Decision for dispute CAC-UDRP-101038

Case number	CAC-UDRP-101038
Time of filing	2015-08-18 11:22:34
Domain names	PROAIRCOUPON.COM, PROAIR-COUPON.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Teva Respiratory, LLC

Complainant representative

Organization	Matkowsky Law PC

Respondent

Organization	JC

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

Complainant is Teva Respiratory, LLC, the US-based respiratory division of Teva Pharmaceutical Industriels Ltd. Complainant uses the ProAir® sign for the commercialization of inhalation aerosols for, inter alia, the treatment or prevention of bronchospasm.

Complainant owns the PROAIR trademark Reg. No. 3,166,297 in the United States, registered on October 31, 2006 in class 5 (inhalers filled with pharmaceutical preparations for the treatment of respiratory disease).

Complainant is also the owner of the domain names <proair.com> since February 20, 1996 and of the domain name <myproair.com> since November 7, 2007.

FACTUAL BACKGROUND

FACTS ASSERTED BY COMPLAINANT AND NOT CONTESTED BY RESPONDENT:

Complainant is the U.S.-based respiratory division of Teva Pharmaceutical Industries Ltd., a leading global pharmaceutical

company, committed to increasing access to high-quality healthcare by developing, producing and marketing affordable generic drugs as well as innovative and specialty pharmaceuticals and active pharmaceutical ingredients.

Complainant's ProAir® HFA Inhalation Aerosol is indicated in patients 4 years of age and older for the treatment or prevention of bronchospasm with reversible obstructive airway disease and for the prevention of exercise-induced bronchospasm.

According to Complainant, the ProAir® HFA Inhalation Aerosol is the #1 dispensed quick-relief inhaler in the United States based on the number of prescriptions of ProAir HFA (IMS National Rx Audit, September 2014).

Complainant asserts that the ProAir® trademark is clearly well-known in the albuterol category in the United States. ProAir® HFA revenues amounted to $ 1,448 million in 2014 (IMS National Sales Perspectives, for the year ending December 2014). Complainant also asserts that its ProAir® RespiClick (albuterol sulfate) is the first and only FDA-approved multidose breath-activated rescue inhaler.

The disputed domain names <proaircoupon.com> and <proair-coupon.com> have respectively been registered by Respondent on March 23, 2012 and June 4, 2012.

Both disputed domain names returned a 500 Internal Server Error as of when the Complaint was submitted to the Provider. However, according to Complainant and in light of the annexes provided, DomainTools® has a screenshot of the domain name <proaircoupon.com> showing it was used in 2014 in connection with providing information about Complainant's PROAIR trademark with an advertisement to a third-party site where the ProAir® coupon could be found.

Moreover, Respondent uses a mark (“PROAIR COUPON”) to brand the page that Complainant contends is substantially indistinguishable from Complainant's registered trademark.

According to Complainant, the <proaircoupon.com> website also had a false copyright notice legend which indicated that copyright ownership was in the name of "Proair Coupon", not the Respondent.

The screenshot submitted by Complainant shows a hyperlink to “SAVE ON EVERY PRESCRIPTION FOR FREE,” which shows that the savings card being promoted was also offering other prescriptions which may have even been competitive with Complainant’s product.

Complainant has not provided any proof of existing website related to the disputed domain name <proair-coupon.com>, however, according to evidence submitted, search results confirm a similar use was made of the <proair-coupon.com> domain name without the consent of Complainant.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trademark or service mark in which Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

Complainant has, to the satisfaction of the Panel, shown Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are 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

Paragraph 14 of the Rules addresses the principles to be used in case of default:

“(a) In the event that a Party, in the absence of exceptional circumstances, does not comply with any of the time periods established by these Rules or the Panel, the Panel shall proceed to a decision on the complaint.

(b) If a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, these Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate”.

Consequently, failure on the part of Respondent to file a response to the complaint permits an inference that Complainant’s allegations are true. It may also permit the Panel to infer that Respondent doesn’t deny the facts that Complainant asserts (see Harrods Limited v. Harrod’s Closet, WIPO Case No. D2001-1027). The fact that Respondent did not provide any response reverses the burden of proof on his side (See Southcorp Limited v. Frontier Direct Pty Ltd, WIPO Case No. D2004-0949).

1. Confusing similarity to a trademark in which Complainant has rights (paragraph 4(a)(i) of the Policy).

Complainant contends that Respondent’s disputed domain names are confusingly similar to the trademark PROAIR in which Complainant has rights pursuant to paragraph 4(a)(i) of the Policy.

Among other trademark registrations, Complainant is the owner of the trademark PROAIR registered in the United States under No. 3,166,297 since October 31, 2006. Complainant’s trademark right is prior to Respondent’s registration of the disputed domain names which have been registered in 2012.

Respondent’s domain names <proaircoupon.com> and <proair-coupon.com> incorporate Complainant’s trademark PROAIR in its entirety.

As prior panels have recognized, the incorporation of a trademark in its entirety in a domain name is sufficient to establish that a domain name is identical or confusingly similar to the complainant’s registered mark for purposes of the Policy. The addition of other terms in the disputed domain names, such as the term “coupon”, does not affect a finding that the domain names are identical or confusingly similar to Complainant’s trademark for purposes of the Policy (see See Chubb Security Australia PTY Limited v. Mr Shahim Tahmasebi, WIPO Case No. D2007-0769).

On the contrary, the generic term “coupon” is likely to increase the confusion between the disputed domain names and Complainant’s PROAIR trademark as it implies a discount or promotion related to Complainant’s ProAir® products, which is a type of offer that is promoted by Complainant as well (savings card).

Further, the addition of the gTLD “.com” to the disputed domain names should not be taken into consideration in order to evaluate the similarity between the disputed domain names and Complainant’s trademark, and therefore does not preclude any likelihood of confusion (See F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., WIPO Case NO. D2006-0451).

Therefore, the Panel finds that Respondent’s disputed domain names <proaircoupon.com> and <proair-coupon.com> are confusingly similar to the PROAIR trademark in which Complainant has rights, and thus that paragraph 4(a)(i) of the Policy is fulfilled.

2. Rights or Legitimate Interests (paragraph 4(a)(ii) of the Policy

Complainant alleges that Respondent has no rights or legitimate interest in the disputed domain names pursuant to paragraph 4(a)(ii) of the Policy.

Even though the Respondent defaulted, it is still Complainant's burden to prove that Respondent lacks rights or legitimate interest in the disputed domain names (See EAuto, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc., WIPO Case No. D2000-0047).

Complainant needs only to make a prima facie case on this element, at which point the burden shifts to Respondent to present evidence that he has some rights or legitimate interests in the disputed domain names (See Vicar Operating, Inc. v. Domains by Proxy, Inc. / Eklin Bot Systems, Inc., WIPO Case No. D2010-1141).

Complainant has made a prima facie case that Respondent lacks any right or legitimate interest in the disputed domain names.

Indeed, Respondent has never been authorized, contracted, licensed or otherwise permitted by Complainant to use the PROAIR trademark, and Respondent is neither commonly known by the disputed domain names in view of the Whois database records and pursuant to paragraph 4(c)(ii) of the Policy.

Further, the fact that the disputed domain names are not currently resolving to a website does not support Respondent's rights or legitimate interests in the disputed domain names (see Melbourne IT Ltd. v. Stafford, WIPO Case No. D2000-1167).

It has been shown to the Panel that the disputed domain name <proaircoupon.com> used to resolve to a website displaying advertisements on coupons for ProAir® products using Complainant's PROAIR trademark. Said advertisements resolved to a third-party site where the coupons could be found. Same website also mentioned at the bottom of the page a copyright notice legend assigning copyrights to "Proair Coupon".

Even though the disputed domain name <proair-coupon.com> does not appear to resolve to any website, it has been shown to the Panel from Internet search results submitted by Complainant that the disputed domain name appeared to have resolved to similar websites offering coupons on ProAir® products using Complainant's PROAIR trademark.

By this use of the disputed domain names, not only is Respondent reproducing and using Complainant's PROAIR trademark but also directly competing with Complainant's business related to ProAir® savings card using Complainant's own trademark, and therefore creating a likelihood of confusion as to purposely direct consumers to its websites instead of Complainant's.

Therefore, it does not appear to the Panel that Respondent used the disputed domain names with a bona fide offering of goods or services pursuant to paragraph 4(c)(i) of the Policy, nor that Respondent was making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers pursuant to paragraph 4(c)(iii) of the Policy.

From all the aforementioned elements, the Panel finds that Respondent lacks rights or legitimate interest in the disputed domain names pursuant to paragraph 4(a)(ii) of the Policy.

3. Registration and use in bad faith (paragraph 4(a)(iii) of the Policy).

Considering the above-mentioned elements, the Panel concedes that Respondent seems to have intentionally attempted to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with Complainant's PROAIR trademark as to the source, sponsorship, affiliation and endorsement of its websites.

Further, considering that Complainant's PROAIR trademark is well-known in the United States, and considering Respondent's use of said trademark and display of related products on its website, there is no doubt to the Panel that Respondent must have known about Complainant's trademark at the time it registered the disputed domain names (see Pfizer Inc. v. NA, WIPO

Case No. D2005-0072).

It has also been asserted in the past that registration of a domain name that is confusingly similar to a well-known trademark by any entity that has no relationship to that mark is itself sufficient evidence of bad faith registration and use (See Allianz, Compañia de Seguros y Reaseguros S.A. v. John Michael, WIPO Case No. D2009-0942).

Complainant's behaviour in light of the aforementioned elements doubtlessly constitutes evidence of bad faith registration and use on behalf of Respondent pursuant to paragraph 4(b)(iv) of the Policy (see Compagnie Gervais Danone v. Domains by Proxy, LLC / SEO Services, Inc., WIPO Case No. D2013-1158).

The Panel also acknowledges that Respondent's concealing of its identity and contact information in regards to the disputed domain names can also be considered as evidence of bad faith registration (see Nelnet Business Solutions, Inc. d/b/a FACTS Management Co. v. Andrew Goldberge, WIPO Case No. D2013-0764).

Therefore, the Panel finds that Complainant has succeeded in proving that Respondent had registered and used the disputed domain names in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PROAIRCOUPON.COM**: Transferred
2. **PROAIR-COUPON.COM**: Transferred

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2015-09-22

Publish the Decision