

Decision for dispute CAC-UDRP-105745

Case number **CAC-UDRP-105745**

Time of filing **2023-09-01 09:24:17**

Domain names **migrossunion.com**

Case administrator

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

Complainant

Organization **Migros-Genossenschafts-Bund,**

Complainant representative

Organization **SILKA AB**

Respondent

Name **CHIPPER CASH**

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, including the following, as per trademark registration certificates submitted as annex 7 to the Complaint:

- European Union trademark registration No. 000744912 for MIGROS (word mark), filed on February 5, 1998 and registered on July 26, 2000 in classes 1, 2, 3, 4, 6, 7, 8, 9, 11, 12, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 34, 35, 36, 37, 38, 39, 40, 41 and 42;
 - Swiss trademark registration n. 2P-414500 for MIGROSBANK (word mark), filed on November 2, 1994 and registered on January 12, 1995, in class 36;
 - Swiss trademark registration n. P-405500 for MIGROS (word mark), filed on February 13, 1993 and registered on September 20, 1993, in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 11, 12, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32 and 34;
 - United Kingdom trademark registration No. UK00001072383 for MIGROS (word mark), registered on December 22, 1976, in class 31;
 - United States trademark registration No. 6026436 for MIGROS (word mark), filed on June 1, 2018 and registered on April 7, 2020 in international class 35.
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FACTUAL BACKGROUND

The Complainant, Migros-Genossenschafts-Bund (MGB), is a cooperative association based in Switzerland. The Complainant, together with affiliated regional cooperatives, the companies belonging to them and foundations, form the Migros community, in short, the “Migros”.

The Complainant coordinates Migros' activities, defines its strategy and represents the Migros community externally and is responsible, among other things, for meeting the needs of regional cooperatives through joint purchasing and production as well as the establishment or takeover of shareholdings and subsidiaries of all kinds.

The core business is the cooperative retail trade. It consists of the activities of the ten regional Migros cooperatives. They operate super/hypermarkets under the MIGROS brand, the specialist stores Do it + Garden, Melectronics, Micasa, SportXX, the Swiss Obi DIY stores, the Alnatura formats in Switzerland as well as the leisure facilities, fitness centers, restaurants and club schools.

The Strategic Business Area Trade comprises further retail formats that are not operated by the cooperatives. These include the online retailer Digitec Galaxus, the discounter Denner, the specialist stores of Ex Libris, the energy service provider Migrol and the convenience formats of Migrolino.

The industrial companies of the Strategic Business Unit Migros Industrie fulfil a dual role: on one hand, they develop and produce innovative own-brand products of good, Swiss quality at fair prices for their own retail trade. On the other hand, they produce products and services that they sell to third-party customers at home and abroad.

Migros also operates in the two strategic business areas of financial and travel services.

In addition, the Complainant operates service units that provide cross-company services such as the national distribution centers, the Group IT services or the SQTS test laboratory as well as cross-functional corporate units, for example in the areas of finance, HR, or compliance.

The Migros Group includes the Migros Industrie companies, various retail and travel companies, Migros Bank AG and several foundations. On an organizational level, these are assigned to the members of the Executive Board of the Complainant. Generally, the subsidiaries are wholly owned by the Complainant.

Migros Bank AG, headquartered in Zurich, is a wholly owned subsidiary of the Complainant and was founded in 1958 by Gottlieb Duttweiler. In terms of total assets, Migros Bank ranks among the ten largest banks in Switzerland.

The Complainant is the owner, amongst others, of the domain names <migros.com>, registered on February 9, 1998, <migros.ch>, registered on January 1, 1996, used by the Complainant to promote its products and services under the trademark MIGROS. The Complainant's subsidiary Migros Bank AG is the owner of the domain name <migrosbank.com>, registered on January 5, 1999.

The disputed domain name <migrossunion.com> was registered on June 1, 2023 and currently resolves to an inactive website. Prior to the present proceeding, it resolved to an active website promoting financial services allegedly offered by a company named Migross Union GROUP AG, which claimed to be a “subsidiary of Migros Bank”.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant contends that the disputed domain name <migrossunion.com> is confusingly similar to the trademark MIGROS in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the term “union”, an extra letter “s” at the end of its MIGROS trademark and the generic Top Level Domain “.com”.

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name since: i) the Respondent is not a licensee of the Complainant and has in no way been authorized or allowed by the Complainant to use the MIGROS trademark; ii) the Respondent does not use, and has not used, the disputed domain name in connection with a *bona fide* offering of goods or services, as the Respondent has used the disputed domain name to intentionally attempt to attract and confuse Internet users seeking the Complainant's products and services, thus taking unfair advantage of the Complainant's goodwill in the MIGROS mark, to offer competing financial services; iii) the Respondent is not commonly known by the disputed domain name; and iv) the Respondent cannot assert to have made a legitimate non-commercial or fair use of the disputed domain name since the disputed domain name falsely suggests an affiliation with the Complainant and, given the distinctiveness and notoriety of the Complainant's trademark, there cannot be any actual or contemplated good faith use of the disputed domain name as this would result in misleading diversion and taking unfair advantage of the Complainant's rights.

The Complainant claims that the Respondent registered the disputed domain name in bad faith because: i) considering the MIGROS trademark is a coined term and has been used since 1925 in connection with various goods and services and since at least 1958 in connection with banking and financial related goods and services, acquiring considerable goodwill and renown worldwide, the Respondent registered the disputed domain name having full knowledge of the Complainant's rights.

The Complainant also submits that the Respondent registered and used the disputed domain name with the intention of taking

advantage of users searching for the Complainant's financial services for commercial gain and to create a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its website.

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

1. The Complainant has provided evidence of ownership of several trademark registrations for MIGROS.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark MIGROS as it reproduces the trademark in its entirety with the mere addition of a letter "s" and the dictionary term "union", which is not sufficient to prevent a finding of confusing similarity.

As to the gTLD ".com", as established in a number of prior UDRP cases, it is viewed as a standard registration requirement and as such can be disregarded for the purpose of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy.

2. With reference to the Respondent's rights or legitimate interests in the disputed domain name, the Panel finds that the Complainant has made a *prima facie* case and that the Respondent, by not submitting a Response, has failed to provide any element from which a Respondent's right or legitimate interest in the disputed domain name could be inferred.

The Panel notes that, based on the records, the Complainant has not authorized the Respondent to register and use its trademark MIGROS. Moreover, based on the records, there is no evidence that the Respondent might be commonly known by the disputed domain name or a name corresponding to the disputed domain name.

As highlighted above, the disputed domain name, confusingly similar to the Complainant's trademark, is not currently pointed to an active website but, according to the screenshots provided by the Complainant, was previously used to promote financial services in direct competition with the ones provided by the Complainant via its subsidiary Migros Bank AG, falsely mentioning that the website was operated by a "subsidiary of Migros Bank". The Panel finds that the Respondent's use does not amount to a *bona fide* offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name without intention to misleadingly divert the consumers or to tarnish the Complainant's trademark.

Moreover, considering the Complainant's trademark MIGROS is well-known and is used to identify the goods and services of the Complainant's cooperative association and the related entities, the disputed domain name, which combines the Complainant's trademark (although misspelled) with the term "union", is inherently misleading and suggests an affiliation with the Complainant that does not exist.

3. As to bad faith at the time of the registration, the Panel finds that, in light of the Complainant's prior registration and use of the

trademark MIGROS and considering the well-known character of the trademark - recognized also in prior UDRP decisions -, the Respondent must have been aware of the Complainant's trademark when it registered the disputed domain name in June 2023. The fact that, according to the evidence submitted by the Complainant - which has not been contested by the Respondent - the Respondent made reference to the Complainant's subsidiary on the website to which the disputed domain name previously resolved, demonstrates that the Respondent was indeed well aware of, and intended to target, the Complainant and its trademark.

The Panel notes that, in view of the use of the disputed domain name to divert users to the website described above, promoting financial services in direct competition with the ones provided by a Complainant's subsidiary and falsely asserting that the website was operated by a "subsidiary of Migros Bank", the Respondent intentionally attempted to attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of its website and the services promoted therein, according to paragraph 4(b)(iv) of the Policy.

As indicated above, the disputed domain name is currently not pointed to an active website. As established in a number of prior cases, the concept of "bad faith use" in paragraph 4(b) of the Policy includes not only positive action but also passive holding. In the present case, considering the well-known character of the Complainant's trademark, the prior use of the disputed domain name made by the Respondent, the Respondent's failure to file a Response and the implausibility of any good faith use to which the disputed domain name may be put, the Panel finds that the current passive holding of the disputed domain name does not prevent a filing of bad faith use.

Therefore, the Panel finds that the Respondent registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **migrossunion.com**: Transferred

PANELLISTS

Name	Luca Barbero
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DATE OF PANEL DECISION 2023-10-23

Publish the Decision
