Decision for dispute CAC-UDRP-106602

Case number	CAC-UDRP-106602
Time of filing	2024-06-13 11:05:35
Domain names	corporate-migros.email

Case administrator

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

Complainant

Organization	Migros-Genossenschafts-Bund

Complainant representative

Organization	SILKA AB

Respondent

Name	Bernard POSTE

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

Among other registered trademarks, the Complainant is owner of International Registered Trademark Number 397821 for the word mark MIGROS, registered on March 14, 1973 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, and designated in respect of multiple territories.

FACTUAL BACKGROUND

The Complainant is a cooperative association founded in 1925 and based in Switzerland. It is owned by more than two million cooperative members and, with more than 99,000 employees, is one of Switzerland's largest retailers. The Complainant operates supermarkets and department stores, and provides services relating to wellness, travel and catering. It reported group sales in excess of CHF 31 billion in 2023. The Complainant has a substantial social media presence with more than 120,000 followers on X (formerly Twitter) and over 90,000 followers on LinkedIn. The Complainant also has a mobile application for the Google Play and Apple App Store platforms. The Complainant's Google Play application has been downloaded more than one million times.

The Complainant's main website, from which it advertises its offerings to consumers, uses the domain name <migros.ch>. The Complainant and its associated/affiliated entities also hold a number of other domain names incorporating the MIGROS mark, such as <migros.com>, <migros.net>, <migros.fr>, <migros.at>, <migros.de> and <migros.us>. The Complainant's MIGROS mark has been recognised as possessing a high degree of distinctiveness and worldwide fame by previous panels, for example in Migros-

Genossenschafts-Bund v. Ling Li, CAC Case No. 105532.

The Respondent has not filed a response in this case. It appears to be an individual based in Paris, France.

The disputed domain name was registered on May 27, 2024. It has previously been used to redirect Internet users to a page on one of the Complainant's official websites, namely, "corporate.migros.ch/en". The Complainant notes that, following its request to the hosting provider to remove the said redirection, the disputed domain name no longer resolves to an active web page and is now passively held.

PARTIES CONTENTIONS

Complainant:

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant submits that the identity/confusing similarity requirement of the first element is satisfied. The Second-Level Domain of the disputed domain name comprises of the Complainant's MIGROS trademark in full, only preceded by the word "corporate" and a hyphen. Panels in previous cases under the Policy have found that, where the relevant trademark is recognisable within the domain name concerned, the addition of other terms (whether descriptive or otherwise) would not prevent a finding of confusing similarity under the first element of the Policy. The MIGROS mark remains clearly distinguishable and recognisable in the disputed domain name.

The Complainant submits that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent does not have trademark rights in, nor is it known by, "corporate-migros" or any similar term. The Respondent is neither connected to nor affiliated with the Complainant, and it has not received any license or consent to use the MIGROS mark in any way. Previous decisions under the Policy have established that the mere ownership of a domain name does not confer rights or legitimate interests on a respondent.

The Respondent has neither used, nor prepared to use, the disputed domain name in connection with a bona fide offering of goods or services, nor for a legitimate non-commercial or fair use. The disputed domain name has previously been used to redirect Internet users to a page on one of the Complainant's official websites at "corporate.migros.ch/en" which involves the subdomain "corporate" under the Complainant's <migros.ch> domain name, and provides Internet users with details on the Complainant's corporate offerings. The disputed domain name, by closely corresponding with the second and third levels of the URL to which it previously redirected Internet users carries a high risk of implied affiliation. Such composition, in particular through the inclusion of the commercial term "corporate", gives Internet users the misleading impression that the disputed domain name is held and used by the Complainant to provide information about its corporate offerings. The choice of the generic Top-Level Domain ".email" also serves to increase the risk of Internet-user confusion, particularly if the Respondent were to use the disputed domain name to send phishing e-mails in connection with such (purporting to originate from the Complainant). Users would, for example, likely believe e-mail addresses ending in "@corporate-migros.email" derive from the Complainant. Such users would have this false impression reinforced by subsequently searching the disputed domain name in their browser's address bar and being redirected to the Complainant's official site.

Where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.

Further, the Complainant contends that the disputed domain name was registered and is being used in bad faith. The Complainant has accrued substantial goodwill and recognition in the MIGROS mark through decades of use. The Complainant's MIGROS trademarks long precede the Respondent's registration of the disputed domain name and cover many jurisdictions. Previous panels under the Policy have repeatedly noted the distinctiveness and worldwide renown of the Complainant's MIGROS mark. The Complainant's MIGROS mark is readily identifiable in publicly accessible trademark databases such as the WIPO Global Brand Database. Additionally, the first result further to a basic Google search of "corporate-migros" clearly pertains to the Complainant's offerings. It is therefore evident that the simplest degree of due diligence would have made the registrant of the disputed domain name aware of the Complainant's rights in its MIGROS mark.

The disputed domain name effectively impersonates the Complainant and the Respondent's selection of same can only be explained by its awareness of, and intention to target, the Complainant.

The Complainant submits that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's MIGROS mark. The Respondent has used the disputed domain name, which, given its composition, can only plausibly relate to the Complainant, to redirect users to a page on one of the Complainant's official websites. Such conduct reinforces Internet users' false impression (given the composition of the disputed domain name) that the disputed domain name forms part of the Complainant's domain name portfolio and is controlled by the Complainant.

Finally, the Complainant notes that, following a request to the hosting provider for the removal of the misleading redirection of the disputed domain name to the Complainant's official website, the disputed domain name no longer redirects Internet users and is passively held. The fact that the disputed domain name is no longer actively used does not prevent a finding of bad faith use under the Policy. Panels have found that the non-use of a domain name can constitute bad faith use under the doctrine of passive holding.

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

The Complainant has demonstrated that it has UDRP-relevant rights in its MIGROS registered trademark by virtue of International Registered Trademark Number 397821.

The second level of the disputed domain name contains the Complainant's MIGROS trademark in its entirety, together with a dash or hyphen and the word "corporate". Neither the presence of the hyphen in the disputed domain name, nor the word "corporate", alter the fact that the Complainant's MIGROS mark is fully recognizable therein on a straightforward side-by-side comparison. It is the dominant and most distinctive element of the disputed domain name. The generic Top-Level Domain in respect of the disputed domain name, namely ".email", is typically disregarded for the purposes of the comparison under the first element analysis of the Policy. Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's MIGROS trademark.

With regard to the second element of the Policy, the Complainant submits that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Complainant asserts that the Respondent is not commonly known by the disputed domain name and is not making a bona fide offering of goods and services thereby, adding that the Respondent is not the owner and/or licensee of any trademark registration corresponding to the disputed domain name, and has no rights in the MIGROS trademark. The Complainant notes that there is no evidence that the Respondent is known by the name "migros" in the course of trade. The Complainant submits that it has never authorized the Respondent to register and use its mark in the disputed domain name and notes that in the absence of any license or permission from the Complainant to use its said trademark, no actual or contemplated bona fide or legitimate use of the disputed domain name could reasonably be claimed. The Panel finds that these submissions, taken together, are sufficient to constitute the requisite prima facie case that the Respondent has no rights and legitimate interests in the disputed domain name (see, for example, section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0")).

The Respondent has failed to rebut the Complainant's said prima facie case in that it has not filed a Response in the administrative proceeding. The Respondent has previously used the disputed domain name to redirect Internet users to a page on one of the Complainant's official websites at "corporate.migros.ch/en" and thereafter, following a request by the Complainant to the Respondent's hosting company to remove said redirection, the disputed domain name does not resolve to any active web page. Such use cannot constitute a bona fide or legitimate use of the disputed domain name.

The Panel therefore considers that it is reasonable in all of the above the circumstances to make a finding that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel turns to the third element assessment, namely the question of registration and use in bad faith in respect of the disputed domain name. The Panel notes that the composition of the Second-Level Domain of the disputed domain name comprises the

Complainant's MIGROS mark together with the word "corporate". The Respondent's choice of the terms "corporate" and "email", combined with the Complainant's MIGROS mark clearly indicates that the Respondent registered the disputed domain name with actual knowledge of, and the intention to capitalise on, the Complainant's MIGROS trademark. The composition of the disputed domain name, which effectively impersonates the Complainant, coupled with the Respondent's use of the disputed domain name to redirect users to a page on one of the Complainant's own official websites at "corporate.migros.ch/en" clearly indicates an awareness of and intention to target the Complainant. For that reason, the Panel accepts the Complainant's submission that the Respondent more likely than not had actual knowledge of Complainant's rights in its MIGROS trademark at the point when the disputed domain name was registered. The Panel also accepts the Complainant's submission that, given the notoriety of such mark, the Respondent could not reasonably have been unaware of the Complainant's trademarks at the time of registration.

The Panel notes that previous panels have found respondents' use of domain names to redirect users to complainants' official websites as evidence of bad faith use under paragraph 4(b)(iv) of the Policy. See, for example, the consensus view outlined in the WIPO Overview 3.0, section 3.1.4: "Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark: […] (v) redirecting the domain name to the complainant's (or a competitor's) website […] panels have found that a respondent redirecting a domain name to the complainant's website can establish bad faith insofar as the respondent retains control over the redirection thus creating a real or implied ongoing threat to the complainant."

The Panel therefore finds that the Respondent's use of the disputed domain name to redirect users to the Complainant's own website constitutes use in bad faith. Insofar as the disputed domain name latterly did not resolve to any active website (following the Complainant's request to remove the redirection), the passive holding of the disputed domain name does not prevent a finding of use in bad faith in the circumstances of this case.

Accordingly, in all of these circumstances, and in the absence of any rebuttal from the Respondent, the Panel finds on the balance of probabilities that the Respondent has 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. **corporate-migros.email**: Transferred

PANELLISTS

Name	**Andrew Lothian**

DATE OF PANEL DECISION 2024-07-13

Publish the Decision