Decision for dispute CAC-UDRP-100885

Case number	**CAC-UDRP-100885**
Time of filing	**2014-11-20 11:57:14**
Domain names	**saxendadietpills.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 other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

Registered US trade mark no. 4541356 “SAXENDA” (word mark) registered on 3 June 2014.

FACTUAL BACKGROUND

[1]
The Complainant is a global health care company, headquartered in Denmark and the owner of, amongst others, various trade mark registrations for “SAXENDA” in numerous countries. One of those registrations is the registered US trade mark no. 4541356, registered on 3 June 2014. The Complainant intends to use the term “SAXENDA” for medical preparations for the treatment of obesity.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

[3]
The Complainant asserts that the Domain Name is identical or confusingly similar to its registered US trade mark no. 4541356 “SAXENDA”. The Complainant argues that the Domain Name incorporates the Complainant’s registered trade mark combined with the merely generic and descriptive term “diet pills”. The Complainant argues that for the purpose of an UDRP proceeding a distinctive term combined with a common noun or adjective is confusingly similar. Furthermore, the Complainant asserts that the presence of the .com top-level domain were irrelevant when comparing a domain name to a trade mark.

[4]
The Complainant furthermore asserts that the Respondent had no rights or legitimate interest in respect of the Domain Name since the Complainant never licensed, consented or otherwise authorised the Respondent to use the term “Saxenda”. The Complainant also argues that it was not aware of prior use of the term “Saxenda” by the Respondent prior to the priority date of the trade mark in question.

[5]
The Complainant is of the opinion that the Respondent intentionally attempted to attract internet users to the Respondent’s website for commercial gain by creating a likelihood of confusion with the Complaint’s mark as to the source, sponsorship, affiliation or endorsement of the Respondent’s website.

[6]
Finally, Complainant asserts that the Respondent had no right or legitimate interest in Domain Name and that the Domain Name was registered and is being used in bad faith. The Complainant relies on a press release dated 11 September 2014, which it issued and in which it is announced that the United States Federal Food and Drug Administration supported the approval of the Saxenda product for the treatment of obesity. The Complainant assumes that the Respondent had positive knowledge of this press release when he registered the Domain Name. The Complainant further points out that the Saxenda drug, once having received marketing authorization, will not be administered as a pill but by injection, a fact which is not mentioned in the press release of 11 September 2014 and that the fact that the Respondent combines the Complainant’s “Saxenda” mark with the term “diet pills” shows the Respondent’s bad faith. The Complainant furthermore sees the fact that the Respondent attempts to attract commercial gain from the content offered under the Domain as an indication of lack of legitimate interest as well as of bad faith. As ANNEX 4 to its Complaint the Complainant submits two screenshots of the website available under the Domain Name. On the first screenshot a sidebar is visible with the inscription “Diabetes? Visit our store”. The second screenshot is of the third level domain buy.saxendadietpills.com, showing the headline “You can Lose Weight Naturally with our Herbal Weight Loss Pills”.

RESPONDENT:

[7]
In his Response the Respondent contended that the Domain Name were used for a web blog about weight loss and obesity. No harm or malice were intended towards the Complainant. The Respondent furthermore argues that he uses the Domain Name as a generic term and had no intention of misusing it in any way.

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

[8]
In order to succeed in its claim, the Complainant must demonstrate that all of the elements enumerated in paragraph 4 (a) UDRP have been satisfied, i.e. that (i) the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; (ii) the Respondent has no rights or legitimate interests with respect to the domain; and (iii) the Domain Name has been registered and being used in bad faith.

[9]
The Complainant has provided sufficient evidence that it is the owner of the U.S. trade mark registration no. 4541356 “SAXENDA”. This trade mark is confusingly similar to the domain as required by paragraph 4 (a)(e) UDRP.

[10]
In the view of the Panel it is the uncontested position under the UDRP that a top-level domain, such as “.com” in the present case, has to be excluded while comparing the trademark with the domain name (cf. eg. CAC UDRP cases nos. 100004 - novotelvietnam.com; 100084 - paiement-cic.com; 100074 - michelintires.info; 100093 - asiaairfrance.com; 100259 - ECCOSHOESSHOP.COM and WIPO cases nos. D2000-1532 - brucespringsteen.com; D2002-0234 - herballife.net and DCC2003-0001 - officemax.cc).

[11]
The second-level domain of the Domain Name is confusingly similar to the trade mark in question since it incorporates the trademark completely and identically and only combines a purely descriptive term (“diet pills”) with the Complainant’s mark consisting of a term that seems to have no meaning and must therefore be considered fanciful.

[12]
In the view of the Panel the Respondent does not have rights or legitimate interest in respect of the Domain Name according to paragraph 4 (a) (ii) UDRP. Although the onus of proof for this second requirement under the UDRP rests with the Complainant, the Panel follows the view that it is impossible for a complainant to prove a “negative fact”, which would require information that is primarily within the knowledge of the Respondent. Therefore, a complainant is required to make out a prima-facie case that the Respondent lacks rights or legitimate interests and the onus of proof then shifts to the Respondent to rebuke the Complainant’s prima-facie case (cf. e.g. CAC UDRP cases Nos. 100053 – enterprisecarrentalonline.info; 100084 – paiement-cic.com; 100092 – lerosmarina.com; 100099 – sublimedirections.com; 100093 - asiaairfrance.com; 100259 – ECCOSHOESSHOP.COM and WIPO cases Nos. D2003-0455 – croatiaairlines.com; D2004-0110 – belupo.com).

In his Response the Respondent does not rely on a right to the term “SAXENDA”. As far as the Respondent argues that the Domain Name were a generic term this only applies to the part “diet pills” but not to “Saxenda”. The Respondent further states that Domain Name were used for a web blog about weight loss and obesity. If the Respondent by this statement tried to make a free speech argument, he cannot succeed. It seems the uncontested opinion amongst UDRP panels, which this Panel shares, that the legitimate interest based on free speech would require a non-commercial use of the domain name in question. Here, however, the Complainant was able to demonstrate that the Domain Name is used for the purpose of commercial gains by offering diet products for sale. Therefore, the Panel is of the opinion that the Complainant made a prima-facie case which has not been rebuked by the Respondent’s Response.

[13]

The Panel is of the opinion that the Respondent uses the Domain Name in bad faith by using the Complainant's trade mark to attract buyers for weight loss products which are not the Complainant's. The Panel is – in the absence of other explanations given by the Respondent in his Response – of the opinion that the Respondent also registered the Domain Name with the intention to use it for weight loss products and thereby to ride on the coattails of the Complainant's mark. Since the term "Saxenda" is not a generic term and has no specific meaning in the context of weight loss products, it is implausible that the registration of the Domain Name was guided by any other intention but taking advantage of the previous publicity the Complainant created for its own weight loss product.

[14]
Since all three requirements under Paragraph 4(a) UDRP have been proven by the Complaint to the satisfaction of the Panel, the Complainant is entitled to a transfer of the Domain Name as requested in the Complaint.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SAXENDADIETPILLS.COM**: Transferred

PANELLISTS

Name	**Dr. Uli Foerstl, LL.M.**

DATE OF PANEL DECISION 2015-01-26

Publish the Decision