

Decision for dispute CAC-UDRP-105434

Case number **CAC-UDRP-105434**

Time of filing **2023-05-10 15:48:01**

Domain names **migrosbch.online**

Case administrator

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

Complainant

Organization **MIGROS-GENOSSENSCHAFTS-BUND**

Complainant representative

Organization **SILKA AB**

Respondent

Name **Zain Chukwuma**

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 numerous trademarks, including but not limited to the following:

- International Trademark No. 315524 for MIGROS, registered on June 23, 1966;
- International Trademark No. 397821 for "MIGROS" registered on March 14, 1973;
- Swiss Trademark No. 623618 for MIGROS BANK (figurative), registered on December 12, 2011;
- Swiss Trademark No. 623622 for "BANCA BANQUER MIGROS BANK" registered on December 12, 2011;
- Swiss Trademark No. 764760 for MIGROS BANK (figurative) registered on 2 June 2021;
- International Trademark No. 631422 for "BANQUE MIGROS" registered on January 12, 1995;
- International Trademark No. 404446 for M MIGROS (figurative) registered on 28 December 1973;
- European Union Trademark No. 000744912 for "MIGROS", registered on July 26, 2000;
- European Union Trademark No. 003466265 for "MIGROS", registered on May 13, 2005; and

- USPTO Trademark No. 6026436 for "MIGROS", registered on April 7, 2020.

FACTUAL BACKGROUND

The Complainant is a Swiss retail company founded in 1925. It is currently Switzerland's largest retailer and largest private employer, with more than 97,000 employees, which manufactures luxury sport equipment and outerwear.

The Complainant is one of the largest retailers in the world and operates manufacturing and wholesale activities through more than 30 companies in Switzerland and internationally. It operates supermarkets, furniture stores, gas station, convenience stores, among many commercial activities. It also operates Migros Bank AG which is one of the largest and most established banks in Switzerland.

The Complainant registered the domain name <migrosbank.ch> on March 20 1996.

The disputed domain name was registered on 19 April 2023 and resolves to a website which displays the Complainant's MIGROS BANK mark in its left-hand section and purports to offer the same services as the Complainant.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

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

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a complainant to show that a domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns trademark registrations of the MIGROS mark.

The disputed domain name contains the Complainant's MIGROS mark in its entirety. The only differences between the disputed domain name and the Complainant's MIGROS trademark are:

- (i) the addition of the generic term "bch"; and
- (ii) the addition of the gTLD ". online".

The addition of the generic term "bch" does not prevent a finding of confusing similarity. It is established that where a trademark is recognizable within the disputed domain name, the addition of a descriptive or geographical term would not prevent a finding of confusing similarity under the first element. (See WIPO Overview 3.0, section 1.8).

It is further established that the gTLD is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. (See WIPO Overview 3.0, section 1.11). The addition of a gTLD to a disputed domain name does not avoid confusing similarity as the use of a TLD is technically required to operate a domain name (see *Accor v. Noldc Inc.*, WIPO Case No. D2005-0016; *F. Hoffmann-La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. D2006-0451; *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003; *L'Oréal v Tina Smith*, WIPO Case No. 2013-0820; *Titoni AG v Runxin Wang*, WIPO Case No. D2008-0820; and *Alstom v. Itete Peru S.A.*, WIPO Case No. D2009-0877).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the MIGROS mark and the element under paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the complainant to show that the respondent has no rights or interests in respect of the domain name. Once the complainant establishes a prima facie case that the respondent lacks rights or legitimate interests in the domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the domain name (see WIPO Overview 3.0, section 2.1).

In the present case, the Complainant has demonstrated prima facie that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and the Respondent has failed to assert any such rights or legitimate interests.

The Complainant submitted evidence that it did not authorize or license the Respondent to use its MIGROS mark (see *OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org*, WIPO Case No. D2015-1149; *Sanofi-Aventis v. Abigail Wallace*, WIPO Case No. D2009-0735). The Complainant also submitted evidence that its registrations and use of its marks predate the registration of the disputed domain name by many years.

In addition, the evidence submitted by the Complainant shows that the Respondent is not commonly known by the disputed domain name.

The Respondent did not submit a response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain name which is sufficient to rebut the Complainant's prima facie case.

Accordingly, the Panel considers that the Respondent has not demonstrated bona fide use of the disputed domain name. The Panel did not find any evidence that paragraphs 4(c)(ii) or (iii) of the Policy apply in the circumstances of this case.

The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain name and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The complainant must show that the respondent registered and is using the domain name in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant has submitted evidence that the Respondent registered the disputed domain name long after the Complainant registered its MIGROS mark. Given that the Complainant's trademarks have been registered for a long time, it is highly unlikely that the Respondent did not know of the Complainant and its MIGROS mark prior to the registration of the disputed domain name. The disputed domain name incorporates the Complainant's MIGROS mark in its entirety with the additional suffix "bch", which given the circumstances of this case, the Panel finds is an attempt by the Respondent to confuse and/or mislead Internet users seeking or expecting the Complainant. Previous UDRP panels have ruled that in such circumstances "a likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic from the Complainant's site to the Respondent's site" (see *Edmunds.com, Inc v. Triple E Holdings Limited*, WIPO Case No. D2006-1095).

The Complainant also submitted evidence that the disputed domain name resolved to an active website which appeared to offer bank loan services that compete with the Complainant's business. The website under the disputed domain name prominently displays the MIGROS mark. This is a clear indication that the Respondent was aware of the Complainant and its registered MIGROS mark and is clear evidence of bad faith registration and use of the disputed domain name. See *Boursorama SA v. Estrade Nicolas*, WIPO Case No. D2017-1463.

It is the Panel's finding that the Respondent specifically targeted the Complainant and its mark and registered the disputed domain name to divert Internet traffic and benefit commercially from unsuspecting Internet users seeking out the Complainant.

The Respondent did not submit a Response in this proceeding which is a further indication of the Respondent's bad faith, which was considered by the Panel.

Based on the evidence presented to the Panel, including the confusing similarity between the disputed domain name and the Complainant's mark, the fact that the disputed domain name was used to redirect Internet users to a website which offered competing services, the fact that no Response was submitted by the Respondent in response to the Complaint, the Panel draws the inference that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **migrosbch.online**: Transferred

PANELLISTS

Name	Jonathan Agmon
------	-----------------------

DATE OF PANEL DECISION 2023-06-21

Publish the Decision
