

Decision for dispute CAC-UDRP-104862

Case number	CAC-UDRP-104862
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Time of filing	2022-09-20 10:37:18
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Domain names	migrosfunding.com
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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	Bitfini Bitfini
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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

The Complainant owns many Trademark Registrations for the mark MIGROS including the following:

- International Trademark no. 315524, registered on June 23, 1966, in international classes 3, 7, 8, 9, 11, 21-31, 34. The trademark designates, inter alia, Serbia and Viet Nam;
- International Trademark no. 397821 MIGROS (word mark), registered on March 14, 1973, in international classes 1-9, 11-12, 14-32 and 34. The trademark designates, inter alia, China and Morocco;
- European Union Trademark no. 000744912 MIGROS (word mark), registered on July 26, 2000, in international classes 1, 2, 3, 4, 6, 7, 8, 9, 11, 12, 14 - 32, 34, and 35-42;
- European Union Trademark no. 003466265 MIGROS (word mark), registered on May 13, 2005, in international class 35;
- International Trademark no. 404446 , registered on December 28, 1973, in international classes 1-9, 11-12, 14-32 and 34. The trademark designates, inter alia, North Macedonia and Monaco;
- International Trademark no. 1469883 , registered on December 28, 1973, in international classes 1-12, 14-32 and 34-45. The trademark designates, inter alia, France and Italy; and
- United States of America Trademark no. 6026436 MIGROS (word mark), registered on April 7, 2020, in international class 35.

PARTIES CONTENTIONS

COMPLAINANT:

Founded in Zurich in 1925, the Complainant is a Swiss retail company that is owned by its more than 2 million cooperative members. With sales of CHF 28.93 billion in 2021, the Complainant is also one of the forty largest retailers in the world and is the country's largest private employer with more the 97.000 employees. The Complainant operates supermarkets, furniture stores, electronic retail stores, gas stations, travel agencies, convenience stores, and bookstores to cite just a few examples.

One of the most relevant ventures of the Complainant is Migros Bank AG, which is a wholly owned subsidiary and consists of the parent company's financial services division. With a total of 67 branches and headquartered in Zurich, Migros Bank AG is one of the largest and most established banks in Switzerland, providing a full range of commercial banking services to both individuals and business customers. This includes deposits, online banking, loans, mortgages, cards and payments, savings, investments, and insurance.

The disputed domain name <migrosfunding.com> was registered on April 30, 2022. The disputed domain name aims to attract consumers to a fake website displaying the MIGROS trademark in connection with investment services in order to deceive members of the public into believing that they can safely deposit money with the Respondent or third parties.

RESPONDENT:

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

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint; however, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See WIPO Jurisprudential Overview 3.0 at paragraph 4.3; see also GROUPE CANAL + v. Danny Sullivan, 102809 (CAC January 21, 2020) ("the Panel, based on the poorly supported and conclusory allegations of the Complainant, retains that the Complainant has not prevailed on all three elements of the paragraph 4(a) of the Policy and, therefore, rejects the Complaint.")

A. The disputed domain name 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 name is 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 websites of the World Intellectual Property Office (WIPO), the European Intellectual Property Office (EUIPO), and the United States Patent and Trademark Office (USPTO) as evidence that it owns registered rights to its asserted MIGROS trademark in many jurisdictions. The earliest of these reflects a registration date of June 23, 1966. Registration with such national and multi-national offices has been found sufficient to satisfy the threshold requirement of proving trademark rights under 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 on April 30, 2022, adds the word "funding" to the MIGROS trademark and the Complainant asserts that this increases the confusing similarity of the disputed domain name as a significant portion of the Complainant's business involves banking and financial activities. 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 trademark and will lead internet users to wrongly believe that the disputed domain name originates or is 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 most often 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 trademark and that the addition of a descriptive word thereto in the disputed domain name is insufficient to avoid a finding that it is 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, the Complainant has the burden of making a prima facie showing that the Respondent has no rights or legitimate interests in the disputed 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 "Respondent is not a licensee of Complainant, and it has not received any consent, permission, authorization or acquiescence from Complainant to use its MIGROS mark in association with the registration of the Domain Name." 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 asserted trademark. Furthermore, the Registrar for the disputed domain names identifies the Registrant only as "Bitfini Bitfini". There is no evidence that the Respondent is known otherwise and its use of the Complainant's trademark on its website does not, alone, 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 name.

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 name resolves to a website that makes prominent use of the Complainant's trademark and claims to offer online services of investment trust management. 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 name to "create the misleading impression that the web site is associated with the Complainant" and to "pass itself off as the Complainant, with the unlawful purpose of obtaining personal information and money from Internet users." The Complainant provides screenshots of the Respondent's resolving website and the Panel notes that this prominently displays the term Migros Funding along with a button titled INVEST NOW. The page further states that "migrosfunding.com offers services of investment trust management of the funds provided by third party investors aiming at obtaining profit by both investors and companies." It goes on to say that "[t]he company also deals with options and crypto- currency trading...." The Complainant's assertion that this use of its trademark is for the purpose of impersonation and illicit commercial gain appears reasonable to the Panel and the Respondent has not filed a Response or made any other submission in this case to offer an alternative explanation for its actions. As the Complainant has made out a prima facie case that has not been rebutted by the 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 of the disputed domain name per Paragraphs 4(c)(i) or (iii) of the Policy.

C. The disputed domain name was registered and used in bad faith

Under Paragraph 4(a)(iii) of the Policy, the Complainant must demonstrate both that the disputed domain name was registered and is being used in bad faith. Further guidance on that requirement is found in Paragraph 4(b) of the Policy, which sets out four examples of possible actions by the Respondent that may satisfy this burden of proof.

Inherently prerequisite to a finding of bad faith under Paragraph 4(a)(iii) of the Policy is some attribution of knowledge of the Complainant's claimed trademark, whether actual or based upon a conclusion that the Respondent should have known of the trademark. See, Domain Name Arbitration, 4.02-C (Gerald M. Levine, Legal Corner Press, 2nd ed. 2019) ("Knowledge and Targeting Are Prerequisites to Finding Bad Faith Registration"); USA Video Interactive Corporation v. B.G. Enterprises, D2000-1052 (WIPO December 13, 2000) (claim denied where "Respondent registered and used the domain name without knowledge of Complainant for a bona fide commercial purpose."). See also, WIPO Overview 3.0, par. 3.1.1 (when examining whether "circumstances indicate that the respondent's intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark", Panels may consider such issues as "the respondent's likely knowledge of the complainant's rights"). Here, the Complainant claims that its mark is famous and it cites "prior decisions under the UDRP [that] have recognized the reputation of the MIGROS mark." Further, the Complainant points to the Respondent's impersonation activities at its website and, specifically, the site's statement "[t]he mother company 'Migros' (German pronunciation: ['migro]) is Switzerland's largest retail company, its largest supermarket chain and largest employer. It is also one of the forty largest retailers in the world." Based on this, the Complainant asserts that "it is impossible to believe that Respondent would have chosen the Domain Name if it did not have Complainant's mark and activities in mind." From this evidence, the Panel concludes that the Respondent had actual knowledge of the Complainant's trademark at the time it registered the disputed domain name.

Next, the Complainant argues that the Respondent registered and uses the disputed domain name in bad faith as the Respondent fraudulently impersonates and passes itself off as the Complainant. Using a confusingly similar domain name to pass oneself off as a complainant can demonstrate bad faith under Paragraphs 4(b)(iii) and (iv) of the Policy. See *Abbvie, Inc. v. James Bulow*, FA 1701075 (FORUM November 30, 2016) ("Respondent uses the <abbvie.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 Complainant asserts that the disputed domain name is used to "to intentionally attempt to attract for commercial gain Internet users to the website hosted by the Domain Name, by creating likelihood of confusion with Complainant's MIGROS mark ... which amounts to registration and use in bad faith in accordance with paragraph 4 (b)(iv) of the Policy". The evidence in this case shows that the Respondent has, for commercial gain, used its website at the disputed domain name to pass itself off as the Complainant to actual and potential customers in furtherance of allegedly promoting investment and trading services in both conventional and crypto currencies. The Respondent has not participated in this case to explain its actions and so, based upon a preponderance of the available evidence, the Panel finds it highly likely that the Respondent registered and uses the disputed domain name in bad faith by seeking commercial gain through confusion with the Complainant's trademark, per Paragraph 4(b)(iv).

Next, the Complainant notes that the disputed domain name has been configured for mail exchange (MX) servers and claims that this "indicates a risk that Respondent potentially uses the Domain Name to create an email address, with the suffix '@migrosfunding.com' for deceiving purposes." Prior decisions have inferred an intent to use a disputed domain name for the sending of email based upon the creation of associated MX records. In *The Standard Bank of South Africa Limited v. N/A / mark gersper*, FA 1467014 (FORUM December 5, 2012), the Panel noted that the "Complainant contends this phishing could be carried out via email and not just through a website. Complainant has examined the domain name's MX records and they apparently allow the transmission of email, which would not be necessary if the domain name was merely parked. The Panel finds Complainant's allegations about the possibility of Respondent using the disputed domain name for phishing sufficient..."). This inference has been adopted in other decisions. See, e.g., *Pepsico, Inc. v. Allen Othman*, 102380 (CAC April 25, 2019) ("The Complainant submits, fairly, that the preparatory steps in relation to email addresses could enable the inappropriate sending or receipt of email communications purporting to emanate from, or intending to be received by, the Complainant. These preparatory steps (configuring 'MX' or mail exchange records) have [been] considered in relation to 'use' for the purposes of the Policy by other Panels, which the present Panel has considered of its own motion."). In the present case, the Complainant submits a screenshot showing that an MX record has been created for the disputed domain name thus indicating that it may be used for the sending and receiving of phishing emails. While, in the abstract, the creation of such record does not indicate any ill intent, in the circumstances of the present case where a domain name that is confusingly similar to the Complainant's well-known trademark has been created by the Respondent and used for an impersonation website, this MX record does require some further explanation which the Respondent has not provided. As such, the Panel finds that the existence of an MX record for the disputed domain name further supports the conclusion that it has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy.

Finally, the Complainant argues that Respondent's use of a WHOIS privacy service and false information when registering the disputed domain name further demonstrates bad faith. Past Panels have noted that although engaging a privacy service alone is not sufficient, it may demonstrate bad faith based on the overall context of the case under Policy paragraph 4(a)(iii). See *Robert Half International Inc. v. robert arran*, FA 1764367 (FORUM February 5, 2018) ("Respondent's use of a privacy registration service in an attempt to conceal his identity, though not itself dispositive, is a further indication of bad faith.") Further, providing false information has been held to support a finding of bad faith registration. See *Farouk Systems, Inc. v. Jack King / SLB*, FA 1618704 (FORUM June 19, 2015) (finding bad faith registration and use pursuant to Policy paragraph 4(a)(iii) where the respondent had provided false contact information when registering the disputed domain name). The publicly available WHOIS information demonstrates that Respondent utilized a privacy service when registering the disputed domain and the information revealed by the concerned Registrar, after the present Complaint was filed, uses a false address of "Null, Null, 00000, Tuvalu". The Panel finds that Respondent's use of a privacy service and false Registrant information further supports the finding of bad faith registration and use under Policy paragraph 4(a)(iii).

Accepted

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

- 1. **migrosfunding.com**: Transferred

PANELLISTS

Name	Steven Levy Esq.
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DATE OF PANEL DECISION	2022-10-18
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Publish the Decision