

ADMINISTRATIVE PANEL DECISION

Migros-Genossenschafts-Bund and Migros France SAS v. Mark Sutton Case No. DEU2023-0024

1. The Parties

The Complainants are Migros-Genossenschafts-Bund of Switzerland (the “First Complainant”), and Migros France SAS of France (the “Second Complainant”), represented by SILKA AB, Sweden.

The Respondent is Mark Sutton of France.

2. The Domain Name, Registry and Registrar

The Registry of the disputed domain name <corporate-migros.eu> is the European Registry for Internet Domains (“EURid” or the “Registry”). The Registrar of the disputed domain name is Combell N.V.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 14, 2023. On June 21, 2023, the Center transmitted by email to the Registry a request for registrar verification in connection with the disputed domain name. On June 23, 2023, the Registry transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .eu Alternative Dispute Resolution Rules (the “ADR Rules”) and the World Intellectual Property Organization Supplemental Rules for .eu Alternative Dispute Resolution Rules (the “Supplemental Rules”).

In accordance with the ADR Rules, Paragraph B(2), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 26, 2023. In accordance with the ADR Rules, Paragraph B(3)(a), the due date for Response was July 16, 2023. The Response was not filed with the Center in due time. The Center notified the parties of the Respondent’s Default on July 17, 2023.

By email dated July 18, 2023, the legal representative of a third party notified the Center that the third party received the Complaint on July 13, 2023 by DHL, and that the third party was not aware of the registration of the disputed domain name. The legal representative of this third party stated that it appeared the postal and email addresses used by the Respondent (that corresponds to the third party’s address and email) have been used fraudulently and requested the extension of deadline for filing the third party observations.

The legal representative of the third party sent to the Center further communication on July 21, 2023, explaining in detail that the third party and the Respondent are not related in any way, the third party has no knowledge on registration of the disputed domain name, and that the Respondent fraudulently used the third's party address and email when registering the disputed domain name.

The Center appointed Mladen Vukmir as the sole panelist in this matter on July 24, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the ADR Rules, Paragraph B(5).

4. Factual Background

- (i) the First Complainant is a Swiss retail company founded in 1928, is owned by its more than 2 million cooperative members, and organized into ten regional cooperatives;
- (ii) the Second Complainant is a wholly-owned subsidiary (based in France) of the First Complainant;
- (iii) the First Complainant is the owner of a portfolio of registered MIGROS trademarks ("MIGROS trademarks")

Trademark	Trademark Scope	Reg. no. / Status	Date of registration
MIGROS (word)	European Union ("EU")	000744912/registered	July 26, 2000
MIGROS (word)	EU	003466265/ registered	May 13, 2005
M MIGROS (figurative)	International	404446/ registered	December 28, 1973
MIGROS (word)	International	637252/ registered	February 13, 1995
MIGROS (figurative)	International	1459503/ registered	December 31, 2018
MIGROS (word)	International	1469883/ registered	December 31, 2018

- (iv) The Complainants operate their official website under the domain name <migros.ch>, and a sub-domain name <corporate.migros.ch>;
- (v) The disputed domain name was registered on January 2, 2023, and redirected to the Complainants' website in an unauthorized manner. The disputed domain name has also been used to falsely impersonate the Complainants' employee in order to send phishing emails.

5. Parties' Contentions

A. Complainants

The Complainants state that:

- (i) With sales of CHF 30.138 billion, and a gross profit of CHF 11.490 billion in 2022, the First Complainant is one of the Switzerland's largest retailer, and one of the country's largest private employer, with over 95,000 employees. The First 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;
- (ii) Prior UDRP decisions have recognized the reputation and well-known character of MIGROS trademarks;

- (iii) The disputed domain name is confusingly similar to MIGROS trademarks. The disputed domain name differs from MIGROS trademark only by hyphen and the word “corporate”;
- (iv) The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not a licensee of the Complainants, and it has not received any consent, permission or acquiescence from the Complainants to use its MIGROS trademarks. The Respondent is not commonly known by the disputed domain name, there is nothing to suggest that the Respondent holds any trademarks on the disputed domain name or words “corporate-migros”, or that it operated under these words. The disputed domain name redirects to the Complainants’ website in an unauthorized manner, which is likely to mislead Internet users into believing that the disputed domain name is connected to the Complainants’ business, so it would not claim for a use of the disputed domain name in connection with a *bona fide* offering of goods and services. The disputed domain name has been used to impersonate the Complainants’ employee in order to send phishing emails. The disputed domain name is almost identical to the Complainants’ sub-domain <corporate.migros.ch>. The Respondent never responded to the Complainants’ cease and desist letter in order to justify the registration of the disputed domain name;
- (v) The Respondent registered and used the disputed domain name in bad faith. Since the disputed domain name redirects to the Complainants’ website and it has been used to send phishing emails impersonating one of the Complainants’ employee, these facts support the inference that the Respondent knew of the Complainants and registered the disputed domain name in order to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainants’ MIGROS trademarks.

B. Respondent

The Respondent did not reply to the Complainants’ contentions.

However, as referenced above in the Procedural History, the Center received email communications from the legal representative of a third party on July 18, 2023 and July 21, 2023. Since the Complainants did not refer to this third party in the Complaint, the third party has no relationship with the Respondent nor indicate any rights or interest in the disputed domain name, the Panel, while noting the third party’s statements about their contact details have been fraudulently used by the Respondent, determined that the third party has no relationship with any of the Parties here and their statements do not change the outcome of the Decision, apart from supporting the Complainant’s arguments under the third element.

6. Discussion and Findings

The Panel now proceeds to consider this matter on the merits in the light of the Complaint, the absence of a response, the Regulation (EC) No. 2019/517 of the European Parliament and of the Council of March 19, 2019 on the implementation and functioning of the .eu Top Level Domain (the “Regulation”), the ADR Rules, and the Supplemental Rules (“the Regulation”).

Considering that panels in earlier .eu cases have established that there are substantive similarities between the ADR Rules and the Uniform Domain Name Dispute Resolution Policy (the “UDRP”), this Panel refers to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#).) where appropriate.

6.1. Procedural Issue - Consolidation of Complainants

The Regulation and the ADR Rules do not expressly prescribe the possibility of an ADR complaint filed jointly by multiple complainants. However, prior panels in similar .eu cases involving multiple complainants rendered decisions based on UDRP, and accepted a complaint filed by more than one complainant against a single respondent.

According to section 4.11.1. of the [WIPO Overview 3.0](#), in assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.

The Second Complainant is a wholly-owned subsidiary of the First Complainant, they are directly related to one another, and under the same legal control. They share a common legal interest in the trademarks held by the First Complainant, and therefore they have a common interest in this proceeding and share a common grievance. It is well established that consolidation is appropriate for a parent company and its wholly-owned subsidiary. The Panel finds that in this case the consolidation would be equitable and procedurally efficient, therefore the Panel accepts the consolidation of the Complainants.

6.2. Substantive Issue

According to Article 4(4) of the Regulation and Paragraph B(11)(d) of the ADR Rules, in order to succeed with the complaint, the complainant must prove following:

- (i) the domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or European Union law and; either
- (ii) the domain name has been registered by the Respondent without rights or legitimate interest in the name; or
- (iii) the domain name has been registered or is being used in bad faith.

A. Identical or Confusingly Similar to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or European Union law

In Paragraph B(11)(d)(1)(i) of the ADR Rules it is prescribed that the Panel shall issue a decision granting the remedies requested in case that the complainant proves that the disputed domain name is identical or confusingly similar to name in respect of which a right recognized by the national law of a Member State and/or European Union law.

The Complainants have proven that are the owners of a number of EU and international MIGROS trademarks registered before the competent authorities. As such, these trademarks provide to the Complainants all the exclusive rights that are granted with such trademark registrations.

After performing a comparison of the disputed domain name and the Complainants' MIGROS trademarks, it is evident to this Panel that the disputed domain name incorporates the Complainants' MIGROS trademark in its entirety. The only difference between the disputed domain name and the Complainants' MIGROS trademarks is the addition of the hyphen and word "corporate" in the disputed domain name. In this Panel's view the addition of hyphen and word "corporate" in the disputed domain name does not prevent a finding of confusing similarity between the disputed domain name and MIGROS trademark.

Among the panels, it is the consensus view that for assessing identity or confusing similarity, the ".eu" country-code Top-Level-Domain has to be disregarded. Concerning confusing similarity the Panel's review consist of a comparison between the disputed domain name and the name for which a right is recognized or established by Member State and/or European Union law.

Given all of the above, this Panel determines that the first requirement stipulated Paragraph B(11)(d), (1), (i) of the ADR Rules for issuing a remedy is fulfilled.

B. Rights or Legitimate Interests

Under Paragraph B(11)(e) of the ADR Rules, rights or legitimate interests may be demonstrated where:

- (i) prior to any notice of the dispute, the Respondent has used the disputed domain name in connection with the offering of goods and services or has made demonstrable preparations to do so;
- (ii) the Respondent, being an undertaking, organization or natural person has been commonly known by the domain name, even in absence of a right recognised or established by national and/or European Union law;
- (iii) the Respondent is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in respect of which a right is recognised or established by national and/or European Union law.

The overall burden of prove lies with the complainant. Cases have shown that it is often impossible for a complainant to prove negative facts because some required information is only within the knowledge of the respondent. Therefore, the complainant is only able to make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name. 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. If the respondent fails to show evidence of rights or legitimate interests it is deemed to have none.

The Complainants stated that the Respondent is not a licensee of the Complainants, and it has not received any consent, permission or acquiescence from the Complainants to use their MIGROS trademarks. The Respondent is not commonly known by the disputed domain name, there is nothing to suggest that the Respondent holds any trademarks on the disputed domain name or words “corporate migros”, or that it operated under these words. In this Panel’s view, the Complainants made a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed domain name. The Respondent did not respond to the Complaint, nor submitted any evidence to prove any rights or legitimate interests, therefore, it can be deemed that it does not have any.

In addition, the use of a domain name for illegal activity (e.g., phishing, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.

Given that the Respondent failed to demonstrate any rights or legitimate interests, this Panel determines that the second requirement (i.e., the requirement that the domain name has been registered by the Respondent without rights or legitimate interest in the name), is fulfilled.

According to Article 4(4) of the Regulation and Paragraph B(11)(d)(1) of the ADR Rules, lack of rights or legitimate interests and (iii) registration or use in bad faith are alternative requirements. Since the Respondent’s lack of rights and legitimate interests has been determined, the Panel would, generally, not find it necessary to argue on the question of bad faith on the side of the Respondent. However, for the sake of completeness, the Panel will further argue on the possibility of bad faith registration or use of the domain name by the Respondent below.

C. Registered or Used in Bad Faith

Under Paragraph B(11)(f)(4) of the ADR Rules, evidence of the registration or use of a domain name in bad faith may be the following:

- the domain name was intentionally used to attract Internet users, for commercial gain to the Respondent’s website or other online location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or European Union law, or it is a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the Respondent

The disputed domain name redirects to the Complainants' website in an unauthorized manner, and it has been used to send phishing emails falsely impersonating the Complainants' employee. The Panel accepts the Complainants' arguments that given the facts that the Complainants are one of the forty largest retailers in the world and is active in manufacturing and wholesaling through more than 30 companies, the Complainants have numerous registered MIGROS trademarks, well known worldwide, it is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainants and their MIGROS trademarks when the disputed domain name was registered.

The disputed domain name fully reproduces the Complainants' MIGROS trademarks, and is highly similar to the Complainants' sub-domain <corporate.migros.ch> which the Complainants use to establish their Internet presence. The Panel agrees with the Complainants that it is extremely unlikely that the Respondent registered the disputed domain name such a domain name by pure chance.

In this Panel's view, the disputed domain name was intentionally used to attract Internet users, for commercial gain, to the Respondent's website by creating a likelihood of confusion with the Complainants' MIGROS trademarks due to their high similarity with the disputed domain name.

In addition, the fact that the Respondent has used false contact information when registering the disputed domain name, as evidenced by the third party's submission, further supports the bad faith registration of the disputed domain name.

In addition, the Complainants provide sufficient evidence to show that the disputed domain name has been used in order to send fraudulent emails, which constitutes bad faith use.

Therefore, this Panel determines that the third requirement stipulated in Paragraph B(11) (d) (1) (iii) of the ADR Rules for issuing a remedy, *i.e.*, the requirement that the disputed domain name has been registered or is being used in bad faith, is fulfilled.

7. Decision

For the foregoing reasons, in accordance with Paragraph B(11) of the ADR Rules, the Panel orders that the disputed domain name, <corporate-migros.eu>, be transferred to the Second Complainant.¹

/Mladen Vukmir/

Mladen Vukmir

Sole Panelist

Date: August 4, 2023

¹ (i) The decision shall be implemented by the Registry within thirty (30) days after the notification of the decision to the Parties, unless the Respondent initiates court proceedings in a Mutual Jurisdiction, as defined in Paragraphs A(1) and 12(d) of the ADR Rules.

(ii) The remedy sought is transfer of the disputed domain name to the Second Complainant, MIGROS FRANCE SAS. As the Second Complainant is established in France, it satisfies the general eligibility criteria for registration of the disputed domain name set out in Article 3 of Regulation (EU) 2019/517.