

Decision for dispute CAC-UDRP-103648

Case number	CAC-UDRP-103648
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Time of filing	2021-04-08 09:48:40
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Domain names	avwst.com, avast.org
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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

Organization	Fundacion Privacy Services Ltd
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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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner inter alia, of the following trademark registrations consisting of or comprising AVAST:

- Unites States trademark registration No. 4174242 for AVAST (word mark), filed on July 22, 2011 and registered on July 17, 2012 in international class 9;
- International trademark registration No. 1011270 for AVAST! (word mark), registered on April 15, 2009 in class 09;
- International trademark registration No. 839439 for AVAST (word mark), registered on June 22, 2004 in classes 09 and 42;
- International trademark registration No. 1376117 for AVAST (figurative mark), registered on May 10, 2017 in international classes 09 and 42;
- German trademark registration No. 30092783 for AVAST (word mark), filed on December 20, 2000 and registered on March 7, 2001 in international classes 09 and 42; and

- Czech trademark registration No. 127257 for AVAST (word mark), filed on November 17, 1997 and registered on December 28, 1998, in classes 9, 16 and 42.

FACTUAL BACKGROUND

The Complainant is a security software company which provides its products and services under the trademark AVAST, currently ranked at the seventh place amongst brands of global antivirus software providers.

The Complainant is also the owner of the domain name <avast.com>, which was registered on October 6, 1997 and is used by the Complainant to promote its products and services under the trademark AVAST online.

The first disputed domain name <avast.org> was originally registered on April 21, 2002. Based on the historical Whois and screenshots submitted by the Complainant – which have not been challenged by the Respondent -, the disputed domain name, currently registered in the name of Whois Privacy Corp., was registered, from April 7, 2012 to at least June 1, 2015, in the name of Fundacion Private Whois and was redirected, on July 27, 2013, to a pay-per-click webpage displayed at the disputed domain name <avwst.com>. On June 25, 2018, the first disputed domain name was pointed to a website offering for sale and distributing the Complainant's products, whilst currently it is pointed to a web page displaying the indication "No Sponsors. This domain currently does not have any sponsors for you".

The second disputed domain name <avwst.com> was registered on February 8, 2013 and is pointed to a parking page with pay-per-click links partly related to the Complainant and competitor's products.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS

COMPLAINANT

The Complainant contends that the disputed domain name <avast.org> is identical to its trademark AVAST as it includes the trademark in its entirety with the mere addition of the generic Top Level Domain ".org", whilst the disputed domain name <avwst.com> is confusingly similar to its trademark as it comprises almost all the Complainant's AVAST trademark, with the sole difference that the third letter "a" in AVAST is replaced by a "w".

The Complainant contends that, as the letter "w" is placed just above the letter "a" on the majority of computer keyboards, it would make it easy for internet users to make a spelling mistake when trying to access the official website of the Complainant and asserts that the replacement of one letter does not change the fact that the disputed domain name <avwst.com> and the Complainant's trademark AVAST are visually and phonetically similar and easy to confuse.

The Complainant states that the Respondents have no rights or legitimate interests in respect of the disputed domain names since they are not commonly known by the disputed domain names or by the name AVAST nor have they ever registered any identical or similar trademark before obtaining the disputed domain names.

The Complainant further highlights that the Respondents are in no way authorized or affiliated by the Complainant and that, considering the use which is being made of both disputed domain names, the Respondents are not using the disputed domain names in connection with any bona fide offering of goods or services or for legitimate non-commercial or fair use purposes, especially considering that such activities only serve to misleadingly divert consumers whilst voluntarily tarnishing the Complainant's trademark.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the Respondents appear to have deliberately concealed their true contact information following the change in registration in 2015 in an attempt to illegally profit from the Complainant's well-known mark in order to attract internet users for potential illegal distribution of AVAST products, and notes that this conduct undoubtedly supports and inference of bad faith registration.

The Complainant also emphasizes that, considering the term “Avast” has no specific meaning in modern English and that, given the prior use of the disputed domain name <avast.org> in 2018 to illicitly sell and distribute the Complainant’s products as well as the current use of the second disputed domain name <avwst.com> to profit financially from the use of pay-per -click links partly connected to the Complainant and partly connected to its competitors, the Respondents were undoubtedly well aware of the Complainant and its rights upon registering the disputed domain names and deliberately registered both disputed domain names to mislead internet users into believing that both domain names were in some way connected, affiliated or endorsed by the Complainant.

Lastly, the Complainant underlines that typosquatting, as is the case for the second disputed domain name <avwst.com>, is also to be considered as being strong evidence of bad faith, especially considering the obvious reference made to the Complainant’s software through the links on the corresponding pay-per-click page.

RESPONDENTS

The Respondents did not reply to the Complainant’s contentions.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 Respondents to have no rights or legitimate interests in respect of the disputed domain names (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 names have been registered and are 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.

As to the Complainant’s request for consolidation of the disputed domain names, which are currently registered in the name of two different companies providing Whois privacy services, the Panel, exercising its general powers according to paragraph 10 of the Rules, has decided to accept the Complainant’s request since, in light of the circumstances of the case, the disputed domain names appear to be under control of a single person or entity or, at least, of individuals or entities acting in concert. Indeed, as highlighted by the Complainant: i) the disputed domain names, which both clearly target the Complainant’s trademark AVAST, are both pointed to IP addresses located in the Netherlands connected to companies providing internet services and hosting solutions; ii) the disputed domain names have been both using Whois privacy services to hide their identity and, in particular, the previous registrant of the first disputed domain name <avast.org> was the same privacy service, located in Panama, currently used for the second disputed domain name <avwst.com>; iii) the first disputed domain name <avast.org> was previously redirecting its internet traffic to the website at <avwst.com> (as shown in the historical screenshots submitted by the Complainant). The Panel also finds that the consolidation of the named Respondents and disputed domain names would be procedurally efficient and fair and equitable to all parties.

PRINCIPAL REASONS FOR THE DECISION

1. The Panel finds that the Complainant has established rights over the trademark AVAST based on the trademark registrations cited above and the related trademark certificates submitted as annexes to the Complaint.

The Panel finds that the disputed domain name <avast.org> is identical to the Complainant’s trademark AVAST as it includes

the Complainant's trademark in its entirety with the mere addition of the generic Top Level Domain ".org" whilst the second disputed domain name <avwst.com> is confusingly similar to the Complainant's trademark, from which it differs only for the substitution of the third letter of the Complainant's trademark "a" with the letter "w" and the generic Top Level Domain ".com". As stated in a number of prior decisions rendered under the UDRP, these minor changes are not sufficient to prevent a finding of identity or confusing similarity. In addition, the registration of <avwst.com> is a clear typosquatting since it includes a clear misspelling of the Complainant's trademark AVAST.

2. The Complainant stated that the Respondents, which have not filed a Response, are not authorized by the Complainant in any way. Based on the records, the Respondents are not commonly known by the disputed domain names or by a name corresponding to the disputed domain names.

According to the documents submitted by the Complainant, which have not been contested by the Respondent, the first disputed domain name <avast.org> was pointed in the past to a pay-per-click website displayed at the second disputed domain name <avwst.com> and, in 2018, to a website offering without authorization purported AVAST products for sale. The second disputed domain name <avwst.com>, instead, has been pointed to a parking page containing pay-per-click links connected to the Complainant and its competitors. The Panel finds that, in view of the described use of the disputed domain names, the Respondents have not made use, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use. Therefore, and in the absence of a Response, the Panel finds that the Complainant has made a prima facie case that the Respondents have no rights or legitimate interest in the disputed domain names.

3. As to bad faith at the time of the registration, the Panel finds that, in light of the identity and confusing similarity of the disputed domain names with the Complainant's prior registered trademarks cited above, and in view of the well-known character of the Complainant's trademark AVAST, the Respondent was more likely than not aware of the Complainant's trademark at the time of the registration of the disputed domain names. Moreover, the explicit references to the Complainant's trademark and products made on the websites to which the disputed domain names resolve or resolved indeed support the conclusion that the Respondents registered the disputed domain names with the Complainant's trademarks in mind.

With regard to the use of the disputed domain names, the Panel notes that, as mentioned above, the disputed domain name <avwst.com> has been pointed since its registration to a web page with pay-per-click links related to products of the Complainant and its competitors.

The disputed domain name <avast.org> is, instead, currently pointed to an inactive website. However, it is well-established that passive holding of a domain name could amount to bad faith under certain circumstances, including the prior use of the domain name made by the registrant and the correspondence of the disputed domain name to a well-known trademark. In the present case, as mentioned above, the disputed domain name <avast.org>, identical to the registered and well-known trademark AVAST, was redirected in the past to a pay-per-click page displayed at <avwst.com> and, in 2018, to a website offering without authorization purported AVAST products for sale.

In view of the above-described use of the disputed domain names made by the Respondents, the Panel finds that the Respondents intentionally attempted to attract Internet users to their websites for commercial gain, by causing a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of their websites according to paragraph 4(b)(iv) of the Policy.

Furthermore, the Panel finds that, in view of the circumstances of the case, the Respondents' use of privacy services to hide their contact details in the Whois records and their lack of Response are additional evidence of their bad faith.

Therefore, the Panel finds that the Respondents registered and are using the disputed domain names in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AVWST.COM:** Transferred
2. **AVAST.ORG:** Transferred

PANELLISTS

Name	Luca Barbero
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DATE OF PANEL DECISION	2021-05-19
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Publish the Decision
