Decision for dispute CAC-UDRP-106344

Case number	CAC-UDRP-106344
Time of filing	2024-03-14 14:52:46
Domain names	migrosiran.com, iranmigros.com

Case administrator

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

Complainant

Organization	Migros-Genossenschafts-Bund
Organization	Migros Ticaret A.Ş

Complainant representative

Organization	SILKA AB

Respondent

Name	mohmdtahr sltan

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 names.

IDENTIFICATION OF RIGHTS

- The First Complainant is the holder of numerous trademarks for MIGROS, which cover many jurisdictions around the world, including

Trademark	Origin	Registration Number	Registration Date	Class(es) Covered
	International	315524	23/06/1966	3, 7-9, 11, 21-31, 34
MIGROS	International*	397821	14/03/1973	1-9, 11-12, 14-32, 34
MIGROS	Switzerland	P-405500	20/09/1993	1-9, 11-12, 14-32, 34
MIGROS	European Union	000744912	26/07/2000	1-4, 6-9, 11-12, 14-32, 34-42
MIGROS	United States	6026436	07/04/2020	35

	Switzerland	667858	29/12/2014	9, 16, 29, 30, 35
	International*	1239151	31/12/2014	9, 16, 29, 30, 35
	Turkey	2015 24514	09/10/2016	9, 16, 29, 30, 35
	Turkey	2015 24515	09/10/2016	9, 16, 29, 30, 35

*Designates Iran.

FACTUAL BACKGROUND

The First Complainant, founded in 1925, is a cooperative association based in Switzerland. The First Complainant is owned by more than two million cooperative members and, with over 97,000 employees, is one of Switzerland's largest retailers. The First Complainant, which made an income in excess of CHF 30 million in 2022, operates supermarkets and department stores, and provides services relating to wellness, travel and catering. The First Complainant principally operates online from migros.ch, which received an average of almost eight million visits per month between July and September 2023. The First Complainant is the holder of numerous trademarks for MIGROS, which cover many jurisdictions around the world.

The Second Complainant, one of the biggest supermarket chains in Turkey, was established as a joint venture with the First Complainant in 1954. The Second Complainant separated from the First Complainant in 1975 once the Koç Group took control of it, by acquiring a majority of the Second Complainant's shares. The Second Complainant is licensed by the First Complainant to use the MIGROS Logo Mark. The Second Complainant has more than 3,000 MIGROS-branded stores (of varying sizes) in 81 provinces across Turkey, and its retail goods are advertised online.

PARTIES CONTENTIONS

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

No administratively compliant Response has been filed.

RIGHTS

The First Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trademark or service mark in which the First Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

- The consensus view among panels, in relation to the first UDRP element, is that where a complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold of having trademark rights for the purposes of standing to file a UDRP case (see WIPO Overview 3.0, section 1.2.1).

- As established in the Factual Grounds, the First Complainant holds many trademark registrations for the MIGROS term, which cover numerous jurisdictions (see paragraph 12.2). The first Complainant has licensed the use of the MIGROS Logo Mark to the Second Complainant. The Second Complainant, as an exclusive licensee of the First Complainant, is considered to have rights in the MIGROS Logo Mark for the purposes of the UDRP (see WIPO Overview 3.0, section 1.4). The MIGROS Logo Mark has become a distinctive identifier of the Second Complainant's goods and services.

- The Complainants submit that the identity/confusing similarity requirement of the first UDRP element is satisfied. The disputed domain names both comprise the MIGROS mark in full, in each case either preceded or proceeded by 'Iran'. Panels have consistently held that, where the relevant trademark is recognisable within a disputed domain name, the addition of other terms (whether geographical or otherwise) would not prevent a finding of confusing similarity under the first UDRP element (see WIPO Overview 3.0, section 1.8). The MIGROS mark is dominant, distinctive, and clearly recognisable in each of the disputed domain names; the addition of 'Iran' does not preclude a finding of confusing similarity. On the contrary, this addition increases the likelihood of confusion insofar that such composition creates the impression that the disputed domain names are likely to lead to official sites of the Complainants' MIGROS offerings for Iran.

- Panels have consistently found confusing similarity in respect of similarly constructed domain names (see, for example, Philip Morris Products S.A. v. Whois Privacy Protection Foundation, Hosting Concepts BV d/b/a Registrar.eu, WIPO Case No. D2023-0023 and Delsey

v. Hassan Shegefti, WIPO Case No. D2023-2319: 'The addition of the term "iran" in the disputed domain name does not prevent a finding of confusing similarity as the relevant trademark remains clearly recognizable within the disputed domain name.').

- The Panel disregards the '.com' extension appended to each of the disputed domain names. The '.com' TLD forms a standard registration requirement and as such is disregarded under the first element confusing similarity test (see WIPO Overview 3.0, section 1.11.1).

- Given the above, the Complainants request that the Panel finds the disputed domain names confusingly similar to the MIGROS mark for the purposes of satisfying 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 names (within the meaning of paragraph 4(a)(ii) of the Policy).

- The Respondent lacks rights or legitimate interests in the disputed domain names. Following the submissions made in this section of the Complaint, the burden will shift to the Respondent to put forward evidence to show that it has rights or legitimate interests in the disputed domain names.

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- The Respondent has not registered any trademarks, nor does the Respondent have unregistered trademark rights, for 'migrosiran', 'iranmigros', or any similar term. Additionally, the Respondent has not been licensed by the Complainants to register domain names featuring its MIGROS mark, nor any confusingly similar variant thereof.

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- Paragraph 4(c) of the Policy stipulates some circumstances in which a respondent may demonstrate that it has a right or legitimate interest in a domain name. The Complainants submit that none of the scenarios confer the Respondent with rights or legitimate interests:

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- before any notice to you of the dispute, your use of, or 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;

- you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights;

- you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

- The Respondent has not used, nor prepared to use, the disputed domain names in connection with a bona fide offering of goods or services. The Respondent also has not used the disputed domain names for some legitimate non-commercial or fair use purpose.

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- The disputed domain names have been used to either resolve or redirect users to content ('the Resolving Content') consisting of an apparent shop that purports to sell a range of consumer goods under a title beginning with the wording (translated into English) 'Migros Online Store' ('the Resolving Content's Title') The Resolving Content includes and adapts the MIGROS Logo Mark, forming the logo 'MIGROS IRAN'. The Resolving Content encourages internet users to select and purchase items from the online store by creating an account and inputting personal details (such as the user's name, e-mail address and billing details.

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- The Respondent's use of the disputed domain names to present the Resolving Content, which, among other things, prominently features the MIGROS Logo Mark (albeit in the adapted 'MIGROS IRAN' form described above), reflects its intention to impersonate/pass off as the Complainants by creating the false impression that the Resolving Content is controlled or endorsed by the Complainants (and, in particular, the Second Complainant). In addition to repeatedly brandishing the MIGROS mark, the Resolving Content adopts a similar look and feel to the Complainants' official sites. Examples of this include the Respondent's prevalent use of the orange colour associated with the MIGROS Logo Mark and the nature of the 'M'-shaped graphic above the 'MIGROS IRAN' logo wording (which has clear parallels to the design mark and logo used by the Second Complainant on many of its storefronts – see, for example, the final row of the table in paragraph 12.2, above). Panels have consistently found that the use of a domain name for illegal activity such as impersonation, passing off, or engaging in other types of fraud, can never confer rights or legitimate interests on a respondent (see

WIPO Overview 3.0, section 2.13.1).

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- The composition of the disputed domain names, each combining the distinctive MIGROS mark with the country name 'Iran', carries a high risk of implied affiliation. These strings give internet users the misleading impression that they are, or may be, used by the Complainants (and in particular the Second Complainant) to advertise the Complainants' official offerings to Iran-based internet users. The risk of internet-user confusion is increased by the fact that Iran neighbours Turkey, where the MIGROS Logo Mark has seen widespread use and accrued a significant degree of renown. The Resolving Content includes an article in which the Respondent effectively acknowledges the MIGROS mark's popularity in Iran and capitalises on this by giving the false impression that 'MIGROS IRAN' is an extension or further development to the Complainants' offerings.

- The composition of the disputed domain names, by effectively impersonating or suggesting endorsement by the Complainants, cannot constitute fair use (see WIPO Overview 3.0, section 2.5.1, and, for example, Decathlon v. Kayhan Art and Construction (هنر و سازه کیهان), Case No. D2021-4295: 'Moreover, the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant (especially noting the use of the redirection to resolve to a website offering products related to camping and hiking camping, which is one of the Complainant's area of business). […] The Panel finds that the use of a disputed domain name reproducing the Complainant's trademark with the term "iran" to redirect to another domain name for commercial gain does not support a finding of rights or legitimate interests in the disputed domain name.').

- The Respondent is not known, nor has ever been known, by the distinctive MIGROS mark, the MIGROS Logo Mark, 'migrosiran', 'iranmigros', nor anything similar. The Respondent is not connected to nor affiliated with the Complainants and has not received license or consent to use the MIGROS term in any way. Past UDRP decisions have also established that the mere ownership of a domain name does not confer rights or legitimate interests on a respondent (see, for example, Parchment LLC v. Jim Lovelle / Parchment Transcript LLC, NAF Case No. 2009654 (2022)).

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- The Complainants have presented a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names for the purposes of paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Complainants have, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

- Under the Policy, bad faith is understood to occur where a respondent 'takes unfair advantage of or otherwise abuses a complainant's mark' (see WIPO Overview 3.0, section 3.1). The Respondent has both registered and is using the disputed domain names in bad faith, in accordance with paragraph 4(a)(iii).

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- The Complainants have accrued substantial goodwill and recognition in the MIGROS term, which was first registered as a trademark more than 50 years ago. In particular, the MIGROS Logo Mark, and the Second Complainant's use of it, long precedes the Respondent's registration of the disputed domain names in December 2023. The Second Complainant has used the MIGROS Logo Mark both extensively within Turkey (with more than 3,000 stores incorporating the branding) and online, its migros.com.tr site receiving an average of more than 11 million monthly visits.

- The MIGROS mark and MIGROS Logo Mark are readily identifiable in publicly accessible trademark databases (e.g., WIPO's Global Brand Database). Additionally, a basic Google search of the MIGROS term clearly directs users to the Complainants' official sites. It is therefore evident that, notwithstanding other considerations, the simplest degree of due diligence would have otherwise made the Respondent aware of the Complainants' rights in the globally renowned MIGROS term.

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- The Respondent's decision to register a domain name combining the MIGROS term with the country name 'Iran' constitutes additional evidence that the disputed domain names were registered to create internet-user confusion through the risk of implied affiliation. The Respondent's subsequent creation of the Resolving Content and the Resolving Content's Title explains its choice of domain name strings. The Respondent's specific knowledge of, and intention to target, the Complainants is also clear through its creation of an article, referred to in paragraph 13.13 above, which describes and compares the Second Complainant with its own purported 'MIGROS IRAN' offerings

- The requests were sent to the Registrar and hosting provider concerning the unauthorised Resolving Content and risk of the use of, in particular, <migrosiran.com> for phishing purposes (see further details on this point in paragraphs 13.27 and 13.28 below). The Registrar relayed the Complainants' message to the Respondent, who replied by stating, among other things: 'The name and logo of the

site are completely different and we did not intend to violate copyright laws. migrosiran domain belongs to Iran and is a separate store. And there is no threat to the migros brand.' A further reply was sent directly to the Respondent, emphasising the Respondent's infringement of the MIGROS mark and requesting the transfer of both the disputed domain names in addition to <migrosiran.ir> and <iranmigros.ir> (two other domain names held by the Respondent). The Respondent replied once more, claiming among other things that 'a lot of damage will be done to our brand in Iran. Therefore, you have to pay compensation to transfer this domain, otherwise we will do the necessary follow-up.'

- The abovementioned responses from info@migrosiran.com show that the Respondent had prior knowledge of the Complainants' MIGROS brand and, despite its claims, intended to capitalise on the trademark value associated with such.

- Having established the matter of bad faith registration, the Respondent has used the disputed domain names in bad faith within the meaning of paragraph 4(b)(iv) of the Policy:

- by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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.

- The Respondent has intentionally attempted to attract, for commercial gain, internet users by creating a likelihood of confusion with the Complainants' MIGROS mark. As noted above, the disputed domain names have been used to resolve or redirect to the Resolving Content, under the Resolving Content's Title, which reproduces the MIGROS Logo Mark and purports to sell goods. The Resolving Content has a similar look and feel to the Complainants' official websites and is clearly designed to create the false impression that the disputed domain names are controlled or otherwise authorised by the Complainants.

- The degree of the Respondent's deception is heightened by two other factors: (i) its publication of content describing the Second Complainant's offerings, which it uses to give the false impression that the Resolving Content is endorsed or otherwise associated; and (ii) its failure to attempt to disclaim the lack of connection between the Resolving Content and Complainants (e.g., through a clear and sufficiently prominent disclaimer). In respect of this second point, rather than attempting to mitigate the risk of confusion, the Respondent's prominent and recurrent display of the MIGROS mark and footer text such as '© All rights reserved by Migros Iran.' Only reinforces the false and misleading impression that the disputed domain Names are under the Complainants' control.

- UDRP panels have repeatedly found that a respondent's use of a domain name to reproduce a complainant's logo mark is evidence of bad faith use within the meaning of paragraph 4(b)(iv) (see, for example, Opportunity Financial, LLC v. James Slavin, Forum Case No. 2008765 (2022): 'Finally, Respondent used the disputed domain name to pass off as Complainant by displaying Complainant's mark and logo on the resolving webpage. The Panel finds that Respondent uses the <opploans.cash> domain name with intent to attract Internet users with a false impression of association with Complainant in bad faith pursuant to Policy ¶ 4(b)(iv).').

- The Respondent has configured <migrosiran.com> with an MX (mail exchange) record, so it can be used to send and receive e-mails. The Respondent has similarly configured <migrosiran.ir>, to which the disputed domain names currently redirect users, with an MX record. Given the nature of the Domain Names' compositions (creating the risk of implied affiliation) and the manner in which they have been used (leading users to the Resolving Content which impersonates/passes off as the Complainants), there is a high risk that the disputed domain names may be used to send phishing e-mails. Internet users receiving correspondence from an e-mail ending in @migrosiran.com are highly likely to believe such correspondence originates from the Complainants or an authorised agent of the Complainants.

- Panels have repeatedly found that the activation of MX records, in circumstances where there is a high likelihood of internet-user confusion, is indicative of a respondent's intention to engage in illegitimate conduct (see, for instance, TEVA Pharmaceutical Industries Limited v. Name Redacted, WIPO Case No. D2022-3791 ('The Panel finds that Respondent's registration of MX records in respect of the disputed domain are further circumstances demonstrating bad faith registration and use of the disputed domain name.') and Morgan Stanley v. Stone Gabriel, Forum Case No. 1998634 (2022) ('The Panel has determined that there are MX records for the disputed domain name, therefore it might be intended for use in an email phishing scheme.')).

PROCEDURAL FACTORS

Pursuant to paragraph 11(a) of the Rules, unless otherwise agreed by the parties, or otherwise specified in the Registration Agreement, the

language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

Paragraph 10(b) and (c) of the Rules requires the Panel to ensure that the proceeding takes place with due expedition and that the parties are treated fairly and given a fair opportunity to present their respective cases.

The language of the Registration Agreement for the disputed domain name is German. From the evidence on record, no agreement appears to have been entered into between the Complainant and the Respondent regarding the language issue. The Complainant filed its Complaint in English and then requested that English be the language of the proceeding.

The Panel notes that:

(a) the CAC has notified the Respondent of the proceeding in both English and German;

(b) thus, the Respondent has been given the opportunity to present its case in this proceeding and to respond formally to the issue of the language of the proceeding;

(c) however, the Respondent has not responded to nor contested the Complainant's request for a change of the language from German to English.

Considering the above circumstances, the Panel finds that the choice of English as the language of the present proceeding is fair to both parties and is not prejudicial to either one of the parties in his or her ability to articulate the arguments for this case.

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

The Complainants have, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

The Respondent's decision to register a domain name combining the MIGROS term for instance with the country name 'Iran' constitutes additional evidence that the disputed domain names were registered to create internet-user confusion through the risk of implied affiliation. The Respondent's subsequent creation of the Resolving Content and the Resolving Content's Title explains its choice of domain name strings. The Respondent's specific knowledge of, and intention to target, the Complainants is also clear through its creation of an article which describes and compares the Second Complainant with its own purported 'MIGROS IRAN' offerings.

The Respondent has configured <migrosiran.com> with an MX (mail exchange) record, so it can be used to send and receive e-mails. The Respondent has similarly configured <migrosiran.ir>, to which the disputed domain names currently redirect users, with an MX record. Given the nature of the Domain Names' compositions (creating the risk of implied affiliation) and the manner in which they have been used (leading users to the Resolving Content which impersonates/passes off as the Complainants), there is a high risk that the disputed domain names may be used to send phishing e-mails. Internet users receiving correspondence from an e-mail ending in @migrosiran.com are highly likely to believe such correspondence originates from the Complainants or an authorised agent of the Complainants.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **migrosiran.com**: Transferred
2. **iranmigros.com**: Transferred

PANELLISTS

Name	**Thomas Hoeren**

DATE OF PANEL DECISION 2024-04-11