

ADMINISTRATIVE PANEL DECISION

Case No. DCN-1600687

Complainant:	MIGROS-GENOSSENSCHAFTS-BUND (Federation of Migros Cooperatives)
Respondent :	Lin Wei Cai
Domain Name:	migrosgroup.com.cn and migrosgroup.cn
Registrar:	HiChina ZhiCheng Technology Ltd.

1. Procedural History

The Complainant filed the Complaint with the Hong Kong International Arbitration Centre (the "Centre") and chose to have a sole panelist handle the dispute on 3 May 2016 in accordance with the CNNIC Domain Name Dispute Resolution Policy ("CNDRP") issued by the China Internet Network Information Center ("CNNIC") and becoming effective on 21 November 2014, the Rules for CNNIC Domain Name Dispute Resolution Policy ("Rules of CNDRP") issued by the CNNIC and becoming effective on 21 November 2014, and the HKIAC Supplemental Rules for CNDRP and Rules of CNDRP ("Supplemental Rules"), issued by the Hong Kong International Arbitration Centre and becoming effective on 21 November 2014. On 4 May 2016, the Centre confirmed receipt of the said Complaint and transmitted by email to HiChina ZhiCheng Technology Ltd. (the Registrar of the domain name) a request for registrar verification in connection with the domain names at issue. On 4 May 2016, the said Registrar sent a reply to the Centre and clarified that the CNNIC Domain Name Dispute Resolution Policy is applicable to the domain names at issue.

On 17 May 2016, the Centre sent the Notice of Complaint to the Respondent and requested the Respondent to reply within 20 days (on or prior to 6 June 2016), and forwarded the Complaint as well as all of the Annexures to the Complaint, in accordance with the Rules of CNDRP and the Supplemental Rules. The procedure for handling this case formally commenced on 17 May 2016. On 7 June 2016, the Centre issued a Default Notice and confirmed that the Respondent did not file a formal Reply with the Centre, within the required time limit for filing a Reply.

On 23 June 2016, the Centre appointed Mr. Matthew Murphy as the sole panelist for arbitrating this case. The Panel considered that it was properly constituted and submitted the acceptance notice as well as a statement of impartiality and independence. The Centre formally

transferred the case to the Panelist on the same day. The Panelist agreed to deliver his decision with respect to the domain names at issue on, or prior to, 7 July 2016.

2. Factual background

For the Complainant

The Complainant, Migros, says that it was founded in 1925 in Zurich, and is now listed as a FORTUNE 500 company. It also claims that it is one of the largest department stores in Switzerland, offering a wide range of food, non-food products and services. It has a diversified business of travel agencies, cultural institutions, museum, magazines, restaurants, aqua/fitness/golf parks, several pension funds and foundations and a bank. The Complainant further claims it established Migros (Hong Kong) Ltd. in Hong Kong in 1995 to manage the sourcing of products and suppliers, with this entity acting as an intermediary between Migros' headquarters in Switzerland and suppliers in the Far East. In addition, the Complainant claims that it has been operating its own office in Shanghai since 2005.

The Complainant claims it owns the following International Trademark Registrations designating China: No. 637252, "MIGROS" mark registered on 13 February 1995; and No. 397821, "MIGROS" mark registered on 14 March 1973. The Complainant also claims it owns the following locally filed Chinese Trademark Registration: No. 6762810, "MIGROS" mark registered on 28 September 2010. All of these trademark registrations were registered many years before registration of the domain names at issue, by the Respondent. The Complainant further claims that it also owns various "MIGROS" domain names, such as www.migrosgroup.com, www.migros.com, www.migros.ch.

For the Respondent

The Respondent, Lin Wei Cai, is an individual with an email contact of icityfish@163.com. The Respondent registered the Disputed Domain Name < migrosgroup.com.cn > on 22 April 2015, and registered Disputed Domain Name < migrosgroup.cn > on 8 April 2015. The Respondent did not file any Reply or any other materials with the Centre within the required time limit.

3. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

- i. The disputed domain names are identical with or confusingly similar to the Complainant's name or marks in which the Complainant has civil rights and interests:

The Complainant claims it owns a Swiss trademark registration consisting or containing “MIGROS”: registration number P-405500, registered in 1993; the Complainant also claims it owns two international registrations consisting or containing “MIGROS” which designates China: registration number 637252 which was registered in 1995; and registration number 397821 which was registered in 1973. Moreover, the Complainant claims it owns a Chinese Trademark Registration: No.6762810 which was registered in 2010. All of these trademark registrations were registered years before the domain names at issue. In addition, the Complainant says it holds numerous domain names incorporating the “MIGROS” trademark. The Complainant claims that it has previously successfully challenged several “MIGROS” domain names registered by third parties, and referred the Panel to WIPO cases: D2000-1171, D2008-0092, DCH2008-0016, DCH2010-0020, DCH2010-0021, D2015-0564, D2015-0326, D2015-1197, D2015-1364, D2015-1012; and US National Arbitration Forum case FA1505001621184.

The Complainant claims it established Migros (Hong Kong) Ltd. in Hong Kong in 1995 and since 2005, the Complainant has been operating its own office in Shanghai since 2005. The Complainant claims that Chinese customers are familiar with the Complainant’s products such as hard goods, textiles and food.

The Complainant considers the domain names at issue, directly and entirely incorporates the Complainant’s well-known trademark “MIGROS”, that the domain names are identical to the Complainant’s “MIGROS” trademark and that the domain names would be perceived by Internet users as descriptive of a website where they could find information about the Complainant’s well-recognized products and services.

- ii. The holder of the disputed domain names has no legitimate right or interest in the domain names or a major part of the domain names:

The Complainant argues the Respondent is not commonly known by the domain names at issue, nor does the Respondent claim to have made legitimate, non-commercial use of the domain names. The Complainant also argues that the Respondent has not tried to use the domain names for any purpose that might explain its choice in a manner consistent with having rights or legitimate interest in the name “MIGROS” or “MIGROS GROUP”; Moreover, the Complainant claims that there is no evidence that the Respondent has a history of using, or preparing to use, the domain names under a bona fide offering of goods and services.

The Complainant argues that it seems to be unlikely that the Respondent was not aware of the brand MIGROS. In addition, the Complainant also argues that the Respondent’s explanation for “migros” in Chinese – “our grain is the best” for its new launching business, is not convincing.

- iii. The holder of the disputed domain names registered or used the disputed domain names in bad faith:

The Complainant argues that the Respondent has registered the domain names in bad faith by intentionally adopting the Complainant's widely known marks in violation of the Complainant's right.

In addition, the Complainant claims that their WHOIS search shows that the Respondent has registered a number of other domain names consisting of well-known marks, such as chevroletmotor.com, jeepmotor.cn, volvomotor.cn. The Complainant considers that the evidence showing that the Respondent registers well-known trademarks as domain names can be taken into account as an indication of bad faith.

Moreover, the Complainant argues that its international and Chinese trademark registrations predate the Respondent's domain name registrations, and it is highly unlikely that the Respondent was not aware of the rights that the Complainant has for the trademarks at issue.

B. Respondent

The Respondent did not submit any Reply within the required time limit.

4. Findings

As to the case, Article 8 of CNDRP provides that a complaint against a registered domain name shall be supported if the following conditions are fulfilled:

- i. The disputed domain name is identical with or confusingly similar to the Complainant's name or mark in which the Complainant has civil rights or interests;
- ii. The disputed domain name holder has no right or legitimate interest in respect of the domain name or major part of the domain name;
- iii. The disputed domain name holder has registered or has been using the domain name in bad faith.

Article 7 of CNDRP states that the Complainant and the respondent shall bear the burden of proof for their own claims. With reference to the complaint and the attached documents, the Panel of this case considers that:-

Language of the Proceedings

The Complainant filed the Complaint with the Centre in English, and requested English be the language of the proceedings based on the following reasons: 1) the Respondent replied to the Complainant's cease and desist letter in English, which indicates the Respondent has a level of English language which allows them to understand the proceedings if carried out in English; 2) the Respondent's right will not be detrimentally affected if the case proceeded in English.

Following the line of reasoning in previous cases, when deciding "whether to allow the proceedings to be conducted in a language other than the language of the Registration Agreement, and to require the Complainant in an appropriate case to translate the Complaint into the language of that agreement, the Panel must have regard to all 'the relevant circumstances'". Such circumstances include "whether the Respondent is able to understand and effectively communicate in the language in which the complaint has been made and would suffer no real prejudice, and whether the expenses of requiring translation and the delay in the proceedings can be avoided without at the same time causing injustice to the parties". For a discussion of the issues in this area, see: *SWX Swiss Exchange v. SWX Financial LTD*, WIPO Case No. D2008-0400.

Based on the above and using CNDRP precedents that were conducted in English (e.g. Case No. DCN-1500624), the Panel considers that: it is reasonable to infer that the Respondent probably has reasonable English language ability, and therefore, should be able to understand the proceedings of conducted in English. Further, the Respondent has had sufficient time and opportunity to comment on or object to the Complainant's language request, however, the Respondent has not filed a Reply or any requests/submissions of any kind.

Thus, upon weighing relevant circumstances on both sides, the Panel considers it would be appropriate to exercise its discretion and conduct the proceedings in English.

Identical or Confusing Similarity

The Panel finds that the Complainant has proved that it is the owner for the "MIGROS" trademark by providing the detailed registration list for its "MIGROS" trademark registrations, including two international trademark registrations designating China and one locally filed Chinese trademark registration. The Panel considers that the Complainant has established the sole and close correspondence between the "MIGROS" trademark and the Complainant due to many years of wide use of the "MIGROS" trademark and trade name. Obviously, the domain names at issue, being <migrosgroup.com.cn> and <migrosgroup.cn> completely incorporate the Complainant's "MIGROS" trademark and trade name, and such incorporation makes the domain names at issue confusingly similar with the Complainant's trademark - this is because "the first and immediately striking element in the Domain Name is the Complainant's name. Adoption of it in the Domain Name is inherently likely to lead people to believe that the

Complainant is connected with it." – See: Dixons Group Plc v Mr. Abu Abdullaah, WIPO Case No. D2000-0146.

Further, the suffix "GROUP" appearing in the domain names at issue, after the Complainant's "MIGROS" trademark, does not help to reduce confusing similarity in any way. On the contrary, the suffix "GROUP" could increase the likelihood of confusing similarity, because "MIGROSGROUP" is the group name for the Complainant, and the Complainant owns many domain names which contain "MIGROSGROUP".

In conclusion, the Panel considers that the Complainant has satisfied Article 8.1 of the CNDRP.

Rights or Legitimate Interests of the Respondent

The Complainant's "MIGROS" trademark was first registered in 1973 (and was apparently extended to China by country designation at a later time). The Complainant's "MIGROS" trademark was also registered under local Chinese trademark application procedures in China on 28 September 2010. These registration dates are much earlier than the registration date of the domain names at issue, being the 22 April 2015 and 8 April 2015. "Once a Complainant makes out a prima facie showing, the burden of production on this factor shifts to the Respondent to rebut the showing by providing concrete evidence that it has rights to or legitimate interests in the Domain Name." See: Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270. Thus, the Panel finds that it is appropriate that the burden of proof should be shifted to the Respondent.

There is no evidence proving that the Respondent has any legal right and interest in the domain names at issue, the Respondent could not sufficiently prove that it "owns legal rights and interests thereof" by the mere registration of the domain names at issue. See: Adobe Systems Incorporated v. Domain OZ, WIPO Case No. D2000-0057. Further, no evidence exists to show that the Respondent has any rights or relationship in respect of the domain names at issue. Upon comprehensively considering the circumstances of the case as well as visiting the websites located at the domain names at issue, the Panel considers that the Respondent does not have rights and legitimate interests in the domain names at issue.

Given the foregoing, the Panel considers that the Complainant has satisfied the Article 8.2 of the CNDRP, the Respondent has no rights or legitimate interests in respect of the domain names at issue.

Bad Faith

Before the Respondent registered the domain names at issue, due to years of use of the "MIGROS" by the Complainant, the mark already possessed strong market recognition and visibility around the world including in China. It is reasonable for the Panel to infer that the

Respondent knew about its existence when registering the domain names (see Banca Sella S.p.A. v. Mr. Paolo Parente, WIPO Case No. D2000-1157; Expedia, Inc. v. European Travel Network, WIPO Case No. D2000-0137) and that the purpose to register the domain names at issue by the Respondent is to confuse and mislead the public, so that the relevant public mistakenly considered that the disputed domain names at issue, are owned by the Complainant or there is a certain relationship with the Complainant.

In a reverse WHOIS search by the Complainant, the result shows the Respondent not only registered domain names using the Complainant's trademark, but also registered numerous domain names containing third party owned well-known trademarks, such as <chevroletmotor.com>, <jeeptomotor.cn>, <volvomotor.cn> and so on. The Panel finds that the Respondent repeatedly maliciously registered a large number of domain names that are very similar to well-known trade name and/or trademarks owned by the Complainant and/or others, in order to cause confusion to the public and obtain improper benefits or prevent the legitimate trademark owners from reflecting their trademarks in corresponding domain names, which has satisfied Article 9.2 of the CNDRP and constitutes bad faith registration and use.

In conclusion, the Panel considers that the Complainant has satisfied Article 8.3 of the CNDRP.

5. Decision

Pursuant to Article 40 of the CNDRP Rules, this Panel orders that the domain names <migrosgroup.com.cn> and <migrosgroup.cn> be transferred to the Complainant.

Matthew Murphy
Sole Panelist

Dated: 30 June 2016