Decision for dispute CAC-UDRP-100897

Case number	**CAC-UDRP-100897**
Time of filing	**2014-12-08 12:06:59**
Domain names	**saxendapills.com**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**Novo Nordisk A/S**

Complainant representative

Organization	**Wallberg IP Advice**

Respondent

Name	**zac bassham**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which relate to the disputed domain name SAXENDAPILLS.COM (the 'Domain Name').

IDENTIFICATION OF RIGHTS

Novo Nordisk A/S (the 'Complainant') is the owner of numerous registered trade marks for SAXENDA across a large number of territories worldwide, including the European Union and the United States of America.

FACTUAL BACKGROUND

The Complainant is a global healthcare company with its headquarters in Denmark. The Complainant employs approximately 40,700 employees across 75 countries, and markets its products in more than 180 countries. The Complainant had an annual turnover in 2013 of Euros 11.2 billion.

The Complainant holds around 30 trade mark registrations for the SAXENDA mark including as a European Community Trade Mark and in the United States of America. SAXENDA is planned to be the brand of a product procured by the Complainant which will be for the treatment of obesity.

The Complainant is the owner of the various domain names containing the SAXENDA mark including 'saxenda.com'.

The Domain Name was registered by Zac Bassham (the 'Respondent') on 31 October 2014, and has been used to resolve to an active website through which the Respondent sells third party weight loss products.

PARTIES CONTENTIONS

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COMPLAINANT:

The Complainant asserts that the Domain Name is identical or confusingly similar to its trade mark SAXENDA for the Domain Name incorporates the Complainant's trade mark SAXENDA combined with the generic and descriptive term "pills". This combination constitutes a domain name which is confusingly similar to the Complainant's trade mark SAXENDA.

The Complainant furthermore claims that the Respondent has no rights or legitimate interests in respect of the Domain Name since the Complainant has not licenced, consented or otherwise authorised the Respondent to use its trade mark SAXENDA in a domain name or in any other manner.

According to the Complainant, the Respondent was not using the Domain Name as a trade mark, company name, business or trade name prior to the registration of the Domain Name, nor is the Respondent commonly known in reference to the Domain Name.

The Complainant claims that by deliberately including the Complainant's SAXENDA trade mark in his registration of the Domain Name, the Respondent is intentionally attempting to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's SAXENDA mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

Finally, Complainant asserts that the disputed Domain Name was registered and is being used in bad faith. In this regard, the Respondent had positive knowledge as to the existence of the Complainant's SAXENDA trade mark at the time the Respondent registered the Domain Name. The Complainant submitted evidence that there had been publicity about expected FDA approval of the Complainant's SAXENDA obesity treatment prior to the Respondent's registration of the Domain Name.

The Complainant concludes that the Respondent is using the Domain Name to divert Internet traffic to the Respondent's website selling weight loss products. By doing so, the Respondent intentionally attempts to attract, for commercial gain, Internet users to his 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.

RESPONDENT:

The Respondent submitted a response stating his website is a web-store that sells weight loss products. The Respondent states he is not "squatting" and is using the Domain Name legally.

The Respondent does not wish to sell the Domain Name or relinquish ownership because the Domain Name "appears to have a weight loss drug reference" in its title, and states he does "not have any bad intentions" and is "willing to come to an agreement".

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is confusingly similar to a trade 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.

The Complainant, being represented by Wallberg IP Advice in Denmark, filed its complaint in relation to the Domain Name with the Czech Arbitration Court on 8 December 2014.

The CAC formally commenced proceedings on 9 December 2014 and notified the Respondent accordingly.

The Respondent submitted his Response within the time frame required, following which the Complainant requested a temporary suspension of the proceedings to attempt to reach a settlement. The Czech Arbitration Court suspended the proceedings accordingly under Par. 11(a) of its UDRP Supplemental Rules. However, the Respondent did not reply to the Complainant's approach, and therefore the Czech Arbitration Court was asked by the Complainant to resume proceedings which it did. The Response was accepted by the Czech Arbitration Court on 30 December 2014, and the proceedings continued.

Having received a Statement of Acceptance and Declaration of Impartiality, the Czech Arbitration Court appointed Steve Palmer, of Palmer Biggs Legal - Solicitors, as the Panel in these UDRP proceedings on 12 January 2015.

PRINCIPAL REASONS FOR THE DECISION

IDENTICAL OR CONFUSINGLY SIMILAR - paragraph 4(a)(i) of the Policy

The disputed Domain Name 'saxendapills.com' consists of the Complainant's SAXENDA mark registered in the European Union and the United States of America (the latter being the country of residence for the Respondent), combined with the generic term 'pills' and the '.com' suffix.

The '.com' suffix may be disregarded when it comes to considering whether a domain name is confusingly similar to a trade mark in which the Complainant has rights.

Further, the mere addition of the generic term 'pills' does not serve to distinguish the Domain Name from the Complainant's SAXENDA trade mark, particularly in light of the fact that the Complainant's SAXENDA trade mark registrations cover pharmaceutical preparations in class 5. See Warner Bros. Entertainment Inc.; New Line Productions, Inc. and DC Comics v. Procount Business Services FA 360942 (Nat. Arb. Forum Dec 22, 2004), finding that the addition of generic terms as well as the omission of spaces fails to create a meaningful distinction between the disputed domain name and the mark within it because "such additions do not disguise the fact that the dominant features of the domain names are Complainant’s marks, and each domain name is therefore confusingly similar to the marks pursuant to Policy ¶ 4(a)(i)".

As a result, the Panel concludes that the disputed Domain Name is confusingly similar to a trade mark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS - paragraph 4(a)(ii)of the Policy

The Respondent does not appear to have any trade marks associated with the distinctive SAXENDA mark. There is no evidence that he is commonly known by this mark and he does not have any consent from the Complainant to use this mark.

The Respondent has not provided any evidence to show he has used the disputed Domain Name for any bona fide offering of goods or services of his own. The products which appear on the Respondent's website appear to the panel to compete in some way or another with the Complainant's planned SAXENDA product. This is not therefore a bona fide offering of goods and services under 4(c)(i) of the Policy and it is not a legitimate non-commercial or fair use under 4(c)(iii) of the Policy. See AM Int'l Group Inc. v Benjamin, FA 9442542 (Nat. Arb Forum May 11, 2007) finding that the respondent's use of a confusingly similar domain name to advertise real estate services which competed with the complainant's business did not constitute a bona fide offering of goods and services under paragraph 4(c)(iii) of the Policy.

Accordingly, the Panel finds that the Respondent does not have any rights or legitimate interests in the Domain Name within the meaning of paragraph 4(a)(ii)of the Policy.

REGISTERED AND USED IN BAD FAITH - paragraph 4(a)(iii)of the Policy

Paragraph 4(b) of the Policy sets out non-exclusive criteria which shall be evidence of the registration and use of a domain name in bad faith including circumstances where, by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its web site or location or of a product or service on its web site or location.

The evidence of the Respondent's website shows it is an online store selling third party weight loss products. This is of note bearing in mind the Complainant's planned launch of the SAXENDA product is also in relation to weight loss. The Panel therefore finds that the Respondent has attempted to attract and cause confusion amongst Internet users between the Complainant's distinctive SAXENDA mark, and that the Respondent's sale of third party weight loss products on the website attached to the disputed Domain Name is for commercial gain. See AOL LLC v AIM Profiles, FA 964479 (Nat Arb Forum May 20, 2007) finding registration and use of the disputed domain name in bad faith pursuant to paragraph 4(b)(iv) of the Policy because the Respondent was commercially gaining from the likelihood of confusion between the complainant's mark and the competing instant messaging products and services advertised on the Respondent's website attached to the disputed domain name. Further, see Pfizer Inc. v Suger 02002-0187 (WIPO Apr 24, 2002) finding the link between the complainant's mark and the content advertised on the respondent's website was obvious, and therefore the respondent must have known about the complainant's mark when it registered the disputed Domain Name.

As such the Panel finds that the Complainant has made out its case under paragraph 4(b)(iv) of the Policy, and therefore the Domain Name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SAXENDAPILLS.COM**: Transferred

PANELLISTS

Name	**Steve Palmer**

DATE OF PANEL DECISION 2015-01-21

Publish the Decision