Decision for dispute CAC-UDRP-100544

Case number	CAC-UDRP-100544
Time of filing	2012-12-02 16:25:54
Domain names	ordergenericlexapro.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	H. Lundbeck A/S

Complainant representative

Organization	Wallberg IP Advice

Respondent

Organization	Domain Name Privacy Protection

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other pending or decided legal proceedings.

IDENTIFICATION OF RIGHTS

Complainant has a registered trademark in the word Lexapro in more than 100 countries around the world, inter alia the following trademark registered in Argentina, the Respondent's country of residence:

Word trademark registered in Argentina, reg. No. 1.909.748, for the term LEXAPRO, registered on January 1, 2003.

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.

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).

For more information, reference is made to the official website www.lundbeck.com.

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 trademark Lexapro® is registered in more than 100 countries around the world.

A. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))

The contested domain name is confusingly similar to the trade mark Lexapro®, in which the complainant holds rights. The domain name incorporates the complainants registered trademark combined with the generic and descriptive terms "order generic" as prefix. The Complainant claims that for the purpose of a UDRP proceeding, when a well-known and invented mark is combined with a common noun or adjective, 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.

B. 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 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.

Also, to the best knowledge of the Complainant, the Respondent has no legitimate interest in the contested domain name. As mentioned it is 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 terms "order" and "generic" indicates that you can order "generic" versions of 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 emphasize that Lexapro® is a controlled substance and, as such, under the laws of all countries may not be sold online without a prescription from an authorized person (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.

See also CAC Case No. 100447 BUYONLINELEXAPRO.NET in which the Panels 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).”

Finally, 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.

C. 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 recorded country of residence of the Respondent.

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.

Further, as mentioned above 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).

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).

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).

PROCEDURAL FACTORS

The registrar, Dattatec.com, has not responded to CAC´s request for verification despite multiple reminders.

Neither the written notice of the Complaint nor the advice of delivery thereof was returned to the CAC by the Respondent. The CAC is therefore unaware if the written notice was received by the Respondent or not. As far as the eMail notice is concerned the CAC received a confirmation that the eMail sent to ordergenereclexapro.com@traxhost.com - specified in the whois-database - was relayed. The eMail sent to postmaster@ordergenereiclexapro.com was returned back undelivered. The CAC did not find any further eMail address on the website published under the disputed domain name.

PRINCIPAL REASONS FOR THE DECISION

The Respondent Domain Name Privacy Protection is obviously not the owner of the domain name as Domain Name Privacy Protection provides a domain name privacy protection service. But when the CAC has complied with paragraph 2(a) of the Rules, proceedings are validly commenced in relation to the domain name, and provided the panel is satisfied that proceedings have been appropriately conducted in accordance with the Policy and Rules, any subsequent finding of the Panel in respect of the domain name is binding upon the domain name registrant (whoever that may be). Further, even if there has been any procedural irregularity in the manner in which these proceedings were commenced, the Panel has the power under paragraph 10 of the Rules to determine that these proceedings can validly continue and proceed to a binding decision notwithstanding that irregularity. So who is the Respondent for the purposes of 3(b)(v) of the Rules? In the Panel's opinion the only answer to this question is that it is prima facie the entity that is recorded in the registrar's register as revealed by a who-is search. In the current case the Panel notes that there is no suggestion that either at the time the Complainant forwarded its Complaint to the CAC or the CAC sent its verification email to the Registrar, Domain Name Privacy Protection was not the entity recorded as the registrant for the domain name in the relevant who-is register. In light of these conclusions, the Panel decides on the merits of the contentions of the Complainant as the Panel is satisfied that all procedural requirements under Policy and Rules were met and there is no other reason why it would be inappropriate to provide a decision as the CAC met all requirements set in force by paragraph 2 and paragraph 4 of the Rules to forward the complaint, including any annexes, electronically to the Respondent. However, CAC should inform ICANN about the breach of the Registrar Accreditation Agreement (RAA) as the registrar did not answer the „Request for Registrar Verification" in order to enable ICANN to take further actions against the registrar to fulfill its obligations in the future.

1.
There can be no question but that the domain name <ordergenericlexapro.com> is confusingly similar to Complainant's <Lexapro> trademark. Respondent's domain name incorporates in its entirety the <Lexapro> trademark despite the addition of other descriptive words (order generic).

2.
The Respondent does not have a legitimate interest in the domain name and used and registered the domain name in bad faith as the Respondent merely sells the trademarked goods of the Complaint and not a drug product that is comparable to Lexapro in dosage form, strength, route of administration, quality and performance characteristics, and intended use. Furthermore the use of the Complainant´s trademark as part of the disputed domain name, combined with the specific content of the web site, indicates that the Respondent knew of the existence of the Complainant's trademark at the time of the registration of the domain name.

3.
The Panel accepts the Complainant's submissions and finds, in the absence of any evidence to the contrary, that the Respondent has to transfer the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ORDERGENERICLEXAPRO.COM**: Transferred

PANELLISTS

Name	**Prof. Dr. Lambert Grosskopf, LL.M.Eur.**

DATE OF PANEL DECISION 2013-01-13

Publish the Decision