

Decision for dispute CAC-UDRP-103887

Case number	CAC-UDRP-103887
Time of filing	2021-06-24 09:44:24
Domain names	migrosprivateonline.com , MIGROSCREDIT.COM

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	MIGROS-GENOSSENSCHAFTS-BUND
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Complainant representative

Organization	SILKA AB
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Respondent

Name	Richard Nora
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OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns the following Swiss National Trademark Registrations:

- MIGROS, Reg. No. P-405500, dated 20.09.1993;
- MIGROS, Reg. No. 2P-415060, dated 13.02.1995;
- MIGROSBANK Logo, Reg. No. 623618, dated 12.12.2011; and
- MIGROSBANK, Reg. No. 414500, dated 01.12.1995.

FACTUAL BACKGROUND

Founded in Zurich in 1925, the Complainant is known throughout Switzerland as one of the biggest department stores, offering a wide range of food, non-food products and services. It also operates other businesses including travel agencies, cultural institutions, and restaurants. These businesses are promoted at the website <https://migros.ch>. Finally, starting in 1958, the Complainant has operated pension funds and a bank through which it offers banking and credit options to its private customers. These banking and credit services are provided online at the website <https://www.migrosbank.ch>. The trademarks MIGROS and MIGROSBANK are promoted through the above-mentioned websites as well as through social

media accounts on such platforms as Facebook, Twitter, YouTube, Xing, and others. In 2016 the Complainant employed 21,762 personnel and operated banks in 67 locations in Switzerland.

The disputed domain names <migrosprivateonline.com> and <migroscredit.com> were both registered on June 3, 2021. The disputed domain names aim to attract consumers to a fake website displaying the MIGROS trademark in connection with banking services in order to deceive members of the public into believing that they can safely pay money to a third party.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that each of the disputed domain names 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 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 disputed 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

Consolidation of Respondents

The Complainant has requested that its dispute against the two named Respondents be consolidated into a single proceeding based on evidence that both of the disputed domain names are, in fact, under common ownership or control. Paragraph 3(c) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") provides that a "complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder." Despite being presented with WHOIS records that name different Registrants, prior Panels have held that consolidation of a case against multiple domain names is appropriate where there are other similarities that indicate a likelihood of common ownership. See, e.g., *American Airlines, Inc. v. Ramadhir Singh, WhoisGuard Protected, WhoisGuard, Inc. / Reema Gupta, Ballu Balwant, Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Lucy Lionel, Lucy99, Red Keep, D2021-0294 (WIPO March 11, 2021)* (consolidation upheld based on "the similar content and layout of the websites that were linked to the disputed domain names; the fact that all the disputed domain names target a specific sector and the same trademark within this sector; the similar patterns in the disputed domain names; and the identical reaction of the Respondents to the Complaint, not replying to the Complainant's contentions."); *Brooks Sports, Inc. v. Shuai Li / Nan Zhang, FA 1932371 (FORUM March 18, 2021)* (similar website content, use of same registrars and privacy services).

The Complainant contends that, despite their respective WHOIS records listing the different Registrant names of Richard Nora and marteen van gogh, the disputed domain names are controlled by the same entity because, among other facts, both were registered on the same date with the same registrar and use the same privacy service. Further, both owners list postal addresses in the United States and use email addresses on the gmail.com service. Finally, both of the disputed domain names resolve to websites that impersonate the Complainant and claim to provide banking services.

In light of the above, and in the absence of participation in these proceedings by any party claiming to be a Registrant of these disputed domain names, the Panel determines that it is more likely than not that both of the disputed domain names are under common control by the same domain name holder. As such, it will not be inequitable for the present case to proceed in a consolidated manner against both of the disputed domain names. For the remainder of this decision their holder will be referred to in the singular as the "Respondent".

The Panel is satisfied that all other 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

A. Each of the disputed domain names is confusingly similar to a trademark or service mark in which the Complainant has rights

Paragraph 4(a)(i) of the Policy requires that the Complainant demonstrate its ownership of trademark rights and that the disputed domain names are confusingly similar to such trademark. *Boehringer Ingelheim Animal Health France / Merial v. S Jon Grant*, 103255 (CAC September 30, 2020) (“it is imperative that the Complainant provides evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant’s trade mark(s).”).

The Complainant has submitted screenshots from the website of the Swiss Federal Institute of Intellectual Property (“IPI”) as evidence that it owns registered rights to its asserted MIGROS and MIGROSBANK trademarks. Registration with such an office has been found sufficient to satisfy the threshold requirement of Paragraph 4(a)(i) of the Policy. *Margaritaville Enterprises, LLC v. Neil Wein*, FA 1916531 (FORUM November 9, 2020) (“It is well established by decisions under this Policy that a trademark registered with a national authority is evidence of trademark rights”). The disputed domain name, which was registered long subsequent to the existence of the Complainant’s trademark rights, adds the words “privateonline” or “credit” to the MIGROS trademark. The domain name further adds the “.com” gTLD. Thus, the Complainant asserts that the second level of the disputed domain name is confusingly similar to the asserted trademarks and will lead internet users to wrongly believe that the disputed domain names are endorsed by the Complainant. Prior panels have found confusing similarity under similar fact situations. *Avast Software s.r.o. v. Milen Radumilo*, 102384 (CAC April 19, 2019) (“it is well accepted that where the relevant trademark is recognizable within the disputed domain name, the addition of descriptive terms would not prevent a finding of confusing similarity.”).

Also, the extension “.com” typically adds no meaning or distinctiveness to a disputed domain name and may be disregarded in the Paragraph 4(a)(i) analysis. *Novartis AG v. Wei Zhang*, 103365 (CAC December 9, 2020) (“it is generally accepted that the addition of the top-level suffix in the domain name (e.g., ‘.com’) is to be disregarded under the confusing similarity test”).

Accordingly, the Panel finds that the Complainant has rights to its claimed trademarks and that the addition of descriptive words thereto in the disputed domain names is insufficient to avoid a finding that they are confusingly similar to the Complainant’s trademarks. Thus, the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

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

Pursuant to Paragraph 4(a)(ii) of the Policy, a complainant has the burden of making a prima facie showing that the respondent has no rights or legitimate interests in a domain name. *Cephalon, Inc. v. RiskIQ, Inc.*, 100834 (CAC September 12, 2014). Once this burden is met, it then shifts to the respondent to demonstrate that it does have rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy offers the Respondent several examples of how to demonstrate its rights or legitimate interests in the disputed domain name.

With reference to Paragraph 4(c)(ii) of the Policy the Complaint states that the Respondent is not related in any way to the Complainant and has not received any license or authorization to use the Complainant’s trademark. The Respondent has not participated in this case and so it does not contest this. As such, the Panel concludes that the Respondent is not affiliated with the Complainant, nor is it authorized or licensed to use the Complainant’s trademark or to seek registration of any domain name incorporating the aforementioned trademark. Furthermore, the Registrar for the disputed domain names identifies the Registrants as Richard Nora and marten van gogh. There is no evidence that the Respondent is known otherwise and its illegitimate use of the Complainant’s trademark on its websites cannot support a different conclusion.

Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com", D2000-0847 (WIPO October 16, 2000) ("use which intentionally trades on the fame of another" should not be considered. "To conclude otherwise would mean that a Respondent could rely on intentional infringement to demonstrate a legitimate interest, an interpretation that is obviously contrary to the intent of the Policy.") Based upon the available evidence in this case, the Panel cannot conclude that the Respondent is commonly known by the disputed domain names or that it has any rights to the Complainant's trademark.

Next, under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy the Panel considers whether the Respondent is using the disputed domain name to make a bona fide offering of goods or services or whether it is making a legitimate non-commercial or fair use of the disputed domain name. The disputed domain names resolve to websites that make prominent use of the Complainant's trademark and claim to offer banking services. Using a confusingly similar domain name to pass oneself off as a Complainant is not a bona fide offering of goods or services or a legitimate non-commercial or fair use per Paragraphs 4(c)(i) or (iii) of the Policy. See *Ripple Labs Inc. v. Jessie McKoy / Ripple Reserve Fund*, FA 1790949 (FORUM July 9, 2018) (finding that the Respondent did not use the disputed domain name to make a bona fide offering of goods or services per Paragraph 4(c)(i) of the Policy or for a legitimate non-commercial or fair use per Paragraph 4(c)(iii) where the website resolving from the disputed domain name featured the Complainant's mark and various photographs related to the Complainant's business). Here, the Complainant claims that the Respondent uses the disputed domain names to pass itself off as the Complainant 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 provides screenshots of the Respondent's resolving websites and highlights that these sites fraudulently impersonate the Complainant by prominently featuring its trademark and content that claims to offer the same banking and credit services as those offered by the Complainant. The trademark is misspelled in certain places and at least one of the website pages displays a photograph of a third-party bank that bears no relation to the Complainant. The Respondent has not filed a Response nor made any other submission in this case. As the Complainant has made out a prima facie case that has not been rebutted by Respondent, upon a preponderance of the evidence before it the Panel finds that the Respondent fails to make a bona fide offering of goods or services or a legitimate non-commercial or fair use per Paragraphs 4(c)(i) or (iii) of the Policy.

C. The disputed domain names were registered and used in bad faith

The Complainant argues that the Respondent registered the disputed domain names in bad faith as it must have been aware of the Complainant's rights in the asserted trademarks at that time. Actual knowledge of rights in a trademark at the time of registering a disputed domain name is generally sufficient as a foundation upon which to build a case for bad faith under Paragraph 4(a)(iii) of the Policy, and can be demonstrated through a Respondent's use of such trademark. *Arcelormittal (SA) v. acero*, 102399 (CAC April 22, 2019) ("the Respondent's use of the disputed domain name and content of the web site under the disputed domain name prove Respondent's actual knowledge of the Complainant and its trademark.") The Complainant submits screenshots of the Respondent's websites which use copies of the Complainant's trademark and claim to offer banking services that are the same as those offered by the Complainant. Based upon this evidence it is asserted that the Respondent must have been aware of the Complainant's trademark. The Respondent does not attempt to refute this. In light of the Complainant's evidence and the fact that the asserted trademark is rather distinctive with respect to banking services and unlikely to be replicated by mere chance, the Panel finds it highly likely that the Respondent registered the disputed domain names with actual knowledge of the Complainant's trademarks.

Next, the Complainant argues that the Respondent registered and uses the disputed domain names in bad faith as the Respondent uses them to fraudulently impersonate and pass itself off as the Complainant. Using a confusingly similar domain to pass oneself off as a complainant can demonstrate bad faith per Paragraphs 4(b)(iii) and (iv) of the Policy. See *Abbvie, Inc. v. James Bulow*, FA 1701075 (FORUM November 30, 2016) ("Respondent uses the <abvue.com> domain name to impersonate Complainant's CEO. Such use is undeniably disruptive to Complainant's business and demonstrates bad faith pursuant to Policy Paragraph 4(b)(iii), and/or Policy Paragraph 4(b)(iv)"). The evidence in this case shows that the Respondent has, for commercial gain, posted websites through which it attempts to pass itself off as the Complainant to actual and potential customers. The Respondent has not participated in this case to explain its actions and so, based upon the available evidence, the Panel finds that the Respondent registered and uses the disputed domain names in bad faith by disrupting the Complainant's business, per Paragraph 4(b)(iii) of the Policy, and by seeking commercial gain through

confusion with the Complainant's trademarks, per Paragraph 4(b)(iv).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MIGROSPRIVATEONLINE.COM** : Transferred
 2. **MIGROSCREDIT.COM**: Transferred
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PANELLISTS

Name	Steven M. Levy, Esq.
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DATE OF PANEL DECISION 2021-07-23

Publish the Decision
