Decision for dispute CAC-UDRP-101967

Case number	CAC-UDRP-101967
Time of filing	2018-04-18 13:40:00
Domain names	mirapex.xyz

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	BOEHRINGER Ingelheim Pharma GmbH & Co. KG

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	Pelres Investments Ltd.

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the Disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of numerous registrations for the trademark 'MIRAPEX', including the EU trademark No 003364585, registered on January 25, 2006, for goods and services in class 5.

The Disputed domain name was registered by the Respondent on March 29, 2018.

FACTUAL BACKGROUND

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

The Complainant states that it is a member of a German pharmaceutical group of companies. This group was founded by Albert Boehringer in Ingelheim am Rhein in 1885. The Complainant explains that today the group has become a global pharmaceutical enterprise with about 140 affiliated companies and approximately 46,000 employees.

The Complainant submits that MIRAPEX (pramipexole dihydrochloride) tablets are a prescription medicine that is used to treat the signs and symptoms of Parkinson’s disease.

The Complainant adds that this medicine has been a trusted treatment for Parkinson's disease for over 12 years and that in clinical studies MIRAPEX was shown to significantly improve patients' motor scores and their ability to perform activities of daily living.

The Complainant underlines that it is the owner of a portfolio of trademarks including the word MIRAPEX registered in several countries and that it is also the owner of the domain name <mirapex.com> registered on February 27, 1998.

The Complainant observes that the Disputed domain name was registered by the Respondent on March 29, 2018.

The Complainant submits that the Disputed domain name has been used to redirect users to a website that offers various pharmaceutical products for sale, including the Complainant's products and the Complainant's competitors products.

The Complainant argues that the Disputed domain name <mirapex.xyz> is identical to its trademarks MIRAPEX and domain names associated. The Complainant observes that the Disputed domain name includes in its entirety the above-mentioned trademark without any addition of letter or word.

The Complainant contends that the addition of the top-level domain ".xyz" does not change the overall impression of the designation as being connected to Complainant's trademark and that it does not prevent the likelihood of confusion between the Disputed domain name and the Complainant's trademarks and domain names associated.

The Complainant points out that it is well established that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests and that once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. The Complainant adds that if the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP.

The Complainant argues that the Respondent is not known as the disputed domain name and has not acquired trademarks mark rights on this term.

The Complainant contends that the Respondent is not affiliated with the Complainant nor authorized by the Complainant in any way to use the trademark MIRAPEX in a domain name or on a website.

The Complainant declares that it does not carry out any activity for, nor has any business with the Respondent.

The Complainant asserts that the Disputed domain name points to another website known as "Pharmacy XL", directly on a page related to the Complainant's trademark MIRAPEX and its product.

The Complainant submits that the Respondent's website displays the Complainant's trademarks and its products for sale and also displays products from competitors of the Complainant. The Complainant argues that this fact demonstrates a lack of legitimate interests in respect of the disputed domain name.

The Complainant argues that the Respondent has registered the Disputed domain name with knowledge of the Complainant and of its trademark MIRAPEX.

The Complainant considers that the Respondent's offer of pharmaceutical drugs also from the Complainant's competitors shows bad faith.

The Complainant contends that the Respondent must have been aware of the Complainant's MIRAPEX trademark at the time the Respondent registered the Disputed domain name, because the latter resolves to a website that makes direct reference to the MIRAPEX products and the Complainant.

The Complainant points out that the Respondent is in the business of the sale of pharmaceutical products, and for this reason was aware of the Complainant's trademarks at the time of registration of the Disputed domain name, and deliberately

sought to use their goodwill to attract Internet users seeking the Complainant's product.

The Complainant argues that the Respondent has registered and used the Disputed domain name with the aim of deceiving Internet users seeking the Complainant's product, so as to generate revenue from selling unrelated or competing pharmaceutical products.

The Complainant considers that the fact that the Respondent has registered and used the Disputed domain name intentionally to attract visitors for commercial gain by confusion with the Complainant's trademarks constitutes bad faith within the meaning of the Policy.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Disputed 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 Disputed 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 Disputed 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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the Disputed domain name, the Complainant has to demonstrate that:

(i) The Disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed domain name; and

(iii) The Disputed domain name has been registered and is being used in bad faith.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the Disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark or service mark.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the Disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "MIRAPEX", identified in section "Identification of rights" above.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the Disputed domain name itself to the Complainant's trademark.

The Disputed domain name differs from the Complainant's trademark only by the addition of the top-level domain ".xyz".

It is well established that merely adding a top-level domain to a trademark is not sufficient to distinguish a domain name from a trademark. See, for example, CAC Case No. 100831.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the Disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the Disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [Disputed] domain name or a name corresponding to the [Disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [Disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [the Respondent] [is] making a legitimate noncommercial or fair use of the [Disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the Disputed domain name.

The Respondent has no connection or relationship with the Complainant.

The Complainant has not authorized the Respondent to use the Complainant's trademark.

The Respondent does not appear to be commonly known by the name "MIRAPEX" or by a similar name.

The Respondent does not appear to make any legitimate noncommercial or fair use of the Disputed domain name, nor any use in connection with a bona fide offering of goods or services.

Indeed, the Respondent is using the Disputed domain name for a website where pharmaceutical products are sold, including products from competitors.

In fact, the Respondent is using the Disputed domain name to attract Internet users to its website, where the Respondent is selling the same kind of products offered for sale by the Complainant.

Taking into account the fact that the Respondent has no connection or relationship with the Complainant, and that the Complainant has not authorized the Respondent to register the Disputed domain name or to use the Complainant's trademark, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the Disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the Disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [Disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [Disputed] domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [Disputed] domain name; or

(ii) [the Respondent] [has] registered the [Disputed] domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent] [has] engaged in a pattern of such conduct; or

(iii) [the Respondent] [has] registered the [Disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [Disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] 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 [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the Disputed domain name was registered in bad faith and that it has been used in bad faith.

In particular, the Panel accepts the Complainant's unchallenged assertions that the Respondent is using the Disputed domain name with the aim of intentionally attracting, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website.

Indeed, it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark "MIRAPEX" when registering the Disputed domain name.

The Panel observes that the Complainant's trademark long predates the registration of the Disputed domain names, and is highly distinctive and well known.

Furthermore, the Panel points out that it is well established that the registration of a well-known trademark of which the Respondent must reasonably have been aware constitutes bad faith (see, for example, WIPO Case No. D2008-0287).

Moreover, other panels have considered that the registration and use of a domain name intentionally to misdirect and divert customers looking for information about the Complainant and its product to a commercial website that profits from an online pharmacy that offers third-party products, including products that compete with the Complainant's product are evidence of registration and use in bad faith (see, for example, WIPO Case No. D2013-1771).

Accordingly, the Panel finds that the Disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MIRAPEX.XYZ**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2018-06-08

Publish the Decision