

Decision for dispute CAC-UDRP-103980

Case number CAC-UDRP-103980

Time of filing 2021-10-19 09:27:45

Domain names avastsecurityt.com

Case administrator

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

Complainant

Organization Avast Software s. r. o.

Complainant representative

Name Rudolf Leška

Respondent

Organization PenetrationIT

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 registered trademarks across various jurisdictions, including:

- registered international word mark "AVAST!" no. 1011270 for goods and services in the classes 9, including software (Czech application with designation for AU - DK - EE - FI - GB - GR - IE - JP - LT - SE - TR and by virtue of Article 9sexies of the Madrid Protocol also for the following countries: AT - BG - BX - CN - CY - DE - FR - HU - IT - LV - PL - PT - RO - RU - SI - SK - VN) with registration date April 15, 2009;

- registered international word mark "AVAST" no. 839439 for goods and services in the classes 9 and 42, including software (German registration with designation for AU - DK - EE - FI - GB - GR - IE - JP - LT - SE - TR - US and by virtue of Article 9sexies of the Madrid Protocol also for the following countries: AT - BG - BX - CH - CN - CY - FR - HU - IT - KZ - LV - PL - RO - RU - SI - SK) with registration date June 22, 2004;

- registered EU word trademark "AVAST" no. 010253672 for goods and services in the classes 9, 16, 42 with priority since August 25, 2011;

- registered US word trademark "AVAST" no. 85378515 for goods and services in the classes 9 with priority from July 22, 2011 and with registration date July 17, 2012;

- registered US figurative trademark "avast" no. 87236956 for goods and services in the classes 9, 42 with priority since November 15, 2016 and with registration date September 5, 2017;

- registered international figurative trademark "avast" no. 1376117 for goods and services in the classes 9, 42 (US application with designation for CO – DE – FR – IT – MX – RU) with registration date May 10, 2017;

- registered Indian national trademark "avast!" No. 1827321 for goods in class 9 with priority date June 9, 2009; and

- registered UK word trademark "AVAST" no. UK00910253672 for goods and services in the classes 9, 16, 42 with priority from August 25, 2011.

The Complainant proved its ownership of listed trademark registrations by submitted excerpts from the pertinent trademark Registers.

FACTUAL BACKGROUND

The Complainant is one of the largest security software companies in the world using next-gen technologies to fight cyberattacks in real time. It is a Czech Republic based security software company with reputation selling on the 7th rank among antivirus software globally. It has tradition since 1988 and more than 400 million users. It trades under the name "AVAST", which has no specific meaning in modern English.

The Complainant is the owner of numerous trademarks consisting of the word "AVAST" registered in relation to, inter alia, software.

The Complainant distributes its products via its website located at www.avast.com where a customer can find product information and can directly download AVAST software. On this official website (under <avast.com> domain name), the Complainant also offers customer support relating to AVAST software and administration of AVAST account.

According to the Registrar, the Respondent is PenetrationIT. It provides its address as being at New York, California, in the United States. It registered the disputed domain name on October 7, 2021. The disputed domain name does not resolve to an active website.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

A. The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademarks.

The Complainant assumes that the word "AVAST" is automatically connected with the Complainant by an ordinary customer. The Complainant claims its trademarks are globally well-known and enjoy good reputation. In this respect, it points out CAC case No. 101909, CAC case No. 101917, CAC case No. 103911, CAC case No. 103954.

According to the Complainant, it is well established that the specific top level domain, 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 (WIPO Case No. D-2000-1525; WIPO case No. DTV2000-0001; WIPO case No. DBIZ2002-00148; WIPO case NO. DTV-2008-0003).

The Complainant states that the disputed domain name contains the Complainant's trademark AVAST and the word "-security" and the typo "-t". The part "-security" is descriptive in nature meaning protection or safe keeping. The Complainant adds that such word included in the disputed domain name misleadingly indicates that under the disputed domain name, the Complainant's products and services used to ensure the safety against the viruses are provided. The part consisting of descriptive word "-security" is not able to change overall impression and does not eliminate the confusing similarity with the older trademarks of the Complainant. In the view of the Complainant, the typo "-t" placed at the end of the word "-security" can be very easily overlooked by internet users. The Complainant assumes that this is typical case of typosquatting. It is almost inevitable that when consumers access the website www.avastsecurityt.com, they will think that they are accessing a website affiliated with the Complainant.

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

First, no evidence suggests that the Respondent has been commonly known within the consumers by the disputed domain name or by the distinctive part "AVAST" before the beginning of this dispute nor ownership of any identical or similar trademark nor use of any identical or similar brand by the Respondent before the registration of the contested domain name. The Complainant did not grant any license or authorization to register or use the disputed domain name by the Respondent.

Second, before the dispute, the 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 he has not provided the trademarked goods and services but has used the trademark for illegal activity.

Third, the disputed domain name is inactive, however, registered in order to participate in malicious conduct – for the distribution of malwares.

C. The Complainant contends that the disputed domain name has been registered and is being used in bad faith.

The Complainant argues that the disputed domain name was registered for malicious purposes. According to the Complainant's findings, the disputed domain name is used for the distribution of malware by serving a malicious Command and control server used by attackers to distribute and control malware. As a malicious and infected source, it was recognized by nine security vendors according to www.virustotal.com. In the Complainant's opinion, the disputed domain containing "AVAST" trademark was registered for the purpose of misleading customers in order to attack their computers by malware.

Furthermore, the Complainant states that there is no indication that the disputed domain name was registered and used in bona fide and that the Respondent was clearly aware of the registration and the use of the Complainant's trademarks before the registration of the domain name. According to the Complainant, the registration of the disputed domain names seeks to take advantage of an association with the businesses of the Complainant and its trademark – the Respondent abuses the good reputation of the Complainant and its products for malicious (fraudulent) activity. In the view of the Complainant, this constitutes bad faith.

The Complainant points out that according to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") the non-use of a domain name (including a blank page) would not prevent a finding of bad faith under the doctrine of passive holding. The Complainant's follows that its trademarks are distinctive and well-known in its industry, the Respondent abuses the Complainant's well-known trademarks for illegal activity, the Respondent concealed its identity, there is not any reasonable justification why the disputed domain name should include the Complainant's trademark (use of the disputed domain name by any third party different from the Complainant will infringe the Complainant's rights).

The Complainant concludes that the disputed domain name is used by the Respondent to reach the Complainant's

customers (even in the future). This could suggest (incorrectly) that the Respondent operates as an affiliate or a partner of the Complainant or has Complainant's authorization to use its trademark.

The Complainant adds that the bad faith of the Respondent is further supported by the fact that the Respondent has concealed its identity, under the disputed domain name there are not any contact details of the Respondent. In addition to that, the use of a proxy service by the true owner hidden behind the Respondent is often by itself an indicator of bad faith.

RESPONDENT:

No administratively Complaint 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).

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 the Policy were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

I. CONFUSING SIMILARITY

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks consisting of "AVAST" verbal element.

The WIPO Overview 3.0 in Paragraph 1.2.1 states: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The WIPO Overview 3.0 in Paragraph 1.7 states: "[...] 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."

Using of the generic Top-Level Domain ".com" is generally disregarded in the similarity test "as it does not add anything to the distinctiveness of the disputed domain name" (CAC case No. 102399).

In the present case, the Complainant's trademark "AVAST" is clearly recognizable in the disputed domain name. The Complainant owns numerous "AVAST" trademarks registered for, inter alia, software in various jurisdictions, such as, the United States of America, European Union, India etc. These trademarks enjoy good reputation and are globally well known which was confirmed in the previous Panel decisions (CAC case No. 101909 or CAC case No. 101917).

The added elements "-securityt" do not change an overall impression of the disputed domain name. Moreover, the

Complainant's trademarks relate to the software security, so the confusing nature is increased by using the descriptive word for safety, i.e., security.

The disputed domain name <avastsecurityt.com>, as it reproduces "AVAST" trademark in its entirety, with the addition of the descriptive word "-security" and the typo "-t" is considered to be confusingly similar to the relevant trademark.

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

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DOMAIN NAME

The Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name.

The WIPO Overview 3.0 in Paragraph 2.13.1 states: "Panels have categorically held that the use of a domain name for illegal activity (e. g. [...], distributing malware) [...] can never confer rights or legitimate interests on a respondent."

According to Paragraph 4(a)(ii) of the Policy, the Complainant shall make case that the Respondent lacks rights and legitimate interests in the disputed domain name. If the Complainant fulfils this demand the burden of proof shifts to the Respondent and so the Respondent shall demonstrate rights or legitimate interests in the disputed domain name. If the Respondent fails to prove its rights or legitimate interests, it is assumed that the Complainant satisfied the element of Paragraph 4(a)(ii) of the Policy (see CAC case No. 102430). Moreover, the Panel is of the view that it is difficult or sometimes impossible to prove negative facts, i.e., absence of rights or legitimate interest on the part of the Respondent. In this respect, the Panel refers to WIPO case No. 2000-1769. Within the meaning of Paragraph 4(a)(ii) of the Policy, once the complainant has made something credible (prima-facie evidence), the burden of proof shifts to the respondent to show that he has rights or legitimate interests in the domain name at issue by providing concrete evidence.

In CAC case No. 102279, the Panel stated that "[i]n 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."

In the present case, the Complainant asserts that the Respondent is not commonly known under the disputed domain name, and that the Complainant never granted any rights or authorization to the Respondent to use the Complainant's trademarks. The Respondent did not reply to the Complaint and so failed to demonstrate its rights or legitimate interests in the disputed domain name.

Moreover, the Respondent used the disputed domain name for illegal activity of developing and distributing malware. This activity was proved by the submitted evidence – extracts from www.virustotal.com where nine security vendors identified the disputed domain as malware/malicious.

Therefore, the Panel finds that the Complainant has satisfied condition under Paragraph 4(a)(ii) of the Policy.

III. THE REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

The Panel finds that the Respondent registered and used the disputed domain name in bad faith.

The WIPO Overview 3.0 in Paragraph 3.2.1 states: "Particular circumstances panels may take into account in assessing whether the respondent's registration of a domain name is in bad faith include: (i) the nature of the domain name (e.g., a typo of a widely-known mark, or a domain name incorporating the complainant's mark plus an additional term such as a

descriptive or geographic term, or one that corresponds to the complainant's area of activity or natural zone of expansion)[...] (viii) other indicia generally suggesting that the respondent had somehow targeted the complainant."

The WIPO Overview 3.0 in Paragraph 3.4 states: "Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include [...] malware distribution."

In CAC case No. 102380, the Panel found that "This Respondent must have been aware of the Complainant's rights when it registered the disputed domain name, in light of its very well-known and famous nature. [...] the combination of the passive holding with the very close similarity between the disputed domain name and the Complainant's mark makes a finding of bad faith a real possibility."

In this case, the Complainant owns numerous trademarks consisting of "AVAST" verbal element that enjoy reputation. This was declared by previous decisions of the Panel (cited above) and proved by the submitted trademark registration's extracts. The Complainant asserts that it is one of the largest software security companies in the world. This contention has been proven by the evidence provided by the Complainant (reports from website monitoring – www.similarweb.com; internet searching screenshots – Google search of "avast.com"; followers on social media – Facebook, Twitter; the article "World's Top 10 Best Selling Antivirus 2017, Internet Security Software [online] www.trendingtopmost.com). The Panel states that the Respondent must have been aware of the Complainant's trademarks and their reputation before the registration of the disputed domain name on October 7, 2021.

Moreover, the Respondent used "AVAST" trademark in the disputed domain name into which he added the general descriptive word "security" and the typo "-t". In connection with use for malware distribution via the disputed domain name, the Panel concurs with the Complainant that the Respondent abused "AVAST" trademarks for malicious purposes.

Following the above mentioned, the Panel finds that the Complainant has satisfied requirement within the meaning of Paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. AVASTSECURITYT.COM: Transferred

PANELLISTS

Name	JUDr. Radim Charvát, Ph.D., LL.M.
------	-----------------------------------

DATE OF PANEL DECISION 2021-11-17

Publish the Decision
