Decision for dispute CAC-UDRP-100847

Case number	**CAC-UDRP-100847**
Time of filing	**2014-11-13 11:34:15**
Domain names	**actiqcoupons.com, actiqrebate.com**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**Anesta, LLC**

Complainant representative

Organization	**Matkowsky Law PC**

Respondent

Name	**Rex Bowden**

OTHER LEGAL PROCEEDINGS

The panel is not aware of any proceedings related to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is, inter alia, proprietor of the Community trademark ACTIQ, CTM 000279182, registered on May 18, 1998 in class 5 which is in force.

FACTUAL BACKGROUND

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

The Complainant claims that Anesta LLC (formerly Anesta Corp.) was acquired in October 2000 by Cephalon, Inc. (hereinafter “Cephalon”), an indirect wholly-owned subsidiary of Teva Pharmaceutical Industries Ltd. (hereinafter, collectively, the "Teva Group"), which is a global biopharmaceutical company with a marketed portfolio and pipeline of specialty products dedicated to improving the quality of life of individuals around the world. In the United States where the Respondent operates, Actiq® (fentanyl oral transmucosal lozenge) is indicated for the management of breakthrough pain in cancer patients 16 years of age and older who are already receiving and who are tolerant to around-the-clock opioid therapy for their underlying persistent cancer pain. Because of the risk for misuse, abuse, addiction, and overdose, Actiq® is available in the United States only through a restricted program required by the Food and Drug Administration (FDA), called a Risk Evaluation and Mitigation Strategy (REMS). Actiq® was first approved by the FDA in the United States in 1998. Anesta

and Cephalon share in Teva Group's vision to be the most indispensable medicines company in the world, upholding its obligations to its patients, customers, shareholders and employees.

The Complainant claims its mark is registered covering oral opioid analgesic for treatment of pain caused by cancer, including with the United States Patent and Trademark Office ("USPTO") (U.S. Reg. No. 2,162,569; issued Jun. 2, 1998). This registration is valid and in full force and effect. The registration was applied for, and issued, well prior to December 8, 2010, the earliest date any of the disputed domain names were created.

According to the Complainant the disputed domain names are confusingly similar to the Complainant's mark for the disputed domain names incorporate the Complainant's mark in its entirety while adding nothing distinctive to negate confusing similarly, but only adding generic terms “rebate” or "coupons," respectively, and the gTLD “.com.” If anything, the words 'coupons' and 'rebate' only add to the confusion because visitors are likely to mistakenly believe the disputed domain names belong to, or are authorized by, the Complainant, where the coupons or rebates can be obtained or exchanged.

The Complainant claims that the Respondent does not have any rights or legitimate interests in disputed domain names. The Complainant has not authorised, licensed, or permitted the Respondent to register or use the disputed domain names, or to use its trademark. The Respondent is not known by the disputed domain names, nor has the Respondent acquired any trademark rights with respect to the domain names.

The Respondent uses the <actiqcoupons.com> domain name to confuse uninsured people who are looking to save money on prescription drugs into signing up for Respondent's coupon program by projecting an image that it is the Complainant. The Respondent intends to confuse uninsured people into mistakenly believing that Actiq® trademark-owner is offering the Actiq Discount Card that is already "activated" through the site hosted at <actiqcoupons.com>, and that they can take to their local pharmacy for "big savings." The information regarding Actiq® on the site is not reliable and is being delivered in a manner to confuse users into thinking it's delivered by the Complainant, or with a Complainant's permission or approval. The Complainant contends that the Respondent has a history of trying to monetize the prominence of trademarks of well-known drugs by diverting Internet users looking for official, or at least authorized offers. Although the nature of the use may have changed over the years, this overall practice has not ceased, even after protest on multiple occasions.

Furthermore, the Complainant claims that the Respondent is using the domain names to disrupt Complainant's business by registering its trademark in multiple domains and diverting users looking for reliable patient financial assistance that they may find through the Teva Group at sites such as TevaCares.org and CephalonCares.com. The "activated" ready-to-use so-called Actiq® Discount cards being offered on <ActiqCoupons.com> includes a phone number to call for membership information. The recording directs users to visit one of two other websites for more information regarding their Actiq® Discount Card. Both of the two other websites use generic or descriptive names that lead people to mistakenly believe it relates to their official Actiq® Discount Card that they printed out. One of them is called "YourRxCard.com" and the other is "PatientAssistance.com." Both of these sites are under Respondent's common ownership or control.

The Respondent could have registered <FentanylCoupons.com> or <FentanylRebate.com> to reflect non-affiliation or fair use. The domains are still available as evidenced from the public Whois. Instead, the Respondent deliberately chose to use the Actiq® trademark to capture more traffic from the target audience that would likely go to the site under the mistaken belief it originates with the Complainant, or is under the Complainant's auspices.

The Complainant states that even if the sites were actually offering bona fide Actiq® coupons as a reseller, the Respondent still would have no legitimate interest because he does not accurately disclose his relationship with the trademark owner, which is required under the well known decision in Oki Data Americas, Inc. v. ASD, Inc. WIPO Case No. D2001-0903. There is no information about the Respondent and its relationship with the Complainant, because no such relationship exists. The domain <Actiqcoupons.com> is being used to trade on the goodwill of the trademark and to take advantage of the reputation of the mark by attracting customers to the site hosted on the domain under false pretences that it is either provided by, or has been approved by the Complainant. These features and the absence of any other reasonable attempt to clarify sponsorship on the landing page of the disputed domain strongly implies a deliberate attempt by the Respondent to suggest sponsorship and endorsement by the Complainant. While adding a disclaimer is not a panacea that will always

prevent confusion, the absence of a disclaimer nonetheless militates against a finding of bona fide or nominative fair use.

In order to further exploit the goodwill of the mark, the Respondent serves competitive ads with links to third-party sites on <actiqcoupons.com>. The Complainant is part of the Teva Group, which markets a competitive product to Subpoxone, namely Buprenorphine hydrochloride sublingual tablets. Clearly, there is no legitimate interest in serving competitive ads on domain names confusingly similar to protected trademarks.

The Complainant contends that the <ActiqRebate.com> domain name has been registered and extended by the Respondent since 2010 and is "parked" with GoDaddy with a mail server configured on the domain name. A registrant of a domain name determines by its instructions to the relevant registrar the MX record to be used for any email addresses that include that domain. Given that the Respondent clearly was aware of the trademark significance of the term "Actiq" (evidenced from the content hosted on <ActiqCoupons.com>) when it registered and extended the <actiqrebate.com> domain name, and is using it for a mail server, there is a strong inference that it is being used to send and receive email related to the complainant's discount card programs and information services. The Privacy Policy on PatientAssistance.com states that healthcare information is never persistently stored, and when a user's session is finished, the site will have no record of it. However, a user profile on the site does in fact store a user's medications, and it is saved in a database tied to their name and email address. Especially knowing that the Respondent processes, collects, and stores not only names and email addresses of visitors by diverting traffic from ActiqCoupons.com to affiliate sites YourRxCard.com and PatientAssistance.com, but also stores their sensitive health information such as medications, id., using the disputed domain name <ActiqRebate.com> for a mail server to send and receive mail from Actiq patients or prospective patients who will likely be confused or misled into mistakenly believing the communication from <ActiqRebate.com> originates with, or is endorsed or sponsored by the Complainant is not a bona fide offering of goods or services or a legitimate noncommercial or fair use under the Policy.

Furthermore, even assuming the MX records are not being used even though configured by the Respondent, the use of <ActiqRebate.com> to post a parked page would not of itself confer rights or legitimate interests arising from a "bona fide offering of goods or services" or from "legitimate noncommercial or fair use" of the domain name, especially where resulting in connection to goods or services competitive with those of the rights holder. The Respondent has recently used the disputed domain name to host competitive sponsored listings, including for Prilosec which is an unfair use resulting in misleading diversion.

The Complainant claims that the Respondent has registered and used the disputed domain names for commercial gain to mislead and divert consumers in the promotion of its affiliate programs, and with respect to <actiqcoupons.com>, put the Google AdSense account number into the programming code to host syndicated ads for pay-per-click revenue, including competitive ads, all of which is not in good faith. The domain names were registered in order to prevent the mark owner from using them, and the registrant has engaged in a pattern of such registration. The domain names were registered and are being used primarily to disrupt the business of the Complainant looking for Complainant's information regarding financial assistance programs, and/or to intentionally attempt to attract users for commercial gain by creating a likelihood of confusion as to source or affiliation. The Respondent’s use in bad faith is also characterized by the website’s structure at <actiqcoupons.com>, which delivers inaccurate information.

Finally, according to the Complainant the Respondent has a pattern of cybersquatting on famous pharmaceutical brands, which is also evidence of bad-faith.

The Respondent’s use of the disputed domain names causes harm to the Complainant through leading Internet users to be misled or deceived into thinking that they are arriving at an official web site of the Complainant, or have received or transmitted email an account under Complainant's control. Such registration and use is clearly in bad faith.

The Respondent should have made an effort to make it clear to visitors that it was not affiliated with the Complainant. This intentional attempt to attract, for commercial gain, Internet users to its web site, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's web site is evidence of bad faith under Policy.

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 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 disputed domain names “actiqcoupons.com “ and “actiqrebate.com” are confusingly similar to the Complainant’s “ACTIQ” trademark since the elements “rebate” and “coupons” are not distinctive.

The Complainant contends that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name, and is not commonly known under the disputed domain names.

In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Complainant also proved that the Respondent, inter alia, is using the disputed domain names on websites attracting consumers by mentioning the trademarked goods hosting competitive ads for pay-per click revenue and is therefore intentionally attempting to attract, for commercial gain, Internet users to his websites by creating a likelihood of confusion with Complainant´s trademark.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ACTIQCOUPONS.COM**: Transferred
2. **ACTIQREBATE.COM**: Transferred

PANELLISTS

Name	**Dietrich Beier**

DATE OF PANEL DECISION 2014-12-23

Publish the Decision