Decision for dispute CAC-UDRP-102383

Case number	**CAC-UDRP-102383**
Time of filing	**2019-03-12 13:39:29**
Domain names	**avgretail.net**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

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

Complainant representative

Organization	**Rudolf Leška, advokát**

Respondent

Organization	**avgretailnet**

OTHER LEGAL PROCEEDINGS

The Panel is unaware of other pending or decided proceedings pertaining to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of, inter alia, the following trademarks all of which are registered also for consultancy in the area of software, installation, maintenance of software:
- registered international word mark “AVG” no. 930231 for goods and services in the classes 9 (software), 37 (repair and maintenance of computer) and 42 (consultancy in the area of software and hardware, installation, updating, renewal and maintenance of computer software), based on a Czech application with designation for AU, JP, KR, NO, SG, TR and by virtue of Article 9sexies of the Madrid Protocol also for CH, CN, HR, ME, RS, UA, with registration date February 2, 2007;
- registered international figurative mark (black and white logo) no. 945555 for goods and services in the classes 9 (software), 16 and 42 (consultancy in the area of software and hardware, installation updating, renewal and maintenance of computer software) based on a Czech application with designation for AU, KR, NO, SG, TR and by virtue of Article 9sexies of the Madrid Protocol also for CH, CN, HR, ME, RS, UA with registration date August 1, 2007;
- registered EU word mark “AVG” no. 013174875 for goods and services in the class 9 (software) and 42 (use of computer software for security) with priority from August 14, 2014;
- registered EU word mark “AVG” no. 3893716 for goods and services in the class 9 (software) with priority from July 24, 2006;
- registered EU figurative mark (black and white logo) no. 5484431 for goods and services in the class 9 (software), 16 and

42 (consultancy in the area of software and hardware, installation updating, renewal and maintenance of computer software) with priority from November 20, 2006;
-registered EU figurative mark (black and white logo) no. 3957313 for goods and services in the class 9 (software), 16 and 42 (consultancy in the area of software and hardware, installation updating, renewal and maintenance of computer software) with priority from August 3, 2004;
- registered U.S. word mark no. 3122712 for goods and services in the class 9 (computer software and programs for security protection) with priority from September 14, 2014;
- registered U.S. figurative mark (black and white logo) no. 3629247 for goods and services in the class 9 (computer software programs for computer antivirus protection) and 42 (technical consultancy in the field of software and computer hardware, computer software installation).

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 which is available at the registrar's website. Furthermore, the website under the domain name avgretail.net is only in English version what indicates that the Respondent targets global audience and prefers communication in English.

The Complainant and his rights

The Complainant provides to its customers one of the most famous and effective antimalware security suite (antivirus software) from 1991. The Complainant is well known on the market globally as a reliable company with long history, as a security pioneer offering a wide range of protection, performance and privacy solutions for customers and businesses. Its popularity on the market and high quality is supported by the fact that AVG antivirus surpassed 200 million users worldwide and acquired more than 20 awards from independent industry comparative tests, such as PC Mag Editors Choice, Top Product-AV-Test or Top Product – Corporate Endpoint Protection.
Furthermore, it is the owner of, inter alia, the following trademarks all of which are registered also for consultancy in the area of software, installation, maintenance of software and cover the territory of China:
- registered international word mark "AVG" no. 930231 for goods and services in the classes 9 (software), 37 (repair and maintenance of computer) and 42 (consultancy in the area of software and hardware, installation, updating, renewal and maintenance of computer software), Czech application with designation for AU, JP, KR, NO, SG, TR and by virtue of Article 9sexies of the Madrid Protocol also for CH, CN, HR, ME, RS, UA, with registration date February 2, 2007;
- registered international figurative mark (black and white logo) no. 945555 for goods and services in the classes 9 (software), 16 and 42 (consultancy in the area of software and hardware, installation updating, renewal and maintenance of computer software) Czech application with designation for AU, KR, NO, SG, TR and by virtue of Article 9sexies of the Madrid Protocol also for CH, CN, HR, ME, RS, UA with registration date August 1, 2007;
- registered EU word mark "AVG" no. 013174875 for goods and services in the class 9 (software) and 42 (use of computer software for security) with priority from August 14, 2014;
- registered EU word mark "AVG" no. 3893716 for goods and services in the class 9 (software) with priority from July 24, 2006;
- registered EU figurative mark (black and white logo) no. 5484431 for goods and services in the class 9 (software), 16 and 42 (consultancy in the area of software and hardware, installation updating, renewal and maintenance of computer software) with priority from November 20, 2006;
-registered EU figurative mark (black and white logo) no. 3957313 for goods and services in the class 9 (software), 16 and 42 (consultancy in the area of software and hardware, installation updating, renewal and maintenance of computer software) with priority from August 3, 2004;
- registered U.S. word mark no. 3122712 for goods and services in the class 9 (computer software and programs for security protection) with priority from September 14, 2014;
- registered U.S. figurative mark (black and white logo) no. 3629247 for goods and services in the class 9 (computer

software programs for computer antivirus protection) and 42 (technical consultancy in the field of software and computer hardware, computer software installation).
Avast Software B.V. is a legal successor of the company AVG Netherlands B.V. By virtue of law, rights and obligations of AVG Netherlands B.V. passed on its successor. The rights to intellectual property, including the mentioned trademarks, were assigned by Avast Software B.V. to the Complainant by the agreement of May 2, 2018. Therefore, it is not an obstacle to this Complainant that the Complainant has not yet been registered as an owner of the international and EU trademarks (US trademarks are yet registered under the Complainant).
The Complainant distributes its antivirus i.a. via its website www.avg.com (registered from November 1, 1994) where a customer can find product information and can directly download AVG antivirus. Through this website, the Complainant also provide support to its customers in case they need any help regarding the antivirus.

This dispute concerns the domain name www.avgretail.net registered by the Respondent on February 10, 2016. It follows that the 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 competing paid service regarding the Complainant's antivirus to the Complainants customers, as expressly stated on the Respondent´s website: "AVG Retail Help – Step by Step guide for AVG Activate, Download & complete installation from www.avg.com/retail online. We are providing independent support service if in case you face problem to activate or install AVG product. Just fill the form above and will get in touch with you as quick as possible."

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

A. The domain name is confusingly similar to the Complainant´s trademarks

Word AVG is at the core of Complainant's family of marks. It has no generic meaning in common English or in any other language. The Complainant's trademarks are thus highly distinctive and the AVG trademark is a globally known brand with reputation as the Complainant belongs to the antivirus software market leaders according to the respected OPSWAT Report.

Based on a large number of the users of the Complainant´s antivirus, it can be assumed that the word AVG is automatically associated with the Complainant by an ordinary customer and Internet user.

The domain name registered by the Respondent www.avgretail.net is confusingly similar to the Complainant´s 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).

The Complainant´s mark "AVG" is entirely reproduced in the disputed domain name. From the perspective of the average customer, "AVG" 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 "-retail" is descriptive in nature. It consists of one generic term meaning sale or trade. This phrase is very often used by any producer of products or provider of services in order to offer for sell or provide services. 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 more true in a situation where Complainant itself provide customer support and retail directly on its official website www.avg.com (as well as under avg.com/retail) to which the Respondent refers many times under the disputed domain name. This word in conjunction with the well-known AVG brand of anti-virus software could not possibly be taken by an internet user to mean anything other than support and sale regarding AVG software. This must strengthen in the mind of the internet user the notion that the disputed domain name is an official domain name of AVG and that it is in effect an offer by Complainant to provide paid support for its AVG anti-virus

software, which of course must have been the intention of the Respondent.
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 an ordinary consumer will believe that the domain name registered by the Respondent is owned by the Complainant or its partner and will access the website only due to its misleading character assuming that the support is provided directly by the Complainant or alternatively by its official partners.
Moreover, the Respondent contributes to the confusion of the public by placing the Complainant´s domain name " WWW.AVG.COM/RETAIL" on the top of disputed domain in big letters and by copying the graphical design of main page of Complainant´s official domain avg.com as is evident from the attached printscreens.
Thus, there can be no question but that the disputed domain name is confusingly similar to the Complainant´s family of marks "AVG" for purposes of the Policy.

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 "AVG" 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.

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 competing service (Nikon, Inc. v Technilab, WIPO Case no. D2000-1774). Moreover, the Respondent does not accurately disclose its relationship with the Complainant (Oki Data Americans, Inc. v. ASD, Inc., WIPO case no. D2001-0903). The relationship with the Complainant is only indicated in the disclaimer placed at the very bottom of the pages in small grey letters stating that: "Avgretail.net is an independent support provider on On-Demand Remote Technical Services for AVG products. We are an independent service provider for software related issues in desktops, laptops, devices and peripherals. Use of AVG Name, logo, trademarks & Product Images is only for reference and in no way intended to suggest that avgretail.net has any business association with AVG. AVG trademarks, Names, logo and Images are the property of their respective owners. We holds no association or affiliation with any of these brands or third-party companies and solely provide support service for the product issues faced by users. If Your Product is under Warranty, you may get free service/support from the brand owners." Such disclaimer will barely get into attention of average Internet users. The average Internet user will not notice the disclaimer as it is situated at the bottom of the page. Average Internet user usually not read and analyse all content of 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 (Thirty & Co. v. Jake Marcum, Marcum Creative, LLC, WIPO Case no. D2016-1212). The disclaimer is not effective as it comes after a full page of marketing where the "AVG" appears many times and is placed under the form and telephone number for ordering Respondent's service (and is not perceptible immediately by the public (Dr. Ing. h.c. F. Porsche AG v. Sabatino Andreoni, WIPO Case No. D2003-0224; Pliva, Inc. v. Eric Kaiser, WIPO Case No. D2003-0316; DRS Number 02801 Parties The Emigration Group Limited v Sanwar Ali). In such a case the existence of the disclaimer cannot by itself cure the lack of bona fide (Thirty & Co. v. Jake Marcum, Marcum Creative, LLC, WIPO Case no. D2016-1212). It is worth pointing out that it is only by unauthorised use of the trademark that the potential customer is brought to the website (containing the disclaimer) in the first place.

Furthermore, bona fide use cannot be found in this case as the Respondent misleadingly creates the impression that the services offered on the website are provided by the Complainant by reference to the official website of the Complainant avg.com/retail. This directly proves that the Respondent was aware of Complainant´s website, the trademarks as well as its

popularity and good reputation when creating the disputed domain name. The Respondent is thus trying to make money by trading on the Complainant's good name and brand.

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).

The Complainant points out the recent case no. 101661 (Avast Software B.V. in the matter of the dispute domain name avgcustomersupport.com) with similar facts in which the Panel held that the disputed domain name was registered with intention to obtain financial advantage from the similarity between the disputed domain name and complainant´s trademark as the disputed domain name does currently resolve to a commercial website offering services in connection with the complaint´s products. This domain name was transferred to the Complainant. Similarly, in the case no. 102208 (Avast Software s.r.o. in the matter of the dispute domain name avgsupporttech.com), and Forum case no. FA1901001823512 regarding the domain avg-retail.us.

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 official Claimant's website and AVG trademark. 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 (Thirty & Co. v. Jake Marcum, Marcum Creative, LLC, WIPO Case no. D2016-1212).

It is important to point out that the Respondent states under the disputed domain name instead reference to its domain avgretail.net a reference to avg.com/retail which is real and official website of the Complainant, clearly to support conviction of internet user that is using official websites of the Complainant and thus evoke impression that provided service is safe, professional and under the control of the Complainant.

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). As indicated in the case Avast Software s.r.o. v Waseem Shafi CAC case no. 101661, the Complainant´s AVG trademark is deemed well known and highly distinctive.

Furthermore, the disputed domain name is used by the Respondent to reach the Complainant´s customers and offer them the identical or very similar 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 placement of the Complainant´s trademark on every page of disputed domain name and by using similar graphic design (including green colour) of official website of the Complainant (after clicking on green button "get started" graphically similar website will appear). The confusion is even more true when domain avg.com/retail is in real managed by the Complainant. The official partners of the Complainant with the right to provide official support to the customers are clearly specified by the Complainant on its website and Respondent does not belong to them. The Respondent is not related in any way to the Complainant´s business. 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. By the exploitation of the Complainant´s trademark the Respondent gains the profit (the service provided under the disputed domain name is paid) and as such causes significant damage to the Complainant.

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

PRINCIPAL REASONS FOR THE DECISION

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

(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.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The Disputed domain name is confusingly similar to the Complainant’s trademarks. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of

a) disregarding the top-level suffix in the domain name (i.e. “.net”), and

b) not finding that the addition of a generic word (such as “RETAIL”) would be sufficient to distinguish a domain name from a trademark.

Therefore, the Panel comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the UDRP.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

The Complainant has put forward that the Respondent is not commonly known by the disputed domain name other than for the purpose of registering the disputed domain name. Neither is the Respondent in any way related to the Complainant. Nor has the Respondent been granted an authorization or license to use the disputed domain name by the Complainant. This has not been contested by the Respondent. Instead, the Respondent has failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

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

In the recent decision in case no. 101661 (Avast Software B.V. in the matter of avgcustomersupport.com), the Panel held that the disputed domain name was registered with intention to obtain financial advantage from the similarity between the disputed domain name and that the Complainant´s trademark as the disputed domain name resolved to a commercial website offering services in connection with the Complainant´s products. This domain name was transferred to the Complainant, as was the domain name in case no. 102208 (Avast Software s.r.o. in the matter of avgsupporttech.com), and Forum case no. FA1901001823512 regarding the domain name avg-retail.us.

The Panel concludes that the Respondent did not establish any right or legitimate interest to the Disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith. For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations for use, of either the disputed domain name in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the disputed domain name. The Respondent is also in no way commonly known under the disputed domain name other than for the purpose of registering the domain name. The information provided by the Respondent in connection with the registration of the domain name is incomplete and misleading as the name consists only of the domain name including the top level gTLD.

There is no indication that the disputed domain name was registered and is being used in a bona fide manner. The Respondent must have been aware of the registration and the use of the Complainant´s trademarks before the registration of the domain name as is shown by the Respondent´s explicit references on his website to the official Complainant’s website and AVG trademark. Rather than curtail customers´ confusion, the barely noticeable disclaimer at the bottom of the Respondent's website merely confirms the Respondent´s knowledge and bad faith disregard of Complainant’s rights (see e.g. the decision in WIPO Case no. D2016-1212: Thirty & Co. v. Jake Marcum, Marcum Creative, LLC).

The Respondent actually makes reference to avg.com/retail which is the official website of the Complainant. This is clearly intended to suggest to internet users that they are using official websites of the Complainant and thus to evoke the impression that the provided service is safe, professional and under the control of the Complainant.

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). As indicated in the case Avast Software s.r.o. v Waseem Shafi, CAC case no. 101661, the Complainant´s AVG trademark is deemed well known and highly distinctive.

Given the reputation of the Complainant and its trademarks as held in the above cited case, the Panel must conclude that the Respondent was fully aware of the Complainant's trademarks "AVG" at the time of registering the disputed domain name <AVGRETAIL.NET>. Therefore, it has been established to the satisfaction of the Panel that the disputed domain name was registered and is being used in bad faith, in order to prevent the Complainant from making proper use of the mark in the disputed domain name.

Therefore, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement 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. **AVGRETAIL.NET**: Transferred

PANELLISTS

Name	**Udo Pfleghar**

DATE OF PANEL DECISION 2019-07-16

Publish the Decision