Decision for dispute CAC-UDRP-100898

Case number	CAC-UDRP-100898
Time of filing	2014-12-16 14:02:55
Domain names	PROAIRALBUTEROL.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	TEVA RESPIRATORY, LLC

Complainant representative

Organization	Matkowsky Law PC

Respondent

Name	Bogdan Orlovskiy

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other proceedings.

IDENTIFICATION OF RIGHTS

The Complainant (formerly known as IVAX Labs. Inc.) relies on its registration of the PROAIR word mark, U.S. Reg. No. 3,166,297 covering inhalers filled with pharmaceutical preparations for the treatment of respiratory disease, in Int. Class 5 and US classes 6,18,44,46,51 and 52, registered on 31 October 2006, with a priority filing date of 17 December 2004. It also relies on its use in trade in the US.

FACTUAL BACKGROUND

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

The Complainant is the U.S.-based division of Teva Pharmaceutical Industries Ltd, a global pharmaceutical company with headquarters in Israel and a generic drug maker, with a substantial product portfolio and a direct presence in approximately 60 countries employing approximately 45,000 people around the world with some $20.3 billion in net revenues in 2013.

The Complainant's PROAIR HFA is a leading inhaler for asthma with a significant market share in the U.S. market. According to IMS Health's, National Prescription Audit, PROAIR was first in the albuterol category (52.9% Total Prescription share based on an IMS Health, National Prescription Audit, for the 12 months ending March 2014). PROAIR revenues amounted to $345 million in the first quarter of 2014 (IMS National Sales Perspectives, for the quarter ending March 2014).

The Complainant says it owns numerous registrations for the PROAIR mark but relies here on U.S. Reg. No. 3,166,297.

The Complainant asserts the Disputed Domain Name is confusingly similar to PROAIR and says the Complainant has satisfied paragraph 4(a)(i) of the Policy because the Disputed Domain Name incorporates the mark in its entirety and merely adds the descriptive term ‘albuterol’ citing CAC Case No. 100832. Albuterol sulfate is the active ingredient of PROAIR HFA Inhalation Aerosol.

The Complainant claims the risk of confusion should be considered with care because the goods covered by the registration are pharmaceuticals, and the likelihood of confusion could cause death or physical harm, citing F. Hoffman-La Roche AG v. Transure Enterprise Ltd. and Above.com Domain Privacy, WIPO Case No. D2009-1729.

The Complainant asserts its exclusive rights to the PROAIR mark for use on or in connection with inhalers filled with pharmaceutical preparations

for the treatment of respiratory disease, and says no license, permission, authorization or consent was granted to the Respondent to use PROAIR in the Disputed Domain Name. It claims the Respondent registered and is using the Disputed Domain Name to drive traffic to rogue online pharmacies for commercial gain and that it does this by creating a likelihood of confusion with the Complainant's trademarks as to source, sponsorship, affiliation, or endorsement of rogue online pharmacies. It complains the Disputed Domain Name does not make clear that it pertains to websites unconnected with the Complainant (there is no disclaimer on the sites complained of). The Complainant alleges the Respondent uses the Disputed Domain Name to advertise the online pharmacies and their products. It says none of the above constitutes a legitimate non-commercial or fair use under the Policy, citing CAC Case No. 100833.

In particular, the Complainant alleges the Disputed Domain Name is being used as a mail server and to host a "feeder" site to exploit PROAIR to drive traffic to rogue online pharmacies. The Complainant alleges the Respondent is engaged in criminal activity and that to conceal such criminal activity, the Respondent displays a spoofed 503 error while the Respondent sends commercial email messages from the Disputed Domain Name to drive sales to these pharmacies. In particular, it says three online pharmacies are advertised and promoted; "SKY Pharmacy," "Canadian Health&Care Mall," and "Trusted Tablets." It complains that the Respondent advertises competitive albuterols at these sites. It notes that that the sites advertise that no prescription is required and that shipment is worldwide. It alleges that some of the sites have counterfeit government seals and Visa and Mastercard logos. The Complainant alleges "this website is "rogue" by industry standards." The Complainant goes on to allege this online pharmacy belongs to a "criminal network" (the Panel does not set out these claims here) but the Complainant makes allegations about various sites including www.trustedgenerics-online.com. It says the Respondent's registrant email address is associated with other domains and the Respondent has a pattern or practice of trying to exploit pharmaceutical trade marks to drive traffic to rogue online pharmacies.

The Complainant alleges the Respondent cannot satisfy the requirements of Oki Data Americas Inc v. ASD Inc, WIPO Case No. D2001-0903 so as to claim a right or legitimate interest. Cephalon v. Jack n Oliver, CAC Case No. 100835 ("[E]ven if the Oki Data conditions were potentially of relevance, the fact that the relevant websites sell other products than the genuine products of the Complainant, makes it clear that those conditions could not be satisfied."). It says the Respondent registered and uses the Disputed Domain Name to benefit from the reputation of the mark and illegitimately trade on it for commercial gain and profit. It says the Respondent must have been aware of PROAIR when registering the Disputed Domain Name. Therefore, the requirement of bad faith registration and use of the Disputed Domain Name pursuant to paragraph 4(a)(iii) of the Policy has also been met, citing CAC Case No. 100833.

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

On 20 January 2015 the Panel requested supplemental information from the Complainant regarding clarification of the relationship between the current registered proprietor of the US registered trade mark No.3,166,297, IVAX Labs. Inc., and the Complainant pursuant to paragraph 12 of the Rules. The Complainant provided the information on the same day.

Furthermore, the Panel undertook limited factual research into matters of public record it deemed necessary (including visiting various websites referred to in the Complaint in order to obtain more information about the Respondent and use of the Disputed Domain Name).

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

While the Disputed Domain Name incorporates the Complainant's registered trade mark PROAIR, the additional word Albuterol is descriptive of the name of the active drug, namely Albuterol sulfate. Indeed the online USPTO records show that other related marks and applications of the Complainant disclaim any exclusivity in that word for the same reasons. The Panel finds the Disputed Domain Name to be similar to the Complainant's trade mark, based on the inclusion of the mark. Therefore, 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 UDRP).

The Panel accepts the Complainant's assertions that the Respondent is not affiliated with nor authorised by the Complainant. However, this is not the end of the inquiry. Other legitimate uses would include bona fide offering based on descriptive and nominative honest use under paragraph 4(c)(i) of the UDRP.

The Panel could not access any of the pharmacy sites in issue other than www.trustedgenerics-online.com (visited 20 January 2015) and that site advertised many medicines and a search on it gave the result that they did not carry PROAIR at this time but suggested a form could be completed requesting it. That site had the following notice:

"Some products available in our pharmacy require a valid prescription. If the law of your country or territory requires you to obtain prescription for any of the products which you plan to purchase you will be asked by our customer support representative to send it after you complete the order. Please be informed that we require a valid prescription for your order. You should fax it to or send a scan copy to the email. Please be advised that in case you don't provide a valid prescription within a three-day period your order will not be processed. We strongly recommend you to consult your physician, prior to ordering, to be sure that the medicine you are about to order, is the one you need."

The way back machine had a listing for and archived pages for www.myskypharmacy.com (as of 18 December 2014) and while that site then listed alternative products, it did not appear to list PROAIR. The pages with the fine print were not archived so it is not clear what notices were given.

This is not therefore a simple reseller case where the pharmacies are re-selling the genuine PROAIR product. Subject to the issues below, if this was a case where the pharmacies were selling the genuine product, even together with other competing products (just as offline pharmacies do), then this would come very close to honest descriptive and nominative use in the Panel's view.

The spam trackers site relied on in evidence led to a press release from the FDA and also had a link to this guidance: http://www.fda.gov/Drugs/ResourcesForYou/Consumers/BuyingUsingMedicineSafely/BuyingMedicinesOvertheInternet/BeSafeRxKnowYourOnlinePharmacy/default.htm. The FAQ at that site include the following:

"3 To identify a safe online pharmacy, make sure that the online pharmacy:
Requires a valid prescription
Provides a physical address in the United States
Is licensed by the state board of pharmacy in your state and the state where the pharmacy is operating
Has a state-licensed pharmacist to answer your question

4. Is it okay to buy prescription medicine online from other countries?
FDA does not have jurisdiction of prescription medication from other countries; therefore, FDA cannot guarantee the safety or effectiveness of those medication…."

See also:

"7. Why are consumers increasingly turning to online pharmacies for their medicines? The Internet provides consumers with instant access to information and services, including online pharmacies for prescription medicines. Health insurance plans are encouraging home delivery of maintenance medications and use of pharmacy services online. As the cost of prescription medicine continues to increase, consumers may look for cost savings from online pharmacies to afford their medicines. In addition, many consumers value the convenience and privacy of purchasing their medicines online. For those consumers that may be considering purchasing from online sources that are not associated with health insurance plans or local pharmacy, these consumers need to know the risks of buying from fraudulent online pharmacies."

It is very important to recognise that online pharmacies represent a new business model and this development may be regarded as disruptive but it is not per se illegal.

Purchases and imports of medicines from online foreign pharmacies for limited amounts for personal use appear (from online public resources viewed by the Panel) to be legal (in the UK at least) provided a prescription can be produced to customs on request, if any. It seems online domestic pharmacies can be legitimate in the US if they comply with the requirements listed above. Outside the US jurisdiction, other countries legal approaches will vary. This Panel therefore considers these activities can in theory be honest and bona fide. Therefore, as noted above, if this was a reseller case where the pharmacies were re-selling the genuine PROAIR product even together with other competing products (just as offline pharmacies do), then this would come very close to honest descriptive and nominative use in the Panel's view, no greater commercial connection would be assumed by consumers than in the case of offline pharmacies.

The Panel notes also that the UDRP might protect the pharmacies if selling only the Complainant's own medicines under the authority of Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No.D2001-0903. However, the Panel is compelled to note again that EU trade mark law may protect the sales and advertisements of the Complainant's own medicines alongside alternatives. However, trade mark law in the EU in relation to permitted comparative advertising of alternative products alone by keywords and domain names is in flux. The Panel must record its concern that the UDRP must be bought further into alignment with changing legal norms and public expectations in this regard. It seems unreasonable that resellers should be limited to one product.

However, under the UDRP the Complainant need only make a prima facie showing of absence of rights or legitimate interest in the Disputed Domain Name on the part of the Respondent and the evidentiary burden then shifts to the Respondent to show it has rights or legitimate interests in that name. The Respondent has made no attempt to do so here. It would not therefore be right to explore the legitimate use issues further here where there is no response.

The Panel notes also that the FDA press release at the link given above discusses enforcement action against 9,600 websites selling unapproved prescription medicines including some operated by "an organised criminal network" with websites that purport to be "Canadian Pharmacies" and this appears to have included www.canadianhealthandcaremall.com. It is not possible on the evidence here for the Panel to be certain this is the same site complained of above or to properly determine the application to this case and so these matters have been disregarded in this decision.

Therefore, this Panel finds the Complainant has shown the Respondent to have no rights or legitimate interests in respect of the Domain Disputed Name (within the meaning of paragraph 4(a)(ii)of the Policy).

As to bad faith, the Panel finds on the balance of probabilities that the Respondent was likely aware of the Complainant´s trademark when registering the Disputed Domain Name.

Therefore, in light of the failure of the Respondent to come forward and defend its use as legitimate and rebut 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 UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PROAIRALBUTEROL.COM**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2015-01-21

Publish the Decision