Decision for dispute CAC-UDRP-103232

Case number	**CAC-UDRP-103232**
Time of filing	**2020-08-18 10:20:47**
Domain names	**avast.company**

Case administrator

Name	**Olga Slanařová (Case admin)**

Complainant

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

Complainant representative

Organization	**Rudolf Leška, advokát**

Respondent

Organization	**MAI KIM ANH**

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware of.

IDENTIFICATION OF RIGHTS

The Complainant uses the domain name "avast.com" which resolves to its main website. It owns various trade mark registrations for its AVAST! and AVAST marks including the Vietnamese designation of International word mark registration 1011270 for AVAST! registered on 15 April 2009 and United States trade mark registration number 85378515 for AVAST registered on 17 July 2012.

FACTUAL BACKGROUND

The Complainant, based in the Czech Republic, is one of the largest security software companies in the world using next-gen technologies to fight cyber attacks in real time. The Complainant asserts that it is well known on the market globally as a reliable company that has operated since 1988. Its popularity on the market and high quality is supported by the fact that its AVAST antivirus software has more than 400 million users. It owns registered trade marks as set out above and operates its main website at the domain name <avast.com>.

The Respondent, based in Vietnam, registered the disputed domain name on 28 January 2019. The disputed domain name

resolves to an active website that appears to promote software under the AVAST mark and uses details taken from the Complainant's own website.

PARTIES CONTENTIONS

THE COMPLAINANT'S SUBMISSIONS

Language of the proceeding

The Complainant requests the Panel to proceed in the English language. It is acknowledged that the Registrar confirmed that the language of the registration agreement was Vietnamese. However, the Complainant contends that the terms and conditions of the Registrar are in the English language (see attached agreement) and that upon registering the disputed domain name, the Respondent most likely agreed with the English terms.

The Complainant notes that disputed domain name is in English language and in the Latin alphabet. Furthermore, it says that it has been established that where the merits of the case strongly favour the complainant and translating the complaint would cause unnecessary delay, English is an acceptable language for the proceedings (cf. WIPO case No. D2016-1567 "Remy Martin"). The Complainant contends that this is the case here and requests that English is the language of the administrative proceedings.

The Complainant submits that the Respondent is engaged in trade mark and copyright infringement on its website at the disputed domain name. It says that the Respondent mimics the trade dress of the Complainant, illegally uses Complainant´s trade marks, its well-known logo and offers the Complainant´s software for download and other products for sale. Moreover, says the Complainant, the Respondent pretends to be the Complainant (intentionally mislead the Internet users and Complainant´s customers that the disputed domain name is owned by the Complainant) and illegally uses the trade name of the Complainant in order to present that the services and products are provided directly by the Complainant.

The Complainant says that its trade marks are highly distinctive and due to its long history, large number of the customers and substantial commercial activities, the AVAST trademark is a globally known brand with a reputation that ranks as 7th amongst antivirus software products globally. It says that based on a substantial number of the users of its products, the “AVAST” mark is recognised automatically in relation to its products by ordinary customers. Previous cases, says the Complainant, have found that the Complainant´s trade marks enjoy a strong reputation in their field and are well known (seeADR case no. 101909 Avast Software s.r.o., AVAST Software B.V, vs Avastcoin Limited, and CAC case no 101917 Avast Software s.r.o. vs adisoftronics).

The Complainant notes that it distributes its products i.a. via its website www.avast.com where a customer can find product information and can directly download AVAST software. The authorization to use software downloaded from its' website is regulated by an End User License Agreement and is strictly limited to personal, non-commercial use. It also noted that it owns various country code level domain names such as "avast.cz" and "avast.se".

This disputed domain name was created on January 28, 2019. The Complainant says that it follows that the disputed domain name was registered with the knowledge of older above mentioned trade marks of the Complainant. It says that all the content depicted at the website to which the disputed domain name resolves was copied from the official website of the Complainant at <avast.com> including the trade name of the Complainant, its address, products, number of users and all other information. Further the Complainant says that the website at the disputed domain name is used by the Respondent to offer illegal copies of the Complainant´s AVAST products to Internet users (including the Complainant´s customers). Internet users are instructed to complete the form to order the products from the Respondent in the mistaken assumption that the product is provided by the Complainant.

The Complainant submits that the disputed domain name is identical to the Complainant’s family of AVAST trade and

service marks (both statutory and common law) named above, that the Respondent has no rights or legitimate interests in respect of <avast.company> domain name which has been registered and is being used in bad faith.

A. The disputed domain name is identical to the Complainant´s trademarks

The Complainant says that the word “AVAST” is at the core of Complainant’s family of marks and is part of Complainant´s trade name and that it has no specific meaning in modern English. It notes that the AVAST trade mark is a globally known brand with a good reputation. The Complainant says, in relation to its AVAST products, that it has more than 4 million followers on Facebook and about 174,000 followers on Twitter. Furthermore, the Complainant´s website avast.com is visited by approximately 13,6 million of Internet users in a 6 month period.

It says that the disputed domain name is identical to the Complainant´s “AVAST” trade mark and 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. The Complainant says that it provides its products and customer support at its official website at <avast.com> and that this makes the confusion more likely as it leaves an impression that the website is operated by the Complainant.

B. The Respondent has no right or legitimate interests in respect of the disputed domain name

bThe Complainant submits that there is no evidence to suggest that the Respondent has been commonly known by the disputed domain name, or by the name or mark “AVAST” prior to dispute. Nor is it aware of ownership of any identical or similar trade mark, nor of the use of any identical or similar brand by the Respondent before the registration of the disputed domain name. The Complainant confirms that it has not granted to the Respondent any license or authorisation to register or use the disputed domain name.

The Complainant says that the use of its AVAST trademark, AVAST software and official logo at the website to which the disputed domain name resolves amounts to copyright and trade mark infringement. In addition, the Complainant says that the Respondent is using its trade name, Avast Software s.r.o.. in order to attract the Complainant´s customers. 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, says the Complainant, 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. This, says the Complainant , is because the Respondent has used the Complainant's trade mark to bait Internet users and then switch them to his competing AVAST software (Nikon, Inc. v Technilab, WIPO Case no. D2000-1774). Competing use is not considered a bona fide offering of goods and services, nor a legitimate non-commecial or fair use, according to the Complainant (see WIPO case no. D2017-0655-NUOVARIVER.COM). Moreover, says the Complainant, the use of its logo excludes any possibility of a bona fide reference to Complainant’s services, as for bona fide nominative fair use only a textual reference can usually be acceptable.

The Respondent intentionally misleads Internet users into thinking that the disputed domain name is operated by the Complainant. This follows from the fact that the Respondent has placed the Complainant's copyright notice in the footer of each webpage, namely “Copyright 1988-2019 Avast Software sro” and under tab “Contact” placed trade name and address of the Complainant: “Avast Software sro, registered office at Pikrtova 1737 / 1a, Prague 4, Nusle, Postal Code 140 00, Czech Republic, ID number 02176475, VAT CZ02176475, registered in the Register of Commerce managed by the Court of the City of Prague, Part C, Case No. 216540”. Furthermore, says that Complainant, the Respondent has repeatedly used the “AVAST” trade mark at the website to which the disputed domain name resolves, as well as the AVAST logo.

Past panels, says the Complainant, have found that the use of a complainant’s trade mark and logo along with the offer for download and sale of other of complainant´s products and in the absence of complainant’s authorisation and in violation of End User License Agreement, negates any potential justification of use by the Respondent. Further says the Complainant, the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent (Avast Software

s.r.o. v Victor Chernyshov, CAC Case no. 101568). Overall submits the Complainant, the Respondent is 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).

C. The disputed domain name has been registered and is being used in bad faith

The Complainant submits that the Respondent was clearly aware of the registration and the use of the Complainant´s trade marks before the registration of the disputed domain name. It follows, says the Complainant, from the Respondent´s explicit references to the Complainant, its trade marks and the AVAST Antivirus software and logo on the website to which the disputed domain name resolves, that it must have been aware of the Complainant's trade marks. Moreover, notes the Complainant, text placed on the website at the disputed domain name was illegally copied and translated from the official website of the Complainant at <avast.com>. For example, the Respondent copied this text: “We are 400 million. Be our “plus one” Our 400 million users are the 400 million reasons why we lead the digital security pack. Each Avast-loaded device is a source of real-time intelligence about new and current threats. That’s how we stop over 66 million of them every day. By joining Avast, you help to make that network even stronger.”

In the footer of each webpage the Respondent placed a copyright notice: Copyright 1988-2019 Avast Software sro. Under the tab “Contact”, it states trade name and address of the Complainant: Avast Software sro, registered office at Pikrtova 1737 / 1a, Prague 4, Nusle, Postal Code 140 00, Czech Republic, ID number 02176475, VAT CZ02176475, registered in the Register of Commerce managed by the Court of the City of Prague, Part C, Case No. 216540. It follows that the Respondent has attempted to deceive customers into thinking that that the disputed domain name is operated by the Complainant and that authorised products are being offered on the website to which it resolves.

The Complainant notes that 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 a previous case, says the Complainant, the Panel held that the AVAST trade marks are well-known and enjoy a strong reputation in their field (see CAC case no. 101909, CAC case no 101917). The Complainant notes that in recent CAC case no.103044 the Panel declared that AVAST trade mark enjoys considerable recognition throughout the world.

Finally, the Complainant submits that the disputed domain name is used solely for the illicit distribution of the Complainant’s AVAST software. The Complainant never authorised such distribution and under paragraph 2.4 of the End User License Agreement (the EULA), any resale or further distribution of the AVAST solution is prohibited. Therefore, says the Complainant, the unauthorised distribution of AVAST software from the website at <avast.company> constitutes a material breach of EULA, violates applicable copyright laws and causes significant damage to the Complainant.

In conclusion, the Complainant says that the disputed domain name is used by the Respondent to target the Complainant´s customers. This together with the misleading text referring to the Complainant suggests incorrectly that the disputed domain name is operated by the Complainant and that the official version of AVAST software is being offered by the Respondent, when this is not the case. Further evidence in this regard, says the Complainant, comes from the Respondent´s unlawful placement of Complainant´s logo on every page as well as the imitation of graphic design from the Complainant´s website

The Complainant notes that paragraph 4 (b) (iv) of the Policy says that bad faith registration and use can be found in respect of a disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent´s website or other online location, by creating a likelihood of confusion with a complainant´s mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location. It says that the disputed domain name has no other purpose than to misleadingly divert potential consumers of the Complainant in order to distribute illegally the AVAST software and to tarnish the Complainant's trade marks by creating a

likelihood of confusion with the Complainant´s marks.

Bad faith of the Respondent is further supported by the fact that the Respondent concealed his/her identity by using a proxy service in order to hide the disputed domain name's true owner.

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.

The Panel notes that although the Registrar advised that the language of the registration agreement was in Vietnamese, the terms and conditions of the registrar are in English, the disputed domain name is in Latin script in English and on the website to which the disputed domain name resolves, many of the drop down menus also use English terms. Considering these factors, which have been previously acknowledged by past panels as factors that may assist in determining the language of the proceedings (see section 4.5.1 of the WIPO Jurisprudential Overview 3.0), the absence of objection from the Respondent, the particular nature of this case concerning a disputed domain name that resolves to a website masquerading as being the Complainant's as outlined in the "Principal Reasons For Decision" and the overall interest in determining the proceedings expeditiously, the Panel accepts the Complainant's request for the language of the proceedings to be in English.

PRINCIPAL REASONS FOR THE DECISION

The Complainant has demonstrated that it owns registered trade mark rights in the AVAST mark, in particular, including the Vietnamese designation of International word mark registration 1011270 for AVAST! registered on 15 April 2009 and United States trade mark registration number 85378515 for AVAST registered on 17 July 2012. The disputed domain name wholly incorporates the Complainant's AVAST mark and the Panel finds that the elements of the disputed domain name before the ".company" generic toplevel domain name element are therefore identical or confusingly similar to the Complainant's registered trade marks.

The Complainant submits that there is no evidence to suggest that the Respondent has been commonly known by the disputed domain name, or by the name or mark “AVAST” prior to dispute. Nor is it aware of ownership of any identical or similar trade mark, or of the use of any identical or similar brand by the Respondent before the registration of the disputed domain name. The Complainant confirms that it has not granted to the Respondent any license or authorisation to register or use the disputed domain name.

The Complainant has submitted that the use of its AVAST trademark, AVAST software and official logo at the website to which the disputed domain name resolves amounts to copyright and trade mark infringement. In addition, the Complainant

asserts that the Respondent is using its trade name, Avast Software s.r.o. in order to attract the Complainant´s customers to its website at the disputed domain name without authorisation.

Before the dispute, submits the Complainant, 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. This, says the Complainant , is because the Respondent has used the Complainant's trade mark to bait Internet users and then switch them to his competing AVAST software Moreover, says the Complainant, the use of its logo at the website to which the disputed domain name resolves excludes any possibility of a bona fide reference to Complainant’s service. In essence the Complainant has submitted that the Respondent has intentionally misled Internet users into thinking that the disputed domain name is operated by the Complainant. Overall the Complainant's case is that the Respondent is 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.

The Panel finds, for these reasons and as described below in relation to bad faith, that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. As this case has not been rebutted by the Respondent, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The disputed domain was registered on 28 January 2019, many years after the Complainant registered its trade marks. Considering the distinctive nature of the AVAST mark, and the very substantial degree of renown attaching to it and the fact that the website at the disputed domain name replicates various elements and details from the Complainant's website, the Respondent was very likely well aware of the Complainant and its AVAST trade mark at the date of registration of the disputed domain name.

Under paragraph 4 (b) (iv) of the Policy bad faith registration and use can be found in respect of a disputed domain name, where a respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent´s website or other online location, by creating a likelihood of confusion with a complainant´s mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location. It is clear in this case that the the disputed domain name seeks to confuse and to divert potential consumers of the Complainant to the Respondent's website for its own commercial purposes or possibly in order "to phish" for customer details. This amounts to evidence of registration and use in bad faith under this part of the Policy.

In any event the Respondent's use of the disputed domain name to resolve to a website that masquerades as if it is the Complainant's website and which uses the Complainant's trademarks, corporate details and address without its authority and in addition distributes software under the Complainant's trademarks and without its authority amounts to illegitimate use of the disputed domain name in bad faith.

The Panel finds that the Respondent's bad faith is further supported by the fact that the Respondent concealed his/her identity by using a proxy service in order to hide the disputed domain name's true owner.

As a consequence the Panel finds that the disputed domain name was both registered and has been 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. **AVAST.COMPANY**: Transferred

PANELLISTS

Name	**Alistair Payne**

DATE OF PANEL DECISION 2020-09-19

Publish the Decision