Panel Decision for dispute CAC-ADREU-005739

Case number	**CAC-ADREU-005739**
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Domain names	**avast.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**AVAST Software a.s., Eduard Kučera**

Respondent

Organization / Name	**Avira GmbH, Avira GmbH**

FACTUAL BACKGROUND

Avast Software a.s. (the "Complainant") is a company providing services and selling products, directly and indirectly, in the area of information technology and computer software. It focuses primarily on security related products, anti-virus software, malware-protection as well as other related solutions and products. The Complainant offers a portfolio of computer security software, namely a well-known and commercially successful family of anti-virus solutions distributed under the trade name “avast!”. This antivirus product branded as “avast!” has been used by more than 100 million users all over the world in 2010 and has been distributed under this name since 1992.

The Complainant protects its well-known product brand by a number of trademarks, namely: (i) Czech national trademark no. 294988, “AVAST!” (word mark); (ii) German national trademark no. 30092783, “AVAST” (word mark); (iii) International trademark no. 1011270, “avast!” (word mark); and (iv) International trademark no. 839439, “AVAST” (word mark). The Complainant also holds rights to the domain name <www.avast.com> (registered on 6 October 1997), under which its commercial presentation of its products is published and through which the “avast!” product is distributed worldwide since 2001.

Avira GmbH (the "Respondent") is a limited liability company incorporated under German law involved in the production and supply of self-developed security solutions for both professional and private use. The Respondent is a direct competitor of the Complainant offering directly competing products and solutions. On 11 June 2006, the Respondent registered the disputed domain name <www.avast.eu> (the "Disputed Domain Name") and, in 2007, began re-directing Internet users from the Disputed Domain Name to the Complainant’s related domain <www.avast.com>. Following such registration, the Complainant requested the Respondent to co-operate in transferring the Disputed Domain Name. While the Respondent was ready to transfer the Disputed Domain Name, and declared its intention to make it available to the Complainant, the transfer failed to happen.

It then came to the attention of the Complainant, in December 2009, that the Respondent not only kept the Disputed Domain Name but had ceased re-directing the incoming traffic to the Complainant’s related domain <www.avast.com> and had commenced re-directing the incoming traffic to the webpage’s of <www.avira.com>, being the domain of the Respondent and which offered products that competed directly with the products of the Complainant.

The Complainant attempted to contact the Respondent to discuss and resolve the issue of the Disputed Domain Name. Consequently, three letters were sent by the legal representatives of the Complainant in March, April and June 2010, requesting the Complainant to transfer the Disputed Domain Name and to cease re-directing the traffic from the Disputed Domain Name to the home page of the Respondent , <www.avira.com>. The Respondent did not respond to any of these letters. The only change achieved was that the Respondent ceased re-directing the traffic from the Disputed Domain Name to its home-page <www.avira.com> but instead proceeded to create a cover webpage offering the products of the Complainant's competitors. The Complainant filed a complaint (the "Complaint") with the Alternative Dispute Resolution centre (the "Centre") for .eu domain name disputes on 21 June 2010. After initiation of the alternative dispute resolution (the "ADR") steps, the Respondent removed all content from the Disputed Domain Name. The Centre appointed Mr Alistair Payne as the sole panellist in this matter on 16 November 2010.

A. COMPLAINANT

Firstly, the Complainant alleges that the Disputed Domain Name is identical or confusingly similar to the trademarks in which the Complainant has rights (including (i) Czech national trademark no. 294988, "AVAST!" (word mark); (ii) German national trademark no. 30092783, "AVAST" (word mark); (iii) International trademark no. 1011270, "avast!" (word mark); and (iv) International trademark no. 839439, "AVAST" (word mark).

Secondly, the Complainant alleges that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name under the second limb of the test under Article 21 (1) of Commission Regulation (EC) No 874/2004 (the "Regulation") as it does not satisfy any of the evidentiary requirements of paragraph B 11 (e) of the .eu ADR Rules (the "ADR Rules") and has not demonstrated that: (1) it had used the Disputed Domain Name prior to the ADR procedure for the purpose of offering goods or services; (2) it is commonly known by the Disputed Domain Name; or (3) it is making a legitimate and non-commercial or fair use of the Disputed Domain Name, without intention to mislead consumers or harm the reputation of a name in which a right is recognised.

The Complainant supports its claim under this heading by showing that the Respondent is not commonly known by the Disputed Domain Name and that the Disputed Domain Name was registered by the Respondent despite the Respondent's awareness of the fact that the Disputed Domain Name was already used, at the time of registration, by the Complainant in the <www.avast.com> domain name, which is the key product name of the Complainant and which competes directly with the products of the Respondent.

Further, and linked with the Complainant's claim under the third limb of Article 21 (1) of the Regulation, the Complainant submits that the Respondent is not making a legitimate or fair use of the Disputed Domain Name for the purposes of demonstrating a right or legitimate interest in accordance with paragraph B 11 (e) (3) of the ADR Rules. The Complainant supports its claim by showing that while the Respondent in 2007, six months after registration, re-directed Internet users from the Disputed Domain Name to the Complainant's related site <www.avast.com>, the Respondent ceased this practice in 2009 and commenced diverting Internet users from the Disputed Domain Name to the website of the Respondent which offered products for sale that were in direct competition with those of the Complainant, thereby demonstrating an intention on the part of the Respondent to mislead consumers. This is illustrated by the emails from Milos Korenko to Tjark Auerbach (CEO of the Respondent) dated 21 January 2010 and from Tjark Auerbach to Pavel Baudis (co-founder of the Complainant), dated 20 July 2009.

Thirdly, the Complainant alleges that the Respondent has registered or has used the Disputed Domain Name at issue in bad faith as the Respondent satisfies a number of factors under Article 21 (3) of the Regulation illustrating bad faith including: (i) Article 21 (3) (d) of the Regulation, that the Disputed Domain Name was used to intentionally attract Internet users for commercial gain to the Respondent's, or other competitors of the Complainants, website by creating a likelihood of confusion with a name in which a right is recognised; (ii) Article 21 (3) (c) of the Regulation, that the Disputed Domain Name was registered primarily for the purpose of disrupting the professional activities of the Complainant; and (iii) Article 21 (3) (a) of the Regulation, that the Disputed Domain Name was registered primarily for the purpose of selling, renting, or otherwise transferring the Disputed Domain Name to the holder in respect of which a right is recognised.

The Complainant supports its claim under Article 21 (3) (c) and Article 21 (3) (d) of the Regulation by pointing to the email sent by Tjark Auerbach (CEO of the Respondent), dated 1 April 2010, which indicates that the Respondent, in 2009, resumed the practice of re-directing Internet users from the Disputed Domain Name to <www.avira.com>, being the domain name of the Respondent, despite the Complainant's efforts to have the domain name transferred. The Complainant supports its claim under Article 21 (3) (a) of the Regulation by proving that the Respondent had previously registered the domain name in respect of which another competitor, "AVG", had rights as well as the attempted registration of the "AVG" Community Trademark ("CTM"). Evidence of this is provided by a CTM application printout indicating the applicant for the "AVG" CTM to be Tjark Auerbach. Tjark Auerbach is the founder and CEO of Avira GmbH.

B. RESPONDENT

The Respondent has not submitted a response to the Complaint.

DISCUSSION AND FINDINGS

To succeed under Article 21 (1) of the Regulation, the Complainant must demonstrate that the Disputed Domain Name:

(a) is identical or confusingly similar to a name in respect of which the Complainant has a recognised right; and

(b) has been registered by its holder without rights or legitimate interests; or

(c) has been registered or is being used in bad faith.

Each limb of this test will now be examined.

(a) Rights in the Mark

The Complainant owns numerous trademark registrations for the "AVAST!" and "AVAST" marks in various jurisdictions as noted above. The Disputed Domain Name differs from the Complainant's "avast!" registered trademark only by the removal of an exclamation mark. Previous panels have found that domain names differing by only one letter are confusingly similar to trademarks (NATURE-ET-DECOUVERTE, Case No. 04928; BAYERGARDEN, Case No. 04661; WALTHER-PRAEZISION, Case No. 04477; TSE-Systems, Case No. 01328; ZOTT-SALE, Case No. 05468) and, in the circumstances of a distinctive mark such as "avast!", the Panel finds that this is also the case here. Further, the "AVAST" mark in which the Complainant has rights is identical to the Disputed Domain Name. Accordingly the Complaint succeeds in relation to the first limb of the test under Article 21 (1) of the Regulation in that the Complainant has rights in a mark which is identical or confusingly similar to the Disputed Domain Name.

(b) Rights or Legitimate Interests

The Complainant submits that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name because there is no evidence of bona fide use of an equivalent mark by the Respondent and the Complainant has never authorised the use of, or licensed the use of, the Disputed Domain Name, by or to the Respondent.

As a result of the foregoing, the Panel concludes that the Complainant has established a prima facie case that the Respondent registered the Disputed Domain Name without having any rights or legitimate interests in that name. As a result of the Respondent's failure to rebut any of the Complainant's submissions and based further on the discussion under bad faith below, and in the absence of any evidence to rebut the Complainant's case, the Panel infers that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name. Accordingly, the Complaint succeeds in relation to the second limb of the test under Article 21 (1) of the Regulation.

(c) Registered or Used in Bad Faith

The Complainant submits that the Respondent is one of its direct competitors in the computer security software solution

industry and clearly knew of the Complainant's business and use of the "AVAST!" mark at the time of registration of the Disputed Domain Name. Based on the Complainant's assertion that its "AVAST!" branded product has been used by more than 100 million users all over the world and has been distributed under this name since 1992 and also on the assertion that the Complainant and the Respondent are direct competitors and knew each other, or at the very least knew of each other, the Panel infers that on the balance of probabilities the Respondent knew of the Complainant's "AVAST!" mark at the date of registration in June 2006. Presumably based on a request from the Complainant, although this is not entirely clear in the materials before the Panel, the Respondent subsequently re-directed Internet users to the Complainant's related domain <www.avast.com> around 6 months after registration and for a period of two years. As the circumstances of this redirection are not clear the Panel declines to make a finding concerning registration in bad faith but this is not in any event material to the outcome because of the subsequent conduct of the Respondent.

By subsequently re-directing the Disputed Domain Name to <www.avira.com> and then ignoring correspondence from the Complainant and eventually re-directing the Disputed Domain Name to a cover webpage featuring products of the Complainant's competitors, the Panel finds that the Respondent has acted in blatant disregard for the Complainant's rights and knowingly in bad faith.

The Panel finds that the Respondent's conduct in re-directing the Disputed Domain Name to its own website was to intentionally attract Internet users for commercial gain to the Respondent's website by creating a likelihood of confusion in Internet users minds between the products of the Complainant and those of the Respondent in terms of Article 21 (3) (d) of the Regulation. Purposefully going one step further and specially creating a webpage featuring the Complainant's competitors products and re-directing the Disputed Domain Name to that webpage is plainly even more indicative of the Respondent's bad faith.

Accordingly, the Panel finds that the Respondent used the Disputed Domain Name in bad faith and that the Complaint succeeds under the third limb of the test under Article 21 (1) of the Regulation.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) of the ADR Rules, the Panel orders that the domain name AVAST be transferred to the Complainant.

PANELISTS

Name	**Alistair Payne**

DATE OF PANEL DECISION 2010-12-10

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant provided evidence of its registered trade marks rights for "avast!" and "AVAST" in numerous jurisdictions as well as internationally. The Panel found that the Disputed Domain Name was identical and/or confusingly similar to the registered trade marks owned by the Complainant. The Complainant requested that the Disputed Domain Name be transferred on the basis that the Complaint satisfied the requirements of Article 21 (1) of the Regulation. The Complainant submitted that: (i) the Disputed Domain Name was identical and/or confusingly similar to trade marks in respect of which it had registered rights; (ii) the Respondent had registered the Disputed Domain Name without rights or legitimate interests; and (iii) that the Respondent registered and used the Disputed Domain Name in bad faith. The Respondent did not file a response to the Complaint. The Panel found that the Complainant had established a prima facie case that the Respondent did not have any rights or legitimate interests in the Disputed Domain Name and, in the absence of a response by the Complainant rebutting the Complainant's submissions, accepted the Complainant's submissions in that respect. Further, the Panel considered that the Respondent, in re-directing the Disputed Domain Name to its own domain <www.avira.com>, and later, when requested to cease this practice, by specifically putting in place at the Disputed Domain Name a webpage advertising the products of the Complainant's competitors, had used the Disputed Domain Name in bad faith in accordance

with Article 21 (3) of the Regulation. Accordingly, the Panel ordered that the Disputed Domain Name be transferred to the Complainant.