Decision for dispute CAC-UDRP-103396

Case number	CAC-UDRP-103396
Time of filing	2020-11-06 09:21:54
Domain names	migrosprivate.com, migros-private.com, migrosprivate.info, migros-private.info

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

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

Complainant representative

Organization	SILKA AB

Respondent

Name	Willy Seban

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the Domain Names.

IDENTIFICATION OF RIGHTS

The Complainant, Migros Genossenschafts-Bund (hereinafter referred to as "Complainant"), is one of the biggest retail companies of Switzerland.

The Complainant has submitted evidence, which the Panel accepts, showing that it is the registered owner of the following trademarks in several classes and domain names bearing the “MIGROS“ phrase.

Currently, Migros is the owner of various trademark registrations such as:

The Swiss Word trademark n° P-405500 dated 13.02.1993 designating goods and services in classes 1-9, 11, 12, 14-32 and 34. MIGROS Word mark 2P-415060 Swiss national n° 2P-415060 dated 27.09.1994 designating the services in classes 35-42. The EU trademark n° 003466265 dated 29.10.2003 designating the services in class 35.

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. The Complainant has been extensively using the “MIGROS” denomination on all internet environments including and not limited to the company’s

official websites.

FACTUAL BACKGROUND

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

Migros Genossenschaftsbund (hereinafter referred to as Complainant), is the Swiss based umbrella organization of the regional Migros Cooperatives. The 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. 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.

Migros bank
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.

MIGROSBANK Word mark no. 414500, Swiss national reg. 1995-01-12

The Complainant has previously successfully challenged several MIGROS domain names through the UDRP process see among others the following WIPO cases: D2020-0327, D2019-0803, D2017-2076, 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 CAC cases 101810, 101876, 103159. Further, the US National Arbitration Forum recently took a decision in favor of the Complainant (FA1505001621184, dated on July 8, 2015) where similar fact has been stated.

The Complainant showed evidence that the disputed domain names <migrosprivate.com>, <migros-private.com>, <migrosprivate.info>, <migros-private.info> (“hereinafter referred to as the Domain Names”) were registered between September 22, 2020 and October 15, 2020 and directly and entirely incorporates Complainant’s well-known trademark MIGROS. The addition of the generic Top-Level Domain (gTLD) “.com” does not add any distinctiveness to the Domain Name. The combination with the abbreviated term “private” which is used for private banking strengthens the confusingly similarity element since the words are closely connected to the Complainant’s trademark and business activities. The reason is that the Complainant offers online banking. It is well-established under UDRP precedents that a gTLD suffix is disregarded under the confusingly similarity test as it is a technical requirement. Where the Domain Name is compared with the Complainant’s registered MIGROS mark, “migros” is still the most distinctive part and the addition of the generic word “private” does not diminish the overall likelihood of confusing similarity to the Complainant’s trademark. On the contrary, in the present case, the word exaggerates the confusing similarity between the Domain Name and the Complainant’s trademark, since the Complainant operates an online bank for private customers. Compare with the recent WIPO Case Case No. D2017-0647 Migros-Genossenschafts-Bund v. James Okogb, Micrio regarding the domain name <migrosbonline.com> where the Panel held that “The addition of the elements “b” and “online” in the disputed domain name, while not identical to Complainant’s trademark, do not negate their confusing similarity to that trademark”. Nearly the identical circumstances are at hand in the current case. See as an example the WIPO Overview on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), as well as the recent International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581 where the Panel stated the following “In addition, it is generally accepted that the addition of the top-level suffix in the domain name (e.g., “.info” or “.org”) is to be disregarded under the confusing similarity test”. The following should apply in the current case and the Domain Names should be considered as identical to the registered trademark MIGROS at point of Complainant's view.

The Complainant remarked that the Respondent has no rights or legitimate interests in respect of the Domain Names.

First of all, there is no bona fide offering of goods or services where the Domain Names incorporate a trademark which is

not owned by the Respondent, nor is the Respondent known by the name “Migros”. The combination with “private” strengthens the impression of a legitimate connection between the website to which the Domain Names resolves and Complainant. Complainant has not found that the Respondent is commonly known by the Domain Names. The Respondent has not provided Complainant with any evidence of its use of, or demonstrable preparations to use the Domain Names in connection with a bona fide offering of goods or services. The tendency of the Domain Names is to induce consumers into visiting the related websites under the misapprehension that the websites are 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

The Respondent has made no effort to use the Domain Names 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` official website. The Respondent could easily perform a similar search before registering the Domain Names and would have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks for a significant period of time.

There is no evidence that the Respondent has a history of using, or preparing to use, the Domain Names 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 Names is to take advantage of an association with the business of Complainant.

The websites:
Two out of the four domain names < migrosprivate.com, migros-private.com> were previously pointing to a website that aimed to attract consumers to a false bank website by copying the design of Complainant's official website https://www.migrosbank.ch/. The Domain Names were used to set up a website in order to deceive members of the public into believing that they can safely pay money to a third party in reliance on information provided by a trusted company when in fact the website has no connection with the Complainant. The Complainant managed through the web host to urgently suspend the websites from further activities and is at the time of filing the Complaint inactive. The websites were deceptively similar in layout, colour and content. The Complainant took all measures to try and have the sites removed. The other two domain names <migrosprivate.info, migros-private.info> have not been connected to any active websites (so far at least). Due to the historical use of the sites there is always a risk that the sites will be activated again. Clearly, the Respondent is not known by the Domain Names, nor does the Respondent claim to have made legitimate, non-commercial use of the Domain Names.

The Complainant argues further that the disputed Domain Names were registered and are being used in bad faith.

It must be highlighted that the Complainant’s trademarks valid for MIGROS (where the and the active business presence of Complainant also shows that it seems to be unlikely that the Respondent was not aware of the unlawful registration of the Domain Names. The fact that the Respondent reproduced the Complainant’s website by adopting the Complainant’s logo and overall look was with the intention to deceive internet users into believing the websites were in fact operated by the Complainant. Compare with WIPO decision D2017-0066 where the same circumstances were at hand. The Respondent created a website nearly identical with the Complainant whose core business was banking. The Panel stated that: The Respondent did not make a fair or non-commercial use of the disputed domain name. On the opposite, the Respondent used a privacy shield service to register the domain name and then used it to resolve to an obviously infringing website copying the official Complainant’s website and reproducing the Complainant’s trademarks. Same circumstances are at hand in the present case.

The Domain Names are being used in bad faith
Since the registration of the Domain Names the Respondent was using the domain names to resolve to infringing websites dedicated to banking services and offering the Internet users to contact the bank via an email address incorporating the Complainant’s trademark. Such ongoing use does not constitute good faith use of the Domain Names. The fact that the

websites at the time of filing the Complaint leads to suspended sites does not cure the bad faith use as established by the Respondent.

The Complainant summarized, the confusingly similar nature of the disputed Domain Names to the Complainant's trademarks, together with the word “private” in the disputed Domain Names demonstrates lack of good faith. Consequently, the Respondent should be considered to have registered and to be using the Domain Names in bad faith.

The Respondent didn’t react to the Complainant‘s contentions.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Names are 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 Domain Names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Names have been registered and are 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

It is necessary for the Complainant, if it is to succeed in this administrative proceeding, to prove each of the three elements referred to in paragraph 4(a) of the Policy, namely that:

(i) the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights; and
(ii) the Respondent has no rights or legitimate interest in respect of the disputed domain name; and
(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel finds that the disputed domain names <MIGROSPRIVATE.COM, MIGROS-PRIVATE.COM, MIGROSPRIVATE.INFO, MIGROS-PRIVATE.INFO> are confusing similar to the trademarks of the Complainant. The domain names <MIGROSPRIVATE.COM, MIGROS-PRIVATE.COM, MIGROSPRIVATE.INFO, MIGROS-PRIVATE.INFO>, which were registered between September and October 2020, incorporate entirely the Complainant’s well-known, registered trademark MIGROS with a generic indication “Private”. The addition of the gTLD “.com”and „.info“ do not add any distinctiveness to the Domain Names.
The Complainant rightfully contended that the Domain Names are confusingly similar to the prior trademark MIGROS of the Complainant. The Complainant also referred to the distinctiveness and reputation of its MIGROS trademarks.

This makes it highly unlikely that the Respondent had no knowledge of the Complainant's prior trademark rights at the time of registration of the Domain Names. The Complainant rightfully contended that the Respondent has used the Domain Names intentionally to attract visitors for commercial gain by creating confusion with the Complainant’s trademarks, and that the Respondent has used the Domain Names with that intention, namely in bad faith. See e.g., Accor v. Shangheo Heo / Contact Privacy Inc., WIPO Case No. D2014-1471 where the Panel stated that: “The unopposed allegation of phishing, and

the evidence submitted in support of phishing, combined with the likelihood of confusion, is sufficient evidence of bad faith. …It seems likely, as Complainant alleges, that Respondent intentionally attempted to deceive consumers into providing personal and financial information, believing that Respondent was associated with the bona fide services offered by Complainant."
Reference is made also to: CAC cases no. 101810 MIGROS vs. Mary Hines; no. 101036, Boehringer Ingelheim Pharma GmbH & Co. KG vs. SKYRXSHOP - dulcolax.xyz and WIPO Case no. D2014-0306 Boehringer Ingelheim Pharma GmbH & Co. KG v. Klinik Sari Padma, BAKTI HUSADA.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Domain Names. The Complainant has not granted the Respondent any right to use the MIGROS trademark within the disputed Domain Names, nor is the Respondent affiliated to the Complainant.

Moreover, the Complainant contends and provides evidence that the Respondent has not developed a legitimate use in respect of the Domain Names. The Complainant contends that the Respondent was seeking to use the Domain Names only to divert consumers to its own business and that the Respondent has no legitimate interests in respect of the Domain Names. Two out of the four domain names < migrosprivate.com, migros-private.com> were previously pointing to a website that aimed to attract consumers to a false bank website by copying the design of Complainant's official website https://www.migrosbank.ch/ other two domain names <migrosprivate.info, migros-private.info> have not been connected to any active websites (so far at least). Due to the historical use of the sites there is always a risk that the sites will be activated again.

In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the Domain Names.

Furthermore, the Respondent was using a hidden identity. But this argument is not to be discussed further because bad faith is evident, whatsoever. Accordingly, the Panel finds that the Domain Names were both registered and used in bad faith and that the Complaint succeeds under the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MIGROSPRIVATE.COM**: Transferred
2. **MIGROS-PRIVATE.COM**: Transferred
3. **MIGROSPRIVATE.INFO**: Transferred
4. **MIGROS-PRIVATE.INFO**: Transferred

PANELLISTS

Name	**Dr. jur. Harald von Herget**

DATE OF PANEL DECISION 2020-12-17

Publish the Decision