Decision for dispute CAC-UDRP-100447

Case number	**CAC-UDRP-100447**
Time of filing	**2012-05-10 13:53:03**
Domain names	**buyonlinelexapro.net**

Case administrator

Name	**Tereza Bartošková (Case admin)**

Complainant

Organization	**H. Lundbeck A/S**

Complainant representative

Organization	**Wallberg IP Advice**

Respondent

Name	**Yury Kilosek**

OTHER LEGAL PROCEEDINGS

There are none of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant has established by evidence that the Panel accepts that it has a trademark for LEXAPRO registered in more than 100 countries. Notably, those countries include Azerbaijan, the country in which the Respondent is domiciled (the word mark LEXAPRO, reg. no. 778106, registered on 16 March 2002).

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). 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.

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 online". 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. 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 "buyonline" 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. Complainant emphasize that Lexapro® is a controlled substance and, as such, under United States of America law as well as in all other countries such as in Canada – the website claims to be the website of the "Official Canadian Pharmacy" - may not be sold online without a prescription from an authorized person (doctor).
The Complainant 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´s trademark Lexapro® is registered in the recorded country of residence of the Respondent through the Madrid Protocol.

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 Complainant has made out a strong case supported by evidence to show that each of the 3 elements specified in paragraph 4(a) of the Policy has been satisfied.

2. The Respondent has been shown to have taken the Complainant's trademark LEXAPRO, to incorporate it in its entirety in the disputed domain name without permission and adding the expression "buyonline", which can only mean that if the domain name is followed to a website, the internet user will be able to buy online at that website, the pharmaceutical product know as Lexapro and sold under the Complainant's trademark LEXAPRO.

3. This is untrue and deceptive, as Lexapro may only be bought and sold with a prescription and it may not be bought and sold online.Not only is the modus operandi of the Respondent therefore based on a deception, but it is engaging in a dangerous act, as it makes it possible for the product to be bought when it may not be appropriate for the patient and will not have been manufactured and stocked under the quality control that would normally be expected.

4. These circumstances bring the proceeding clearly within the provisions of the Policy, for the domain name is an abuse of the Complainant's trademark, the Respondent has no right to use the Complainant's trademark in a domain name or anywhere else and the conduct of the Respondent from the registration of the domain name to its use in a website is a classic case of bad faith.

5. Finally, the Panel is aware of the decision in proceeding No. 100445, H. Lundbeck A/S V. Segio Kiloser, where the panel said

the following:

"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."

The Panel as presently constituted has read the decision in Sanofi-aventis v. Rx World, Nils Bor (supra) but respectfully disagrees. The fact that a product is available only on prescription, when the Respondent is promoting it for sale online and, by necessary implication , without a prescription, is a relevant consideration. It is particularly relevant as it shows an intention to deceive, which is the essence of bad faith and destructive of any notion that the Respondent has the right to act as it has done. Panelists under the UDRP have a wide discretion to admit evidence and to consider submissions made by the parties and in the opinion of this panelist the issue presently under discussion is relevant. In the opinion of this panelist, the issue is not outside the ambit of the UDRP as suggested in Sanofi-aventis v. Rx World, Nils Bor (supra).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BUYONLINELEXAPRO.NET**: Transferred

PANELLISTS

Name	**The Hon. Neil Brown, QC**

DATE OF PANEL DECISION 2012-06-15

Publish the Decision