

Decision for dispute CAC-UDRP-103718

Case number	CAC-UDRP-103718
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Time of filing	2021-04-08 11:03:37
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Domain names	wwwavg.com
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Avast Software s.r.o.
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Complainant representative

Name	Rudolf Leška
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Respondent

Name	D.L. Webb
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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 is the owner of different trademark registrations for "AVG". In particular Avast Software s.r.o. owns, among others:

- International Registration for "AVG" no. 930231 registered on February 2, 2007 and duly renewed for classes 09, 37 and 42;
- EU trademark for "AVG" no. 3893716 filed on June 24, 2004, registered on August 29, 2005 and duly renewed for classes 9, 16 and 42; and
- U.S. trademark for "AVG" no. 3122712 filed on September 14, 2004, registered on August 1, 2006 and duly renewed for classes 9, 37 and 42.

The Complainant also relies on its use online of the domain name <avg.com> registered in 1994.

FACTUAL BACKGROUND

The Complainant affirms to be well known on the market globally as a reliable company with long history, as a security pioneer offering a wide range of protection, performance and privacy solutions for customers and businesses. Avast's popularity on the market and high quality is supported by the fact that, as proved by the Complainant, the "AVG" antivirus (provided by the same Complainant) surpassed 200 million users worldwide and acquired important awards.

The Complainant has also proved to be the owner of numerous trademark registrations for "AVG" duly protected in many countries.

The Complainant states that the "AVG" antivirus is distributed via the website www.avg.com linked to the domain name <avg.com> registered from November 1, 1994.

The Complainant informs that the present dispute concerns the domain name <wwwavg.com> which was registered in 2004 but acquired by the current owner between February and April 2018. According to the Complainant this circumstance indicates that the Respondent was well aware of the Complainant prior trademark rights at the moment of the acquisition of the domain name in dispute.

Furthermore, the Complainant points out that (i) "AVG" has been operating since 1991 (ii) in 1992 its first anti-virus guard product has been launched (iii) since 1997 licenses have been sold across Europe and United States of America.

According to the above it is the Complainant's view that the title "AVG" has been used across all territories of the world by the Complainant as an identifier of its product and services in a similar manner to a trademark use, which at the time of the first registration of the disputed domain name has been associated by the consumers with the services and products offered under the name "AVG" owned by the Complainant.

Therefore, it is the Complainant's opinion that "AVG" has been recognized as a common law mark at the time of the first registration of the disputed domain name especially in consideration of the fact that the Complainant was under significant media attention in 2004 when it has launched its "AVG" Anti-Virus 7 version.

According to the Complainant, the disputed domain name <wwwavg.com> is identical to the Complainant's registered trademark "AVG" and it is also identical to the domain name linked to the official website of the Complainant <avg.com>.

The Complainant informs that no evidence suggests that the Respondent has been commonly known within the consumers by the disputed domain name or by the name "AVG" entirely reproduced in the disputed domain name before the beginning of the present dispute. The Complainant also states that it did never grant any license or authorization to register or use the disputed domain name to the Respondent.

Finally, the Complainant points out that the domain name in dispute is used to redirect users to Complainant's website and, in the Complainant's view, this use of the domain name is an indication of bad faith.

PARTIES CONTENTIONS

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the domain name, the Complainant must prove that each of the following elements is present:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

A) Confusing similarity.

In this procedure, the Complainant relies on trademarks filed after the creation date of the disputed domain name. The Complainant maintains that it also owns unregistered trademark rights since 1991, when it started using the trademark "AVG" publicly. The Panel does not feel necessary to evaluate these unregistered rights at this stage, as in order to assess the first requirement under the Policy it is not strictly necessary to verify the status of the owner's right before the date of registration of the domain name in dispute. This evaluation may have an impact on the assessment of the second and third Policy requirements, but for the purposes of identity or confusingly similarity with a complainant's trademark, UDRP panels have constantly held that it is sufficient to establish that trademark rights are in existence at the time the complaint is filed (see *FrogProg Limited vs. Pavlo Kucheruk*, CAC Case no. 103413). As at the time of the filing of the complaint the Complainant is the owner of several trademark registrations for "AVG", the Panel is satisfied that the Respondent has standing to file this dispute, and the Panel is entitled to evaluate whether the first requirement under the Policy has been met. The disputed domain name combines three elements: (1) the prefix "www" (2) the term "avg" and (3) the suffix ".com." The relevant comparison to be made is with "wwwavg", as it is well-established that the top-level domain name ".com" should be disregarded for this purpose (see *Playboy Enterprises International, Inc. v. John Taxiarchos*, WIPO Case No. D2006-0561; *Burberry Limited v. Carlos Lim*, WIPO Case No. D2011-0344; *Magnum Piercing, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525). Therefore, only the part <wwwavg> of the disputed domain name has to be considered while evaluating confusing similarity or identity. In this respect the Panel notes that "avg" is identical to the Complainant's trademark "AVG" while "www", corresponds to the well-known acronym for "world wide web", and is an extremely common prefix (when succeeded by a period) to the domain name in a URL for a website on the Internet. The letters "www" thus have no distinguishing capacity in the context of domain names disputes (see *Allianz SE v. Venkateshwara Distributor Private Limited/PrivacyProtect.org*, WIPO Case No. D2010-0951). In fact, in the context of domain names, the letters "www" have the effect of focusing particular attention on the succeeding word, in this case the word "avg". This is because a casual reader of the domain name may wrongly think that there is a period between the "www" and the succeeding word, and so wrongly assume that the domain name is in fact comprised only of the succeeding word. In addition, the practical effect of preceding a trademark with the letters "www" in a domain name is so-called "typo-piracy" (see *World Wrestling Federation Entertainment, Inc. v. Matthew Bessette*, WIPO Case No. D2000-0256 and *CSC Holdings, Inc. v. Elbridge Gagne* WIPO Case No. D2003-0273) - that is, attracting to a different website the Internet user who mistakenly fails to insert a period after the letters "www" when typing the URL of the intended website. This situation of confusing similarity is even more evident in the present case since the official website of the Complainant is www.avg.com practically identical to the disputed domain name (the Complainant has registered the domain name <avg.com> in 1994). In consideration of both the visual similarity and the potential typo-piracy, the disputed domain name is confusingly similar to the Complainant's trademark "AVG" (see *Volkswagen AG v. Privacy Protection Services*, WIPO Case No. D2012-2066). Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B) The Respondent's rights or legitimate interests in the disputed domain name.

The Complainant has long standing rights in the mark "AVG". The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and as the Respondent was never authorized or licensed or otherwise permitted by the Complainant to use the disputed domain name. The Respondent, in the absence of any response, has not shown any facts or elements to justify legitimate rights or interests in the disputed domain name. Therefore, on the basis of the evidences submitted and in the absence of a response, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. The fact that the domain name in dispute was registered in 2004 and therefore before the filing dates of the Complainant's mark is totally irrelevant in assessing possible legitimate interests of the Respondent in the term "AVG". This because (i) the Complainant uses the unregistered trademark "AVG" since 1991 (ii) the Complainant has registered the <avg.com> domain name from November 1, 1994 and since then it has extensively used said domain name in order to run a website (www.avg.com) fully dedicated to the promotion and distribution of the antivirus products marked "AVG" and (iii) the domain name in dispute was never used for an independent business activity of the Respondent not linked to the Complainant since the only use of the domain name in dispute shown to the Panel consists of the redirection of internet traffic to Complainant's official website. Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C) Registration and use in bad faith.

The Panel has duly considered that, according to the current Whois records and to the domain report made available by Complainant, the disputed domain name was registered in 2004, but the ownership of the disputed domain name has (apparently) changed between February and April 2018. The Panel also knows that according to section 3.9 of the WIPO Overview 3.0, "the transfer of a domain name registration from a third party to the respondent is not a renewal and the date on which the current registrant acquired the domain name is the date a panel will consider in assessing bad faith". Now, according to the domain report, it results that in the period February/April 2018 the ownership of <www.wavg.com> passed from Mr. David Webb to a domain privacy service used to conceal the owner identity named PRIVACYDOTLINK CUSTOMER 3542472. Anyway, by the Registrar Verification made on April 13, 2021 it results that the current owner of the disputed domain name concealed under PRIVACYDOTLINK CUSTOMER 3542472 is Mr. Webb from the city of Wylie located in Texas which corresponds to the previous owner of <www.wavg.com>. In consideration of the above the Panel is not convinced that a transfer of the domain name in dispute, with the meaning of section 3.9 of the WIPO Overview 3.0, effectively took place as stated by the Complainant. On the contrary, in the Panel's view, in the period February/April 2018 the owner of the domain name in dispute simply decided to use a domain privacy service in order to conceal its identity. In order to correctly address the issue of bad faith registration it must be considered that at the time of the registration of the disputed domain name by the Respondent, the Complainant had already extensively used the unregistered mark "AVG" since it has been used to contradistinguish the Complainant's antivirus since 1991 and in consideration of the fact that (i) it was created a website dedicated to the "AVG" products linked to the domain name <avg.com> registered since November 1, 1994 and (ii) since 1997 licences on the "AVG" products have been sold across Europe and United States of America allowing the use of "AVG" identifier across many territories of the world. The Panel is definitively convinced that the Complainant's unregistered mark "AVG" was distinctive and sufficiently well-known at the time of the disputed domain name registration due to the fact that the Respondent uses the domain name in dispute only to redirect users to Complainant websites which incontrovertibly demonstrates that the Respondent was perfectly aware of Complainant's rights on "AVG" when it decided to register (clearly in bad faith) the domain name <www.wavg.com> which fully includes the Complainant's trademark (being the only distinctive part of the domain name in dispute).

As seen before, the Respondent uses the domain name in dispute to redirect users to Complainant websites. According to the Panel, the use of the domain name in dispute to redirect the traffic to the Complainant's own website implies bad faith as there is a risk that the Respondent may at any time cause Internet traffic to redirect to a website that is not that of, or associated with, the Complainant (see MySpace, Inc. v. Mari Gomez, WIPO Case No. D2007-1231) and as it may increase customer confusion that the domain name in dispute is somehow licensed or controlled by the Complainant (see PayPal Inc. v. Jon Shanks, WIPO Case No. D2014-0888). Furthermore, the Panel draws an adverse inference from the Respondent's use of a privacy protection service to conceal its identity. Whilst privacy shields may be legitimate in certain cases, it is difficult to see why the Respondent

in this case needs to protect its identity “except to frustrate the purposes of the Policy or make it difficult for a brand owner to protect its trade marks against infringement, dilution and cybersquatting” (see Ustream.TV, Inc. v. Vertical Axis, Inc, WIPO Case No. D2008-0598). Finally, the Panel also finds that the Respondent’s failure to take part in the present proceedings constitutes an additional indication of its bad faith. Accordingly, the Panel finds that the Complainant has satisfied also paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **WWWAVG.COM**: Transferred

PANELLISTS

Name	Avv. Guido Maffei
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DATE OF PANEL DECISION	2021-05-10
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Publish the Decision