Decision for dispute CAC-UDRP-100508

Case number	**CAC-UDRP-100508**
Time of filing	**2012-09-25 20:58:15**
Domain names	**5mglexapro.com**

Case administrator

Name	**Tereza Bartošková (Case admin)**

Complainant

Organization	**H. Lundbeck A/S**

Complainant representative

Organization	**Wallberg IP Advice**

Respondent

Name	**Anatoliy Petrov**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant owns a large number of registered trademarks worldwide comprising the word 'LEXAPRO', inter alia the international trademark registration no. 778106 “LEXAPRO” (word) with registration date 16 March 2002. This international trademark registration is protected in numerous countries, including the Ukraine.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

Factual Background

The Complainant H. Lundbeck A/S is an international pharmaceutical company engaged in the research, development, production, marketing and sale of pharmaceuticals across the world. The company's products are targeted at disorders such as depression and anxiety, psychotic disorders, epilepsy and Huntington's, Alzheimer's and Parkinson's diseases. Lundbeck was founded in 1915 by Hans Lundbeck in Copenhagen, Denmark. Today Lundbeck employs approximately 6,000 people worldwide. According to the Complain Lundbeck is one of the world's leading pharmaceutical companies working with brain disorders. In 2011, the company's revenue was DKK 16.0 billion (approximately EUR 2.2 billion or USD 3.0 billion).

Lundbeck markets a number of different pharmaceuticals for the treatment of brain disorders. The most recently launched compounds include: Cipralex/Lexapro (depression), Ebixa (Alzheimer's disease), Azilect (Parkinson's disease), Xenazine (chorea associated with Huntington's disease), Sabril (epilepsy), Sycrest (bipolar disorder) and Onfi (Lennox-Gastaut syndrome).

The Complainant contends that the domain name is identical or confusingly similar to a trademark in which the Complainant has rights (Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1)). The domain name incorporates the complainants registered trademark combined with the generic and descriptive term "5mg" as prefix. The Complainant claims that for the purpose of a UDRP proceeding, when a well-known and invented mark is combined with common nouns or adjectives, that combination constitutes a domain name which is confusingly similar to an invented and well known mark.

Also, the Complainant asserts that it is an established and recognized principle under the UDRP that the presence of the .com top level domain designation is irrelevant in the comparison of a domain name to a trademark.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the domain name (Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2)). The Respondent has not received any license or consent, express or implied, to use the complainant´s trademark Lexapro, in a domain name or in any other manner from the Complainant, nor has the Complainant acquiesced in any way to such use or application by the Respondent. At no time did the Respondent have authorization from the Complainant to register the disputed domain name.

Further, to the best knowledge of the Complainant, the Respondent has no legitimate right in the contested domain name. The Respondent did thus not use the domain name as a trademark, company name, business or trade name prior to the registration of the disputed domain name, nor is the Respondent otherwise commonly known in reference to the name. On the contrary it is evident from the content of the Respondents website, on which Complainant's product Lexapro is being offered for sale, that the inclusion of the Complainants trademark Lexapro in the domain name is done deliberately and with specific reference to this mark. By doing this the Respondent intentionally attempts to attract for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

The Complainant further contends that, to the best knowledge of the Complainant, the Respondent has no legitimate interest in the contested domain name. The Complainant considers it evident from the wording of the website that the inclusion of the Complainants trademark Lexapro in the domain name is done deliberately and with specific reference to this mark, and that the inclusion of the term "order" on the website indicates that you can order the Complainants´ product Lexapro on the website. The Respondent does however not use the domain name in connection with a bona fide offering of goods and services. Complainant emphasizes that Lexapro is a controlled substance and, as such, under United States of America law as well as in all other countries including in Ukraine – the apparent country of residence of the Respondent – may not be sold online without a prescription from an authorized person (medical doctor). The Complainant asserts that the activity conducted at the disputed site may well be illegal as to the controlled substance Lexapro. See, e.g., American Online, Inc. v. Xianfeng Fu, WIPO Case No. D2000 1374 and Roche Products Inc. and Genentech, Inc. v. Vincent Holman and Whois Privacy Services Pty. Wipo Case No. D2010-1951.

The Complaint also refers to the CAC Case No. 100447 BUYONLINELEXAPRO.NET in which the Panel stated:

"The fact that a product is available only on prescription, when the Respondent is promoting it for sale online and, by necessary implication, without a prescription, is a relevant consideration. It is particularly relevant as it shows an intention to deceive, which is the essence of bad faith and destructive of any notion that the Respondent has the right to act as it has done. Panelists under the UDRP have a wide discretion to admit evidence and to consider submissions made by the parties and in the opinion of this panelist the issue presently under discussion is relevant. In the opinion of this panelist, the issue is not outside the ambit of the UDRP as suggested in Sanofi-aventis v. Rx World, Nils Bor (supra)."

The Complainant finally contends that it is evident that the Respondent does not "make a legitimate noncommercial 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" as stated in § 4 c of the UDRP, but that instead the domain name was registered and is being used in bad faith (Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3)). The Complainant´s trademark Lexapro is registered in the registered country of residence of the Respondent Ukraine. The Complainant claims that because of the distinctive nature and intensive use of the Complainant´s trademark Lexapro, and because of the specific content of the web site, the Respondent had positive knowledge as to the existence of the Complainant's trademark at the time the Respondent registered the domain name.

Furthermore, the Respondent uses the domain name to divert Internet traffic to a site that claims to offer online sale of Complainants product Lexapro without the mandatory prescription. By doing this the Respondent intentionally attempts to attract for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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). Apart from the descriptive prefix '5mg', the Domain Name is identical to Complainant's protected brand name 'LEXAPRO'.

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 Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy). The Domain Name is not being used to host any legitimate site, but merely to promote online sales of Complainant's prescription drug without the necessary prescription.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy). By using the Domain Name, the Respondent intentionally attempted to attract, for commercial gain, Internet users to a sponsored link web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of this web site.

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

The Panel finds that the Domain Name is confusingly similar to Complainant's trademark cited above. The only difference between the Domain Name and this trademark is the descriptive prefix '5mg", which is insignificant to the overall impression.

The Panel finds that Complainant successfully submitted prima facie evidence that Respondent has made no use of, or demonstrable preparations to use, neither of the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. This prima facie evidence was not challenged by Respondent.

In the absence of a Response, the Panel infers that Respondent had Complainant's trademark in mind when registering the Domain Name, which was therefore registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **5MGLEXAPRO.COM**: Transferred

PANELLISTS

Name	**Dr. Thomas Schafft**

DATE OF PANEL DECISION 2012-11-15

Publish the Decision