Decision for dispute CAC-UDRP-100857

Case number	CAC-UDRP-100857
Time of filing	2014-11-21 14:17:26
Domain names	ACTIQSIDEEFFECTS.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Anesta, LLC

Complainant representative

Organization	Matkowsky Law PC

Respondent

Organization	Domains By Proxy, LLC

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant, a biopharmaceutical company, is the holder of a “actiq" US Trade Mark (Reg. No. 2,162,569; Application Filing Date: April 29, 1996) and a “ACTIQ” Community Trade Mark (Reg. No. 000279182, Application Filing Date: June 17, 1996), both covering “oral opioid analgesic for treatment of pain caused by cancer” (International Classes: 05, 06, 18, 44, 46, 51, 52).The US and the Community Trade Mark are renewed and in full force and effect.

FACTUAL BACKGROUND

The Complaint against Domains By Proxy, LLC - a privacy/proxy provider - was filed by Anesta, LLC, represented by Matkowsky Law PC, with the Czech Arbitration Court (CAC) on November 13, 2014. On the same day the CAC transmitted by email to GoDaddy.com, LLC a request for registrar verification in connection with the disputed domain name. On November 15, 2014 GoDaddy.com, LLC transmitted by email to the CAC its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. GoDaddy.com, LLC named as registrant Mr. Matthew Bartilson and also pointed out that the disputed domain name expires on December 31, 2014. The CAC sent an email communication to the Complainant on November 24, 2014 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an

amendment to the Complaint. The Complainant filed an amendment to the Complaint on November 27, 2014. Notwithstanding the registrar verification the Amendment Complaint was filed a second time against Domains By Proxy, LLC.

The CAC verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements and formally notified Mr. Matthew Bartilson of the Complaint and the proceedings on November 27, 2014. On December 18, 2014 the CAC informed the Complainant that neither the written notice of the Complaint nor the advice of delivery thereof was returned to the CAC and that the CAC is therefore unaware if the written notice was received by Mr. Matthew Bartilsont or not. As far as the email notice is concerned, the CAC received a confirmation that the emails sent to ACTIQSIDEEFFECTS.COM@domainsbyproxy.com and mbartilson@hotmail.com were relayed and the email notice sent to postmaster@ACTIQSIDEEFFECTS.COM was returned back undelivered as the email address had permanent fatal errors. The CAC also informed the Complainant that Mr. Matthew Bartilson never accessed the online platform.

The Complainant, Anesta LLC (formerly Anesta Corp.), claims it was acquired in October 2000 by Cephalon, Inc. (“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.

The Complainant contends that 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). The Complainant contends that Actiq® was first approved by the FDA in the United States in 1998.

The Complainant claims the disputed domain name is confusingly similar to the Complainant's mark for it incorporates the mark “ACTIQ” in its entirety while adding nothing distinctive to negate confusing similarly, but only adding the generic term “side effects.”

The Complainant states it has not authorized, licensed, or permitted to register or use the disputed domain name, or to use its trademark and that the Respondent, i.e. Domains By Proxy, LLC, is not known by the disputed domain name, nor has the Respondent acquired any trademark rights with respect to the domain name.

According to the Complainant the services offered by the Respondent, i.e. Domains By Proxy, LLC, do not constitute a bona fide offering of services, but rather mislead users into falsely assuming an affiliation with the Complainant in order to drive subscriptions for MedFax Reports.

Moreover, the Complainant claims the site hosted on the domain in dispute is designed to drive traffic and increase sales of MedFax Reports. The MedFax Reports are commercial, as the MedFax advertisement includes a "LIMITED TIME OFFER" to subscribe for a year at the discounted rate of $79.99. The Complainant contends that the Respondent, i.e. Domains By Proxy, LLC not only does nothing affirmative to disclaim a relationship with the trademark owner, but the Respondent has gone out of its way to exacerbate any likelihood of confusion on its homepage, first by masking its identity with proxy services (sic!) in registering the domain name, and then by including a falsified copyright notice legend in the name of "Side Effects of Actiq".

The Complainant contends there is no indication that the Respondent, i.e. Domains By Proxy, LLC, must use the Complainant's registered mark to sell the MedFax.com Reports, and even if it were only an informational site on the side effects of fentanyl, the Respondent, i.e. Domains By Proxy, LLC, did not have to use the trademark of the Complainant in the domain name. This is corroborated by how the Respondent, i.e. Domains By Proxy, LLC, itself chooses to describe the website under the dispute domain name, as revealed in its meta data.

The Complainant contends that the navigation architecture of the site hosted on the disputed domain name is specifically designed to actually drive traffic to MedFax.com without any indicator of third-party sponsorship, let alone an unambiguous

one. In fact, the default landing section of the navigation menu is "SIDE EFFECTS," which advertises "To learn more about Actiq and it's side effects visit MedFax.com." A likelihood of confusion does not require that 100% of the target audience be likely confused. In fact, the test is usually described as being concerned with the "average purchaser." It is enough that visitors to the site who actually make their way through the content on the default landing page built into the site's architecture are expressly being encouraged to leave the site all together and visit MexFax.com without any disclaimer that the site itself is not from the Complainant or under its auspices: "To learn more about Actiq and it's side effects visit MedFax.com." Furthermore, for some users that are familiar with Actiq®, they will go straight to REPORTED PROBLEMS, while still under the false impression that the site is under Complainant's auspices. Such ordinary users, who very well may be sixteen years of age, are being invited to submit sensitive health data, which could likely lead to tarnishing the Complainant or the Teva Group's reputation if such users later learn they were under the mistaken impression that the site was under Complainant's auspices.

The Complainant states that when it comes to users' experiences in relation to the use of fentanyl, particularly adverse events, it is especially important to mitigate against any likelihood of confusion when it comes to submission of sensitive health data. While it is true that by submitting the information, the user is agreeing to publish the story, users may believe that stories would be published stripped of their personal information, or that their story cannot be associated with their IP address or other cookies stored on their computer, when in fact the meta data shows that Google Analytics is being run on the site. There are no terms of service even to explain what laws govern the site, or to whom users are providing possibly sensitive health data over the open Internet. Under such circumstances, it is particularly important to ensure that appropriate measures are taken to ensure that there is not exploited likelihood of confusion to encourage the submission of sensitive health data under the mistaken belief the site is under the Complainant's auspices, when it isn't. The Respondent, i.e. Domains By Proxy, LLC, could have easily achieved the same objective by posting a conspicuous disclaimer of any association on the landing page. Nothing would have stopped the Respondent, i.e. Domains By Proxy, LLC , from using Actiq® on the site in its trademark sense if the information being published were true, but that Respondent did not have to go out of its way to mask their identity with proxy services (sic!) and falsify the copyright notice legend, all while registering and using a string of characters with respect to the subject matter that inherently increases the likelihood of mistake, deception or consumer confusion, especially with respect to a site that encourages submission of sensitive health data.

The Complainant claims that 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 Respondent, i.e. Domains By Proxy, LLC, to suggest sponsorship and endorsement by Complainant.

According to the Complainant the disputed domain name has been registered and is being used in bad faith for the Respondent exacerbated any likelihood of confusion by using a false copyright notice legend, hiding its identity, and not even bothering to post any disclaimer whatsoever, all in order to drive traffic for profit to MedFax.com, without disclosing the nature of its relationship with TruthMD or Truven Health Analytics. There is no reason why the owner of the disputed domain name would have used proxy services and a legal name containing the Complainant's trademark in the copyright notice legend, except if it were trying to increase consumer confusion to drive traffic to MedFax.com.

According to the Complainant the use of the disputed domain name 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. Such registration and use is clearly in bad faith. The Respondent's bad faith is also evidenced by the falsified copyright notice legend. The use of the falsified copyright notice will lead users to believe the web site under the disputed domain name is connected or affiliated with the Complainant.

The Complainant claims that the same facts that support a finding that the Respondent lacks rights in the disputed Domain Name also supports a finding of bad faith registration and use. In addition to boldly admitting its intention for commercial gain on the homepage by encouraging visitors to leave the site and visit MedFax, the owner of the website made no 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 the web site, by creating a likelihood of confusion with the complainant's mark is evidence of bad faith.

The CAC notified the Respondents' default on December 18, 2014 and appointed the Panel to decide on the Complaint.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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NO RIGHTS OR LEGITIMATE INTERESTS

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BAD FAITH

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PROCEDURAL FACTORS

On January 15, 2015, the Panel on its sole discretion decided that the deadline for delivering the decision is to be prolonged by one week due to the illness of the Panellist in accordance with paragraphs 10 (c) and 15 (b) of the Rules.

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 because the CAC send the written notice of the Complaint to Mr. Matthew Bartilson and the email notices to ACTIQSIDEEFFECTS.COM@domainsbyproxy.com, mbartilson@hotmail.com and to postmaster@ACTIQSIDEEFFECTS.COM as the privacy/proxy provider Domains By Proxy, LLC disclosed that Mr. Matthew Bartilson is the true registrant of the disputed domain name.

PRINCIPAL REASONS FOR THE DECISION

An entity and an individual person are identified as owners of the disputed domain name in this procedure. Domains By Proxy, LLC were identified as the owner of the disputed domain name on a "whois" search carried out on behalf of the Complainant prior to filing the Complaint, whilst Mr. Matthew Bartilson is according to the Registrar the true owner of the disputed domain name.

A “whois” search by the Panel shows that Mr. Matthew Bartilson is named as the owner of the disputed domain name. Therefore only Mr. Matthew Bartilson has the standing as a Respondent in the proceedings (§ 3(b)(v) Policy) but even as the Complainant were noticed on November 24, 2014 that Mr. Matthew Bartilson is the true owner of the disputed domain name the Complainant - represented by his lawyer - did not file the Amendment Complaint on November 27, 2014 against Mr. Matthew Bartilson or added Mr. Matthew Bartilson to the Complaint.

In these circumstances the Panel has to dismiss with prejudice the claims against the Respondent as Domains By Proxy, LLC is not the holder of the disputed domain name. It is the principle task of the Complainant to name the Respondent. The Panel is bound to the decision of the Complainant and the Panel is not entitled to reformulate or supplement a Complaint or an Amendment Complaint. Only if a Respondent is named mistakable or misspelled a Panel is authorized to correct an obvious error. In this case, however, the Complaint is filed against a really existing entity under the company name, that there is practically no room for an interpretation and the Panel is obliged to dismiss the Complain especially when the CAC asked the Complainant to amend the Complaint with reference to the registrar verification.

Some panels have taken a different stance and have still decided the cases against a privacy/proxy provider even when the true registrant of the disputed domain name was disclosed (see for example CAC Case No. 100221 - nationalrentelcar.vom; WIPO Case No. D2010-1665 – order-valium.net).But from a procedural point of view, there is no room for such a decision against the privacy/proxy provider when the CAC asked the Complainant to amend the Complaint with reference to the registrar verification and the Complainant files an Amendment Complaint without taking the registrar verification into account.

Other panels have decided the cases also against a privacy/proxy provider but only when the true registrant was named as a second Respondent in the proceedings (see for example XXXX). But in this proceeding the Complainant only named the privacy/proxy provider as Respondent even when the true registrant of the disputed domain name was disclosed.

Only if the privacy/proxy provider does not disclose the true registrant of the disputed domain name or does not disclose complete WHOIS information about the true registrant of the disputed domain name the proceedings can carried out against the privacy/proxy provider (see WIPO Case No. D2009-0028 - alushipcom; WIPO Case No. D2006-0696 - fifththirdreward.com. This also applies when a cat is named as the true registrant of the disputed domain name: NAF Case No. 671304 - mymorganstanleyplatinum.com). In the present case, however, there are no indications that the privacy/proxy provider did not disclose the true registrant of the disputed domain name.

There is another reason why the Panel may not decide against the privacy/proxy provider in the proceeding: the Amendment Complaint and other procedural orders have not been served to the privacy/proxy provider as far as can be seen by the Panel and therefore it would be a violations of the right to be heard to take a decision against the privacy/proxy provider. But as the true registrant of the disputed domain name was disclosed and the CAC invited the Complainant to submit an amendment to the Complaint against the true registrant of the disputed domain name the CAC was not obliged to serve the Amendment Complaint and other procedural orders to the privacy/proxy provider. Instead it was the task of the Complainant to name the true Respondent. But the Complainant represented by a lawyer failed to do so.

Finally there are potential legitimate reasons that a domain name registrant may wish to employ a privacy/proxy provider: 1) ease of account management and re-registration (especially where the registrant has registered a portfolio of domain names), 2) the avoidance of identity theft, and 3) the evasion of spam (see WIPO Case No. D2007-0861 - divex.com). Another benefit may be the ability to maintain the confidentiality of a registration strategy. However, privacy/proxy services may also have unsatisfactory or even illegitimate uses, such as to delay UDRP proceedings (see WIPO Case No. D2006-0523 - rymanauditorium.com) or to facilitate cyberflight (WIPO Case No. D2007-0062 - creditkeeper.com). Obviously the privacy/proxy provider was used in this case not for a legitimate purpose but nonetheless the Complaint was not filed against the true registrant of the disputed domain name that there is no room for a decision against the privacy/proxy provider as the privacy/proxy provider did not use the domain name in a illegitimate way.

The Panel is therefore also prevented from examining the other facts of the case because it is not the purpose of the procedure to bring about decisions on legal issues that do not require examination and discussion in order to do justice to a claim.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **ACTIQSIDEEFFECTS.COM**: Remaining with the Respondent

PANELLISTS

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

DATE OF PANEL DECISION 2015-02-08

Publish the Decision