# Decision for dispute CAC-UDRP-106762

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| Case number | CAC-UDRP-106762 |
| Time of filing | 2024-07-31 09:31:32 |
| Domain names | migrosfrancemigros-ltd.com, migros-ltd.com |

## Case administrator

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| Name | Olga Slanařová (Case admin) |

## Complainant

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| Organization | Migros-Genossenschafts-Bund / Federation Of Migros Cooperative |

## Complainant representative

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| Organization | SILKA AB |

## Respondent

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| Name | Antreas Papadopoulos |

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 owns more than 200 MIGROS trademarks registered worldwide, both as word and figurative marks, across several classes and not limited to retail, food, and delivery services. Notable registrations include, particularly, the following:

- European Union Trademark for MIGROS (word) no. 000744912, registered on July 26, 2000;
- European Union Trademark for MIGROS (word) no. 003466265, registered on May 13, 2005;
- International Registration Trademark for MIGROS (word) no. 637252, registered on February 13, 1995;
- International Registration Trademark for MIGROS (figurative) no. 1459503, registered on December 31, 2018.

FACTUAL BACKGROUND

The Complainant was founded in 1925 and is one of Switzerland's largest retailers and private employers, operating through five business units: cooperative retailing, commerce, industry and wholesaling, travel, and services.

The Complainant owns more than 200 MIGROS trademarks registered worldwide, both as word and figurative marks, across several classes and not limited to retail, food, and delivery services.

The Complainant is also the registrant of the domain names <migros.ch>, registered in 1996, and <migros.com>, registered on

February 9, 1998.

The disputed domain names were registered on June 14, 2024. At the time of this decision, the disputed domain names resolve to inactive websites.

PARTIES CONTENTIONS

## A. Complainant

The Complainant asserts that each of the elements enumerated in paragraph 4(a) of the Policy and the corresponding provisions in the Rules have been satisfied. In particular, the Complainant asserts that:

(1) The disputed domain names are confusingly similar to the Complainant's MIGROS trademark. The Complainant holds rights to the MIGROS trademark. Each of the disputed domain names incorporates the MIGROS trademark in its entirety, along with the country name "FRANCE" and the abbreviation "LTD", as well as the generic Top-Level Domain ("gTLD") ".COM." This combination clearly indicates the Respondent's intention to mislead Internet users into believing that the disputed domain names are associated with the Complainant. By adding the terms "France" and "Ltd", the Respondent is attempting to impersonate the Complainant, making the disputed domain names appear as though they represent (a) the Complainant's business in France or (b) a corporate branch or official website of the Complainant. The addition of the gTLD ".com" does not add any distinctiveness to the disputed domain names, nor does it eliminate the confusing similarity with the Complainant's MIGROS trademark, as the gTLD is viewed as a standard registration requirement.

(2) The Respondent has no rights or legitimate interests in the disputed domain names. The Complainant has never assigned, granted, licensed, sold, transferred, or otherwise authorized the Respondent to register or use the MIGROS trademark in any manner. The Respondent has never been commonly known by any of the disputed domain names and has not acquired any trademark rights in them. By registering disputed domain names, the Respondent's intention is to prevent the Complainant from exercising its legitimate rights over the MIGROS trademark, in which the Complainant has prior rights.

(3) The disputed domain names should be considered as having been registered and used in bad faith by the Respondent. The MIGROS trademark is clearly famous and widely known. The Complainant's active presence in the market and on social media makes it unlikely that the Respondent was unaware of the MIGROS trademarks. The fact that the disputed domain names resolve to inactive websites indicates that the Respondent has not made legitimate use of the disputed domain names since their registration, suggesting that the Respondent had no demonstrable or legitimate plan to use the disputed domain names or engage in any activity related to them. The disputed domain names were registered with the intent of taking advantage of the reputation of the Complainant's MIGROS trademark.

The Complainant requests transfer of the disputed domain names.

**B. Respondent**

The Respondent did not reply to the Complainant's contentions.

RIGHTS

The 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 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 names (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 names have been registered and are 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

To succeed, in a UDRP complaint, complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

(i) the disputed domain names are 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 disputed domain names; and

(iii) the disputed domain names have been registered and are being used in bad faith.

The Respondent had 20 days to submit a response in accordance with paragraph 5(a) of the Rules and failed to do so. Paragraph 5(f) of the Rules establishes that if a respondent does not respond to the Complaint, the Panel's decision shall be based upon the Complaint. The Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complainant's contentions.

However, concerning the uncontested information provided by the Complainant, the Panel may, where relevant, accept the provided reasonable factual allegations in the Complaint as true. See, section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0").

It is further noted that the Panel has taken note of the WIPO Overview 3.0 and, where appropriate, will decide consistent with the consensus views captured therein.

**A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview 3.0, section 1.7.

The Complainant has shown rights in respect of a trademark MIGROS for the purposes of the Policy. WIPO Overview 3.0, section 1.2.1.

The entirety of the trademark is reproduced within the disputed domain names, following the geographical term "france" in the disputed domain name <migrosfrancemigros-ltd.com> and the abbreviation "ltd" in both disputed domain names. This does not prevent a finding of confusing similarity between the disputed domain names and the trademark under the Policy, paragraph 4(a)(i). The gTLD ".com" is considered a standard registration requirement and is therefore disregarded under the first element of the confusing similarity test (see WIPO Overview 3.0, sections 1.7, 1.8, and 1.11.1). Bearing this in mind, the Panel holds that the disputed domain names are confusingly similar to the Complainant's trademark MIGROS.

The Panel finds the first element of the Policy has been established.

**B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

It is well established that, as it is put in WIPO Overview 3.0, section 2.1, while the overall burden of proof in the proceedings is on the complainant, 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. Therefore, the Panel agrees with prior UDRP panels that the complainant is required to make out a prima facie case before the burden of production on this element shifts to the respondent to show that it has rights or legitimate interests in the disputed domain name.

The Complainant has made out a prima facie case showing that the Respondent has no rights or legitimate interests in the disputed domain names, notably by demonstrating rights in the MIGROS trademark, which precede the Respondent's registration of the disputed domain names for years, and confirming that the Respondent is neither affiliated with, nor has it been licensed or permitted to use the Complainant's MIGROS trademark or any domain names incorporating the MIGROS trademark.

According to the case file, there is nothing to suggest any bona fide use that might confer rights or legitimate interests in the disputed domain names on the Respondent. Nor is there any evidence that the Respondent has made demonstrable preparations to use the disputed domain names in connection with a bona fide offering of goods or services. To the contrary, the disputed domain names currently resolve to inactive web pages.

Consequently, the burden of production shifts to the Respondent to rebut the Complainant's prima facie case by providing relevant evidence that he or she has rights or legitimate interests in the disputed domain names. However, the Respondent has failed to file a

response to prove his or her rights or legitimate interests in the disputed domain names under paragraph 4(c) of the Policy.

Bearing in mind that the Panel has not found evidence that the Respondent has been commonly known by the disputed domain names, and that the Complainant has not licensed, authorized, or permitted the Respondent to register the disputed domain names incorporating the Complainant's mark, taking into account that the Respondent is not sponsored by or legitimately affiliated with the Complainant in any way, the Panel found that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Panel finds, therefore, that the second element of the Policy has been established.

**C. Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Complainant has submitted evidence that the Respondent registered the disputed domain names long after the Complainant registered its MIGROS trademark. Given the accumulation of good will and distinctiveness of the Complainant's mark over the course of its long history, and the fact that the MIGROS mark appears to be distinctive, 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 names.

In addition, the disputed domain names incorporate the entirety of the Complainant's MIGROS mark along with various additional suffixes which the Panel finds is an attempt by the Respondent to confuse and/or mislead Internet users seeking or expecting the Complainant. To this end, the Panel establishes that attracting Internet traffic by using a domain name that is identical or confusingly similar to create a likelihood of confusion with a registered trademark may be evidence of bad faith under paragraph 4(b)(iv) of the Policy.

Furthermore, the Panel considers that by registering the two disputed domain names in this case, the Respondent has acted in bad faith pursuant to paragraph 4(b)(ii) of the Policy, which provides that bad faith is evidenced where a registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct.

Finally, the Respondent's passive holding of the disputed domain names (i.e., where the domain name does not resolve to any website) does not prevent a finding of bad faith. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. See section 3.3 of the WIPO Overview 3.0. All of these conditions seem to have been met in the current proceedings.

The Respondent did not submit a response in this proceeding. Under the circumstances of this case, this is an additional indication of the Respondent's bad faith, which was considered by the Panel.

The Panel finds the third element of the Policy has been established.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **migrosfrancemigros-ltd.com**: Transferred
2. **migros-ltd.com**: Transferred

## PANELLISTS

| Name | **Ganna Prokhorova** |
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DATE OF PANEL DECISION 2024-08-22

Publish the Decision