

Decision for dispute CAC-UDRP-104645

Case number CAC-UDRP-104645

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Domain names migrosbank-ag.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization MIGROS-GENOSSENSCHAFTS-BUND

Complainant representative

Organization SILKA AB

Respondent

Name Gray Hunt

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 submitted evidence that it is the owner of the following trademarks "MIGROS" and "MIGROS BANK" (hereafter the "Trademarks"):

- Swiss Trademark (figurative trademark with word elements) "M MIGROS" no. 3P-268357, registered on December 28, 1973, in international classes 1-9, 11-12, and 14-34;
- International Trademark (figurative mark with word elements) "MIGROS" no. 315524, registered on June 23, 1966, in international classes 3, 7, 8, 9, 11, 21-31, 34;
- European Union Trademark (word trademark) "MIGROS" no. 000744912, registered on July 26, 2000, in international classes 1, 2, 3, 4, 6, 7, 8, 9, 11, 12, 14 - 32, 34, and 35-42;
- United States of America Trademark (word trademark) "MIGROS" no. 6026436, registered on April 7, 2020, in international class 35;
- Swiss Trademark no. 623618 (figurative mark with word elements) "MIGROSBANK", registered on December 12, 2011, in international classes 35 and 36;
- Swiss Trademark no. 764760 (figurative mark with word elements) "MIGROS BANK", registered on June 2, 2021, in

international classes 9, 35 and 36;

- International Trademark (word trademark) no. 1603319 "BANCA BANQUE MIGROS BANK", registered on June 1, 2021, in international classes 35 and 36. The trademark designates, inter alia, France and Italy; and
 - International Trademark (figurative mark with word elements) no. 1239151 "MiGROS", registered on December 31, 2014, in international classes 9, 16, 29, 30 and 35.
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FACTUAL BACKGROUND

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

The Complainant (MIGROS-GENOSSENSCHAFTS-BUND, a Swiss retail company founded in 1925 by Mr. Gottlieb Duttweiler) claims to be Switzerland's largest retailer and largest employer active in many commercial areas, with more than 97.000 employees and sales of CHF 28.93 billion in 2021 (in various markets including supermarkets, furniture stores, electronic retail stores, etc).

Migros Bank AG is one of the most relevant ventures of the Complainant. The Complainant asserts that Migros Bank AG is one of the largest and most established banks in Switzerland; the Complainant further asserts that Migros Bank AG is a wholly owned subsidiary, consisting of the parent company's financial services division and offering deposits, online banking, loans, mortgages, cards and payments, savings, investments, and insurance to both individuals and business customers.

The Complainant further claims to own the trademarks "MIGROS" and "MIGROS BANK" (i.e., the "Trademarks" as mentioned above). The Complainant submitted evidence that it is the registered owner of the Trademarks mentioned above under "Identification of rights".

The Complainant declares that its domain name <migrosbank.ch> (registered on March 20, 1996) hosts a website that displays information about its activities.

The disputed domain name was registered on May 1, 2022.

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).

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

PRINCIPAL REASONS FOR THE DECISION

1. Confusing similarity

The disputed domain name includes the Complainant's Trademarks MIGROS and MIGROS BANK along with a hyphen and the abbreviation "ag". According to the Complainant, these additions do not prevent confusion between the Complainant's Trademarks and the disputed domain name due to Section 1.7 of WIPO Overview 3.0, which provides that, "in cases where a domain name contains the whole of a trademark, or where at least one dominant feature of the relevant trademark is recognisable in the domain name, the domain name shall normally be considered confusingly similar to that trademark for the purposes of UDRP status".

It should be noted that "ag" is widely recognised (at least in German-language countries) as an abbreviation for "Aktiengesellschaft" (similar to a limited liability company). Section 1.8 of WIPO Overview 3.0 states: "Where the relevant mark is recognisable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) would not preclude a finding of confusing similarity under the first element". A number of UDRP panels have also stated in the past that the addition of non-distinctive elements (such as a hyphen in this case) is not sufficient to distinguish a domain name from a trademark.

Numerous previous panels have accepted that the incorporation of a trademark in its entirety into a domain name is sufficient to establish that the disputed domain name is identical or confusingly similar to a registered trademark. Indeed, in most cases where a domain name incorporates the entirety of a trademark, the domain name is, for the purposes of the Policy, considered as confusingly similar to the trademark.

In this case, the Panel notes that the disputed domain name incorporates the entirety of the Complainant's "MIGROS" and "MIGROSBANK" Trademarks. The Panel finds that the addition of the term "AG" and the ".com" gTLD does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy. The addition of the generic word "AG" (an abbreviation for "Aktiengesellschaft") does not change the finding of confusing similarity. If anything, this addition increases the risk of confusion with the Complainant's wholly owned subsidiary Migros Bank AG. The ".com" suffix may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which the Complainant has rights.

The Panel concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. Rights or legitimate interests

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous Panels have found that 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 burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then must weigh all the evidence, with the burden of proof always remaining on the Complainant.

The Complainant contends that:

- (1) The Respondent has not been authorised or licensed by the Complainant to use the Trademarks or the disputed domain name;
- (2) The disputed domain name does not correspond to the name of the Respondent;
- (3) The Respondent is not commonly known as the disputed domain name or by the term "migrosbank-ag";
- (4) The Respondent does not seem to own identical or similar trademarks to the disputed domain name;
- (5) The disputed domain name does not correspond to an active website;
- (6) The disputed domain name is not used in a fair or non-commercial way.

The Respondent did not file an administratively compliant (or any) response. In such circumstances, the Panel finds from the

facts put forward that:

There is no evidence to show that the Respondent has been commonly known by the disputed domain name. In fact, the results of a Google search of the disputed domain name mostly refer to the Complainant and its activities. There is no evidence that the Respondent is or has been commonly known, by the disputed domain name or by the term “migrosbank-ag”.

There is no evidence to show that the Respondent may have used the disputed domain name for any bona fide offering of goods or services of its own or has made any preparations to do so in the future.

There is no evidence to show that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademarks at issue. The Complainant has sufficiently shown that the Respondent does not appear to have any rights or legitimate interests associated with the Trademarks, nor with variations thereof such as “migrosbank-ag.com”. The trademark is clearly recognizable in the disputed domain name and the Respondent does not seem to own any registered trademarks consisting of the terms “MIGROS BANK” or “MIGROS”. The Respondent does not seem to have any consent to use the Trademarks or variations thereof. The disputed domain name does not correspond to the name of the Respondent. There is no evidence that the Respondent is commonly known by the Trademarks or with variations thereof such as “migrosbank-ag.com”.

In sum, on the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Panel concludes that the Respondent does not have rights or legitimate interests in the disputed domain name.

3. Bad faith

Bad faith Registration

The Complainant argues that the disputed domain name is “passively held”. The Complainant states that the disputed domain name was registered and is being used in bad faith since the webpage associated with the disputed domain name does not currently provide access to a site in use. The Complainant’s Trademarks “MIGROS” and “MIGROS BANK” have been in use well before the registration date of the disputed domain name. The disputed domain name was registered on May 1, 2022, whereas several of the Complainant’s trademarks were registered several decades ago.

Furthermore, the Complainant states that the Complainant’s Trademarks “MIGROS” and “MIGROS BANK” are distinctive and well known around the world. The Complainant claims to be one of the forty largest retailers in the world, active in manufacturing and wholesaling through more than 30 companies (about 25 Swiss-based and around 10 abroad) in many commercial areas. According to the Complainant, the fact that the Respondent has registered a domain name that is confusingly similar to these Trademarks indicates that the Respondent had knowledge of the Complainant’s Trademarks at the time of registration of the disputed domain name.

The Complainant argues that a basic internet search under the terms “migrosbank-ag.com”, would have led the Respondent to the Complainant and its activities. The disputed domain name fully reproduces the Complainant’s Trademarks “MIGROS” and “MIGROS BANK” without the consent or authorisation of the Complainant.

Moreover, the disputed domain name is virtually identical to the name of the Complainant’s subsidiary Migros Bank AG and closely resembles the Complainant’s domain name “migrosbank.ch” (registered 26 years before the disputed domain name was registered). The Complainant argues that it is more unlikely that the disputed domain name would have been registered if it were not for the Complainant’s Trademarks. A simple search in online trademark registers or in the Google search engine would have informed the Respondent on the existence of the Complainant and its rights in the “MIGROS” and “MIGROS BANK” Trademarks.

Bad faith use

According to the Complainant, the disputed domain name is not being used for any bone fide offering of goods or services because the disputed domain name does not resolve to an active website. According to section 3.3 of WIPO Overview 3.0, the non-use of a domain name would not prevent a finding of bad faith use under the doctrine of passive holding if certain circumstances are met.

The Panel finds that, on the balance of probabilities, it can be presumed that the Respondent had actual knowledge of the existence of the Complainant and its activities as well as of the Complainant's Trademarks and the scope of the Trademarks for the following reasons:

All of Complainant's Trademarks predate the registration of the disputed domain name.

It is highly unlikely that the Respondent would have come up with a domain name consisting of the term "MIGROS" in combination with the terms "BANK" and "AG" without having prior knowledge of the Complainant and the Complainant's Trademarks and activities.

On the balance of probabilities, it may be expected that the Respondent had knowledge of the existence of the Complainant and its activities, and of the existence of the Complainant's Trademarks and the scope of these Trademarks (in particular, banking services).

The Respondent did not contest any of the Complainant's arguments and did not provide any explanation concerning its choice for registering and/or using a domain name that includes the Complainant's registered Trademark(s) in combination with the term "bank" (describing the banking activities of the Complainant and/or its subsidiary) and the term "AG" (an abbreviation of the company form of the Complainant's subsidiary Migros Bank AG).

The Panel believes from the facts in this case that the Respondent had the Trademarks of the Complainant in mind when registering and subsequently using the disputed domain name. The Panel concludes that there is at least a risk that the disputed domain name is being used for the purpose of defrauding Internet users.

For all the reasons set out above, the Panel concludes 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.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. MIGROSBANK-AG.COM: Transferred

PANELLISTS

Name	Bart Van Besien
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DATE OF PANEL DECISION 2022-07-29

Publish the Decision
