

Decision for dispute CAC-UDRP-103863

Case number CAC-UDRP-103863

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Domain names migros-kampagne.com

Case administrator

Organization Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization MIGROS-GENOSSENSCHAFTS-BUND

Complainant representative

Organization SILKA AB

Respondent

Name Nusret Yilmaz

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 name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of, inter alia, a number of trademarks consisting of MIGROS, including the following examples:

- Swiss Trademark n° 415060 MIGROS (word mark), registered on February 13, 1995, in international classes 35, 36, 37, 38, 39, 40, 41 and 42;

- Turkish Trademark n° 2015 24515 MIGROS (and design), registered on October 9, 2016, in international classes 9, 16, 29, 30 and 35. This trademark is the Turkish designation of International trademark n° 1239152;

- Turkish Trademark n° 2015 24514 MIGROS (and design), registered on October 9, 2016, in international classes 9, 16, 29, 30 and 35. This trademark is the Turkish designation of International trademark n° 1239152;

- European Union ("EU") Trademark n° 000744912 MIGROS (word mark), registered on July 26, 2000, in international classes 1, 2, 3, 4, 6, 7, 8, 9, 11, 12, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 34, 35, 36, 37, 38, 39, 40, 41 and 42;

- European Union ("EU") Trademark n° 003466265 MIGROS (word mark), registered on May 13, 2005, in international class 35; and

- United States of America Trademark n° 6026436 MIGROS (word mark), registered on April 7, 2020, in international class 35.

FACTUAL BACKGROUND

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

The Complainant in this proceeding is MIGROS-GENOSSENSCHAFTS-BUND, a Swiss retail company founded in 1925 by Mr. Gottlieb Duttweiler. Today, the Complainant is owned by its more than 2 million cooperative members, organized into ten regional cooperatives.

The Complainant is currently one of the forty largest retailers in the world and it is active in manufacturing and wholesaling through more than 30 companies (about 25 Swiss-based and around 10 abroad) in many commercial areas. For instance, Complainant operates supermarkets (MIGROS), furniture stores (MICASA), electronic retail stores (M-ELECTRONICS), gas stations (MIGROL), travel agencies (HOTELPLAN), convenience stores (MIGROLINOS), bookstores (EX LIBRIS), or the fifth-largest bank in Switzerland (MIGROS BANK), among other ventures.

Complainant's MIGROS mark was registered and has been in use well before the registration of the disputed domain name which was registered on May 16, 2021. The disputed domain name does not currently resolve to an active website.

PARTIES CONTENTIONS

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).

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") establishes that the threshold test for confusing similarity under the Policy involves a comparison between the trademark and the domain name to assess whether the trademark is recognizable within the domain name.

In this case, the disputed domain name consists of the use of the Complainant's trademark MIGROS, together with a hyphen, the term "kampagne" and the gTLD ".com". Account must be taken to the fact that the term "kampagne" is translated into English as "campaign" which is defined as "a planned series of activities that are intended to achieve a particular aim" and is widely used in the retail industry to make reference, for example, to marketing or advertising campaigns. Therefore, the term "kampagne", does not serve to alleviate the confusing similarity between Complainant's marks and the disputed domain name. It is well-established that the addition of other terms (whether generic, descriptive, geographical, pejorative, meaningless, or otherwise) to a complainant's mark does not prevent a finding of confusing similarity between a domain name and that mark.

See for instance:

"Similarly, numerous prior panels have held that the fact that a domain name wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other words to such marks. (e.g. EAuto, L.L.C. v. EAuto Parts, WIPO Case no. D2000-0096; Caterpillar Inc. v. Off Road Equipment Parts, WIPO Case no. FA0095497)." (CAC Case No.102384)

Finally, although the disputed domain name also incorporates the generic Top-Level Domain (“gTLD”) “.com”, it does not have capacity to dispel confusing similarity between the disputed domain name and the mark for the purposes of the Policy. It is important to highlight that gTLDs are commonly view as a standard registration requirement, and as such they are disregarded under the first element confusing similarity test (WIPO Overview 3.0, section 1.11). This approach has been stated in a number of previous CAC decisions, such as the following example:

“UDRP panels also agree that the top-level domain is usually to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the Complainant’s trademark as it is a technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).” (CAC Case No. 102396)

In view of the above, since the disputed domain name contains the Complainant’s distinctive MIGROS mark with the mere addition of generic term “Kampagne” and the gTLD “.com”, which may be disregarded for the purposes of the comparison in this proceeding, it can be concluded that the disputed domain name is identical or confusingly similar to a mark in which the Complainant has rights. Therefore, the conditions in paragraph 4(a)(i) of the Policy are fulfilled.

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).

In accordance with WIPO Overview 3.0, section 2.1, “[w]hile the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.”

Section 4(c) of the Policy sets out certain circumstances that, if proven by the evidence presented, may demonstrate the respondent’s rights or legitimate interests in the domain name. In the present case, however, none of those circumstances applies. In this respect, the Complainant notes that:

- The Respondent is not a licensee of the Complainant, and it has not received any consent, permission, authorization or acquiescence from the Complainant to use its MIGROS trademarks in association with the registration of the disputed domain name;
- There is no evidence that the Respondent has been commonly known, by the disputed domain name;
- With reference to the previous contention, a search in Google of “migros-kampagne” shows that the results are referred to the Complainant and its activities. Therefore, it is more than likely that Internet users will associate the disputed domain name with the Complainant and its activities, when in fact they are not related;
- The Complainant has found nothing to suggest that the Respondent owns any identical or similar trademarks to “migros-kampagne” (see the results of the search carried out on the WIPO Global Brand Database);
- The disputed domain name does not resolve to an active website. However, it previously resolved to a website which prominently displayed the Complainant’s MIGROS design mark and the messages “7200 CHF und 5700 CHF für die ersten 1000 Personen” and “7200 CHF für die ersten 1000 Leute! Und 5200 CHF! iPhone XS für die ersten 1000 Personen!!” (“7200 CHF and 5700 CHF for the first 1000 people” and “7200 CHF for the first 1000 people! And 5200 CHF! iPhone XS for the first 1000 people!!”). Likewise, the website had a section where Internet users could introduce their credit card numbers to benefit from the alleged prize. Therefore, it can be concluded that the Respondent has been using the disputed domain name to pass itself off as the Complainant, with the unlawful purpose of obtaining personal information and credit card numbers. In

this sense, a number of previous UDRP panels and section 2.13.1 of the WIPO Overview 3.0 state that the impersonation of a complainant cannot confer rights or legitimate interest on a respondent.

In relation to this, please find below some CAC Decisions in support of this finding:

“Additionally, as per the evidence on record, the Respondent, in the website that resolves from the Disputed Domain Name, utilized the Complainant’s trademark and reproduced the look and feel of one of the Complainant’s websites, giving the appearance that the Disputed Domain Name is directly related to the Complainant. This is further supported by the use of the generic term “planta” in the Disputed Domain Name, which is meant to further cement the misrepresentation, which in the view of the Panel amounts to impersonation/passing off in the terms described under paragraph 2.13.1 of WIPO Overview 3.0. This passing off, under no circumstances, can confer rights or legitimate interests on the Respondent and there is no available evidence on record that would otherwise allow the Panel to find any rights or legitimate interests for the Respondent in the Disputed Domain Name.” (CAC Case No. 102256)

“[...] While the disputed domain name <avastcenter.com> currently does not resolve to an active webpage, it used to refer to a website bearing the Complainant's trademarks, copyrighted logo and links to the Complainant's privacy policy and license agreement. The evidence of the case shows that the Respondent previously used the website connected to the disputed domain name <avastcenter.com> to mislead Internet users into believing that the download link posted on the website was genuine and either the product of, or endorsed by, the Complainant.

Panels have categorically held that the use of a domain name for illegal activity (e.g., phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on the Respondent.” (CAC Case No. 101962).

Finally, bearing in mind that:

- a) the disputed domain name reproduces in full the Complainant’s well-known MIGROS mark;
- b) the only difference between the disputed domain name and the Complainant’s MIGROS mark is the term “kampagne”, which exaggerates the impression that the disputed domain name is somehow affiliated with the activities carried out by the Complainant;
- c) Internet users commonly associate “migros-kampagne” with the Complainant; and
- d) the disputed domain name resolved to a website which prominently displayed the Complainant’s MIGROS design mark.

The Panel contends that the disputed domain name implies a high risk of implied false affiliation with Complainant and its activities (see WIPO Overview 3.0, section 2.5.1).

In view of all these circumstances, it is highly unlikely that the Respondent intended to use the disputed domain name for any legitimate or fair use. Likewise, the Panel cannot conceive any possible use in which the use of the disputed domain name would not infringe its rights in MIGROS. Therefore, the Panel asserts that the Respondent has no rights or legitimate interests in the disputed domain name and that the requirements of Paragraph 4(a)(ii) of the Policy are fulfilled.

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). Bad faith Registration.

According to the evidence submitted with the Complaint, the Complainant’s MIGROS mark was registered and has been in use well before the registration the registration of the disputed domain name. Considering that the disputed domain name

reproduces in full the Complainant's well-known MIGROS mark together with the generic term "kampagne"; and that Internet users commonly associate "migros-kampagne" with the Complainant, it is not possible to conceive of a plausible situation in which Respondent would have been unaware of Complainant and Complainant's mark when the disputed domain name was registered.

Moreover, previous UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous trademark by an unaffiliated entity can by itself create a presumption of bad faith (see section 3.1.4 of the WIPO Overview 3.0). "Given the well-known character of the MIGROS trademark and the existence of the MIGROS BANK, the name of which is protected by the MIGROSBANK trademark, the Respondent could not ignore the MIGROS and MIGROSBANK trademarks when it registered the disputed domain name." (CAC Case No. 101876)

"The Panel is of the opinion that due to the earlier rights of the Complainant on the trademark "MIGROS" trademark registered worldwide, the Respondent, located in the United States of America, was aware of the Complainant and its globally well-known "MIGROS" trademark at the time of the registration of the Disputed Domain Name." (CAC Case No.101810)

Finally, pursuant to section 3.2.1 of the WIPO Overview, "Particular circumstances panels may take into account in assessing whether the respondent's registration of a domain name is in bad faith include: [...] (iii) the content of any website to which the domain name directs, including any changes in such content and the timing thereof". Since the disputed domain name resolvee to a website which prominently displayed the Complainant's MIGROS design mark, this fact supports the inference that the Respondent registered the disputed domain name in bad faith, in order to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with Complainant's MIGROS mark.

In view of all these circumstances, the Panel asserts that the Respondent had the Complainant's rights in mind at the time of registration of the disputed domain name, which amounts to a registration in bad faith.

In this case, the disputed domain name does not currently resolve to an active website. However, "Passive holding of the disputed domain name does not preclude a finding of bad faith given the overall circumstances of the case. In this respect, see section 3.3 of the WIPO Overview 3.0 and Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, which found that the passive holding of a domain name can constitute bad faith in certain circumstances, particularly where the trade mark in question has a strong reputation and is widely known." (Instagram, LLC v. Zafer Demir, Yok, WIPO Case No. D2019-1072).

As previously stated, the disputed domain name previously resolved to website which prominently displayed the Complainant's MIGROS design mark and invited Internet users to provide their credit card numbers in order to receive money or a telephone. Therefore, the Respondent has used the disputed domain name in an effort to impersonate the Complainant, or otherwise mislead Internet users as to the source of the Respondent's website, in order to engage them in a phishing scheme. In this regard, previous UDRP panels have stated that phishing is a clear evidence of registration and use of a domain name in bad faith.

See, for instance:

"The evidence outlined above that the Respondent is falsely suggesting he is connected and/or authorised by the Complainant in order to gather personal information for phishing purposes is evidence that the Responded has acted in opposition to the Complainant's commercial interests and has unduly disrupted the business of the Complainant.

The use of the Complainant's mark, bird logo and similar trade dress to that of the Complainant on the site attached to the Domain Name demonstrates that the Respondent had actual knowledge of the Complainant its rights, business and services. In the opinion of the Panel the use made of the Domain Name in relation to the Respondent's site is confusing and deceptive in that visitors to the Respondent's site might reasonably believe it is connected to or approved by the Complainant when there is no connection due to deceptive use of the Complainant's mark, bird logo and similar trade dress. Accordingly, the Panel holds additionally that the Respondent has intentionally attempted to attract for commercial gain

Internet users to his website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of that web site or services offered on it."

(Auchan Holding SA v. WhoisGuard Protected / WhoisGuard, Inc. / Daniel Morgan, WIPO Case No. D2021-0797)

"The Complainant asserts that Respondent was using its website to obtain personal information from Internet users. Using a domain name to attempt to pass off as the Complainant is not a bona fide offering of good and services or a legitimate noncommercial or fair use. A fishing activity is also a probable consequence to have such a similar web site.

The presence of fishing activities is a proof of a bad faith as established in two CAC Cases 101856 and 101857 ENIBANQUE.COM and BANQUE-ENI.com in which it was stated that: "The presence of a fishing activity in a connected domain name is a clear evidence that the Respondent is involved in a scientific bad faith project aiming at duplicating BANQUE ENI web site and communications to the world". (CAC Case No. 102223)

Taking the above into consideration, it can be concluded that the Respondent intentionally attempted to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with the Complainant's MIGROS trademark as to the source, sponsorship, affiliation or endorsement of this website. Such circumstances are evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

Moreover, the disputed domain name is associated with mail servers ('MX servers') that enable the Respondent to use it for creating and using e-mail addresses composed with "@migros-kampagne.com". These e-mail addresses, could, be used for any purposes and notably for spamming or phishing purposes, to obtain banking and personal data from the Complainant's customers and to misuse these data, being this MX association an additional evidence of bad faith.

See KingfisherInvestissements v. BricoDepot, BricoDepot, WIPO Case No. D2020-2702:

"The Panel also notes that the Complainant has argued and provided evidence that the disputed domain name has been used to activate a mail exchanger record (MX Record). Previous UDRP decisions inferred a bad faith behavior from the activation of MX servers, which can be used to create email addresses for phishing purposes (see Robertet SA v. Marie Claude Holler, WIPO Case No. D2018-1878)."

Finally, the Complainant wishes to point out that the Respondent's use of a privacy registration service for the disputed domain name is an additional indication for a finding of bad faith registration and use, as decided in earlier CAC cases.

See, for instance, the below Decisions:

"Further, it would appear that whoever is actually behind the registration, that person or entity has decided to use the services of a "privacy service" that does not reveal the identity of the underlying registrant in response to a registrar verification request made in the course of UDRP proceedings. That is also an indicator of bad faith registration and use (as to which see the last paragraph of section 3.6 of the WIPO Overview 3.0 and the decision in 1IQ PTY LTD v. 1337 Services LLC WIPO Case No. D2017-2156)." (CAC Case No. 102110)

"The Panel underlines that the Respondent did conceal its identity behind a privacy service; it has often been observed in cases under the Policy that this is not, in and of itself, indicative of bad faith though it may be one of several cumulative factors to be weighed in the balance (see, for example, WIPO case No. D2017-0453)".

In view of all these circumstances, the Respondent's conducts prove that the disputed domain name was registered and is being used in bad faith. Therefore, the Panel considers that the third element of the Policy is deemed satisfied.

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 Respondent intentionally attempted to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with the Complainant's MIGROS trademark as to the source, sponsorship, affiliation or endorsement of this website. The disputed domain name previously resolved to website which prominently displayed the Complainant's MIGROS design mark and invited Internet users to provide their credit card numbers in order to receive money or a telephone. Therefore, the Respondent has used the disputed domain name in an effort to impersonate the Complainant, or otherwise mislead Internet users as to the source of the Respondent's website, in order to engage them in a phishing scheme.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. MIGROS-KAMPAGNE.COM: Transferred

PANELLISTS

Name	Thomas Hoeren
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DATE OF PANEL DECISION 2021-07-28

Publish the Decision