Decision for dispute CAC-UDRP-102947

Case number	**CAC-UDRP-102947**
Time of filing	**2020-03-02 11:27:36**
Domain names	**avg-avg.com**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

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

Complainant representative

Organization	**Rudolf Leška, advokát**

Respondent

Name	**Tarun Upadhyay**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns the following trademarks:

- 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).

The disputed domain name was registered by the Respondent on 12 September 2019

FACTUAL BACKGROUND

As the Respondent did not file any response to the complaint, the Panel took into account the following facts asserted by the Complainant (and supported by the documentary evidence submitted by the Complainant) and unchallenged by the Respondent:

(a) 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.

(b) 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 Complainant's Trademarks, were assigned by Avast Software B.V. to the Complainant by the agreement of 2 May 2018.

(c) The Complainant distributes its antivirus i.a. via its website www.avg.com (registered from 1 November 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.

(d) The website under the disputed domain name is used by the Respondent to offer competing paid service (online customer support) regarding the Complainant’s antivirus to the Complainants customers, as expressly stated on the Respondent´s website: “In terms of complete support for AVG antivirus downloading & installing or any updated, we provide one of the best support to our customers.”

PARTIES CONTENTIONS

THE COMPLAINANT:

In addition to the above factual assertions, the Complainant also contends the following:

(a) Denomination AVG is at the core of Complainant’s Trademarks. It has no generic meaning in common English or in any other language. The Complainant’s Trademarks are thus highly distinctive. The disputed domain name is identical to this distinctive element of Complainant's Trademarks and its repetition in the disputed domain name does not eliminate the confusing similarity with the older trademarks of the Complainant. Moreover, the Respondent contributes to the confusion of the public by placing the trademark “AVG” and well-known logo (also registered as Complainant´s trademark) on the website available under disputed domain name and by imitating trade dress of the Complainant.

(b) 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 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 and logo under the disputed website in the absence of Complainant’s authorization represents illegal unauthorized conduct of the Respondent which cannot be protected.

(c) 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. Moreover, the Respondent does not accurately disclose its relationship with the Complainant. The relationship with the Complainant is only indicated in very general terms at the very bottom of the page and certainly does not meet the requirements of the so called Oki Data test (Oki Data Americans, Inc. v. ASD, Inc., WIPO case no. D2001-0903). Therefore, the Respondent has no legitimate interest in the disputed domain name.

(d) There is no indication that the disputed domain name was registered and is used in good faith. The Respondent was clearly aware of the registration and the use of the well known Complainant´s Trademarks before the registration of the domain name as follows from the Respondent´s explicit references on his website to the AVG trademark and AVG logo. 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.

(e) Furthermore, 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 official 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 AVG (as well as logo) on every page of disputed domain name. The Respondent uses the Complainant´s Trademarks 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. Therefore, the disputed domain name has been registered and is being used by the Respondent in bad faith.

THE RESPONDENT:

The Respondent did not provide any response to the complaint.

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).

For details, please see "Principal Reasons for the Decision".

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).

For details, please see "Principal Reasons for the Decision".

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).

For details, please see "Principal Reasons for the Decision".

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

Paragraph 4(a) of the Policy requires that the Complainant proves each of the following three elements to obtain an order that the disputed domain name should be transferred or revoked:

(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 will proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in these proceedings.

RIGHTS

The disputed domain name is confusingly similar to Complainant’s Trademarks. It contains the distinctive element of Complainant's Trademarks "AVG" which is repeated and separated by a dash (avg-avg.com).

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the identity / confusing similarity test as it is a necessary technical requirement of registration.

Therefore, the Panel concludes that the Complainant satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTEREST

The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, a respondent carries the burden of demonstrating rights or legitimate interests in a domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (please see, for example, WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

The website under the disputed domain name purports to offer support services for the AVG antivirus product of the Complainant. However, the Panel is not entirely convinced that there is a bona fide offering of such services by the Respondent. The content of the website is very general, there is no detailed specification of the offered services or any price information, it only emphasises that the prospective customers should call a toll free number to obtain such services. Privacy Policy and Terms and Conditions of the website are also very general and do not make very much sense. In such situation the Panel finds more likely that there is actually no genuine offering of goods or services on such website.

Even if there was some genuine offering of services on the website operated under disputed domain name, it would establish Respondent's legitimate interest to the disputed domain name only under certain conditions, which are outlined in the so called Oki-Data test (please see WIPO Case No. D2001-0903 Oki Data Americas, Inc. v. ASD, Inc., <okidataparts.com>). The website under the disputed domain name would have to:

(i) actually be offering the goods or services at issue;

(ii) sell only the goods or services marked by Complainant's Trademarks;

(iii) accurately and prominently disclose the Respondent's relationship with the Complainant; and

(iv) not “corner the market” in domain names that reflect Complainant's Trademarks.

It is apparent that the website under the disputed domain name fails in particular on paragraph (iii) above, as there is no accurate and prominent disclosure of the relationship of the Respondent to the Complainant. The disclaimer at the website is very general and apparently insufficient for this purpose.

Therefore, the Panel finds that the Respondent has no rights or legitimate interest to the disputed domain name.

BAD FAITH

The Panel concurs with the Complainant that the Respondent has registered the disputed domain name in full knowledge of Complaiant's Trademarks as the reference to the AVG antivirus product of the Complainant is clearly made at the website under the disputed domain name. As stated above, the Panel is not entirely convinced that there is genuine offering of services at the website under the disputed domain name. In such case, the disputed domain name was registered by the Respondent for no apparent reason. The Panel agrees that the Complainant's Trademarks are well-known as it was already established in CAC Cases no. 101661 and 102383 referred to by the Complainant. Registration of the disputed domain name corresponding to well-known trademark without authorization of the Complainant is in itself indication of bad faith of the Respondent (please see WIPO Jurisprudential Overview 3.0, Section 3.1.4).

If the services offered under the disputed domain name are genuine, the Respondent did not accurately and predominantly disclose its relationship to the Complainant and therefore failed to prevent likelihood of false association of the website under the disputed domain name with the Complainant. As a result, the Respondent uses the Complainant´s Trademarks for the commercial gain to misleadingly divert the Complainant´s consumers to the services of the Respondent by creating the likelihood of confusion with the Complainant´s Trademarks. By such unauthorized exploitation of the Complainant´s Trademark the Respondent gains the unjustified benefit which would otherwise not have been gained.

For such reasons the Panel concluded that the disputed domain name has been registered and is 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. **AVG-AVG.COM**: Transferred

PANELLISTS

Name	**Michal Matějka**

DATE OF PANEL DECISION 2020-03-29

Publish the Decision