Decision for dispute CAC-UDRP-102946

Case number	**CAC-UDRP-102946**
Time of filing	**2020-03-02 10:37:09**
Domain names	**avast-avast.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	**Aurn Negi**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided proceedings which relate to the disputed domain name.

IDENTIFICATION OF 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.

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 US word trademark no. 85378515 for goods and services in the classes 9 with priority from July 22, 2011 and with registration date July 17, 2012;

- 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; and

- registered Indian national trademark avast! No. 1827321 for goods in class 9 with priority date June 9, 2009.

FACTUAL BACKGROUND

This dispute concerns the domain name <avast-avast.com> created on October 12, 2018.

It follows that the disputed domain name was registered with the knowledge of 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. As expressly stated by the Respondent: “We Provide complete support for Avast antivirus installation, uninstallation and updates.”

According to Complainant, the disputed domain name should be transferred back as it resolves in an unauthorized and speculative use of the well-know AVAST earlier trademark rights.

On July 6, 2020 the CAC notified the Respondent's default.

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

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

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to the Complainant's trademarks (within the meaning of paragraph 4(a)(i) of the Policy). In particular, the Panel finds that the disputed domain name includes the trademark in its entirety, without any addition or deletion.

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). Respondent's default in submitting any of the theoretically possible rebuttal of Complainant's detailed prima facie submissions leaves the Panel uncomfortable in finding possible justifications for Respondent's fair use of the disputed domain names.

Notwithstanding the disclaimer in Respondent's website states "Company Disclaimer: AvastCom Support is an independent technical support service for software. We are unique as we have expertise in products from a wide variety of third-party companies. Any use of Trademarks, Brands, Products and Services is referential and AvastCom Supprot. has no affiliation with any of these third-party companies. The service we offer is also available on the website of the brand owners", it is the Panel belief the disputed domain name may not be considered genuinely noncommercial, and clearly distinct from Complainant's services and websites. This is particularly the case where Complainant's trademarks are intensively used without any additional/differentiating element (either in the domain name as well as in the website, reproducing the trademark) and the services are likely to overlap with Complainant's professional services covered by the trademarks registrations and offered in addition to the classical free version of the famous antivirus software platform. For such reasons, it is the Panel's belief the disputed domain names is more likely to "corner the market" in domain names that reflect the (well-known) trademark, according to last element of OKI DATA test Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903), as already state by previous panels in CAC decisions No. 101909 and 101917 (avastcustomersupport.com).

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). The disputed domain name resolves in a duplication of the famous AVAST trademark, prominently displayed in the website purportedly used in conjunction with Complainant's trademarked services.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AVAST-AVAST.COM**: Transferred

PANELLISTS

Name	**Roberto Manno**

DATE OF PANEL DECISION 2020-07-06

Publish the Decision