Decision for dispute CAC-UDRP-103044

Case number	CAC-UDRP-103044
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Domain names	avast-a-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	sysco

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has evidenced to be the owner of the following trademark registrations with protection for many countries worldwide:

- Word mark AVAST, World Intellectual Property Office (WIPO), registration No.: 839439, registration date: June 22, 2004, status: active;

- Word mark AVAST, European Union Intellectual Property Office (EUIPO), registration No.: 010253672, registration date: August 25, 2011, status: active.

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 on the website www.eranet.com. The website under the domain name avast-a-avast.com is only in English version what indicates that the Respondent targets global audience and prefers communication in English.

Evidence: Registration agreement

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.

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

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 software. On this official website (under https://support.avast.com) the Complainant also offers customer support relating to AVAST software.

This dispute concerns the domain name www.avast-a-avast.com created on September 5, 2019. It follows that the 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.”

The domain name avast-a-avast.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 avast-a-avast.com 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 “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.

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 complainant (presenting AVAST) has more than 4 million of followers on Facebook and about 174,000 followers on Twitter. The Complainant´s website avast.com was during 6 months visited by approximately 13,3 million of Internet users.

The domain name registered by the Respondent www.avast-a-avast.com 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 disputed domain name registered by the Respondent is confusingly similar to Complainant´s trademarks “AVAST”. It contains Complainant´s trademark “AVAST” which is repeated and separated by a letter “a” surrounded by dashes (avast-a-avast.com). “AVAST” is the distinctive part in the disputed domain name. It is the first and the last dominant part to which an attention of the public is concentrated. Furthermore, such disputed domain name makes an impression that the website is operated by the Complainant with the intention to provide support to its own customers. It is almost inevitable that when consumers access the website avast-a-avast.com, they will think that they are accessing a website affiliated with the Complainant.

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 assuming that certified AVAST support is provided directly by the Complainant or with its authorisation.

Moreover, the Respondent contributes to the confusion of the public by placing the trademark “AVAST” and well-known logo (also registered as Complainant´s trademark) on the websites available under disputed domain name and by imitating trade dress of the Complainant (Respondent uses orange colour which is very typical for the Complainant and its AVAST product) presumably in order to abuse this very famous trademark, logo and Complainant´s good reputation in his favour.

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.

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” 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 logo and trademark under the disputed domain name in the absence of Complainant’s authorization represents illegal unauthorized conduct of the Respondent (copyright and trademark infringement). The Panel in similar CAC case no. 101568 Avast Software s.r.o. vs. Victor Chernyshov noted that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent (as stated in par. 2.13.1 of the WIPO Overview 3.0).

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).

Respondent intentionally tries to make impression of cooperation with the Complainant. The Respondent placed the Complainant´s trademark and logo on every page of the website and mimics trade dress of the Complainant using orange colour.

The relationship with the Complainant is only indicated in the disclaimer placed at the very bottom of the pages in small (hardly visible and readable) letters stating that: “avast-a-avast.com 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 avast-a-avast.com has no affiliation with any of these third-party companies. The service we offer is also available on the website of the brand owners. “ However, such disclaimer might not be entirely legible for the average Internet users and will barely get into their attention given that it is depicted at the bottom of the website. The average Internet user will not notice the disclaimer as it usually not read and analyse every page before contacting the Respondent and ordering the service. The disclaimer is not effective as it comes after a full page of marketing where "AVAST" appears many times and is placed far below the place where telephone number to order Respondent's service is depicted (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. Moreover, the use of the logo usually excludes any possibility of bona fide reference to Complainant’s services (in case of bona fide nominative fair use of a trademark, only textual reference is usually acceptable).

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).

Under the Policy, a complainant may make out a prima facie case that the respondent lacks rights or legitimate interests in the domain name at issue. Once such a 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 may be deemed to have satisfied paragraph 4(a)(ii) of the Policy.

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 its website to the Complainant’s trademark, AVAST Antivirus software and logo.

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 cases 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. (see CAC case no. 101909 and CAC case no 101917).

Complainant´s trademarks have considerable reputation in software sector. The Complainant and its trademark have also considerable exposure and presence in the Internet through tents of domains including the word AVAST, such as avast.com, avast.io, avastmobilesecurity.com, avastsupport.com. In this day and age of the Internet and advancement in information technology, the reputation of brands and trademarks can transcend national borders. A simple search on the Internet would reveal the presence of the Complainant’s trademark and domain names. Therefore, it is not conceivable that the Respondent would not have had actual notice of the Complainant’s trademark rights at the time of the registration of the disputed domain name (similarly in WIPO case no. D2012-0583). When entering the term “avast“ into the Google search engine, the returned results point to Complainant and its business activities (see attached printscreen from Google search for the word “avast”). Respondent could easily perform a similar search before registering the disputed domain names. He would then quickly have learned that Complainants own the AVAST trademark, and that Complainant has been using it globally. The registration of the disputed domain names seeks to take advantage of an association with the businesses of Complainant and its trademark. This socalled wilful blindness constitutes bad faith.

Furthermore, the disputed domain name is used by the Respondent to reach the Complainant´s customers and offer them the identical (and therefore competing) 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 Respondent´s statement on the website that the service is provided by the “specialists” what in the context of the disputed website and used logo gives misleading impression that the Respondent is certified by Complainant to provide the service. The quality of the service provided by the Respondent is not under the Complainant´s control and therefore such service can very easily harm good reputation built by the Complainant for years. It follows that under the Complainant´s trademark the Responded promotes competitive service and thus intentionally damages the Complainant.

The Respondent did not accurately and predominantly disclose its relationship with the Complainant and therefore failed to prevent likelihood of false association of the website under the disputed domain name with the Complainant.

The Complainant assumes that the respondent is engaged in a pattern of trademark-abusive domain name registrations (pattern of bad faith conduct). The Complainant filed a complaint before CAC under no. 102946 regarding the disputed domain name avast-avast.com which contains the identical content as the disputed domain name in question and states the same contact information regarding the provider of the customer support (identical address: Shady Lake Dr. 102Q Streetsboro, Ohio 44241, United States). The case no. 102946 has not yet been decided.

Factors finding in favour of the conclusion that the domain name has been registered and is being used in bad faith are mainly similarity between the Complainant’s official web site and the web site under the disputed domain name (in particular, use of trade dress of the Complainant), the content of the website, including references to Complainant’s trademark, AVAST software, AVAST logo and reputation of the Complainant which prove clear indication that the Respondent was aware of Complainant, its business and marks (see e.g. CAC Case No. 100837 and CAC Case No. 101022).

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. 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 service by the true owner hidden behind the Respondent is often by itself an indicator of bad faith.

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 Panel finds that the disputed domain name is confusingly similar to the AVAST trademark in which the Complainant has rights. The disputed domain name incorporates the AVAST trademark in its entirety and does so even twice. Numerous UDRP panels have recognized that incorporating a trademark in its entirety can be sufficient to establish that the disputed domain name is at least confusingly similar to a registered trademark.

Therefore, the Complainant has established the first element under the Policy as set forth by paragraph 4(a)(i).

Moreover, the Complainant contends, and the Respondent has not objected to these contentions, that the Respondent has neither made use, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain name, nor is the Respondent commonly known thereunder. The Respondent has not been licensed or otherwise authorized to use the Complainant's AVAST trademark, either as a domain name or in any other way. Also, there is no reason to believe that the Respondent's name somehow corresponds with the disputed domain name and the Respondent does not appear to have any trademark rights associated with the term "Avast" on its own. Furthermore, the Complainant has demonstrated that the disputed domain name redirects to an active website at "www.avast-a-avast-com" which offers paid service in relation to the Complainant's AVAST software and prominently shows, inter alia, the Complainant's official AVAST logo, but which, by the same time, also promotes more general desktop support and other related computer services which do not seem to be related exclusively to the Complainant's AVAST software products (quotation: "… we have expertise in products from a wide variety of third-party companies"); also, though the website under the disputed domain name contains a disclaimer in the footer of each webpage, such disclaimer is rather small, not as easy to recognize and drafted in a very general language which does not expressly state that there is no business relationship between the Parties as such, plus that the Respondent's official company name remains unclear throughout the whole website. Therefore, the Respondent obviously does not use the website under the disputed domain name to sell only the Complainant's software products, and also does not accurately and prominently disclose the (non-existing) relationship between the Respondent as the domain name owner and the Complainant as the AVAST trademark holder, which is why the Respondent fails to meet the requirements of nominative fair use of the disputed domain name as an unauthorized reseller under the so-called "Oki Data test", widely

recognized among UDRP panels.

Accordingly, this Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Therefore, the Complainant has also satisfied paragraph 4(a)(ii) and, thus, the second element of the Policy.

The Panel finally holds that the disputed domain name was registered and is being used by the Respondent in bad faith. It is undisputed between the Parties that the Complainant's AVAST trademark enjoys considerable recognition throughout the world; also, the way in which the disputed domain name has been created (namely by including Complainant's AVAST trademark even twice) and the way in which it is used leaves no doubt that the disputed domain name directly aims at targeting the Complainant's AVAST trademark. Therefore, redirecting the disputed domain name which is confusingly similar to the Complainant's AVAST trademark to a website which offers, inter alia but not exclusively, the Complainant's AVAST software products and prominently shows, inter alia, the Complainant's official AVAST logo for the purpose of promoting also more general desktop support and other related computer services, is a clear indication that the Respondent intentionally attempted to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with the Complainant's AVAST trademark as to the source, sponsorship, affiliation or endorsement of this website. Such circumstances are evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

Therefore, the Complainant has also satisfied the third element under the Policy as set forth by paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Stephanie G. Hartung, LL.M.**

DATE OF PANEL DECISION 2020-08-12

Publish the Decision