Decision for dispute CAC-UDRP-107161

Case number	CAC-UDRP-107161
Time of filing	2024-12-13 09:33:12
Domain names	migrosch.shop

Case administrator

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

Complainant

Organization	Migros-Genossenschafts-Bund

Complainant representative

Organization	SILKA AB

Respondent

Name	Roaden Sikarskie

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, Migros Genossenschafts-Bund (hereinafter referred to as "Complainant"), is one of the biggest retail companies of Switzerland.

The Complainant has submitted evidence, which the Panel accepts, showing that it is the registered owner of the following trademarks in several classes and domain names bearing the “MIGROS“ phrase.

Currently, Migros is the owner of various trademark registrations - all valid - such as:

- The Swiss Word trademark n° P-405500 dated February 13, 1993 designating goods and services in classes 1-9, 11, 12, 14-32 and 34. MIGROS Word mark 2P-415060 Swiss national n° 2P-415060 dated September 27, 1994 designating the services in classes 35-42;

- The EU trademarks n° 003466265 dated October 29, 2003 designating the services in class 35 and no. 000744912 MIGROS (word mark), registered on July 26, 2000, in international classes 1, 2, 3, 4, 6, 7, 8, 9, 11, 12, 14 - 32, 34, and 35-42;

- The International Trademarks, e.g. no. 315524, registered on June 23, 1966, in international classes 3, 7, 8, 9, 11, 21-31, 34 and International Trademark no. 397821 MIGROS (word mark), registered on March 14, 1973, in international classes 1-9, 11-12, 14-32 and 34.

Complainant also owns various registrations for domain names that include its registered trademarks, including <migros.ch>, <migros.com>, among others. The Complainant has been extensively using the “MIGROS” denomination on all internet environments including and not limited to the company’s official websites.

FACTUAL BACKGROUND

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

Migros Genossenschaftsbund (hereinafter referred to as Complainant), is the Swiss based umbrella organization of the regional Migros Cooperatives. The Complainant is known throughout Switzerland as one of the biggest Swiss department stores, offering a wide range of food, non-food products and services (wellness, travel, catering). The company was founded by Gottlieb Duttweiler in 1925 in Zurich and has now evolved into a community of ten regional Cooperatives. With sales of CHF 31 billion (2023), the Migros Group is Switzerland's largest retailer, and with over 99 000 employees, it is also Switzerland's largest private employer. Migros is owned by its more than 2 million cooperative members, organised into ten regional cooperatives.

The Respondent is according to the Registry a citizen of Hongkong, CN. The disputed domain name was registered on November 19, 2024. The Complainant showed evidence that the disputed domain name <migrosch.shop> (“hereinafter referred to as the Domain Name”) directly and entirely incorporates Complainant’s well-known trademark MIGROS. The addition of two letters and the generic Top-Level Domain (gTLD) “.shop” does not add any distinctiveness to the Domain Name.

As stated by WIPO Overview of WIPO Overview 3.0, section 1.7, or by the Decision in CAC Case No. 102295: “in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing”. Bearing in mind that the Domain Name reproduces the Complainant’s MIGROS mark entirely, it can be concluded that the trademark is clearly recognizable in the Domain Name.

The Domain Name incorporates the Complainant’s MIGROS mark, together with the term “shop”, which is an English abbreviation for the retail business, though Complainant’s business.

In the Complainant’s view, this addition does not prevent a finding of confusing similarity between the Complainant’s trademarks and the Domain Name. As WIPO Overview 3.0, section 1.8 states: “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”.

The Complainant remarked that the Respondent has no rights or legitimate interests in respect of the Domain Name.

Further, the Complainant contends that the nature of the Domain Name, wholly incorporating the Complainant’s MIGROS mark implies a high risk of implied false affiliation with the Complainant and its activities, as it could be understood that the Domain Name resolves to one of Complainant’s websites in English language. seethe Complainant refers to WIPO Overview 3.0, section 2.5.1 or, for instance, CAC Case No. 101626:

“Furthermore, UDRP panels have found that domain names identical to a complainant’s trademark carry a high risk of implied affiliation. Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), 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 (see WIPO Overview 3.0 at point 2.5.1).”

In view of all these circumstances, the Complainant considers that it is highly unlikely that the Respondent intended to use the Domain Name for any legitimate or fair use. Likewise, the Complainant cannot conceive any possible use in which the use of the Domain Name would not infringe its rights in MIGROS. Therefore, the Complainant asserts that the Respondent has no rights or legitimate interests in the Domain Name and that the requirements of Paragraph 4(a)(ii) of the Policy are fulfilled.

The Complainant argues further that the Domain Name was registered and is being used in bad faith.

Since the registration of the Domain Name the Respondent was using the domain name to attract people on his website with link to baoao.shop and products the Complainant offers too. Such ongoing use does not constitute good faith use of the Domain Name. The Complainant notes that the Respondent uses in the domain name the Complainant’s well known MIGROS mark in the color of Migros Stores and on top website www.migrosch.shop, in order offering consumer products and services. Moreover, the Complainant brought evidence that content of the Respondents website seems to be identical to several pretextual websites found on the Internet.

In view of the above, the Complainant considers that the website at the Domain Name is fake and that it intends to create the misleading impression that the web site is associated with the Complainant (when it was not the case), as it includes the Complainant’s mark in full, it provides products offered by Complainant, and it does not include correct information concerning the ownership of the website. The Complainant refers to WhatsApp LLC v. Bulk Whatsapp Software, WIPO Case No. D2021-0564:

“The website liked to the disputed domain name further uses a similar combination of colors as the one used by the Complainant’s corporate websites and its app (green and white), includes various references to the WHATSAPP mark, the Complainant’s telephone logo within a green circle as well as a modified version of such logo. Additionally, this website does not include any information about the owner or the site and its lack of relationship with the Complainant. The Panel considers that this use of the disputed domain name contributes to a risk of affiliation and confusion.”

The Complainant summarized, the confusingly similar nature of the Domain Name to the Complainant's trademarks demonstrates lack of good faith. Consequently, the Respondent should be considered to have registered and to be using the Domain Name in bad faith.

The Respondent didn’t react to the Complainant‘s contentions.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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 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 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

It is necessary for the Complainant, if it is to succeed in this administrative proceeding, to prove each of the three elements referred to in paragraph 4(a) of the Policy, namely that:

(i) the Domain Name is identical or confusingly similar to a trade mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interest in respect of the Domain Name; and

(iii) the Domain Name has been registered and is being used in bad faith.

The Panel finds that the Domain Name is confusing similar to the trademarks of the Complainant. The Domain Name, which was registered 19.11.2024, incorporates entirely the Complainant’s well-known, registered trademark MIGROS with two additional letters “ch”. The Domain Name and the term “migrosch” have no meaning in Chinese or English. As WIPO Overview 3.0, section 1.8 states: “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”. The addition of the gTLD “.shop” does not add any distinctiveness to the Domain Name. According to WIPO Overview 3.0, section 1.11, the applicable TopLevel Domain (“TLD”) in a domain name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. In this vein, see for instance CAC Case no. 102885:

“For sake of completeness, the Panel asserts that the top-level suffix in the disputed domain name must be disregarded under the identity and confusing similarity tests as it is a necessary technical requirement of registration.”

The Complainant rightfully contended that the Domain Name is confusingly similar to the prior trademark MIGROS of the Complainant. The Complainant also referred to the distinctiveness and reputation of its MIGROS trademarks. Moreover, in relation the Complainant's rights, it should be highlighted that prior decisions under the UDRP have recognized the reputation of the MIGROS mark. See, for instance, CAC Cases no. 101876, 101810, 104862 and 104863.

The Complainant further rightfully asserts that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Respondent is not a licensee of the Complainant, and it has not received any consent, permission, authorization or acquiescence from the Complainant to use its MIGROS mark in association with the registration of the Domain Name. Moreover, the Complainant contends and provides evidence that the Respondent has not developed a legitimate use in respect of the Domain Name. In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the Domain Name.

In the present case, the Complainant rightfully contended that the Respondent registered and is using the Domain Name in bad faith. It is highly unlikely that the Respondent had no knowledge of the Complainant's prior trademark rights at the time of registration of the Domain Name. The Complainant rightfully contended that the Respondent has used the Domain Name intentionally to attract visitors for commercial gain by creating confusion with the Complainant's trademarks, and that the Respondent has used the Domain Name with that intention, namely in bad faith. See e.g., Accor v. Shangheo Heo / Contact Privacy Inc., WIPO Case No. D2014-1471 where the Panel stated that: "The unopposed allegation of phishing, and the evidence submitted in support of phishing, combined with the likelihood of confusion, is sufficient evidence of bad faith. …It seems likely, as Complainant alleges, that Respondent intentionally attempted to deceive consumers into providing personal and financial information, believing that Respondent was associated with the bona fide services offered by Complainant."

Reference is made also to: CAC cases no. 101810 MIGROS vs. Mary Hines; no. 101036, Boehringer Ingelheim Pharma GmbH & Co. KG vs. SKYRXSHOP - <dulcolax.xyz> and WIPO Case no. D2014-0306 Boehringer Ingelheim Pharma GmbH & Co. KG v. Klinik Sari Padma, BAKTI HUSADA.

Accordingly, the Panel finds that the Domain Name was both registered and used in bad faith and that the Complaint succeeds under 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. **migrosch.shop**: Transferred

PANELLISTS

Name	**Harald von Herget**

DATE OF PANEL DECISION 2025-01-15

Publish the Decision