Decision for dispute CAC-UDRP-103235

Case number	**CAC-UDRP-103235**
Time of filing	**2020-08-19 10:22:48**
Domain names	**avgcomretail-avg.com**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

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

Complainant representative

Organization	**Rudolf Leška, advokát**

Respondent

Name	**Jon Phillips**

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 is an owner of (inter alia) following trademarks containing a word element "AVG”:

(i) AVG (word), International (WIPO) Trademark, priority date 2 February 2007, registration date 21 March 2005, trademark no. 930231, registered for goods and services in classes 9, 37 and 42;

(ii) AVG (word), EU Trademark, priority date 24 June 2004, registration date 2 February 2007, application no. 3893716, registered for goods and services in classes 9, 16 and 42;

besides other EU, WIPO and national trademarks consisting of the " AVG" denomination (collectively referred to as "Complainant's trademarks").

The Complainant has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term “AVG”.

FACTUAL BACKGROUND

COMPLAINANT:
The Complainant provides to its customers one of the most famous and effective antimalware security suite (antivirus software) from 1991 under the name "AVG Antivirus" (the "Product").

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 the Product 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.

DISPUTED DOMAIN NAME:
The disputed domain name < avgcomretail-avg.com> was registered on 18 November 2019 and is held by the Respondent.

The domain name website (i.e. website available under internet address containing the disputed domain name) mimics official retail website of the Complainant's Product, uses Complainant's logo associated with the Product and refers to the Complainant, its Product and its official website. Overall, the domain name website resembles official Product website.

The Complainant seeks transfer of the disputed domain name to the Complainant.

PARTIES CONTENTIONS

The Parties' contentions are the following:

COMPLAINANT:

CONFUSING SIMILARITY

The Complainant states that:

- The disputed domain name contains “AVG” word element of Complainant's trademarks in its entirety and it is thus confusingly similar to Complainant’s trademarks.

- The addition of the generic terms “RETAIL“ and “COM” add no distinctiveness to the disputed domain name.

- The Complainant refers to previous domain name decisions contending that adding a general term to a trademark can enhance the confusing similarity of the disputed domain name since it might lead internet users to wrongly believe that the said domain name is endorsed by Complainant and is related to its business.

Thus, according to the Complainant the confusing similarity between Complainant’s trademarks and the disputed domain name is clearly established.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

- The Respondent has not been commonly known by the disputed domain name.

- The Complainant has not authorized, permitted or licensed the Respondent to use Complainant’s trademarks in any manner. The Respondent has no connection or affiliation with the Complainant whatsoever. On this record, Respondent has not been commonly known by the disputed domain name.

- The disputed domain name was used to free ride on Complainant’s trademarks by misleading the public about origin of the

services offered on the domain name website and establishing likelihood of confusion with the Complainant and its business and also likely for fraudulent phishing purposes.

- No bona fide use of the disputed domain name has been established also because the Respondent provided false and misleading statements on the domain name website, apparently with an intention to create a false impression that the services offered through the website were provided either directly by the Complainant or with its authorisation.

BAD FAITH REGISTRATION AND USE

The Complainant states that:

- Seniority of the Complainant's trademarks predates the disputed domain name registration and such trademarks are well known in relevant business circles. The Respondent can be considered to be aware of the Complainant's trademarks when registering the domain name due to well-known character thereof and also because it made various references to Complainant's trademarks on the domain name website.

- It is well-founded that registration of the disputed domain name that is confusingly similar to the Complainant’s trademarks which enjoys strong reputation, plus other facts, such as above described no genuine use of the disputed domain name, are sufficient to establish bad faith under the 4(a)(iii) of the Policy.

- The domain name website is supposed to be used for phishing of confidential information from customers of the Complainant (name, e-mail, telephone number and license key - activation code for AVG product). It also invites Internet users to enter their license keys for AVG product and other information in order to activate the product. All such activities are malicious.

- The Complainant states that it was informed about the fraudulent nature of the disputed domain name by its customers who wrongly believed that the Complainant operates the disputed domain name; this supports Complainant's allegations about malicious and deceiving nature of the disputed domain name website.

- The Complainant refers to previous domain name decisions contending that registering a domain name incorporating trademarks that enjoy high level of notoriety and well-known character constitute prima facie registration in bad faith.

- The Complainant refers to previous domain name decisions contending that (i) registering a domain name incorporating trademarks that enjoy high level of notoriety and well-known character and (ii) abusive use of such trademarks on the domain name website with an aim to mislead the public about origin of the website and services offered through it, both constitute prima facie registration and use in bad faith.

The Complainant presents the following evidence which has been assessed by the Panel:

- Information about the Complainant and its business;
- Excerpts from various trademark databases regarding Complainant's trademarks;
- Copy of Assignment of Intellectual Property Agreements;
- Screenshots of the disputed domain name website (evidencing communication of misleading statements and unauthorised use of Complainant’s trademarks);
- Screenshots of official Complainant’s websites;
- WHOIS information about the disputed domain name.

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

RIGHTS

Since the domain name and the Complainant's trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain name consisting of a term "AVGCOMRETAIL-AVG.COM" is confusingly similar to the Complainant's trademarks.

The Panel contends that the disputed domain name and the Complainant's trademarks are confusingly similar since both fully incorporate a distinctive word element "AVG" that enjoys high level of notoriety at least in relevant business and customer circles. Addition of non-distinctive generic words "RETAIL" and "COM" to it cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant's trademarks and thus the likelihood of confusion still exists.

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 and confusing similarity tests as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is identity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant's assertions that the Respondent is not commonly known by the disputed domain name and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent.
The Respondent, in particular, used the disputed domain name (which include Complainant's Trademarks) in order to present misleading and inaccurate information about Respondent's services that in a way that was capable of creating a false impression that such services were provided by the Complainant or with his consent.
It also appears that the domain name (through domain name website) has been used for fraudulent phishing purposes.
As a result, the Panel concludes that there is no indication that the domain name was intended to be used in connection with a bona fide offering of goods or services as required by the Policy.
Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

BAD FAITH

As described above, the Complainant has proven that the Respondent has used (at least for some time) the disputed domain name for promotion and offer offering services (i) likely with intention to free-ride on reputation and goodwill of such trademarks and Complainant's business and , even more importantly, (ii) in a manner that was detrimental both to the customers as well the Complainant and his business since information provided about such services and Complainant's Product were false and misleading.

Also disputed domain name website has been used as a phishing scheme to mimic the Complainant's site, while intercepting Product activation keys or other information which visitors enter unsuspectingly.

Such unfair use of the disputed domain name cannot be considered as a use thereof in good faith and in compliance with fair business practices.

For the reasons described above, since (i) there is only a remote chance that the Respondent has registered the disputed domain name just by a chance and without having a knowledge about the existence of the Complainant's rights and business (ii) the use of the dispute domain name is not compliant with fair business practices, the Panel contends, on the balance of probabilities, that the disputed domain name has been registered and is being used by the Respondent in bad faith.

Thus, the Panel has taken a view that 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 ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AVGCOMRETAIL-AVG.COM**: Transferred

PANELLISTS

Name	**JUDr. Jiří Čermák**

DATE OF PANEL DECISION 2020-09-24

Publish the Decision