Decision for dispute CAC-UDRP-103159

Case number	CAC-UDRP-103159
Time of filing	2020-07-09 10:31:20
Domain names	mlgros.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	MIGROS-GENOSSENSCHAFTS-BUND

Complainant representative

Organization	SILKA Law AB

Respondent

Name	Jason Merriman

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

With sales of CHF 28.5 billion (2018), the Migros Group is Switzerland’s largest retailer, and with over 106 000 employees, it is also Switzerland’s largest private employer. Migros is owned by its more than 2 million cooperative members, organised into ten regional cooperatives. These cooperatives operate the core business of Migros, retailing. Migros also owns 32 industrial companies, various commercial, travel and logistics enterprises, as well as Migros Bank. Migros is committed, willingly and with conviction, to social and cultural issues. Its primary goal is to improve the quality of life of all of its customers. Complainant owns several trademarks consisting or containing the word “Migros” hereinafter referred to as "the trademark".

Overview of relevant trademark registrations:
MIGROS <word> reg.no. 637252, International, reg.date February 2, 1995;
MIGROS <word> reg.no. 667858, Swiss national, reg.date December 29, 2014;
MIGROS <word> reg.no. 003466265, EUIPO, reg.date May 13, 2005.

FACTUAL BACKGROUND

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

The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))

Complainant also owns various registrations for domain names that include its registered trademarks, including www.migros.com, www.migros.ch, among others see Annex 5. Complainant uses these domain names to connect to websites through which it informs potential customers about its products and services. Complainant has previously successfully challenged several MIGROS domain names through the UDRP process see among others the following WIPO cases: D2019-0803, D2017-2076, D2017-1924, D2016-2547, D2016-0687, D2015-2375, D2015-1630, D2015-1197, D2015-1012, D2015-0921, D2015-0974, D2015-0564, D2015-0326D2000-1171, D2008-0092, DCH2008-0016, DCH2010-0020, DCH2010-0021, D2015-0564, D2015-0326.

Identical or confusingly similar
The domain name mlgros.com ("hereinafter referred to as the Domain Name") were registered on March 18, 2020 directly and entirely incorporates Complainant's well-known trademark. The addition of the generic Top-Level Domain (gTLD) ".com" does not add any distinctiveness to the Domain Name. The Domain Name is confusingly similar to the Complainant's registered trademark. In this regard, the letter "i" has been replaced with the letter "l" and can therefore be displayed almost like the trademark MIGROS in the web browser. This replacement is an obvious misspelling of the trademark, which preserves the conceptual, phonetic and visual similarity with the Complainant's mark. According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "WIPO Overview 3.0"), section 1.9, "[a] domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element". Also compare with NAF Claim Number: FA2002001885664 Google LLC v. Scott Epple / Sophos regarding the domain name <goog1e-mail.com> where the Respondent had swopped the letter "l" with the numerical 1. The Panel held that: "Registration of a domain name that includes a generic word, a hyphen, replacement of a letter with a numeral and a gTLD does not distinguish the domain name from the mark per Policy". The same applies in the present case and the first element of the Policy is therefore fulfilled.

B. The Respondent has no rights or legitimate interests in respect of the Domain Name;
(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2)).

First of all, there is no bona fide offering of goods or services where the Domain Name incorporates a trademark which is not owned by the Respondent, nor is the Respondent known by the name "Migros". The Respondent has made no effort to use the Domain Name for any purpose that might explain its choice in a manner consistent with having rights or legitimate interest in the name "Migros". When entering the typo-terms 'mlgros' in Google search engine, the first returned results point to Complainant` official website. The Respondent could easily perform a similar search before registering the Domain Name and would have quickly learnt that the trademarks are owned by Complainant and that the Complainant has been using its trademarks for a significant period of time. The Respondent indeed registered the Domain Name that reflect the highly distinctive trademark owned by the Complainants without their authorization, in a way that can only reasonably be explained as a reference to the Complainants' trademark.

There is no evidence that the Respondent has a history of using, or preparing to use, the Domain Name in connection with a bona fide offering of goods and services. It is clear that the Complainant has become a distinctive identifier associated with the term "migros" and that the intention of the Domain Name is to take advantage of an association with the business of Complainant.

C. The Domain Name was registered and is being used in bad faith.

(Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

The Domain Name was registered in bad faith

The Domain Name does not resolve to an active webpage nor does it seem to have been actively used in other ways. However, as first stated in WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmallows and repeated in many subsequent decisions under the UDRP: “the concept of a domain name ‘being used in bad faith’ is not limited to positive action; inaction is within the concept. That is to say, it is possible, in certain circumstances, for inactivity by Respondent to amount to the domain name being used in bad faith”. See section 3.3 of the WIPO Overview 3.0. Noting that the Domain Name incorporates the Complainant’s distinctive and reputed trademark MIGROS and the gTLD “.com”, and that there appears to be no conceivable good faith use that could be made by the Respondent of the Domain Name and considering all the facts and evidence of the case. In this case the Respondent’s is concealing its identity, they have not provided any evidence of actual or contemplated good-faith use and the Complainant’s mark is distinctive.

The Domain Name is being used in bad faith
Complainants’ trademarks at the time of registration of the Domain Name, particularly as the Complainants’ trademark significantly predate the registration date of the Domain Name. An additional strong indication of the Respondent’s bad faith is the fact that the Respondent registered the Domain Names using a privacy protection service to conceal his identity. Given that the Respondent has never actively used the Domain Name, such passive holding of the Domain Name cannot preclude a finding of bad faith given the overall circumstances of the case, notably given the Complainants’ distinctiveness and renown worldwide and the Respondent’s failure to provide any evidence of actual or contemplated good faith use of the Domain Name.
To summarize, the confusingly similar nature of the Domain Name to the Complainant's trademark in the Domain Name demonstrates lack of good faith. Consequently, the Respondent should be considered to have registered and to be using the Domain Name in 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).

This is a case of "typosquatting“, i.e. the disputed domain name contains an obvious misspelling of the Complainant’s trademark. It is well established that the specific top level of a domain name such as “.com”, “.org” or in case “.net” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

Previous panels have found that the slight spelling variations does not prevent a domain name from being confusingly similar to the complainant’s trademark. Replacing the second letter “i” in “migros” with the visually very similar letter “l” does not take away the confusing similarity between the domain name and the trademark

Simple exchange or adding of letters is not a sufficient element to escape the finding that the disputed domain name is confusingly similar to the Complainant’s trademarks and domain names.

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).

The Complainant contends that the Respondent is not affiliated with him nor authorized by him in any way to use his trademarks in a domain name or on a website. The Complainant does not carry out any activity for, nor has any business with the Respondent.

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).

Given the circumstances of the case, including the provided information of the use and reputation of the Complainant's trademark MIGROS and the distinctive nature of this mark, it is inconceivable to the Panel in the current circumstances that the Respondent registered the disputed domain name without prior knowledge of the Complainant and the Complainant's mark.

The Panel therefore finds that the disputed domain name was registered in bad faith.

The disputed domain name does not currently resolve to an active website. In this case the Complainant has however evidenced that the disputed domain name enables the Respondent to send emails using an e-mail address that contains the disputed domain name.

Though no concrete examples of such use have been presented to this Panel, it seems inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address. The Panel notes in this connection that passive holding of a domain name does not prevent a finding of bad faith use under 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. The three essential issues under the paragraph 4(a) of the Policy are whether:

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 with respect to the disputed domain name; and

iii. the disputed domain name has been registered and is being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning the disputed domain name, namely the WHOIS databases.

3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

4. The Panel therefore came to the following conclusions:

a) The Complainant states and proves that the disputed domain name is confusingly similar to its trademarks and its domain names. Indeed, the trademark is partially incorporated in the disputed domain name.

The disputed domain name is therefore deemed identical or confusingly similar.

b) The Respondent is not generally known by the disputed domain name and have not acquired any trademark or service

mark rights in the name or mark, nor is there any authorization for the Respondent by the Complainant to use or register the disputed domain name.

The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the disputed domain name.

c) It is clear that the Complainant's trademarks and website(s) were used by the Complainant long time before the disputed domain name was registered. There is no present use of the disputed domain name but the disputed domain name enables the Respondent to send emails using an e-mail address that contains the disputed domain name. Though no concrete examples of such use have been presented to this Panel, it seems inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address. It is concluded that the Respondent makes bad faith use of the disputed domain name.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MLGROS.COM**: Transferred

PANELLISTS

Name	**Lars Karnoe**

DATE OF PANEL DECISION 2020-08-25

Publish the Decision