Decision for dispute CAC-UDRP-100927

Case number	CAC-UDRP-100927
Time of filing	2015-07-17 09:28:30
Domain names	buyproairhfa.com, buy-proair.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	TEVA RESPIRATORY, LLC

Complainant representative

Organization	Matkowsky Law PC

Respondent

Organization	Privacy Hero Inc

OTHER LEGAL PROCEEDINGS

No other proceedings have been notified to the Panel nor is the Panel aware of such proceedings.

IDENTIFICATION OF RIGHTS

"Proair" is a registered U.S. trade mark (Reg. No.3,166,297). It was filed on 17 December 2004 and registered on 31 October 2006 in, amongst others, class 5 which covers pharmaceuticals.

Complainant is the registered owner of the trademark.

FACTUAL BACKGROUND

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

1. The Complainant is the U.S.-based respiratory division of Teva Pharmaceutical Industries Ltd., a global pharmaceutical company. Complainant's ProAir® HFA Inhalation Aerosol is indicated in patients 4 years of age and older for the treatment or prevention of bronchospasm. ProAir® HFA Inhalation Aerosol is the most successful quick-relief inhaler in the USA based on the number of prescriptions. The Complainant is the registrant of the domain names "proair.com" and "myproair.com"

2. The disputed domain names "buyproairhfa.com" and "buy-proair.com" were both registered on 29 December 2010. Respondent 1 (Privacy Hero Inc, Barbados) is a Privacy/Proxy Provider who acts as the Registrar's privacy service and

appears as the registered name holder on both domains according to the Whois database. Respondent 2 (IT Company, Canada) has been revealed by the Registrar to be the actual registrant of the disputed domain names according to their records. Hence, Respondent 1 serves as a registered name holder commissioned by Respondent 2. The latter is not an authorized vendor, supplier, or agent. The disputed domain names link on www.canadianpharmacymeds.com, an Internet drug outlet. The website provides branded and generic medications, not only but also Complainant's ProAir® HFA Inhalation Aerosol. The domain names direct users to landing pages specifically promoting generic alternatives to the Complainant's product.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Names are 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 2 to have no rights or legitimate interests in respect of the Domain Names (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 by Respondent 2, however not by Respondent 1 (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

I. As Respondents have not filed any material response, the Panel is free to accept all facts presented by Complainant as undisputed, insofar as such facts are not obviously wrong.

II.
Firstly, it has to be decided, who - according to the intention of the Complainant - is the Respondent in these proceedings.

Complainant addressed the Complaint against 2 Respondents. Respondent 1 appeared as domain name holder in the who is-database for both domain names in dispute, however, Respondent 2 was identified as the real domain name holder by the Registrar, according to which the Respondent 1 is the privacy service of the Registrar. Obviously, Respondent 1 offers to be registered as holder of domain names on behalf of third parties in order to keep the real domain name holders, secretly, upon the latter's request. Upon being informed on the real domain name holder, Complainant did not withdraw any Respondent from its Complaint. Thus, the Panel decides that the Complaint is aimed at both Respondent 1 and 2 upon Complainant's request.

III. 1.
The disputed domain names are confusingly similar to the Complainant's trademark within the meaning of paragraph 4(a)(i) of the Policy. They incorporate the Complainant's registered trademark in its entirety. Neither the use of purely descriptive wording, such as "buy", nor a hyphen or a gTLD extension itself, is of significance in assessing and assuming confusing similarity. "hfa" is part of the name of Complainant's product "ProAir HFA Inhalation Aerosol" and even intensifies the impression that the domain name is related to Complainant.

III. 2.

Furthermore, the Respondents have no rights or legitimate interests in respect of the domain names (within the meaning of paragraph 4(a)(ii) of the Policy). There is a general principle in international trademark law, which is called exhaustion. The justified selling of goods which originate from the manufacturer may entitle the seller to use a trade mark associated with the goods in connection with their sale. However, this does not give such sellers the right to register and use the trade mark as a domain name without consent of the trade mark owner. This principle applies especially to or in connection with a website that is offering competitive products, because this takes unfair advantage of the trade mark (see: WIPO Case No. D2005-1203; WIPO Case No. D2002-2090). Additionally, in this case it is not clear if the seller and the domain name holder are identical, so the legitimate interest of the selling of goods may not even apply to the Respondents.

III. 3. a)
With regards to Respondent 1, the Complainant has not provided substantial evidence to indicate that the registration has been effected in bad faith. The Respondent 1 is a privacy service that has acted on behalf of Respondent 2. Thus, this does not indicate that the Respondent 1 acted in bad faith when registering the disputed domain names. There is no proof that Respondent 1 did know about the intentions of Respondent 2 at the time of the registration of the disputed domain names. Further, there are no indications known to the Panel that Respondent 1 acted collusively with Respondent 2 in this respect. Thus, the Complaint is rejected with respect to Respondent 1.

III. 3. b)
However, the disputed domain names have been registered and are being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy by Respondent 2. Since the disputed domain names link to a website promoting generic alternatives to the Complainant’s product, it is evident that Respondent 2 knew Complainant’s trademark when registering the domain names. The fact that Respondent 2 commissioned a privacy service to formally appear on the who is-database as formal registrant of the disputed domain names may not shield him from any responsibility. When ordering the described privacy service resulting in the registration of the disputed domain names Respondent 2 was well aware of the Complainant’s trade mark and thus acted in bad faith with regards to the registration. Furthermore, this Panel finds to be present the circumstances mentioned in paragraph 4(b)(iv) of the Policy: by using the domain name Respondent 2 has intentionally attempted to attract, for commercial gain, internet users to its website, by creating a likelihood of confusion with the complainant's sponsorship, affiliation, and endorsement of the website.

Thus, the domain names are to be transferred to the Complainant because the Complaint is accepted with respect to Respondent 2, who is the real domain name holder.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BUYPROAIRHFA.COM**: Transferred
2. **BUY-PROAIR.COM**: Transferred

PANELLISTS

Name	**Dominik Eickemeier**

DATE OF PANEL DECISION 2015-09-07

Publish the Decision