respondent has not been commonly known by the disputed domain names. Finally, the Complainant considers that the disputed domain names were registered and are being used in bad faith. The Complainant contends that the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks and uses the disputed domain names to trade on the Complainant's goodwill and reputation. The Complainant further contends that the Respondent has intentionally attempted to attract, for commercial gain Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.

RESPONDENT:

The Respondent did not reply to the Complainant's contentions.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain names are 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 names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain names have been registered and are 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

A. Language of the proceedings

The Registrar verified that the language of the Registration Agreement is Russian. However, the Complainant contends that this is not evidenced in any way and that the available terms and conditions of the Registrar are in English. The fact that it is

not apparent that a Russian registration agreement is readily available is insufficient for the Panel to question a clear verification of the Registrar concerning the language of the applicable Registration Agreement.

However, as the Complaint was not filed in the language of the Registration Agreement and the Parties did not agree on the language of the administrative proceeding, the Panel may decide on the language of the administrative proceeding, having regard to the circumstances of the administrative proceeding. Indeed, paragraph 11(a) of the Rules reads: “Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding”.

In cases where the use of the English language in the proceedings would not be prejudicial to the interests of the Respondent, whereas it would be a disadvantage for the Complainant to be forced to translate the Complaint, panels often decide to use the English language in the UDRP proceedings (see e.g., The Dow Chemical Company v. Hwang Yiyi, WIPO Case No. D2008-1276, decision according to which, where a respondent can clearly understand the language of the complaint, and the complainant would be disadvantaged by being forced to translate, the language of proceedings can remain the language of the complaint, even though it is different to the language of the Registration Agreement).

The Panel is satisfied that both parties have a good command of English. The Respondent’s websites connected to the disputed domain names are entirely written in English. For example, the disputed domain name <avastio.com> displays the English sentence "Avast – world's FIRST free antivirus". The disputed domain name <avastcenter.com> is comprised of a descriptive English word "center" and the website previously connected to it was entirely written in English, including references to privacy policies and licence agreements. Therefore, the Panel finds that these elements show that the Respondent has a sufficient understanding of English. In addition, Respondent failed to submit any response.

Accordingly, the use of the English language in the proceedings would not be prejudicial to the interests of the Respondent, whereas it would be a disadvantage for Complainant to be forced to translate the Complaint. Therefore, the Panel decides to use the English language in the present proceedings (see e.g., The Dow Chemical Company v. Hwang Yiyi, WIPO Case No. D2008-1276, decision according to which, “where [a] respondent can clearly understand the language of the complaint, and the complainant would be disadvantaged by being forced to translate, the language of proceedings can remain the language of the complaint, even it is different to the language of the registration agreement”).

B. Substantive elements of the policy

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

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are civil, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

2. The Respondent has no rights or legitimate interests in respect of the disputed domain names; and

3. The disputed domain names have been registered and are being used in bad faith.

The Panel has therefore dealt with each of these requirements in turn.

1. Identity or confusing similarity

The Complainant must first establish that there is a trademark or service mark in which it has rights. Since the Complainant is the holder of the registered AVAST trademark, which is used in connection with its cybersecurity business, it is established that there is a trademark in which the Complainant has rights.

The Panel is of the opinion that the mere addition of non-distinctive text to a complainant's trademark constitutes confusing similarity, as set out in paragraph 4(a)(i) of the Policy. The disputed domain names <avastcenter.com> and <avastio.com> incorporate the Complainant's AVAST trademark in its entirety, with mere addition of the non-distinctive suffixes "center" and "io".

The addition of the suffixes "center" and "io" does not add to the distinctiveness of the disputed domain names as "center" is a non-distinctive word meaning middle point or hub and "io" is often used as an abbreviation in the information technology sector for input/output.

Additionally, it is well established that the generic top-level suffix ".com" may be disregarded when considering whether the disputed domain names are confusingly similar to the trademark in which the Complainant has rights.
Therefore, the Panel finds that the disputed domain names <avastcenter.com> and <avastio.com> are confusingly similar to the Complainant's trademarks. Accordingly, the Complainant has made out the first of the three elements that it must establish.

2. 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 names.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that the Respondent has no right or legitimate interest in the disputed domain names in order to shift the burden of proof to the Respondent (see Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455; Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110).

The Panel notes that the Respondent has not been commonly known by the disputed domain names and that the Respondent has not acquired trademark or service mark rights. The Respondent's use and registration of the disputed domain names was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent existed.

Moreover, the Panel is of the opinion that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names. While the disputed domain name <avastcenter.com> currently does not resolve to an active webpage, it used to refer to a website bearing the Complainant's trademarks, copyrighted logo and links to the Complainant's privacy policy and license agreement. The evidence of the case shows that the Respondent previously used the website connected to the disputed domain name <avastcenter.com> to mislead Internet users into believing that the download link posted on the website was genuine and either the product of, or endorsed by, the Complainant.
Panels have categorically held that the use of a domain name for illegal activity (e.g., phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on the Respondent (see section 2.13 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0")). The Panel is of the opinion that the software provided through a download link on the website previously connected to the disputed domain name <avastcenter.com> was used for fraudulent

purposes, such as hacking, malware infections or phishing. Evidently, such use cannot be considered a legitimate noncommercial or fair use of the disputed domain name.

The disputed domain name <avastio.com> is not used to engage in the same activity but simply displays a sentence containing the Complainant's distinctive trademark. While such a use can also not be considered a legitimate noncommercial or fair use of the disputed domain name, nothing precludes the Respondent from using the disputed domain name <avastio.com> in the future for engaging in similar fraudulent activity.

Based on the available record, the Panel finds that the Complainant has established a prima facie case, which was not refuted, and that the Respondent lacks rights or legitimate interests in the disputed domain names. Therefore, the Complainant has satisfied the second requirement that the Respondent has no rights or legitimate interests in the disputed domain names, under paragraph 4(a)(ii) of the Policy.

3. Bad faith

Complainant must prove on the balance of probabilities that the disputed domain names were registered in bad faith and that they are being used in bad faith (see e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006-1052).

Paragraph 4(b) of the Policy provides a non-exclusive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a web site or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the web site or location or of a product or service on the web site or location.

According to the Panel, the awareness of a respondent of the complainant and/or the complainant’s trademark rights at the time of registration can evidence bad faith (see Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070, where POKÉMON was held to be a well-known mark of which the use by someone without any connection or legal relationship with the complainant suggested opportunistic bad faith). In the instant case, the Panel finds that the Respondent must have had knowledge of Complainant’s rights in the AVAST trademark at the moment it registered the disputed domain names, since Complainant’s trademark is a widely known trademark and the Respondent specifically used the disputed domain names in connection to the Complainant's cybersecurity services.

In the instant case, the Respondent was using the Complainant’s trademark and copyright protected images without the Complainant’s authorization and without disclosing its relationship with the Complainant. Doing so, consumers are likely misled into believing that the Respondent’s website is operated by the Complainant itself or a company affiliated to the Complainant. The likelihood of confusion with the Complainant’s mark is clearly with the intention of attracting Internet users for commercial gain, since the purpose of the website connected to the disputed domain name <avastcenter.com> was to deceive Internet users into downloading illegitimate or fraudulent software. The fact that the disputed domain name currently does not resolve to an active webpage does not preclude the fact that the Respondent can at any time resume the previous bad faith use of the disputed domain name. This is also the case for the disputed domain name <avastio.com> which currently displays an English sentence comprising of the Complainant's trademark but which can at any time be used to further pursue bad faith conduct.

Furthermore, the Complainant has demonstrated that the Respondent has a history of bad faith registration of domain names incorporating the trademarks of the Complainant (see CAC Case No. 101568, where it was found that the Respondent acted in bad faith by seeking to create a false impression of association with the Complainant as to its AVAST trademark).
Additionally, by using a proxy registration service, the Respondent has taken active steps to conceal its identity (see Fifth Third Bancorp v. Secure Whois Information Service, WIPO Case No. D2006-0696, where it was held that the use of a proxy

registration service to avoid disclosing the identity of the real party in interest is also consistent with an inference of bad faith when combined with other evidence of evasive and irresponsible conduct).

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the disputed domain names were registered and are being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AVASTCENTER.COM**: Transferred
2. **AVASTIO.COM**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2018-06-06

Publish the Decision