

Decision for dispute CAC-UDRP-104753

Case number	CAC-UDRP-104753
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Time of filing	2022-07-27 15:04:23
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Domain names	migros-bnq.com
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	MIGROS-GENOSSENSCHAFTS-BUND
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Complainant representative

Organization	SILKA AB
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Respondent

Name	Louis
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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, inter alia, a number of trademarks consisting of MIGROS and MIGROS BANK, including the following:

- International Trademark no. 315524, registered on June 23, 1966, in international classes 3, 7, 8, 9, 11, 21-31, 34. The trademark designates, inter alia, Serbia and Viet Nam;
- International Trademark no. 397821 MIGROS (work mark), registered on March 14, 1973, in international classes 1-9, 11-12, 14-32 and 34. The trademark designates, inter alia, China and Morocco;
- Swiss Trademark no. 623618, registered on December 12, 2011, in international classes 35 and 36;
- Swiss Trademark no. 623622 BANCA BANQUE MIGROS BANK (word mark), registered on December 12, 2021, in international classes 35 and 36;
- International Trademark no. 631422 BANQUE MIGROS (word mark), registered on January 12, 1995, in international class 36;
- European Union Trademark 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;

- European Union Trademark no. 003466265 MIGROS (word mark), registered on May 13, 2005, in international class 35;
 - International Trademark no. 404446, registered on December 28, 1973, in international classes 1-9, 11-12, 14-32 and 34. The trademark designates, inter alia, North Macedonia and Monaco;
 - United States of America Trademark no. 6026436 MIGROS (word mark), registered on April 7, 2020, in international class 35; and
 - Swiss Trademark no. 764760, registered on June 2, 2021, in international classes 9, 35 and 36.
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FACTUAL BACKGROUND

MIGROS-GENOSSENSCHAFTS-BUND is a Swiss retail company founded in 1925 by Mr. Gottlieb Duttweiler. Today, the Complainant is owned by its more than 2 million cooperative members, organized into ten regional cooperatives, has a world-wide reputation. With sales of CHF 28.93 billion in 2021, the Complainant not only is the Switzerland's largest retailer, but also the country's largest private employer, with more than 97.000 employees. The Complainant is currently one of the forty largest retailers in the world and it is active in manufacturing and wholesaling through more than 30 companies (about 25 Swiss-based and around 10 abroad) in many commercial areas. For instance, Complainant operates supermarkets (MIGROS), furniture stores (MICASA), electronic retail stores (M-ELECTRONICS), gas stations (MIGROL), travel agencies (HOTELPLAN), convenience stores (MIGROLINOS), or bookstores (EX LIBRIS), just to cite a few examples.

Complainant states that one of the most relevant ventures of the Complainant is Migros Bank AG, which is a wholly owned subsidiary and consists of the parent company's financial services division. With a total of 67 branches and headquartered in Zurich, Migros Bank AG is one of the largest and most established banks in Switzerland, providing a full range of commercial banking services to both individuals and business customers. For instance, the Bank offers deposits, online banking, loans, mortgages, cards and payments, savings, investments, and insurance.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Complainant states that it established its online presence under with the domain name <migrosbank.ch> (registered on March 20, 1996), which hosts a website that displays information about the Complainant and its activities. The disputed domain name <migros-bnq.com> is identical or confusingly similar to it trademark and equally important is virtually identical to Complainant's domain name adding only the three letters "bnq" which letters represent the word "bank." The registration of the disputed domain name is obviously intended as an invitation to visit the website and be deceived into taking action to its detriment.

The Panel attempted to access the disputed domain name and at the present time it does not resolve to an active website, but Complainant attached a copy of the website to which the domain name resolves in its complaint.

Complainant states that Respondent is unknown to it, has not granted permission to it to acquire the disputed domain name, and that there is no conceivable use of it without violating Complainant's rights.

RESPONDENT:

The Respondent did not respond to the Complainant's contentions and did not submit any arguments or evidence in its defense. In such event, UDRP Rule 14 provides (a) that the "Panel shall proceed to a decision on the complaint" and (b) that "the Panel shall draw such inferences therefrom as it considers appropriate." In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint; however, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See WIPO Jurisprudential Overview 3.0 at Para. 4.3.

HIGH T'S

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

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

- (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 respondent has registered and is using the domain name in bad faith.

In this case, the Czech Arbitration Court has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case and defend its registration of <migros-gnq.com>.

By the Rules, paragraph 5(c)(i), respondent is given the opportunity to: "Respond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name ..." Notwithstanding Respondent's default Complainant is not relieved from the burden of establishing its claim. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 3.0, Sec. 4.3: "Noting the burden of proof on the complainant, a respondent's default (i.e., failure to submit a formal response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true." However, if a complainant's adduced evidence supports any element of the Policy, a respondent has an opportunity to contest the contention that its registration of the challenged domain name was unlawful.

A. The disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights.

This first limb of the Policy requires Complainant to prove that it has a trademark right and that the disputed domain name is identical or confusingly similar to that mark. The Panel finds that Complainant has demonstrated that it has a registered trademark right to the term MIGROS. Having established that element of the Policy the next question is whether the disputed domain name is identical or confusingly similar to Complainant's mark. A side-by-side comparison of the domain name and the MIGROS trademark demonstrates that <migros-bnq.com> is confusingly similar to the mark in that it entirely incorporates Complainant's trademark. The addition of a dash plus the letters "bnq" which is a common abbreviation for banque (bank in French)" does not create a distinct name but rather suggests a relationship with Complainant. Indeed, so confusing is <migros-bnq> that an inattentive consumer is very likely to mistake it Complainant's online platform.

At the threshold it is necessary only to consider "whether a domain name is similar enough in light of the purpose of the Policy to justify moving on to the other elements of a claim for cancellation or transfer of a domain name." The Panel in *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, WIPO Claim No. D2000-1415 notes that "numerous prior panels have held [the purposes of the Policy are satisfied] when a domain name wholly incorporates a complainant's registered mark." Similarly, *Magnum*

Piering, Inc. v The Mudjackers and Garwood S. Wilson, Sr., WIPO Claim No. D2000-1525. Panelists generally disregard the top-level suffixes as functional necessities, thus the top-level extension is irrelevant in determining the issue under the first requirement of the Policy. With respect to the hyphen, the Panel in UK-ARCELOMITTAL.COM ARCELOMITTAL S.A, CAC Case No. 102161 explained that "it is well established that hyphens [. . .] may be disregarded when considering whether the disputed domain names are confusingly similar to the trademark in which the Complainant has rights."

Accordingly, having demonstrated that <migros-bnq.com> is confusingly similar to Complainant's MIGROS and MIGROS BANK trademarks the Panel finds Complainant has satisfied Para. 4(a)(i) of the Policy.

B. Rights and legitimate interests, Para. 4(a)(ii)

Under paragraph 4(a)(ii) of the Policy, a complainant has the burden of establishing that a respondent lacks rights or legitimate interests in respect of the disputed domain name, but this burden is light. It is sufficient in the first instance for Complainant to allege a prima facie case, and if the evidence presented is persuasive or yields a positive inference that Respondent lacks rights or legitimate interests, the burden shifts to Respondent to rebut the allegations. This concept of shifting burdens is clearly explained in Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Claim No. D2003-0455 in which the Panel held that "[s]ince it is difficult to prove a negative [. . .] especially where the Respondent, rather than complainant, would be best placed to have specific knowledge of such rights or interests—and since Paragraph 4(c) describes how a Respondent can demonstrate rights and legitimate interests, a Complainant's burden of proof on this element is light."

Once the complainant makes such prima facie showing, "the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP," Malayan Banking Berhad v. Beauty, Success & Truth International, WIPO Claim No. D2008-1393. Finally, "in the absence of direct evidence, complainant and the panel must resort to reasonable inferences from whatever evidence is in the record," Euromarket Designs, Inc. v. Domain For Sale VMI, WIPO Claim No. D2000-1195.

The Complainant contends and the evidence supports the conclusion that Respondent lacks rights or legitimate interests in the disputed domain name. It has not granted any rights to Respondent to use the MIGROS trademark, nor is "Louis" known by the name of disputed domain name. See Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group, FA1804001781783 (Forum May 11, 2018) ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy 4(c)(ii) that Respondent is not commonly known by the disputed domain name"); Amazon Technologies, Inc. v. Suzen Khan / Nancy Jain / Andrew Stanzy, FA 1741129 (FORUM August 16, 2017) (finding that respondent had no rights or legitimate interests in the disputed domain names when the identifying information provided by WHOIS was unrelated to the domain names or respondent's use of the same).

Furthermore, Complainant shows that when it first investigated the disputed domain name it resolved to a website in several languages which reproduces on top the Complainant's brand (Registered as Swiss Trademark no. 764760) and offers banking and financial images. Complainant includes a snapshot of the website as an exhibit to the complaint. The disputed domain name no longer resolves to an active website, but the fact that it was resolving to an impersonation website is sufficient to conclude that "Louis" lacks rights or legitimate interests in the disputed domain name as he is pretending to be MICROS BANK.

Once the burden shifts, Respondent has the opportunity of demonstrating its right or legitimate interest by showing the existence of any of the following nonexclusive circumstances:

- (i) before any notice to you [respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [respondent] are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

If a respondent proves any of these circumstances or indeed anything else that shows it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the respondent must succeed. However, where respondent fails to respond, the Panel must assess the record before it. Here, the choice of the domain names corresponds to the trademark. Therefore, Respondent's default and its failure to rebut Complainant's evidence is particularly telling. Since there is no proof otherwise, the record supports the conclusion that Respondent lacks any right or legitimate interest as measured by the three circumstances of paragraph 4(c). See *Deutsche Telekom AG v. Britt Cordon*, WIPO Claim No. D2004-0487 (holding that "once a complainant establishes a prima facie case that none of the three circumstances establishing legitimate interests or rights applies, the burden of production on this factor shifts to the Respondent. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP). Similarly, in *Malayan Banking Berhad*, supra. (holding that "[i]f the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.").

Accordingly, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name. Thus, Complainant has satisfied Paragraph § 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith, §4(a)(iii)

Having determined that Respondent lacks rights or legitimate interests, the Complainant must then prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith. The consensus expressed in WIPO Overview 3.0, section 3.1.4. is that "the mere registration of a domain name that is identical or confusingly similar [. . .] to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." Particularly probative in this case is that Complainant holds the domain name <migros.com>. The only difference with the disputed domain name is the addition of the letters "bnq" which is a common abbreviation for banque (bank in French). Absent a cogent explanation from Respondent justifying its choice of domain name, this supports the conclusion that it registered <migros-bnq.com> with the purpose of taking advantage of the goodwill and reputation accruing to its trademark.

The Panel finds that the present case is one in which the presumption of bad faith is satisfied. The presumption is further strengthened by the strong inference of Respondent's actual knowledge of Complainant and its MIGROS trademark and the purpose of the registration was to take advantage of its attractive value on the Internet to trick consumers into engaging with it to their financial disadvantage.

Paragraph 4(b) of the Policy sets out four nonexclusive circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. Of the four nonexclusive circumstances, paragraph 4(b)(iv) most readily applies:

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the site or location.

Respondent's registration of the disputed domain name is clearly intended to attract Internet users and as it appears to hold itself out as Complainant's official website. This underscores that its purpose is evident, namely to trick consumers and customers into believing that it is, in fact, Complainant. See *Auchan Holding SA v. WhoisGuard Protected / WhoisGuard, Inc. / Daniel Morgan*, WIPO Case No. D2021-0797 ("The evidence outlined above that the Respondent is falsely suggesting he is connected and/or authorised by the Complainant in order to gather personal information for phishing purposes is evidence that the Responded has acted in opposition to the Complainant's commercial interests and has unduly disrupted the business of the Complainant.")

Where the facts demonstrate an intent to capitalize on an owner's mark and has targeted it in the manner in which Complainant describes and which is supported by proof in the record, the registration is prima facie abusive. Respondent has used the disputed domain name to impersonate Complainant for financial gain and fraud on consumers who will be tricked into believing that the website is sponsored by Complainant. Impersonation is clear evidence of bad faith registration and use. *FLRish IP, LLC v. prince zvomuya*, WIPO Case No. D2019-0868 ("There is no right or legitimate interest in holding a domain name to further fraudulent impersonation, and registration and use of a domain name for such a purposes involves registration and use in bad

faith."). The Panel finds that the Complainant has adduced evidence that the Respondent registered and is using the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraph 4(b)(iv) as well as within the larger notion of abusive conduct. The Panel finds that Complainant has adduced more than sufficient evidence to prove Respondent's bad faith based on the foregoing considerations.

As Respondent has failed to adduce any evidence justifying its acquisition of the disputed domain name, the Panel finds that it registered and is using <migros-bnq.com> the disputed domain name in bad faith and that its conduct firmly supports the conclusion that the registration of the disputed domain name was abusive.

Accordingly, having thus demonstrated that Respondent registered and is using the disputed domain name in bad faith, Complainant has also satisfied paragraph4(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. **MIGROS-BNQ.COM**: Transferred

PANELLISTS

Name	Gerald M. Levine, Ph.D, Esq.
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DATE OF PANEL DECISION	2022-08-26
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Publish the Decision