Decision for dispute CAC-UDRP-103352

Case number	CAC-UDRP-103352
Time of filing	2020-10-15 09:23:29
Domain names	migrosbkswiss.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	MIGROS-GENOSSENSCHAFTS-BUND (Federation of Migros Cooperatives)

Complainant representative

Organization	SILKA AB

Respondent

Name	Jeff Waveson

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Complainant owns several trademarks consisting or containing the word “Migros” and “Migros Bank” including

Trademark Registration number Country Date of Registration
MIGROS
Word mark P-405500 Swiss national 20.09.1993
MIGROS
Word mark 2P-415060 Swiss national 13.02.1995

MIGROSBANK
Word mark 414500
Swiss national 1995-01-12

Complainant also owns various registrations for domain names that include its registered trademarks, including www.migros.com, www.migros.ch, www.migrosbank.com, migrosbank.ch among others. Complainant uses these domain

names to connect to websites through which it informs potential customers about its products and services.

FACTUAL BACKGROUND

The Complainant is the Swiss based umbrella organization of the regional Migros Cooperatives. Complainant is known throughout Switzerland as one of the biggest department stores, offering a wide range of food, non-food products and services (wellness, travel, catering). The company was founded by Gottlieb Duttweiler in 1925 in Zurich and has now evolved into a Community of ten regional Cooperatives. Nowadays, the Migros Group, however, is not only related to the food industry. It consists of 4 travel agencies (Interhome, Hotelplan Suisse, Travelwindow, btw first travel), cultural institutions, a museum, magazines (Saisonkuche, Migros-Magzin), restaurants (cha cha, Molino, Migros- Take Away), aqua/fitness/ golf parks, several pension funds and foundations and a bank. (http://www.migros.ch/de/migros-gruppe.html; http://www.migros.ch/de/ueber-die-migros/organisation/organigramm.html).

Migros Bank is a wholly owned subsidiary of the Migros Group. They operate the website https://www.migrosbank.ch. The bank was founded in 1958 by Gottlieb Duttweiler. The bank is present in 67 locations in Switzerland. The bank is also active on several social media sites such as: Facebook, twitter, Google +, Youtube, Xing and LinkedIn.

https://www.facebook.com/migrosbank
https://twitter.com/migrosbank
https://plus.google.com/+MigrosBankAGWallisellen
https://www.youtube.com/user/MigrosBankAG
https://www.xing.com/company/migrosbank
https://ch.linkedin.com/company/migros-bank

Complainant has previously successfully challenged several MIGROS domain names through the UDRP process see among others the following WIPO cases: 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 and also at the US National Arbitration Forum (FA1505001621184, dated on July 8, 2015).

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant’s contentions can be summarised as follows:

The disputed 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))

The disputed domain name was registered in 2020 and 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 disputed domain name. Nor does the combination with the abbreviated term “bk” for bank and the geographical identifier ‘Swiss’. These components strengthens the confusingly similarity element since the words are closely connected to the Complainant’s trademark and business activities.

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

The disputed domain name does not resolve to an active website at the moment. However, given the nature of the disputed domain name is it likely that it can be used for phishing activities since there are active MX records which means that it can be used for sending out emails.

There is no bona fide offering of goods or services where a domain name incorporates a trademark which is not owned by Respondent. The combination with “bk” and “swiss” strengthens the impression of a legitimate connection between the website to which the disputed domain name resolves and Complainant. The Respondent has not provided Complainant with any evidence of its use of, or demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services. The disputed domain name is likely to induce consumers into visiting the related website under the misapprehension that the websites is endorsed by Complainant. Relying on consumer confusion concerning a well-established trademark is not a route to establishing a claim for rights or legitimate interests. It is clear that the intention of the disputed domain name is to take advantage of an association with the business of Complainant.

The Respondent has made no effort to use the disputed domain name for any purpose that might explain its choice in a manner consistent with having rights or legitimate interest in the name “Migros” or “Migros Bank”. When entering the terms in Google search engine, the first returned results point to Complainant`s official website. The Respondent could easily have performed a similar search before registering the disputed domain name and would have quickly learnt that the MIGROS trademark is owned by Complainant and that the Complainant has been using its trademark for a significant period of time.

Complainant has not found that the Respondent is commonly known by the disputed domain name. Complainant has conducted searches on the Respondent’s name and has not found anything that would justify registration of the disputed domain name, either by company name or trademark registrations.

C. The disputed 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 Complainants’ distinctive MIGROS trademark significantly predate the registration date of the disputed domain name.

Due to Complainant’s trademarks valid for MIGROS and MIGROS BANK and the active business presence of Complainant it seems to be unlikely that the Respondent was not aware of the unlawful nature of the registration of the disputed domain name.

As mentioned, the disputed domain name does not resolve to an active website, 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.

There appears to be no conceivable good faith use that could be made by the Respondent of the disputed domain name 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 of the Complainant’s distinctive mark.

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 disputed domain name registered in 2020 is confusingly similar to the Complainant's MIGROS trade mark (registered in Switzerland since 1993) adding only the letters 'bk' indicating bank, the geographical term 'Swiss' and the gTLD .com which do not prevent confusing similarity between the disputed domain name and the Complainant's MIGROS mark.

The Respondent does not have rights or legitimate interests in the disputed domain name, is not commonly known by it and is not authorised by the Complainant. There has been no use of the disputed domain name and therefore no bona fide use of goods or services or legitimate non-commercial or fair use.

Where a disputed domain name contains a mark with a reputation passive holding can be registration and use in bad faith. The use of 'bk' and 'Swiss' in the disputed domain name indicates the Respondent targeted the Complainant by the registration of the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MIGROSBKSWISS.COM**: Transferred

PANELLISTS

Name	**Dawn Osborne**

DATE OF PANEL DECISION 2020-11-05

Publish the Decision