Decision for dispute CAC-UDRP-106998

Case number	CAC-UDRP-106998
Time of filing	2024-10-25 10:46:10
Domain names	migros-gruppe.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Migros-Genossenschafts-Bund

Complainant representative

Organization	SILKA AB

Respondent

Name	kylew travis

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 has demonstrated ownership of rights in the MIGROS trademark for the purposes of standing to file a UDRP Complaint.

In particular, the Complainant is the owner of trademark registrations for MIGROS, including the following:

- International trademark registration No. 315524 for MIGROS, registered on June 23, 1966;

- European Union trademark registration No. 000744912 for MIGROS, registered on July 27, 2000; and

- European Union trademark registration No. 003466265 for MIGROS, registered on October 29, 2005.

The Complainant also refers to ownership over a number of domain names that incorporate its MIGROS trademark, including the following: <migros.com>, registered on February 9, 1998 and <migrosgroup.com>, registered on April 8, 2015.

FACTUAL BACKGROUND

The Complainant was founded in 1925 in Zurich as a private enterprise. 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 organization 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 organizational 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.

The disputed domain name was registered on September 30, 2024 and it does not resolve to any active website. According to the evidence provided by the Complainant, the disputed domain name was used to send e-mails that impersonate C-level executive of the Complainant.

PARTIES CONTENTIONS

The Complainant

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it. In particular, the Complainant argues that the disputed domain name is confusingly similar to its MIGROS trademark as this trademark is contained in its entirety within the disputed domain name. Further, the Complainant contends that ".com" gTLD is viewed as a standard registration requirement and as such is disregarded.

Regarding the second UDRP element, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark, or apply for registration of the disputed domain name by the Complainant. The Respondent is also not commonly known by the disputed domain name. The Respondent has used the disputed domain name to send fraudulent phishing e-mails impersonating C-level executive of the Complainant and use of the disputed domain name for illegal activity can never confer rights or legitimate interests on a respondent.

With respect to the third UDRP element, the Complainant holds that the registration of a domain name that is confusingly similar to another's mark, despite actual or even constructive knowledge of the mark holder's rights, constitutes bad faith registration and use, pursuant to Policy. The Complainant asserts that it is inconceivable that the registration of the disputed domain name was made without the actual knowledge of the Complainant and its business, given the extensive use and well-known status of the Complainant's MIGROS trademark. Further, the use of the disputed domain name for phishing and impersonation of the Complainant's executives clearly indicates use of the disputed domain name in bad faith.

The 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. The Panel has issued Procedural order No. 1 requesting from the Complainant to clarify remedy

sought by the complaint and to clarify whether there are any other ongoing legal proceedings regarding the disputed domain name. The Complainant has provided the response to procedural order which is satisfactory for the Panel to move forward with the decision.

PRINCIPAL REASONS FOR THE DECISION

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy stipulates that the complainant must prove each of the following:

1. that the disputed domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
2. that the respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. that the disputed domain name has been registered and is being used in bad faith.

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, as stipulated in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“WIPO Overview 3.0”).

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

The entirety of the Complainant's trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the Complainant's trademark for the purposes of the Policy (WIPO Overview 3.0, section 1.7).

Although the addition of other terms, here “gruppe”, may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademark for the purposes of the Policy (WIPO Overview 3.0, section 1.8).

In addition, it is well established that “.com”, as a generic Top-Level Domain, can be disregarded in the assessment of the confusing similarity between the disputed domain name and the Complainant’s trademark (WIPO Overview 3.0, section 1.11.1).

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

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (WIPO Overview 3.0, section 2.1).

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

In particular, the Panel notes that there appears to be no relationship between the Respondent and the Complainant and that the Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant’s MIGROS trademark. There appears to be no element from which the Panel could infer the Respondent’s rights and legitimate interests in the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

On the contrary, based on the undisputed evidence provided by the Complainant, the Respondent has used the disputed domain name to impersonate the Complainant and its C-level executive through fraudulent e-mails. Panels have held that the use of a domain name for illegal activity, such as phishing and fraud can never confer rights or legitimate interests on a respondent (WIPO Overview 3.0, section 2.13.1).

The Panel also finds that the structure of the disputed domain name, which contains the Complainant’s MIGROS trademark in combination with the word "gruppe" (German for "group"), carries a high risk of implied affiliation (see WIPO Overview 3.0, section 2.5.1). This additional word closely corresponds to the Complainant who is organized as a group of cooperative societies.

Having in mind the above, the Panel finds 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 the disputed domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith (WIPO Overview 3.0, section 3.2.1).

In the present case, the Panel notes that the Respondent must have been aware of the Complainant and its MIGROS trademark, especially having in mind the structure of the disputed domain name that contains additional term "gruppe" (German for "group"), which closely corresponds to the Complainant's organization as a group of cooperative societies. The content of the fraudulent e-mail sent by the Respondent leaves no room for a doubt on the Respondent's knowledge of the Complainant and its MIGROS trademark and evidences that the Respondent actually had the Complainant in mind when registering the disputed domain name. It should be also borne in mind that that the registration and use of MIGROS trademark predates the registration of the disputed domain name for decades, making it unlikely that the Respondent was not aware of the Complainant's trademark at the time of registration of the disputed domain name.

Due to the above, the Panel finds that the disputed domain name has been registered in bad faith.

As indicated above, the Respondent has used the disputed domain name for fraudulent activities in order to impersonate the Complainant through e-mails where the Respondent has impersonated C-level executive of the Complainant. Previous panels have consistently held that the use of a domain name for illegal activity (here, claimed impersonation and phishing) constitutes bad faith (see WIPO Overview 3.0, section 3.4). Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that the disputed domain name has been both registered and is being used in bad faith, and consequently that the Complainant has established the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **migros-gruppe.com**: Transferred

PANELLISTS

Name	**Stefan Bojovic**

DATE OF PANEL DECISION 2024-12-05

Publish the Decision