Decision for dispute CAC-UDRP-103141

Case number	CAC-UDRP-103141
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Domain names	mirapex.sucks

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Boehringer Ingelheim Pharma GmbH & Co. KG

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	Honey Salt Ltd.

Respondent representative

Organization	ESQwire.com, P.C.

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of the EU word trademark “MIRAPEX”, with No. 003364585, filed 23 September 2003, issued 25 January 2006, in Class 5, covering “Medicines for the treatment of central nervous system disorders, other than for use by dentists or dental surgeons”. This trademark is hereafter referred to as the "MIRAPEX trademark".

The Complainant is also the owner of the domain name <mirapex.com> which was first registered on 27 February 1998.

FACTUAL BACKGROUND

The Complainant is the owner of the MIRAPEX trademark. The disputed domain name <mirapex.sucks> was registered on 17 June 2020. The Complainant's MIRAPEX trademark registration predates the registration of the disputed domain name.

The disputed domain name consists of the term "MIRAPEX" and the gTLD ".sucks".

The Complainant claims to be a global pharmaceutical company that was founded in 1885 in Germany. The Complainant claims to have about 140 affiliated companies and around 50.000 employees world-wide. The Complainant asserts that its net sales amounted to EUR 18.997 million in 2019 (worldwide and at group level). The Complainant claims that it manufactures and sells, inter alia, pramipexole dihydrochloride tablets under the MIRAPEX trademark. This is a prescription medicine to treat Parkinson's disease.

The Respondent claims to have been formed on or around February 12, 2020 to register and hold domain names for the benefit of the organisation Everything.sucks Inc. (hereafter "Everything.sucks"). The Respondent argues that Everything.sucks is a non-profit organisation and communications forum for social activism. Everything.sucks created a platform on which users may create commentary pages and leave feedback related to causes, individuals, products and companies on a "Wiki" styled directory.

According to the Respondent, when a commentary and feedback page is created by a user at Everything.sucks, Everything.sucks may register the corresponding .sucks domain name to bring attention to the "Wiki Page" created by the user. The Respondent claims to have thousands of domain names under management with each domain name being used to direct users to a commentary and feedback page that references a particular cause, individual, brand, company or product.

The Respondent claims that it registered the disputed domain name and redirected it to the corresponding Everything.Sucks Wiki page for the "Mirapex" medicine. According to the Respondent, the disputed domain name follows the same convention as the Respondent's other domain names, i.e. a trademark coupled with a descriptive TLD (.sucks). The Respondent submitted that its goal is to develop its domain names (including the disputed domain name) to support the websites located at its platform and to resell them to parties that may wish to use these domain names (including the disputed domain name) for expanded or enhanced commentary or feedback purposes on their own site.

The Respondent claims that it registered the disputed domain name for a fair use purpose, i.e. to promote free speech, commentary and feedback referencing Mirapex medicines, and not to confuse consumers, compete with the trademark holder or sell competing products.

The disputed domain name resolves to an active website. On this website, a banner is posted with the message: "domains for sale. Is www.mirapex.sucks available? Click here to check". The disputed domain name is offered for sale via Sedo (through www.sedo.com) for the price of 199 USD. The website available via the disputed domain name contains general information on the Mirapex medicine (including its purposes and active elements), plus some side effects which are claimed to be common, some unsupported general assertions and a couple of reviews, listings (e.g. social media listing) and external links (e.g. to news sites).

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

I. The disputed domain name is identical to the Complainant's registered MIRAPEX trademark.

According to the Complainant, the disputed domain name reproduces the Complainant's MIRAPEX trademark in its entirety, only adding the gTLD ".sucks". The generic top level suffix does not add distinctiveness to the disputed domain name and may be disregarded when considering whether the disputed domain name is identical or confusingly similar to the trademark in which a complainant has rights.

II. The Respondent does not have any rights or legitimate interest in the disputed domain name.

According to the Complainant, the disputed domain name is used to divert consumers and tarnish the Complainant's trademark.

The Complainant asserts that the Respondent is not identified in the WHOIS information as the disputed domain name and has not acquired trademarks rights on the term MIRAPEX.

The Complainant further contends that the Respondent is not affiliated with the Complainant nor authorised by him to use the trademark MIRAPEX trademark in a domain name or on a website. The Complainant claims that it does not carry out any activity for the Respondent and has no business with the Respondent.

According to the Complainant, the disputed domain name resolves to a website displaying information regarding the Complainant, several links loosely related to the Complainant's products, and the message "domains for sale".

The Complainant further points out that the disputed domain name is offered for sale on Sedo for 199 USD. According to the Complainant, this general offer to sell the disputed domain name evidences the Respondent's lack of rights or legitimate interests.

Finally, the Complainant claims that the disputed domain name is used to criticise numerous other companies, not only the Complainant, and that the Respondent registered the corresponding other domain names, which are also offered for sale.

III. The disputed domain name has been registered and is being used in bad faith.

The Complainant claims that the Respondent had prior knowledge of the potential rights of the Complainant. The Complainant further argues that the disputed domain name is held for the purpose of selling it.

The Complainant contends that the disputed domain name is identical to its MIRAPEX trademark and associated domain name(s). The MIRAPEX trademark is registered in the TMCH (Trademark Clearing House).

The Complainant further contends that the Respondent must have been aware of the Complainant's MIRAPEX trademark at the time of its registration, since the disputed domain name resolves to a website that refers directly to the Complainant's MIRAPEX products and to the Complainant itself. Given the content of the website available via the disputed domain name, the Respondent must have registered the disputed domain name in knowledge of the Complainant and its trademarks.

The Complainant reiterates that the disputed domain name is offered for sale on Sedo for 199 USD and that the website available via the disputed domain name publishes a message "domains for sale".

The Complainant also reiterates that the disputed domain name is used to criticise numerous other companies, and that the Respondent registered the corresponding domain names which are also offered for sale.

The Complainant concludes that the Respondent has registered the disputed domain name only to capitalise on, or otherwise take advantage of, the Complainant's trademark rights, which evinces bad faith registration and use.

RESPONDENT:

I. The disputed domain name is not identical or confusingly similar to the Complainant's registered MIRAPEX trademark.

According to the Respondent, its use of the disputed domain name is a recognised form of "fair use". The Respondent claims that it is not a so called "cybersquatter".

II. The Respondent has rights or legitimate interest in the disputed domain name.

1. The Respondent asserts that it uses the disputed domain name for legitimate purposes of criticism and free speech.

The Respondent claims that it has registered and is using the disputed domain name in connection with a commentary and criticism website involving the Complainant's Mirapex product. This wiki style criticism and feedback page is one of many pages that can be found at Everything.Sucks (a portal to critique hundreds of companies, people and products of all types). According to the Respondent, the Complainant's product is one of many that are reviewed and critiqued at Everything.Sucks. The website linked to the disputed domain name contains user generated comments and commentary about the referenced brand or product.

The Respondent claims that visitors are not confused or mislead since the pejorative gTLD ".sucks" clearly indicates that the domain name is connected to criticism and feedback. By using the ".sucks" gTLD, it is clear to visitors that the disputed domain name and the website itself are not affiliated with the Complainant. Also, from the content of the website associated with the disputed domain name, it is clear that the Respondent does not purport to be associated with the Complainant.

The Respondent claims that its registration and use of the disputed domain name falls within Section 4(c)(iii) of the Policy since the Respondent is making a legitimate non-commercial 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.

The Respondent claims that its fair use is protected by the right to freedom of expression or freedom of speech (as protected by many national laws and international conventions such as article 10 of the European Convention on Human Rights and the 1st Amendment of the Constitution of the United States).

The Respondent points out that the website available via the disputed domain name does not generate revenue at the Complainant's expense, does not deceive visitors into believing that there is an association with the trademark owner, and does not exceed the Respondent's rights of free expression or free speech. According to the Respondent, the website associated with the disputed domain name evidences that the disputed domain name is used for the purpose of genuine criticism and commentary, in a non-misleading and fair manner.

2. The Respondent asserts that the (offering for) sale of the disputed domain name without targeting the trademark holder is a legitimate interest

The Respondent admits that it is in the business of registering and using ".sucks" domain names, consistent with the purpose of such domain names (i.e., to be used in connection with criticism and feedback websites). The Respondent admits that the webpage associated with the disputed domain name shows a general notice that the disputed domain name is available for purchase. However, The Respondent asserts that it is not improper to offer the disputed domain name for sale.

III. The disputed domain name has not been registered and is not being used in bad faith.

The Respondent argues that the Complainant failed to provide sufficient evidence that the Respondent targeted the Complainant's MIRAPEX trademark or intended to sell the disputed domain name to the Complainant or intended to mislead visitors. The Respondent claims that it registered the disputed domain name because it incorporates a trademark and the pejorative ".sucks" gTLD with the purpose to support a valid criticism and commentary website. According to the Respondent, it is clearly communicated to visitors of the website that the website contains comments and feedback concerning the referenced product.

The Respondent claims that it is not a "cybersquatter". According to the Respondent, the fact that the disputed domain name is listed for sale is not evidence of bad faith. Where a respondent has a legitimate interest in the domain name, a general offer for sale is not evidence of bad faith. The Respondent points out that it is permissible to sell descriptive domain

names. The combination of a trademark and the ".sucks" gTLD creates a highly descriptive impression and conveys a message to a user that the website associated with the domain has a descriptive (and legitimate) purpose, i.e. to provide negative comment and feedback.

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 not shown that the Respondent has 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 not shown that the disputed domain name has been registered or 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

A. Identical or confusingly similar

The Panel notes that the disputed domain name consists of the term "MIRAPEX" and the generic ".sucks" Top-Level Domain (gTLD). As referred to above, the Complainant has shown that it is the owner of the registered word trademark "MIRAPEX" in the EU for medicines treating central nervous system disorders. The disputed domain name thus incorporates the Complainant's registered MIRAPEX trademark and the gTLD ".sucks".

The Panel notes that previous panels have accepted that the incorporation of a trademark in its entirety into a domain name is sufficient to establish that the disputed domain name is identical or confusingly similar to a registered trademark. See Hürriyet Gazetecilik ve Matbaacılık Anonim Şirketi v. Moniker Privacy Services / Kemal Demircioglu, D2010-1941 (WIPO 28 January 2011) ("a domain name that reproduces the trademark in its entirety is confusingly similar to the mark" when the disputed domain names <hürriyet.com>, <hürriyetemlak.com>, and <hürriyetoto.com> fully incorporated the complainant's HURRIYET mark); See also Bayerische Motoren Werke AG, Sauber Motorsport AG v. Petaluma Auto Works, D2005-0941 (WIPO 20 October 2005) ("It has been stated in several decisions by prior UDRP administrative panels that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is identical or confusingly similar to a registered trademark" when the <bmwsauberf1.com> domain name fully incorporated complainant's BMW and SAUBER marks).

There are some panels that have considered the position to be somewhat more nuanced and that this may not be so in all cases, but it has been recognised that in most cases where a domain name incorporates the entirety of a trademark, the domain name will for the purposes of the Policy be confusingly similar to the mark (see for example, the detailed discussion of this topic in Research in Motion Limited v. One Star Global LLC WIPO Case No. D2009-0227).
Given this, the Panel finds in the case at hand that the disputed domain name incorporates the entirety of the Complainant's MIRAPEX trademark and the ".sucks" gTLD does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy. Therefore, the Panel concludes that the disputed domain name is confusingly similar to the registered MIRAPEX trademark of the Complainant.

B. Rights or legitimate interests

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous panels have found that the complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, the complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then has to weigh all the evidence, with the burden of proof always remaining on the complainant.

The Panel finds that the Complainant has not made a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name, especially in light of the ".sucks" gTLD and the criticism-nature of such gTLDs.

The Complainant made a general argumentation that (1) the disputed domain name is used to divert consumers and tarnish the Complainant's trademark; (2) the Respondent is not identified in the WHOIS information as the disputed domain name and has no trademark rights on the term MIRAPEX; (3) there is no affiliation or authorisation to use the Complainant's MIRAPEX trademark; (4) the website available via the disputed domain name displays information about the Complainant, links to its products and the message "domains for sale"; (5) the domain name is effectively offered for sale for 199 USD; (6) the domain name is used to criticise other companies as well; and (7) the Respondent also registered other domain names which are also for sale.

The Complainant made no reference whatsoever to the specific nature of ".sucks" domain names. The Panel accepts that purposes or intentions of criticism are typical to such ".sucks" domain names.

The Complainant did not sufficiently explain, let alone substantiate, why the Complainant believes that the Respondent tries to divert consumers or tarnish the Complainant's trademark. The Complainant did not explain why the Respondent's registration and use of the disputed domain name results in diversion of consumers and trademark tarnish (especially in light of the ".sucks" extension). It is true that the Respondent has no trademark rights to the term MIRAPEX and is not identified in the WHOIS information as the disputed domain name, but the Complainant failed to explain why this would be relevant in light of the specific circumstances of the case (especially, in light of the ".sucks" extension). The same is true for the Complainant's argument that the Respondent is not affiliated with the Complainant and has no authorisation to use its trademark. The Panel would need more factual elements and more detailed argumentation why this is relevant in light of the circumstances of the case (especially, in light of the ".sucks" extension). Furthermore, the Complainant argues that the website linked to the disputed domain name displays information about the Complainant and its MIRAPEX medicines, but failed to explain (let alone substantiate) why this should be regarded as a lack of rights or legitimate interests in the disputed domain name (which seems to have a criticism purpose). Also, the Panel finds that the offering for sale of a domain name is not by itself a proof of lack of rights or legitimate interests. Finally, the Complainant claims that "the disputed domain name is used to criticize numerous companies, not only the Complainant, and the Respondent registered the corresponding domain names, which are also for sale". The Panel did not see evidence that the disputed domain name is used to criticise other companies and does not agree that such would by itself indicate a lack of rights or legitimate interests. Also, the Panel would need more evidence and more detailed argumentation why the Respondent's purported registration of other domain names would indicate a lack of rights or legitimate interests in the disputed domain name.

The Respondent made a case that he uses or intends to use the disputed domain name for the purposes of legitimate criticism and free expression with regard to the Complainant's MIRAPEX medicines. The Respondent's argumentation and evidence do not seem devoid of credibility.

Given the nature of the ".sucks" domain name gTLD, and given the evidence (or lack of evidence) submitted by the parties, the Panel finds that the Complainant did not prove that the Respondent lacks rights or legitimate interests in the disputed domain name. In particular, the Panel would have expected the Complainant to target its arguments and evidence to the specific criticism-nature of ".sucks" domain names (which the Complainant failed to do).

The Panel considered the Respondent’s admission that it intends to sell the disputed domain name. In other words, criticism and free speech do not seem to be the sole purposes for the registration and use of the disputed domain name. However, since the Complainant failed to explain and substantiate why the sale of the disputed domain name should be considered as the predominant purpose of the Respondent, the Respondent’s admission did not alter the Panel’s conclusion on the second prong of Paragraph 4(a) of the Policy.

In sum, the burden of proof under Paragraph 4(a)(ii) of the Policy lies ultimately and predominantly with the Complainant and the Panel believes that the Complainant did not meet this burden. The Panel emphasises that it is bound by Article 15 (a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"): “A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

The Panel therefore decides that the Complainant failed to prove that the Respondent lacks rights or legitimate interests in the disputed domain name.

C. Bad faith registration and use

In view of the Panel's finding that the Complainant failed to establish the second element of Paragraph 4(a) of the Policy, the Panel does not need to consider the Complainant's assertions that the Respondent registered and uses the disputed domain name in bad faith. Nevertheless, the Panel will state for the record its conclusions on the third element of Paragraph 4(a) of the Policy as well.

The Complainant asserts that the Respondent registered and uses the disputed domain name in bad faith for the following reasons: (1) Constructive knowledge or prior knowledge: according to the Complainant, the fact that the website of the Respondent refers to the Complainant’s MIRAPEX products and to the Complainant itself evidences that the Respondent had prior knowledge of the rights of the Complainant; (2) According to the Complainant, the Respondent holds the disputed domain name for the purpose of selling it (the disputed domain name is offered for sale for 199 USD and the website of the Respondent contains a message “domains for sale”; note: the Panel notes that this message in fact reads “domains for sale. Is www.mirapex.sucks available? Click here to check”); (3) The Complainant further asserts: “the disputed domain name is used to criticize numerous companies, not only the Complainant, and the Respondent registered the corresponding domain names, which are also for sale”. The Complainant concludes that the Respondent registered the disputed domain name only to capitalise on, or otherwise take advantage of, the Complainant's MIRAPEX trademark.

The Panel finds that the Complainant did not demonstrate how the purported constructive knowledge or prior knowledge of the Respondent relates to the criticism-character of the disputed domain name and its “.sucks” extension. The Panel notes that the Complainant did not argue or claim that the disputed domain name lacks a genuine criticism purpose. In fact, the complaint is silent on this issue. The Complainant did not enter into any detail with regard to the criticism character of the disputed domain name and the content of the Respondent’s website. The Complainant limited itself to claim that “the Respondent has registered the disputed domain name only (…) to capitalize on, or otherwise take advantage of, the Complainant's trademark rights”. The Panel finds that the Complainant failed to prove its claim that the Respondent acquired the disputed domain name principally for the purpose of selling it (be it to the Complainant, a competitor, or another party). The Panel finds that the Respondent’s claim that the website available through the disputed domain name has a criticism purpose is not devoid of credibility. The Panel would have expected the Complainant to argue (and corroborate) why it considers this “.sucks” domain name and its purported free expression character as a “smoke screen” and why it is of the opinion that the predominant purpose of the Respondent is to sell this domain name rather than to provide a forum for discussion and criticism. The Complainant did not explain nor substantiate why it considers the criticism character of this website as a pretext. The Panel also finds that the offering of a domain name for sale is not by itself evidence of bad faith. Furthermore, the Panel does not see evidence that the disputed domain name is used to criticise other companies and, even if this would be the case, does not see why this would indicate bad faith under the specific circumstances of this case. The same is valid for the Complainant’s assertion that the Respondent is offering other domain names for sale. The Panel would need more substantiated argumentation in order to accept such claims as evidence of bad faith.

The Panel emphasises that the burden of proof under the third prong of Paragraph 4(a) of the Policy is with the Complainant. The Panel reiterates that it is bound by Article 15 (a) of the Rules and that it should thus decide the complaint on the basis of the statements and documents submitted by the parties. On the balance of the probabilities, and given the lack of convincing evidence of bad faith, the Panel concludes that the Complainant failed to establish the third element of Paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **MIRAPEX.SUCKS**: Remaining with the Respondent

PANELLISTS

Name	**Bart Van Besien, Nathalie Dreyfus, The Hon. Neil Brown, QC**

DATE OF PANEL DECISION 2020-09-01

Publish the Decision