

Decision for dispute CAC-UDRP-105122

Case number	CAC-UDRP-105122
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Time of filing	2023-01-11 09:02:19
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Domain names	migrosshopping.com
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Case administrator

Name	Olga Dvořáková (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	Hakan Şenkal
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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 has submitted evidence, which the Panel accepts, showing that it is the registered owner of the “MIGROS” trademarks, various of which designated Turkey. The Complainant’s certain “MIGROS” trademarks are, *inter alia*, the following:

- International trademark n°315524 registered on June 24, 1966;
- International trademark n°397821 registered on March 15, 1973;
- European Union trademark n°000744912 registered on July 27, 2000;
- International trademark n°1239151 registered on January 1, 2015.

Moreover, the Complainant is also the owner of the domain name <migros.com> registered on February 9, 1998, among many others bearing “MIGROS” trademark.

FACTUAL BACKGROUND

The Complainant is a Swiss cooperative society of commonly known as a supermarket chain serving as the umbrella organization of ten

regional Migros Cooperatives, and a large part of the Swiss population is members of the Migros cooperative. The Complainant offers a wide range of food, non-food products and services relating to wellness, travel and catering. These include travel agencies, cultural institutions, museum and magazines, restaurants, aqua/fitness and golf parks, pension funds and foundations, and a bank. The Complainant is present in 75 countries including Turkey.

The Complainant holds several trademark registrations for "MIGROS" dating back to 1966 in various countries including Turkey and various domain names incorporating "MIGROS" trademark such as <migros.com>.

On November 10, 2022; the Respondent registered the disputed domain name <migrosshopping.com>. The disputed domain name is currently inactive.

PARTIES CONTENTIONS

COMPLAINANT:

1. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR

The Complainant contends that the disputed domain name <migrosshopping.com> is confusingly similar to its well-known and distinctive trademark MIGROS. The Complainant claims that its trademark "MIGROS" is clearly recognizable within the disputed domain name <migrosshopping.com> and the addition of the descriptive term "shopping" does not prevent the likelihood of confusion between the disputed domain name and the Complainant and its trademarks.

2. NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and he is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent.

The Complainant claims that the disputed domain name was registered by the Respondent in its name in an attempt to induce customers of the Complainant to believe that the disputed domain name is of the Complainant and/or associated in some manner with the Complainant. It is stated that in the webpage at the disputed domain name a contact WhatsApp number with Turkey's country code is displayed and it intends to lure European consumers in search of its well known "MIGROS" brand to make purchases for food and olive oil through such website. The Complainant asserts that the Respondent is deliberately trying to portray a (false) association between the disputed domain name and the Complainant.

The Complainant submits that the Respondent is neither a licensee nor authorized agent of the Complainant nor in any other manner authorized to sell Complainant's products or use its trademark(s). It is claimed that the Respondent knew of the Complainant's mark and its business activities as the mark has been in use by the Complainant over the last five decades and already well known globally. The Complainant also claims that the Respondent's registration and use of the disputed domain name is a clear case of cyber-squatting, the Respondent's intention is to take advantage of the Complainant's reputation in order to confuse the public by offering alternative products, divert business, tarnish the reputation of the Complainant and its marks and gain unfair advantage.

Also, the Complainant believes that the disputed domain name is being or intended to be used for phishing or other fraudulent purposes through the use of email IDs ending with '@migrosshopping.com', which may lead customers to infer that the disputed domain name has an association with the Complainant and lead to confusion.

Therefore, the Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

3. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant claims that the disputed domain name is confusingly similar to the Complainant's well-known "MIGROS" trademark. The Complainant referred to numerous UDRP panels recognizing the well-known status of the trademark such as WIPO Case No. D2019-0803 <migrosglobal.com> and WIPO Case No D2016-2547 <migros.store>. The Complainant claims that the Respondent knowingly chose to register and use the disputed domain name <migrosshopping.com> to divert customers and drawing damaging conclusions as to the Complainant's operations through the disputed domain name and even a preliminary search over the Internet or survey among the public in general reveals that the "MIGROS" brand is associated with the Complainant and it has been used by them in their trade and business for decades including in Turkey. Given the distinctiveness of the Complainant's trademarks and reputation, it is claimed that the Respondent has registered the domain name with full knowledge of the Complainant's trademark.

Also, the Complainant believes that the disputed domain name is being or intended to be used for phishing or other fraudulent purposes through the use of e-mail IDs ending with '@migrosshopping.com'. The Complainant further claims that the Respondent has used the disputed domain name to impersonate the Complainant for financial gain and impersonation is clear evidence of bad faith registration and use.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name <migrosshopping.com> in bad faith.

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

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In this context, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

1. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
2. the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. the disputed domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

1. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registration of "MIGROS" trademarks.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's "MIGROS" trademark and the addition of the non-distinctive word element "SHOPPING" is not sufficient to vanish the similarity, if not increase it, as it can easily refer to the Complainant, which is a global supermarket chain.

Moreover, the addition of the gTLD ".COM" is not enough to abolish the similarity.

The Panel is of the opinion that the Internet users will easily fall into false impression that the disputed domain name is an official domain name of the Complainant. The Panel recognizes the Complainant's rights and concludes that the disputed domain name is confusingly

similar with the Complainant's trademark. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

2. NO RIGHTS OR LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the complainant has the burden of establishing that the respondent has no rights or legitimate interests in respect of the domain name.

It is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to the respondent of the dispute, the use or making demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the complainant will have failed to discharge its burden of proof and the complaint will fail. The burden is on the complainant to demonstrate a prima facie case that the respondent does not have rights or legitimate interests in the disputed domain name. Once the complainant has made out a prima facie case, then the respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

The Complainant contends that the Respondent has nothing to do with the Complainant and any use of the trademarks "MIGROS" has to be authorized by the Complainant and there is no such authorization. Moreover, the disputed domain name has no relation with the Respondent and the Respondent is not commonly known as the disputed domain name.

In the absence of a compliant 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.

3. BAD FAITH

The Panel concludes that the Complainant's "MIGROS" trademark is of distinctive character and is well-known. Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in well-known "MIGROS" trademarks, the Respondent, was aware of the Complainant and its trademarks at the time of registration of the disputed domain name (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107). Referring to Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226, the Panel believes that the awareness of the Complainant's trademark at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

In addition, the email received from the Respondent, which is not a compliant Response, states that he can sell the domain name if desired. The intent and offer to sell the domain name to the trademark owner also shows bad faith.

Moreover, the link <migrosshopping.com> is currently inactive but as can be seen from the annexes to the Complaint, it formerly had the photos of MIGROS supermarket shops and activity of selling food such as olive oil. It can deceive the consumers into thinking the Respondent is affiliated with the Complainant and into buying products through the website of the disputed domain name. The Panel considers that this may be evaluated under (iv) of paragraph 4(b), which is as follows: *by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.* In any case, as previously held by various panellists many times before, the current inactive status of the disputed domain name also does not prevent the finding of bad faith.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has established the third element under paragraph 4(a)(iii) of the Policy.

Accepted

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

1. **migrosshopping.com**: Transferred

PANELLISTS

Name	Mrs Selma Ünlü
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DATE OF PANEL DECISION	2023-02-22
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Publish the Decision