Decision for dispute CAC-UDRP-105532

Case number	CAC-UDRP-105532
Time of filing	2023-06-16 09:39:55
Domain names	migros.vip

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Migros-Genossenschafts-Bund

Complainant representative

Organization	SILKA AB

Respondent

Name	Ling Li

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 several trademark registrations for MIGROS, inter alia:

- International trademark registration No 315524 registered for EU, African and Asian countries (registered from June 24, 1966)
- International trademark registration No 397821 registered for several countries including China (registration from March 15, 1973)

The disputed domain name <migros.vip> was registered on April 25, 2023.

PARTIES CONTENTIONS

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

Migros was founded in 1925 in Zurich as a private enterprise by Gottlieb Duttweiler. By 1941, he transformed everything from his privately owned enterprises into regional cooperatives, headed by the Federation of Migros Cooperatives – the Complainant. The Complainant serves as the umbrella organization of ten regional Migros Cooperatives. Large parts of the

Swiss population are members of the Migros cooperative, thus making the Complainant a supermarket chain that is owned by its customers. More than 90% of the assortment of goods is produced by Complainant's ninety subsidiaries and it is one of the biggest department stores in Switzerland. 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, museums and magazines, restaurants, aqua/fitness and golf parks, pension funds and foundations, and a bank.

The Complainant owns a number of trademarks for the distinctive term MIGROS and the variations thereof under numerous classes. The Complainant's brand/mark MIGROS features in news globally and enjoys huge social media following as well. The Complainant's MIGROS mark is indeed well known and recognized by numerous UDRP Panels and it uses its mark in numerous domain names as well in addition to its main website at <migros.com>.

1. The domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights

The Complainant was the first in the world to have conceived and adopted the distinctive mark MIGROS as its brand in 1925 and has been openly, continuously and extensively used since then. The Complainant owns hundreds of registered Trademarks for MIGROS. The disputed domain name <migros.vip> was registered just recently on April 25, 2023, and incorporates Complainant's registered mark MIGROS in its entirety.

The registration and the use of the confusingly similar disputed domain is a direct infringement of the legitimate rights held by the Complainant in the mark MIGROS. Moreover, herein the Complainant's trademark MIGROS is contained in its entirety within the disputed domain name <migros.vip>. Lastly, the addition of the new gTLD ".vip" does not differentiate the domain name from the trademark.

The first element of the Policy is, therefore, deemed satisfied.

2. Respondent has no rights or legitimate interests in respect of the domain name

The Complainant has painstakingly built up a good reputation worldwide and has invested substantial amounts of resources in promoting its product under the trademark MIGROS. The domain name has a recent registration date of April 25, 2023, while the Complainant has been using the trademark MIGROS since its first registration in 1966. The Complainant's distinctive mark registered is not a name that one would legitimately choose as a domain name for a legitimate purpose. This name is certainly not a descriptive term serving to indicate specific characteristics of any other goods or services otherwise but makes a reference to the Complainant and its business only.

Any person or entity using the mark/brand MIGROS in any manner is bound to lead customers and users to infer that its product or service has an association or nexus with the Complainant and lead to confusion and deception. It is indeed extremely difficult to foresee any justifiable use that the Respondent may have with the disputed domain name.

The disputed domain name is clearly intended to exclusively "pass off" as the Complainant herein and have a free ride on its reputation and goodwill. This is evident from the fact that the disputed domain name which even though could not be accessed, however, when searching on Google one can observe the top result refers to the Complainant as their logo is being used. It reads "Forgot password? Sign in. Sign up>>" which raises suspicion that the site is indeed accessible in some geographical locations. This is further evident from a tweet dated May 1, 2023, inviting users to register at <migros.vip/?Q628466>. Further there are three YouTube videos demonstrating the website at the disputed domain name on April 26, 2023, that is, a day after the registration of the disputed domain name.

These YouTube videos contain demos of how to use the website at the disputed domain name for USDT earnings. Two of these videos were uploaded on April 26, 2023, and are in the Urdu language, while the third video was uploaded on April 28, 2023, and is in English. However, all these videos contain images of the Complainant's convenience stores, office building, logo and similar references. That is, the disputed domain name registered by the Respondent attempts to impersonate the

Complainant and induce its customers to believe that the disputed domain name is that of the Complainant and/or associated in some manner with the Complainant. Thereby 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 the Complainant's products or use the trademark MIGROS in any form. The mark MIGROS is a registered trademark globally and it is apparent from the use of the trademark MIGROS at the disputed domain name 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 Respondent's registration and use of the disputed domain name is a clear case of cyber-squatting, intention is to take advantage of the Complainant's substantial reputation and goodwill in order to confuse the public and the viewer by offering other products/services, divert business, and tarnish the reputation and goodwill of the Complainant.

The Respondent is not making a legitimate non-commercial or fair use of the domain name, but has an intention for commercial gain to misleadingly divert consumers and tarnish the trademark at issue, given (a) the distinctive nature of the mark; (b) huge popularity of the Complainant and its trademark; (c) attempt of the Respondent to impersonate the Complainant and defraud prospective customers by the unauthorized use of the mark at the disputed domain name. Accordingly, there is prima facie proof of the Respondent's intent to usurp the reputation of the Complainant and make illegal gains off its worldwide reputation and goodwill. Suffice it to state that the said usage of the disputed domain name by the Respondent has the propensity to cause irreparable loss to the goodwill and reputation of the Complainant.

The said usage is certainly not in terms of clause 4(c)(i) or (iii) of the Policy as neither the demonstrable preparation to use is a bonafide offering of goods or services nor a legitimate noncommercial or fair use of the domain name is being made. Indeed, there is no showing that before any notice to the Registrant of the dispute, the Registrant's use of the domain name in connection with a bonafide offering of goods or services.

UDRP panels have categorically held that use of a domain name for illegal activity, including the impersonation of the complainant, phishing, and other types of fraud, can never confer rights or legitimate interests on a respondent. Circumstantial evidence can support a credible claim made by a complainant asserting the respondent is engaged in such illegal activity, including that the respondent has improperly masked its identity to avoid being contactable.

Further, it does not satisfy the remaining clause 4(c)(ii) of UDRP either, so as to uphold any kind of legitimate interest in Respondent's registering or holding of the disputed domain name. The disputed domain name incorporates a trademark which is neither owned by the Respondent nor is the Respondent commonly known by the name MIGROS either as an individual, business or any other organization.

In view of the prior rights of the Complainant in the trademark MIGROS and the enormous goodwill and reputation vested in the trademark, it is evident from the above assertions that the sole purpose behind the Respondent in registering the disputed domain name is to take undue advantage of the Complainant's mark MIGROS.

3. The domain name was registered and is being used in bad faith

The Complainant is Switzerland's largest retail company, its largest supermarket chain and its largest employer. It is also one of the forty largest retailers in the world. It is structured in the form of a cooperative federation (the Federation of Migros Cooperatives), with more than two million members. The Complainant's popularity is further evident by the numerous domain names it already owns, some of which act as a window to the public all over the world to know more about its products and services. Such wide usage of the mark MIGROS has resulted in the marks transcending regional boundaries and acquiring an enviable trans-border reputation.

The overriding objective of the Policy has been to curb the abusive registration of domain names in circumstances where the

registrant seeks to profit from and exploit the trademark of another.

The following factors contribute in establishing the Respondent’s bad faith conduct in the circumstances of this case:

A) Actual or Constructive Notice

The registration of a domain name that is confusingly similar to another’s mark, despite actual or even constructive knowledge of the mark holder’s rights, constitutes bad faith registration and use, pursuant to Policy 4(a)(iii). Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

Complainant's MIGROS trademark is of distinctive character and is well-known and 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 (Migros-Genossenschafts-Bund v. Hakan Şenkal [CAC-UDRP-105122]).

Given the immense popularity and goodwill enjoyed by the Complainant's trademark globally by virtue of its market reputation, it is clear that the Complainant’s trademark is well-known and the Respondent knowingly chose to register and use the disputed domain name <migros.vip> to divert customers and drawing damaging conclusions as to the Complainant’s operations through the disputed domain name. 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.

It is inconceivable that the registration of the disputed domain name was made without full knowledge of the existence of the Complainant and its ‘well-known’ trademark. The webpage at the Complainant’s website and supporting evidence make the Respondent’s actual knowledge of the Complainant and its mark evident.

Therefore, given that MIGROS is a registered trademark (including China) and similar domain names in use by the Complainant, it is highly unlikely that the Respondent was not aware of the registered rights the Complainant would assume in the trademark and the value of said trademark, at the point of the registration. Respondent bears no relationship to the trademark and the disputed domain name has no other meaning except for referring to Complainant's name and trademark. Given the foregoing, both registration and use of the disputed domain name is clearly intended to capitalize on consumer confusion for Respondent’s profit, a bad faith use under the Policy.

B) Impersonation

The Complainant submits that the Respondent is not authorised by the Complainant to make use of the disputed domain name in any form, rather a website at the disputed domain name is hosted in order to create consumer confusion, lure prospective customers seeking the Complainant’s products. (See Migros-Genossenschafts-Bund v. WhoisGuard Protected, WhoisGuard, Inc. / Jasmine Julius, WIPO Case No. D2020-0327, or MIGROS-GENOSSENSCHAFTS-BUND v. louis, CAC Case No 104753).

Indeed, it is evidence of bad faith registration and use in terms of Clause 4 (b)(iv) of UDRP: “by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location.”

C) Implied Affiliation

Moreover, any person or entity using the mark/name MIGROS in any manner is bound to lead customers and users to infer

that its product or service has an association or affiliation with the Complainant and lead to confusion and deception.

D) Opportunistic Bad Faith

It is a settled law that registration of identical or confusingly similar domain name that is patently connected with a particular trademark owned by an entity with no connection with the trademark owner is indicative of bad faith as understood in the Policy (Migros-Genossenschafts-Bund (Federation of Migros Cooperatives) v. Mevlüt Yildirim, WIPO Case No. D2016-2547).

With regard to famous brands, successive UDRP panels have found bad faith registration where:
- Complainant's name was famous at the time of registration: Cho Yong Pil v. Sinwoo Yoon, D2000-0310.
- Registration of a well-known trademark by a party with no connection to the owner of the trademark and no authorization and no legitimate purpose to utilize the mark reveals bad faith: The Caravan Club v. Mrgsale, NAF-FA95314.
- The very use of domain name by Respondent who had no connection whatsoever with Complainant's mark and product suggests opportunistic bad faith: America Online Inc. v. Chinese ICQ Network, WIPO-D2000-0808.

Bad faith is not confined to the specific circumstances of bad faith and use set out in paragraph 4(b) of the Policy, hence the above submissions. Iit must be recalled that the circumstances identified in paragraph 4(b) are ‘without limitation’ - that is, paragraph 4(b) expressly recognizes that other circumstances can be evidence that a domain name was registered and is being used in bad faith (Telstra Corporation Limited v. Nuclear Marshmallows [WIPO Case No. D2000-0003]).

Given the foregoing, the use and registration of the disputed domain name are clearly intended to capitalize on consumer confusion for Respondent’s profit, a bad faith registration and use under the Policy.

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 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

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

i. The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
ii. The respondent has no rights or legitimate interests in respect of the domain name; and
iii. The domain name has been registered and is being used in bad faith.

I. Identical or Confusingly Similar

The Complainant has established the fact that it has valid rights for the International trademark registration "MIGROS" No 315524 registered for EU, African and Asian countries from June 24, 1966 and International trademark registration "MIGROS" No 397821 registered for several countries including China from March 15, 1973.

The disputed domain name <migros.vip> has been registered on April 25, 2023, i.e. almost than 57 years after the first of the above mentioned MIGROS trademark registration, and fully incorporates the Complainant's trademark MIGROS. It is therefore identical to the trademark for purposes of UDRP. The addition of the generic top level domain ".VIP" does not change the overall impression of the designation as being connected to Complainant's trademark.

The Panel therefore considers the disputed domain name <migros.vip> to be identical to the Complainant's trademark MIGROS which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

As stated in the WIPO Jurisprudential Overview 3.0 at Section 2.1, while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant has established a prima facie case (not challenged by the Respondent who did not file any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name.

The disputed domain name does not resolve to any active webpage, however, it follows from the Google search, that the search results for "migros.vip" return the reference to the disputed domain name the text "Forgot password? Sign in. Sign up>> or to the YouTube videos containing how to use the website at the disputed domain name for USDT earnings. Such "use" of the disputed domain name is not an evidence that the Respondent is engaged in, or have engaged in any activity or work, i.e. legitimate or fair use of the disputed domain name, that demonstrates a legitimate interest in the disputed domain name.

There is further no evidence, that the Respondent is known by the disputed domain name or that it has a legitimate interest over the disputed domain name. It has not been proved by the Respondent that he has rights or legitimate interests in the disputed domain name or the Respondent is related with the Complainant. Neither license nor authorization has been proven to be granted to the Respondent to make any use of the Complainant's trademark or apply for registration of the disputed domain name.

The Panel therefore considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name <migros.vip> within the meaning of paragraph 4(a)(ii) of the Policy.

III. Registered and Used in Bad Faith

The Respondent has registered the disputed domain name which consists of the full content of the Complainant's trademark "MIGROS". There are no doubts that the Complainant's trademark is distinctive, famous and is well-known worldwide as follows from the several UDRP decisions such as CAC-UDRP-103846 or CAC-UDRP-105122. It could be therefore concluded that the Respondent had or should have the Complainant and its trademark in mind when registering the disputed domain name.

The Complainant has established the fact, that the disputed domain name creates direct association to the Complainant and is therefore capable of creating a likelihood of confusion of the internet users. The registration and usage of the disputed domain name could therefore potentially harm Complainant's business by diverting traffic to a different website and violate the Complainant's trademark rights, as well as demonstrate a lack of good faith in the registration and usage of the disputed domain name.

Considering the (i) identity of the Complainant's well-known trademark and the disputed domain name, (ii) long time between the registration of the Complainant's trademark and the disputed domain name, (iii) non-use of the disputed domain name, (iv) distinctiveness of the Complainant's trademark and (v) the failure of the Respondent to submit a response in the UDRP proceedings and to provide any evidence of good faith use, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

The Panel therefore considers that the disputed domain name <migros.vip> has been registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

The Panel finally considers that the Complainant has shown that the disputed domain name <migros.vip> is identical to a trademark in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **migros.vip**: Transferred

PANELLISTS

Name	**Petr Hostaš**

DATE OF PANEL DECISION 2023-08-07

Publish the Decision