Decision for dispute CAC-UDRP-100445

Case number	**CAC-UDRP-100445**
Time of filing	**2012-05-10 13:47:47**
Domain names	**buycheaplexapro.net**

Case administrator

Name	**Tereza Bartošková (Case admin)**

Complainant

Organization	**H. Lundbeck A/S**

Complainant representative

Organization	**Wallberg IP Advice**

Respondent

Name	**Segio Kiloser**

OTHER LEGAL PROCEEDINGS

None

IDENTIFICATION OF RIGHTS

Various trade marks around the world comprising or incorporating the term LEXAPRO including:

(i) Registered Community trade mark 2041259 for the word mark LEXAPRO in class 5 dated 16 December 2003; and

(ii) Registered Canadian trade mark no 794277 for the word mark LEXAPRO in class 5 dated 30 March 2011

FACTUAL BACKGROUND

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

Factual Background
The Complainant H. Lundbeck A/S is an international pharmaceutical company engaged in the research, development, production, marketing and sale of pharmaceuticals across the world. The company's products are targeted at disorders such as depression and anxiety, psychotic disorders, epilepsy and Huntington's, Alzheimer's and Parkinson's diseases.
Lundbeck was founded in 1915 by Hans Lundbeck in Copenhagen, Denmark. Today Lundbeck employs approximately 6,000

people worldwide. Lundbeck is one of the world's leading pharmaceutical companies working with brain disorders. In 2011, the company's revenue was DKK 16.0 billion (approximately EUR 2.2 billion or USD 3.0 billion). See extracts form the Annual Report 2011 attached as Annexes 1. For more information, reference is made to the official website www.lundbeck.com. Lundbeck markets a number of different pharmaceuticals for the treatment of brain disorders. The most recently launched compounds include: Cipralex/Lexapro® (depression), Ebixa® (Alzheimer's disease), Azilect® (Parkinson's disease), Xenazine® (chorea associated with Huntington's disease), Sabril® (epilepsy), Sycrest® (bipolar disorder) and Onfi® (Lennox-Gastaut syndrome).

The trademark Lexapro® is registered in more than 100 countries around the world, cf. Annex 2.

A. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
(Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))
The contested domain name is confusingly similar to the trade mark Lexapro®, in which the complainant holds rights. The domain name incorporates the complainants registered trademark combined with the generic and descriptive terms "buy cheap". The Complainant claims that for the purpose of a UDRP proceeding, when a well-known and invented mark is combined with a common noun or adjective, that combination constitutes a domain name which is confusingly similar to an invented and well known mark.

Also, the Complainant asserts that it is an established and recognized principle under the UDRP that the presence of the .net top level domain designation is irrelevant in the comparison of a domain name to a trademark.

B. The Respondent has no rights or legitimate interests in respect of the domain name;
(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))
The Respondent has not received any license or consent, express or implied, to use the complainant´s trademark Lexapro®, in a domain name or in any other manner from the Complainant, nor has the Complainant acquiesced in any way to such use or application by the Respondent. At no time did the Respondent have authorization from the Complainant to register the disputed domain name.

Further, to the best knowledge of the Complainant, the Respondent has no legitimate right in the contested domain name. The Respondent did thus not use the domain name as a trademark, company name, business or trade name prior to the registration of the disputed domain name, nor is the Respondent otherwise commonly known in reference to the name. On the contrary it is evident from the content of the Respondents website that the inclusion of the Complainants trademark Lexapro® in the domain name is done deliberately and with specific reference to this mark. See the printouts from the website www.buycheaplexapro.net in Annex 3. By doing this the Respondent intentionally attempts to attract for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website
Also, to the best knowledge of the Complainant, the Respondent has no legitimate interest in the contested domain name. As mentioned it is evident from the wording of the website that the inclusion of the Complainants trademark Lexapro® in the domain name is done deliberately and with specific reference to this mark, and that the inclusion of the term "order" indicates that you can order the Complainants´ product Lexapro® on the website. The Respondent does however not use the domain name in connection with a bona fide offering of goods and services. Complainants emphasize that Lexapro® is a controlled substance and, as such, under United States of America law as well as in all other countries, may not be sold online without a prescription from an authorized person (doctor). The Complainants asserts that the activity conducted at the disputed site may well be illegal as to the controlled substance Lexapro®. See, e.g., American Online, Inc. v. Xianfeng Fu, WIPO Case No. D2000 1374 and Roche Products Inc. and Genentech, Inc. v. Vincent Holman and Whois Privacy Services Pty. Wipo Case No. D2010-1951.

Finally, it is evident that the Respondent does not "make a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue" as stated in § 4 c of the UDRP.

C. The domain name was registered and is being used in bad faith.
(Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

The Complainant claims that because of the distinctive nature and intensive use of the Complainant´s trademark Lexapro®, and because of the specific content of the web site, the Respondent had positive knowledge as to the existence of the Complainant's trademark at the time the Respondent registered the domain name.

Further, as mentioned above the Respondent uses the domain name to divert Internet traffic to a site that claims to offer online sale of Complainants product Lexapro® without the mandatory prescription. By doing this the Respondent intentionally attempts to attract for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

1. The Domain Name is confusingly similar (as that term is understood) to the Complainant's LEXAPRO trade marks for the reasons given in Research in Motion Limited v. One Star Global LLC, WIPO Case No. D2009-0227.

2. The Panel rejects the Complainant's argument based upon the assertion that the goods on sale from the website are for sale without mandatory prescription. Although the Panel accepts that there are UDRP cases in which panelists have found in favour of a trade mark owner on that basis, the Panel respectfully suggests that such an approach is misconceived. The reasons for this were set out in detail by the Panel in Sanofi-aventis v. Rx World, Nils Bor, WIPO Case No. D2007-1773. Further, that reasoning is not addressed in Genentech, Inc. v. Vincent Holman and Whois Privacy Services Pty. WIPO Case No. D2010-1951, the case relied upon by the Complainant in support of its case.

3. Nevertheless, the Panel is able to and does find for the Complainant on more conventional grounds that the Respondent has registered and has used the Domain Name to take unfair advantage of the Complainant's marks. In particular, the only basis upon which it appear to the Panel that the Respondent could possibly argue that it has a legitimate interest and has not acted in bad faith, would be on the grounds set out in Oki Data Americas Inc v. ASD Inc, WIPO Case No. D2001-0903. However, it is for the Respondent to put forward such a case and he has not done so (see Owens Corning v. NA, WIPO Case No. D2007-1143). Further, had he attempted to do so, that argument would most likely have failed, given that it seems unlike that the Respondent could have satisfied the Oki Data conditions. Further, this Panel has questioned whether the Oki Data defence is available in a

case where the domain name (as is the case with the Domain Name) does not clearly distinguish the operator of the website from the trade mark owner (see Research in Motion Limited v. One Star Global LLC, WIPO Case No. D2009-0227 at paragraph 6.19).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BUYCHEAPLEXAPRO.NET**: Transferred

PANELLISTS

Name	**Matthew Harris**

DATE OF PANEL DECISION 2012-06-07

Publish the Decision