Anonymized decision for dispute CAC-UDRP-106814

Case number	CAC-UDRP-106814
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Domain names	migrosgruppe.com

Case administrator

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

Complainant

Organization	Migros-Genossenschafts-Bund

Complainant representative

Organization	SILKA AB

Respondent

Organization	[redacted]

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 <migrosgruppe.com>.

IDENTIFICATION OF RIGHTS

The Complainant owns several trademarks for the distinctive term "MIGROS" and the variations thereof. The first trademark MIGROS was applied in 1966 as an international trademark under 17 classes and covers numerous EU, African and Asian countries, vide International Trademark Registration number 315524, registered on June 24, 1966. The Complainant, thereafter, applied for numerous other trademarks and owns hundreds of registered trademarks for MIGROS. The Complainant also relies on the goodwill and recognition that it has attained under the MIGROS Group.

The Complainant and its affiliated companies / subsidiaries hold numerous domain names which encompass the MIGROS mark, and these are used to advertise the Complainant's goods and services across a wide range of territories around the world. These registrations include <migros.com>, <migrosgroup.com>, <migros-shop.com> and <migros-online.com> among others.

Furthermore, the Complainant also has a strong social media presence with, for example, 127 thousand followers on Twitter (@migros), 189 thousand followers on Instagram (@migros), and 8 thousand followers on LinkedIn (@migros).

The disputed domain name <migrosgruppe.com> was registered on August 12, 2024.

FACTUAL BACKGROUND

The Complainant, Migros-Genossenschafts-Bund (Migros), was founded in 1925 in Zurich as a private enterprise by Gottlieb Duttweiler. From the opening of the first self-service grocery store in 1948 to this day, the Complainant keeps the cooperative society as its form of organisation and serves as the umbrella organization of ten regional Migros Cooperatives. The Complainant offers a wide range of food, and non-food products and services relating to wellness, travel and catering. The offerings include travel agencies, cultural institutions, museums and magazines, restaurants, water and fitness parks, golf parks, pension funds and foundations, and Banking.

The 'Migros Group' includes the Migros Industrie companies, various retail, healthcare and travel companies as well as several foundations. In organisational terms, all these companies fall under six broad divisions: Nutrition and Enjoyment; Health; Lifestyle and Home; Payment, Investment and Finance; Other companies and Foundations and Pension Schemes.

PARTIES CONTENTIONS

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

COMPLAINANT:

• The disputed domain name is identical or confusingly similar to the protected mark

According to the Complainant, the disputed domain name is confusingly similar to the disputed domain name as it fully incorporates the Complainant's well-known trademark MIGROS, as the main and dominant element, with an addition of a word "gruppe" (which means "group" in German language).

The Complainant also contends that the addition of the generic Top-Level Domain suffix ".COM" does not differentiate the domain name from the trademark (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), paragraphs 1.7 and 1.11).

Therefore, the Complainant argues that the disputed domain name is confusingly similar to the Complainant's NANUSHKA trademark within the meaning of Paragraph 4(a)(i) of the Policy.

• The Respondent does not have any rights or legitimate interest in the disputed domain name

The Complainant contends that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and is not related in any way with the Complainant.

Neither licence nor authorization has been granted to the Respondent to make any use of the Complainant's trademark MIGROS, or apply for registration of the disputed domain name by the Complainant.

Also, the disputed domain name does not resolve to an active website, that is, it is passively held.

Moreover, the Complainant provides that the Respondent uses the Complainant's details in the WHOIS Information and the MX servers are activated. Accordingly, the Complainant argues that the disputed domain name is being used, or intended to be used, for phishing or other fraudulent purposes using e-mail IDs ending with '@migrosgruppe.com' and is intended to exclusively "pass off" as the Complainant herein and have a free ride on its reputation and goodwill. The impersonation of the Complainant through the WHOIS along with active MX records only reinforces the (false) association between the Complainant and the disputed domain name. Consequently, the Complainant also requests that the Respondent's details be redacted in the decision as far as they use the Complainant's details.

Therefore, the Complainant contends that the Respondent has no right nor legitimate interest in respect of the disputed domain name, within the meaning of the Paragraphs 4(a)(ii) and (4)(c) of the Policy.

• The disputed domain name has been registered and is being used in bad faith

The Complainant states that the disputed domain name comprises the Complainant's distinctive trademark MIGROS. Thus, given the distinctiveness of the Complainant's trademark and the immense popularity and goodwill enjoyed by the Complainant's trademark globally by virtue of its open, continuous and extensive use and its impeccable market reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. 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.

In addition, the Complainant provides that the Respondent intends to send suspicious emails using the configured Google mail servers. The Respondent has provided the WHOIS information of the Complainant for the disputed domain name likely to create the false impression that the disputed domain name is owned and controlled by the Complainant.

The Complainant contends that the disputed domain name is currently inactive, which accordingly, in the circumstances of this case, the inactive status of the disputed domain name comprises bad faith use under the doctrine of passive holding.

Therefore, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith within

the meaning of Paragraph 4(a)(iii) of the Policy.

In conclusion, the Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

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.

Redaction of Respondent Details

Paragraph 4(j) of the Policy reads, “[a]ll decisions under this Policy will be published in full over the Internet, except when an Administrative Panel determines in an exceptional case to redact portions of its decision.” Panels have carefully carved out identity theft as an “exceptional case” that justifies redacting of victims’ personal information.

The Complainant requests the Respondent's details be redacted in the decision as far as they use the Complainant's details.

The Panel has determined it is appropriate to redact the Respondent’s identity from this Decision.

PRINCIPAL REASONS FOR THE DECISION

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) (the “Policy”) provides that complainant must prove each of the following to obtain transfer or cancellation of the domain name:

1. that respondent’s domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

2. that respondent has no rights or legitimate interests in respect of the domain name; and

3. the domain name has been registered and is being used in bad faith.

1) The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights

The Complainant has provided evidence and proved to be the owner of the trademark MIGROS. Essentially, the Respondent has appropriated the term MIGROS by adding a descriptive word "gruppe" (which means "group" in German language) to presumably create a confusing similarity between the Complainant’s well-known and renown trademark MIGROS and the disputed domain name <migrosgruppe.com> and to lead consumers to believe that it is affiliated with the Complainant.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark MIGROS since the mere addition of a descriptive word "gruppe" does not eliminate any confusing similarity. This is especially true where, as here, the trademark is "the dominant portion of the domain name," LEGO Juris A/S v. Domain Tech Enterprises, WIPO Case No. D2011-2286, or where the trademark in the domain name represents "the most prominent part of the disputed domain name[] which will attract consumers' attention." Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI, WIPO Case No. D2006-0768.

Additionally, the disputed domain name not only fully incorporates the MIGROS trademark but also includes a purely generic top-level domain ("gTLD") "com". Previous UDRP panels have also held that the gTLD ".com" is not to be taken into account when assessing whether a domain name is identical or confusingly similar to a trademark. See e.g., Wiluna Holdings, LLC v. Edna Sherman, FA 1652781 (Forum January 22, 2016).

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, and could confuse Internet users into thinking that the disputed domain name is associated with the Complainant or its trademarks.

In these circumstances, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks.

2) The Respondent lacks rights or legitimate interests in the disputed domain name

Under the Policy, a complainant is required to make out a prima facie case that a respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see WIPO Overview 2.0, paragraph 2.1).

The Panel finds that the Respondent does not have a legal right to use the MIGROS trademark as part of its domain name. The Respondent is not in any way affiliated with the Complainant, nor is it authorized to register the disputed domain name. Past panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use. When entering the terms "migros gruppe" in the Google search engine, the returned results point to the Complainant and its business activities.

In a present case, the Respondent failed to file a Response in which it could have provided evidence in support of its rights or legitimate interests. Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name.

3) The disputed domain name has been registered and is being used in bad faith

The Panel agrees with the Complainant that its trademark MIGROS is distinctive and known. The Complainant's trademarks largely precede the registration of the disputed domain name. The Panel finds that there appears no reason why the Respondent would register the Complainant's trademark as part of the disputed domain name, other than to create the impression that it is connected to the Complainant's business. Given the distinctiveness of the Complainant's trademark worldwide, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks.

The fact that the Respondent has registered the disputed domain name that is confusingly similar to Complainant´s trademark indicates and in the absence of any evidence contrary (or any administratively compliant response at all) being put forward by the Respondent, that the Respondent, according to this Panel, had knowledge of the Complainant's trademark and that it had such knowledge before the registration and use of the disputed domain name.

The disputed domain name redirects to an inactive page. According to the Panel, a passive holding of the disputed domain name may amount to bad faith when it is difficult to imagine any plausible future active use of the disputed domain name by the Respondent that would be legitimate and not infringing the Complainant's well-known mark or unfair competition and consumer protection legislation (See Inter-IKEA v Polanski, WIPO Case No. D2000 1614; Inter-IKEA Systems B.V. v. Hoon Huh, WIPO Case No. D2000 0438; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). Countless UDRP decisions also confirmed that the passive holding of a domain name with the knowledge that the domain name infringes another party's trademark rights is evidence of bad faith registration and use (Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

Moreover, the Respondent uses the Complainant's details in the WHOIS Information and configured MX records. According to the Panel, the Respondent could eventually impersonate the Complainant to its detriment, such as phishing or other fraudulent attempts, which may be considered as registration in bad faith. Consequently, the Panel has determined it is appropriate to redact the Respondent's identity from this Decision.

Accordingly, the Panel concludes that the Complainant has satisfied the third element of the Policy, that is that the Respondent's registration and use of the disputed domain name in bad faith.

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy, which is that the Respondent's registration and use of the disputed domain name is in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

PANELLISTS

Name	**Barbora Donathová**

DATE OF PANEL DECISION 2024-10-09

Publish the Decision