Decision for dispute CAC-UDRP-100969

Case number	CAC-UDRP-100969
Time of filing	2015-04-17 11:02:42
Domain names	ACTIQSIDEEFFECTS.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Anesta, LLC

Complainant representative

Organization	Matkowsky Law PC

Respondent

Organization	Truth MD LLC

OTHER LEGAL PROCEEDINGS

The disputed Domain Name was already subject to CAC Administrative proceeding No. 100857 initiated by the same Complainant as in the case at hand but against a different Respondent. That Complaint has been rejected by the Panel with its decision dated 8 February 2015.

IDENTIFICATION OF RIGHTS

RIGHTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT

The Complainant relies on its mark <ACTIQ> registered in the United States (U.S. Reg. No. 2,162,569; issued on 2 June 1998), the country where the Respondent resides, for “oral opioid analgesic for treatment of pain caused by cancer”. It results from the evidence before this Panel that this registration is valid and in force.

FACTUAL BACKGROUND

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

According to the Registrars’ verifications the disputed Domain Name was registered with the present registrant at least since 4 March 2015.

It results from the Complainant’s undisputed allegations and evidence that the Respondent does business as MedFax.com

("MedFax" or "TruthMD"). In 2014, MedFax offered for sale reports covering over 3,500 prescription drugs and medications and their side effects.

The Complainant has further provided evidence from which it results that it pursued transfer of the disputed Domain Name. It further results from this evidence that the Respondent, by its legal representatives (letter dated 4 March 2015), conceded it has no present intention to utilize the disputed Domain Name and that it additionally proposed to assign and transfer the disputed Domain Name to the Complainant against a payment U$10,000.

The Complainant claims that the disputed Domain Name is confusingly similar to its mark. Furthermore, it contends that the Respondent does not have any rights or legitimate interest in the disputed Domain Name. It has not been authorized, licensed or permitted to register and use the domains by the Complainant. Moreover, the Complainant states the Respondent has not been commonly known by the disputed Domain Name. Finally, the Complainant claims that the disputed Domain Name has been registered and is being used in bad faith.

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).

The Complainant has established rights in its registered trademark under the Policy as of at least the filing date of its U.S. registration, which predates registration of the disputed Domain Name.

Furthermore, the Panel is satisfied that the disputed Domain Name <ACTIQSIDEEFFECTS.COM> is confusingly similar to the Complainant's trademark <ACTIQ> quoted above since this trademark is fully incorporated in the disputed Domain Name. As the Complainant correctly points out, it is consensus view among UDRP-Panels that the mere adding of the descriptive terms "side effects" to a distinctive mark in the medical sector does not sufficiently change the overall impression of confusing similarity between the mark and the disputed Domain Name (e.g. Forest Laboratories, Inc. v. MLC, WIPO Case No. D2008-0320 <LEXAPROSIDEEFFECTS.COM>, <LEXAPROSIDEEFFECTS.ORG> and <LEXAPRO-SIDE-EFFECTS.ORG>); Ferring B.V. v. Melrock Ltd., NAF-Case No. D2014-0437 <MENOPURSIDEFFECTS.COM>).

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).

The Complainant's assertions that the Respondent is not commonly known by the disputed Domain Name and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed Domain Name on the part of the Respondent. The evidentiary burden therefore shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that Domain Name. The Respondent has made no attempt to do so. Accordingly and in the absence of any explanation and evidence from the Respondent, the Panel finds that the Respondent has no rights or legitimate interests in the disputed Domain Name.

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).

It is undisputed that Respondent has taken active steps to sell the disputed Domain Name to the Complainant by offering to assign and transfer that Domain Name in return of a payment amounting to U$ 10.000. Evidence of offers to sell the domain name are generally admissible under the UDRP, and is often used to show bad faith. This is so both in relation to offers by a respondent to sell made prior to a Complainant's filing of a UDRP complaint (as in the case at issue), or after such filing. The

legal criteria for showing bad faith directly specify that an offer for sale can be evidence of bad faith, and Panels are competent to decide whether settlement discussions represent a good faith effort to compromise or a bad faith effort to extort. In the present case this Panel is satisfied that due to the amount requested going far beyond the usual out-of-pocket expenses for registering a .com-domain name the proposal to assign the disputed Domain Name is rather a bad faith effort to extort. In any case the Respondent failed to submit evidence documenting out-of-pocket costs in any amount in connection with the disputed Domain Name. Additionally, it is to be noted that the Respondent submitted this proposal without the Complainant having solicited any offer to sell. This leads to the Panels conclusion that the Respondent registered and used the Domain Name with the primary purpose of selling it to the Complainant for valuable consideration in excess of Respondent's out-of-pocket costs (see Massachusetts Medical Society v. Michael Karle, WIPO Case No. D2000-0282 <NEWENGLANDJOURNALOFMEDICINE.COM>).

The Complainant has thus established all three elements necessary under paragraph 4(a) of the Policy in order to obtain an order that the disputed domain name should be transferred.

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.

In particular, the previous decision issued by the Panel in CAC Administrative proceeding No. 100857 does not prevent the Panel from proceeding to its decision in the present case. This case involved indeed the same Domain Name but a different Respondent than the Respondent in the case at hand so that the case at issue is not a refiled but a new case.

PRINCIPAL REASONS FOR THE DECISION

The Respondent has registered and used the disputed Domain Name that is confusingly similar to the Complainant's trademark, in respect of which the Respondent has no rights or legitimate interest and which is registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ACTIQSIDEEFFECTS.COM**: Transferred

PANELLISTS

Name	**Dr. Tobias Malte Müller**

DATE OF PANEL DECISION 2015-05-29

Publish the Decision