Decision for dispute CAC-UDRP-100444

Case number	**CAC-UDRP-100444**
Time of filing	**2012-05-10 13:26:19**
Domain names	**comprarlexaproonline.com**

Case administrator

Name	**Tereza Bartošková (Case admin)**

Complainant

Organization	**H. Lundbeck A/S**

Complainant representative

Organization	**Wallberg IP Advice**

Respondent

Organization	**Fundacion Private Whois**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other pending or decided legal proceedings.

IDENTIFICATION OF RIGHTS

Complainant has a registered trademark in the word Lexapro in more than 100 countries around the world, inter alia the following trademark registered in Panama, the Respondent’s country of residence:

Word trademark registered in Panama, reg. No. 123654-01, for the term LEXAPRO, registered on 25 September 2003.

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 as well as brain disorders. The Complainant markets a number of different pharmaceuticals for the treatment of brain disorders, one of the pharmaceuticals is called Lexapro. Lexapro is registered as a trademark in more than 100 countries around the world.

The Complainant contents:

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 term “comparer” (“order”) as prefix and the generic and descriptive term “online” as suffix. The Complainant claims that for the purpose of a UDRP proceeding, when a well-known and invented mark is combined with common nouns or adjectives, 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 “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 including in Panama – the apparent country of residence of the Respondent - 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´s trademark Lexapro is registered in the registered country of residence of the Respondent Panama.

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.

In addition the Complainant also argues:

The Complainant contests that the "okidataparts.com" test (Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No.D2001-0903, <okidataparts.com>) is applicable in this case. The Complainant thus fully agrees with those UDRP panels that have taken the view that, without express authority of the relevant trademark holder, a right to resell or distribute that trademark holder's products does not create a right to use a domain name that is identical, confusingly similar, or otherwise wholly incorporates the relevant trademark.

If the Panel finds that the test is in principle applicable to the present case the Complainant strongly believes that the criteria and in particular the two CAPITALISED criteria below of the test are not met in this case. The following is taken from the WIPO Overview:

"Normally, a reseller or distributor can be making a bona fide offering of goods and services and thus have a legitimate interest in the domain name if its use meets certain requirements. These requirements normally include the actual offering of goods and services at issue, THE USE OF THE SITE TO SELL ONLY THE TRADEMARKED GOODS, AND THE SITE´S ACCURATELY AND PROMINENTLY DISCLOSING THE REGISTRANT´S RELATIONSHIP WITH THE TRADEMARK HOLDER. The respondent must also not try to "corner the market" in domain names that reflect the trademark. Many panels subscribing to this view have also found that not only authorized but also unauthorized resellers may fall within such Oki Data principles. Pay-per-click (PPC) websites would not normally fall within such principles where such websites seek to take unfair advantage of the value of the trademark".

In this context it should be noted that the Panel in the okoidataparts.com decision itself used the following words when introducing the above mentioned criteria:

"To be "bona fide," the offering must meet several requirements. Those include, at the minimum, the following: "

which in view of the Complainant clearly indicates that the decision must be applied very cautiously and as an exception to the rule. The Complainant strongly believes that these criteria and in particular theTWO CAPITALISED criteria are not met in this case.

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.
There can be no question but that the domain name <comprarlexaproonline.com> is confusingly similar to Complainant's <Lexapro> trademark. Respondent's domain name incorporates in its entirety the <Lexapro> trademark despite the addition of other descriptive words (comprar / online).

2.
The Respondent does not have a legitimate interest in the domain name and used and registered the domain name in bad faith as the Respondent does not sell only the trademarked goods of the Complaint and does not disclose that he has no relationship with the Complainant. Furthermore the use of the Complainant´s trademark as part of the disputed domain name, combined with the specific content of the web site, indicates that the Respondent knew of the existence of the Complainant's trademark at the time of the registration of the domain name.

3.
The Panel accepts the Complainant's submissions and finds, in the absence of any evidence to the contrary, that the Respondent has to transfer the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **COMPRARLEXAPROONLINE.COM**: Transferred

PANELLISTS

Name	**Prof. Dr. Lambert Grosskopf, LL.M.Eur.**

DATE OF PANEL DECISION 2012-06-18

Publish the Decision