

Decision for dispute CAC-UDRP-103954

Case number	CAC-UDRP-103954
Time of filing	2021-08-24 09:08:14
Domain names	avastsubscriptions.com

Case administrator

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

Organization	Avast Software s. r. o.
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Complainant representative

Name	Rudolf Leška
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Respondent

Name	Seikh Jawed
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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 name.

IDENTIFICATION OF RIGHTS

Complainant owns rights in the sign “AVAST” and shows its following trademarks have been accepted and are in force:

- United States trademark “AVAST” No. 85378515, registered on July 17, 2012, for goods and services in class 9;
- United States figurative trademark “A AVAST” No. 87236956, registered on September 5, 2017, for goods and services in class 9 and 42.

Complainant also cited some other trademarks but did not show if they were still registered or in which countries.

Complainant also operates the domain name <avast.com> registered since October 5, 1997.

FACTUAL BACKGROUND

Complainant is one of the largest security software companies in the world using next-gen technologies to fight cyberattacks in real time.

Respondent is Seikh Jawed, located in India.

On June 11, 2021, Respondent registered the disputed domain name <avastsubscriptions.com> which is inactive. However, from e-mail address noreply@avastsubscriptions.com, Complainant's customers received a phishing e-mail containing confirmation of order of McAfee Antivirus, that is not one of Complainant's products. Nevertheless, by clicking on the button contained in the e-mail, harmful malware is installed.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

1) Complainant argues that the disputed domain name is confusingly similar to its trademarks.

Complainant considers that the dispute domain name is confusingly similar to the Complainant's registered trademarks.

Complainant establishes that the word at the core of its trademarks, "AVAST", is highly distinctive, and that its trademarks are globally known brand with reputation selling on the 7th rank among antivirus software globally. In addition, Complainants argues that the word "AVAST" is automatically connected with it by an ordinary customer. Therefore, according to Complainant and based on previous UDRP decisions Complainant upholds its trademarks are widely well known.

Complainant emphasizes that the addition of a specific top level of a domain name such as ".COM", ".ORG", ".TV" or ".NET" does not affect the domain name for the purpose of determining the identity or similarity of domain name and a trademark.

Furthermore, to highlight the fact that the disputed domain name is confusingly similar to Complainant's trademarks "AVAST", Complainant describes the descriptiveness of the part "-subscriptions" of the disputed domain name, asserting that it evokes that the disputed domain name serves for the administration of subscriptions of Avast products.

Additionally, Complainant considers that the missing "s" in the part "-subscriptions" of the disputed domain name can be very easily overlooked by internet users, and that does not eliminate the confusing similarity with the older trademarks of the Complainant. Complainant estimates that, quite on the contrary, it makes the confusion more likely as it makes an impression that the website is operated by the Complainant itself, and that customers will think that they are accessing a website affiliated with the Complainant.

2) Complainant further asserts that Respondent does not have any rights or legitimate interests in the disputed domain name.

Complainant recalls that it must make a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name, and that once such case is made, Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name.

Complainant argues that Respondent is not commonly known under the disputed domain name nor under the distinctive part "AVAST" before the beginning of the dispute, nor ownership of any identical or similar trademark, nor use of any identical or similar brand by the Respondent before the registration by the Respondent of the disputed domain name.

Moreover, Complainant asserts that Respondent was never granted neither license nor authorization to make any use of the disputed domain name.

Furthermore, Complainant highlights that Respondent did not use the disputed domain name or a name corresponding to the

disputed domain name in connection with a bona fide offering of goods or services because Respondent has not provided the trademarked goods and services but has used the trademark for illegal activity, that is, phishing.

Finally, the disputed domain name is inactive, however registered in order to create trustworthy looking e-mail address for phishing purposes, according to Complainant.

3) Complaint finally comes down to the conclusion that Respondent's registration and use of the disputed domain name amounts to bad faith.

First, Complainant maintains that there is no indication that the disputed domain name was registered and used in bona fide and that Respondent was aware of the registration and the use of the Complainant's trademarks before the registration of the domain name.

Besides, Complainant affirms that it has a considerable reputation in the software sector due to its expanded exposure and its trademark and presence on the Internet through many domains incorporating the word AVAST.

Complainant further asserts that the Internet makes it easier to find out that it is well-known across national borders because a simple search on the Internet would reveal Complainant trademark and domain names presence.

Thus, Complainant claims that it is not conceivable that Respondent would not have had actual notice of the Complainant's trademark rights when registering the disputed domain name. Complainant stresses that Respondent could, without difficulties, perform a similar search before registering the disputed domain name and would have then quickly learned that Complainants owns the AVAST trademarks and that the said trademarks have been used globally by Complainant.

Besides, Complainant states that Respondent's use of the disputed domain name through a parking page cannot amount to legitimate use, especially as Respondent has not demonstrated any activity in respect of the disputed domain name and assimilates it to passive holding, which is evidence that Respondent is using the disputed domain name in bad faith.

Also, Complainant goes on arguing that the disputed domain name seeks to take advantage of an association with its businesses and its trademarks and that Respondent abuses the good reputation of Complainant and its products for phishing activity. Complainant concludes that such action constitutes bad faith.

Based on previous Panels decisions, Complainant contends that the mere registration of a domain name that comprises typos or incorporates the well-known trademarks plus a descriptive term by an unaffiliated entity can by itself create a presumption of bad faith.

Regarding the passive holding of the disputed domain name by Respondent, Complainant relies that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding.

Besides, Complainant puts forward that its trademarks are distinctive and well-known in its industry. Therefore, Complainant believes that Respondent concealed its identity is also a factor to deduce bad faith.

Finally, Complainant contends that there is no plausible reason why Respondent registered the disputed domain name other than to intentionally attempt to attract for commercial gain Internet users to its website or another online location, and to tarnish the trademarks at issue, by creating a likelihood of confusion with the Complainant's trademarks.

RESPONDENT:

Respondent did not provide any response to the complaint, and is therefore in default.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4(a) of the Policy requires the Complainant to prove three elements in order to the transfer of the disputed domain name:

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

RIGHTS

Complainant shown it has valid trademark rights in the “AVAST” sign.

The Panel agrees and considers Complainant’s trademark rights in the sign AVAST are established.

The Panel also agrees that the disputed domain name is confusingly similar to the disputed domain name as it identically reproduces Complainant’s trademark “AVAST”, with the addition of the word “-subscriptions” and the gTLD “.COM”, which do not permit to dismiss the likelihood of confusion with the “AVAST” trademarks.

Under Policy 4(a)(i), top-level domains are indeed generally disregarded in the similarity test, see *ARCELORMITTAL (SA) v. acero*, Case n° 102399 (CAC March 20, 2019) “As stated in WIPO Overview 3.0 “. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing” (see par. 1.7).

In the present case the Complainant’s “ArcelorMittal” trademark is clearly recognizable in the disputed domain name. The addition of the “mx” element does not change an overall impression of the disputed domain name and indicates connection with Mexico where the Complainant has business activity.

The .com domain zone shall be disregarded under the identity or the confusing similarity test as it does not add anything to the distinctiveness of the disputed domain name.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.”.

As a result, the Panel finds that Complainant has satisfied Policy 4(a)(i).

NO RIGHTS OR LEGITIMATE INTERESTS

Complainant shall make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name, under Policy 4(a)(ii). The burden of proof then shifts to Respondent. This standard and burden of proof have been established through continuous case law, see *LESAFFRE ET COMPAGNIE v. Tims Dozman*, Case No. 102430 (CAC, April 2, 2019) “The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP (please see, for example, WIPO case no. D2003-0455, *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*).”.

Complainant asserts that Respondent is not commonly known under the disputed domain name, and that Complainant never granted any right or authorization to Respondent to use Complainant’s trademarks.

In addition, it can be highlighted that Respondent did not reply to the complaint. Previous panels have held that such mutism from the Respondent's part was proof that Complainant and Respondent had no relation and that Respondent is not commonly known under the disputed domain name (see FILEHIPPO S.R.O. v. whois agent, Case No. 102279 (CAC January 31, 2019), "In the absence of a response, the Panel accepts the Complainant's allegations as true that the Respondent has no authorization to use the Complainant's trademarks in the disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.").

Therefore, the Panel concludes that Complainant has made a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name and has therefore satisfied Policy 4(a)(ii).

BAD FAITH

Complainant argues that given the distinctiveness and reputation of its trademark and domain name containing its trademark "AVAST", Respondent could not ignore Complainant's prior rights when registering the disputed domain name. In addition, Complainant asserts that a Google research should have shown Respondent that Complainant beneficiaries from a solid and global reputation.

The Panel acknowledges the well-known nature of the "AVAST" trademarks in the field of security software. Therefore, Respondent could not ignore Complainant's rights at the time of registration. Previous Panels concluded that such domain name registration when the Complainant is well-known is a typical case of bad faith registration (see JCDECAUX SA v. Charles Russam, Case No. 102392 (CAC March 13, 2019) "According to most panels, the complainant is required to make out a prima facie case that the domain name has been registered and is being used in bad faith. Once such prima facie case is made, the respondent carries the burden of demonstrating that this is not the case.

To the Panel's view, elements and information provided for by the Complainant at that stage, are sufficient to establish such prima facie case, notably because of the following:

Given the reputation of the Complainant, the Respondent could hardly ignore the Complainant's existence and activities when registering the disputed domain name.").

Complainant further asserts that the disputed domain name resolves to an inactive page, registered to create a trustworthy looking e-mail address for phishing purposes.

Previous panels have found that such behaviour was evidence that Respondent was showing disputed domain name registration and use, in bad faith (see Crédit Foncier de France v. WhoisGuard Protected, WhoisGuard, Inc. / Uyi Edionwe, WIPO Case No. D2019-3037 (January 22, 2020), "Respondent is using the disputed domain name, which it registered long after Complainant's trademark CRÉDIT FONCIER had become famous in France, to resolve to an inactive web site. Moreover, it is impossible to conceive of any legitimate use to which the disputed domain name could be put that would not constitute a bad faith use of Complainant's well known trademark. See, e.g., Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. Accordingly, the Panel finds that Respondent has registered and is using the disputed domain name in bad faith.").

Finally, the disputed domain name comprises typos in the additional generic term "subscription" (missing the letter "s" after the letter "b"). Panel finds that this is a typical case of typosquatting.

Consequently, the Panel finds that Respondent did not register the domain name in connection to any bona fide offering of goods or services and that it then was not registered in good faith.

Furthermore, Complainant outlines that the disputed domain name may be actively used for e-mail purposes, more precisely, for phishing purposes, as confirmed by the evidence brought by Complainant. Previous panels found that this behaviour constituted evidence of Respondent's use in bad faith, see Bouygues v. Name Redacted, WIPO Case No. D2021-1666, July 8, 2021, "Furthermore, the Panel notes that previous UDRP panels inferred a bad faith behavior from the activation of MX-servers by the respondent, which enable the creation of email addresses for commercial emailing, spamming or phishing purposes (see Robertet SA v. Marie Claude Holler, WIPO Case No. D2018-1878).".

The Panel considers that such use cannot be considered as a use in good faith. Moreover, the fraudulent e-mails that are sent through the disputed domain name refers to another software that is not produced by Complainant but remains in the same field of activity.

Therefore, Panel considers that the disputed domain name is also used in bad faith.

Following the above, the Panel considers that the disputed domain name was 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

Complainant holds trademark rights for the AVAST sign. The disputed domain name is reproducing Complainant's trademark. Respondent failed to establish legitimate rights or legitimate interests in the disputed domain name. Complainant has established that Respondent registered and uses the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **AVASTSUBSCRIPTIONS.COM**: Transferred

PANELLISTS

Name	Nathalie Dreyfus
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DATE OF PANEL DECISION	2021-09-28
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Publish the Decision	
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