Decision for dispute CAC-UDRP-102384

Case number	**CAC-UDRP-102384**
Time of filing	**2019-03-12 13:37:33**
Domain names	**avastmobilesecurity.com**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

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

Complainant representative

Organization	**Rudolf Leška, advokát**

Respondent

Name	**Milen Radumilo**

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has sufficiently established its right of the "AVAST" trademark. The Complainant 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 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.

Furthermore, it is the owner of, inter alia, the following trademarks all of which are registered also for software products:

- 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;

- registered Canadian word trademark avast! No. 1437959 for goods and services in the classes 9 with priority from May 12, 2009;

- registered Canadian word trademark AVAST No. 1357664 for goods and services in the classes 9 with priority from July 30, 2007;

- registered US figurative trademark no. 87236956 for goods and services in the classes 9, 42 with priority from November 15, 2016 and with registration date September 5, 2017;

- registered international figurative trademark no. 1376117 for goods and services in the classes 9, 42 (US application with designation for CO – DE – FR – IT – MX – RU) with registration date May 10, 2017;

- registered Indian national trademark avast! No. 1827321 for goods in class 9

FACTUAL BACKGROUND

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

Language of the proceeding

In accordance with the para. 11 of the Rules, the language of this proceeding shall be English. English is also the language of the Registration Agreement. The website under the domain name avastmobilesecurity.com is only in English version what indicates that the Respondent targets global audience and prefers communication in English.

Evidence: Registration agreement available on <opensrs.com>

The Complainant and his rights

The Complainant 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 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.

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- registered Indian national trademark avast! No. 1827321 for goods in class 9.

Evidence:

- Excerpt from WIPO evidence - registered international word mark AVAST! no. 1011270;
- Excerpt from WIPO evidence - registered international word mark AVAST no. 839439;
- EU certificate of registration no. 010253672;
- Excerpt from TTAB evidence – US mark No 87236956;
- Excerpt from Canadian trademark evidence –mark No 1437959;
- Excerpt from Canadian trademark evidence –mark No 1357664;
- Excerpt from WIPO evidence - registered mark no. 1376117;
- Excerpt from Register of India – mark no. 1827321.

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 Indian and Canadian national trademarks.

Evidence:

Extract from the Commercial register for the Complainant in Czech and English language;

Extract from the Commercial Register for the company Avast Software s.r.o. (Avast Software a.s.) in Czech and English language;

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 antivirus for mobile phones (see <www.avast.com>.

Evidence:

Printscreen of Complainant´s website – Avast Mobile Security.

This dispute concerns the domain name <www.avastmobilesecurity.com> created on January 30, 2019. It follows that the domain name was registered with the knowledge of older above mentioned trademarks of the Complainant. The Respondent uses the disputed domain name for advertising on a parking page comprised of pay-per-click links. Some links (which are shown after clicking on the content of the website) relate to the Complainant´s antivirus AVAST (some links refer to official website <avast.com>), some refers to competitor's products. As the content of the disputed domain name is changing in time it also contains an unrelated links. Moreover, sometimes the domain is redirected to official side of the Complainant avast.com (!). Nowadays, the disputed domain name is for sale.

Evidence: Printscreen of <www.avastmobilesecurity.com>

The domain name avastmobilesecurity.com is confusingly similar to the Complainant's family of AVAST trade and service marks (both statutory and common law) named above, the Respondent has no rights or legitimate interests in respect of the <avastmobilesecurity.com> domain name which has been registered and is being used in bad faith.

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 has no specific meaning in modern 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.

Evidence: Arcticle on best selling antivirus software evidencing Complainant's seventh rank globally <trendingtopmost.com>.

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 domain name registered by the Respondent <www.avastmobilesecurity.com> is confusingly similar to the Complainants ´ registered trademarks.

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 (Magnum Piercing, Inc. v D. Mudjackers and Garwood S. Wilson, Sr. WIPO Case No. D-2000-1525; Hugo Boss A.G. v. Abilio Castro, WIPO case No. DTV2000-0001; Radale Inc. v. Cass Foster, WIPO case No. DBIZ2002-00148. Carlsberg A/S v. Brand Live television, WIPO case NO. DTV-2008-0003).

"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 "-mobilesecurity" is descriptive in nature meaning providing security for mobile phones. This phrase "Avast Mobile Security" is used by the Complainant on its websites to which the disputed domain is redirected and describes the function of AVAST antivirus software. 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. Quite on the contrary, it makes the confusion more likely as it makes an impression that the website is operated by the Complainant.

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). Similarly, numerous prior panels have held that the fact that a domain name wholly incorporates a complaint´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. (e.g. EAuto, L.L.C. v. EAuto Parts, WIPO Case no. D2000-0096; Caterpillar Inc. v. Off Road Equipment Parts, WIPO Case no. FA0095497).

On balance, there is high presumption that ordinary consumers will believe that the domain name registered by the Respondent is owned by the Complainant and will access the website only due to its misleading character. This is even more true when the content under the disputed domain name is changing in time. When the Internet user is redirected to <avast.com> he/she will acquire an impression that the disputed domain is connected with the Complainant and can visit the disputed domain for the second time, but this time the disputed domain will contain pay-per-click advertisement relating to <avast.com> or competing products and the Respondent may increase his/her revenues from the advertisement because of this misleading character.

Moreover, the Respondent contributes to the confusion of the public by placing the trademark "AVAST" of the Complainant

on the websites available under disputed domain name presumably in order to abuse this very famous trademark in his favour and by illegally offering Complainant's copyrighted software AVAST for download (through pay-per-click-advertisement).

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.

Evidence:

Printscreen of avast.com (Complainant's webpage);

Printescreen of avastmobilesecurity.com (disputed domain name).

B. The respondent has no right or legitimate interests in respect of the 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 contested 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 trademark on every page of the disputed website 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 he has not provided the trademarked service but has used the trademark to bait Internet users and then switch them to his website in order to increase pay-per-click revenues (Nikon, Inc. v Technilab, WIPO Case no. D2000-1774). Moreover, the Respondent does not disclose its relationship with the Complainant as the disputed domain name does not contains any disclaimer nor the Respondent reveals his/her true identity (Oki Data Americans, Inc. v. ASD, Inc., WIPO case no. D2001-0903).

In similar CAC case no. 101760 the Panel held that respondent's use of the disputed domain name in connection with a pay-per-click website with sponsored links expressly referring to the Complainant's trademark and products does not amount to a bona fide offering of goods or services or to a legitimate non-commercial or fair use. As follows from the attached printscreens the sponsored links placed under the disputed domain name expressly refers to AVAST trademark.

Evidence:

Decision no. 101760.

As discussed in section 2.9 of the WIPO Overview 3.0 applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users.

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 (Carrefour v Whois Agent, Whois Privacy Protection Service Inc. / Andres Saavedra, WIPO Case no. D2016-0608).

C. The 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 domain name as follows from the Respondent´s explicit references on his website to the Claimant's trademark, AVAST Antivirus software and

to official site of the Complainant <avast.com> (to which the disputed domain is sometimes redirected).

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 (see par. 3.1.3 of WIPO Overview 3.0). In previous case the Panel held that AVAST trademarks are well-known, enjoy good reputation in their field and that when making a search on the name “avast” in Google, all results refer to the Complainant. (CAC case no. 101909).

Evidence:

Decision no. 101909.

It is assumed that the Respondent included the Complainant´s trademark into disputed domain name only due to well known character of “AVAST” trademark, because he/she presumed that by this unauthorised use of trademark the Complainant´s customers will be brought to the disputed domain and his/her pay-per-click revenues will increase (and the value of the domain which is for sale will rise). The Respondent´s only intention must be to enrich himself/herself to the detriment of the Complainant. It is important to point out that there is not any rational reason (other than to abuse the Complainant´s trademark) for using Complaint´s trademark in disputed domain name as its content (pay-per-click advertising) is changing in time. Sometimes the domain contains the links relating to AVAST software, including links where the Internet user can download the Complainant´s software illegally, but many times links relate to competitive products such as software ESET, NORTON etc., or do not relate to antiviruses at all. It follows that under the disputed domain name (and thus under the Complainant´s trademark) the Responded promotes competitive products to AVAST software and thus intentionally damages the Complainant. As stated in the section 3.5 of the WIPO Overview 3: “Particularly with respect to “automatically” generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name.”

The conclusion of the Respondent´s bad faith can be supported by the fact that the disputed domain was connected with Facebook account <facebook.com> which was recently at the request of the Complainant blocked by Facebook due to trademark and copyright infringement. This Facebook account contained Complainant´s well-known logo without Complainant´s consent and was probably used to offer relating support under provided telephone number.

Evidence:

Printscreen of Facebook account Avast Mobile Security.

The Respondent uses the Complainant´s trademark solely for the commercial gain (to increase revenues from advertising, to sell the domain to third party) 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. The circumstances indicate that the Respondent is using the domain name in a way which has confused or is likely to confuse people or business into believing that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

Furthermore, the use of a proxy server by the true owner hidden behind the Respondent is markedly corroborate a finding of bad faith (Carrefour v Whois Agent, Whois Privacy Protection Service Inc. / Andres Saavedra, WIPO Case no. D2016-0608).

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

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

1. Identical or confusingly similar

The Complainant contends that the disputed domain name <www.avastmobilesecurity.com> is confusingly similar to the Complainant's highly distinctive trademark AVAST. The disputed domain name incorporates in full the AVAST trademark, which has no other meanings in modern English, and is followed by the descriptive word "mobilesecurity". Since AVAST is in the industry of selling antivirus software, the added description "mobilesecurity" suggests some link to AVAST's main business areas, and is likely to cause consumer confusion that the disputed domain name is related to the brand of the Complainant's. Moreover, the Complainant also suggested that the phrase "Avast Mobile Security" is already used in advertising its own brand, and therefore the additional part not only did not eliminate the confusing similarity, but has made the additional impression that the website is linked to the Complainant's established brand. Moreover, the Respondent contributed to the confusion by placing the Complainant's trademark "AVAST" on its website, giving an ordinary consumer visiting the Respondent's website the impression that the website is associated with the Complainant's brand.

Like the Complainant suggests, 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. Usually, a domain name wholly incorporates a complainant's registered trademark is already sufficient to establish identify or confusing similarity within the meaning of the Policy, and the Complainant has cited numerous cases to buttress its argument.

The Panel therefore concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. No rights or legitimate interests

Although the Respondent did not file an administratively compliant (or any) response, the Complainant is still required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant contends that no evidence suggests that the Respondent has been known in any way by the disputed domain name or by the distinctive part "AVAST". The Complainant did not grant any license or authorization to the Respondent to register or use the disputed domain name, nor the use of the Complainant's trademark on every page of the disputed website. Before the dispute, the Respondent also has not used the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services.

On the basis of preponderance of evidence, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

3. Bad faith

By trying to establish the bad faith element of paragraph 4(a) of the Policy, the Complainant has primarily attempted to rely on paragraph 4(b)(i) and 4(b)(iv) of the Policy.

As contended by the Complainant, it is true that UDRP Panels have consistently held that the mere registration of a domain name that is confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. However, many instances here have collectively pointed to the conclusion in this case that the disputed domain name has been registered and used in the way attempting to attract for commercial gains by creating a likelihood of confusion with the complainant's trademark. The Respondent never had bona fide business establishments related to the contents of its website. Moreover, it listed the Complainant's well-known trademark on its website without the authorization of the complainant, attempting to derive potential parking traffic for its own website. The Respondent has further established a Facebook account that contains the Complainant's mark without the Complainant's prior authorization.

In addition, as the Complainant as readily pointed out, there could not be any rational reason for the Respondent using the Complainant's trademark as the contents of its website is constantly changing, "sometimes the domain contains the links relating to AVAST software, including links where the internet user can download the Complainant's software illegally", "but many times links relate to competitive products."

Many instances have collected point to the conclusion that the domain name has been registered and is being used in bad faith. Like the Complainant contended here, the Respondent was clearly aware of the existence of the Complainant's brand at the time of registering the domain name, has no bona fide business establishments related to the contents of the website, tries to use the Complainant's readily established trademark to derive parking traffic for its own website, etc.

Therefore, in the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel determines that the disputed domain name was registered and is being used in bad faith within the meaning of 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. **AVASTMOBILESECURITY.COM**: Transferred

PANELLISTS

Name	**Carrie Shang**

DATE OF PANEL DECISION 2019-04-19

Publish the Decision