Decision for dispute CAC-UDRP-101140

Case number	CAC-UDRP-101140
Time of filing	2016-01-12 11:21:34
Domain names	Pradaxa.lawyer

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Boehringer Ingelheim Pharma GmbH & Co. KG

Complainant representative

Organization	Nameshield (Anne Morin)

Respondent

Name	JONATHAN BEDDOES

IDENTIFICATION OF RIGHTS

The Complainant is the holder of International trademark registrations consisting of, or containing, the sign PRADAXA, with designation in multiple countries, namely International trademark registration 807503 for the word mark “pradaxa”, registered on July 9, 2003, in class 5 and International trademark registration 991238 for the figurative mark “pradaxa”, registered on October 29, 2008, in class 5 (hereinafter, the “PRADAXA trademarks”. The PRADAXA trademarks are registered in the Trademark Clearinghouse since April 16, 2014. The Complainant is the holder of the domain names <pradaxa.com>, <pradaxa.net> and <pradaxa.biz>.

FACTUAL BACKGROUND

The Complainant is a family-owned pharmaceutical group of companies with roots going back to 1885. The Complaint has become a global research-driven pharmaceutical enterprise and has today about 140 affiliated companies world-wide with roughly 46,000 employees. The two main business areas of the Complainant are: Human Pharmaceuticals and Animal Health. In 2013, net sales of the Complainant’s group of companies amounted to about EUR 14.1 billion.
The Complainant uses the trademark for a pharmaceutical product with the generic name Dabigatran, an oral anticoagulant from the class of the direct thrombin inhibitors.
On December 9, 2015, the Respondent registered the disputed domain name <pradaxa.lawyer>. When the Complainant filed its complaint with the Center on January 7, 2016, no active website was linked to the disputed domain name. On February 7, 2016, the Respondent informed the Center that it published the first version of its website on the disputed domain name. The website that is now linked to the disputed domain name contains warnings about possible side effects and invites

Internet users who suspect being injured after taking the Pradaxa medicinal product to fill out a contact form “for a free confidential case evaluation by [the Respondent’s] recommended law firm partners”.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant considers the disputed domain name to be confusingly similar to trademarks in which it has rights. The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name. According to the Complainant, the Respondent has not used the disputed domain name in connection with any legitimate use. Also, according to the Complainant, the Respondent has not been commonly known by the disputed domain name. Finally, the Complainant considers that the disputed domain name was registered and is being used in bad faith.

RESPONDENT:

The Respondent argues that he makes legitimate noncommercial or fair use of the domain name, without the intent for commercial gain. According to Respondent, the disputed domain name was registered for use as a criticism and free speech website, offering free information to help injured people finding a lawyer.

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

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.
The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are civil, the standard of proof is the balance of probabilities.
Thus for the Complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:
1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
2. The Respondent has no rights or legitimate interests in respect of the domain name; and
3. The domain name has been registered and is being used in bad faith.
The Panel has therefore dealt with each of these requirements in turn.

Confusing similarity of the Domain Name with existing rights

The Complainant must first establish that there is a trademark or service mark in which it has rights. Since the Complainant is the holder of the PRADAXA trademarks, which are used in connection with its business, it is established that there is a trademark in which the Complainant has rights.
The Panel considers the disputed domain name <pradaxa.lawyer> to be composed of a name identical to the PRADAXA trademarks and the generic TLD “lawyer”. The Respondent does not dispute that the disputed domain name is identical to the PRADAXA trademarks.

Accordingly, the Complainant has made out the first of the three elements that it must establish.

No legitimate rights

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that Respondent has no rights or legitimate interests in respect of the domain names.
It is established case law that it is sufficient for the Complainant to make a prima facie showing that Respondent has no right or legitimate interest in the Domain Name in order to shift the burden of proof to the Respondent. [See: Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094 (championinnovation.com); Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455 (croatiaairlines.com); Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110 (belupo.com).]
The Panel notes that the Respondent has not been commonly known by the domain name and that the Respondent has not acquired trademark or service mark rights. Respondent’s use and registration of the disputed domain name was not authorized by the Complainant. There are no indications that a connection between Complainant and Respondent existed.
The Respondent’s argument that he has a legitimate interest in the disputed domain name for use as a criticism website cannot be upheld. The right to criticize does not necessarily extend to registering and using a domain name that is identical or confusingly similar to the complainant's trademark. That is especially the case if the respondent, as the Respondent is doing in the case at hand, is using the trademark alone as the domain name (i.e., <trademark.tld>) as that may be understood by Internet users as impersonating the trademark owner. (See: Skattedirektoratet v. Eivind Nag, WIPO Case No.D2000-1314 (skatteetaten.com); Triodos Bank NV v. Ashley Dobbs, WIPO Case No.D2002-0776 (triodos-bank.com)).
Moreover, the Respondent’s free speech purpose may primarily be a pretext for commercial advantage, as it appears that the Respondent aims at offering legal services via the disputed domain name.
The Panel therefore concludes that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

Bad faith

Complainant must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (See e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006 1052).

Policy Paragraph 4(b) provides a non-exclusive list of factors, any one of which may demonstrate bad faith registration and use, namely:

(i) circumstances indicating that the domain name is registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name (Policy Paragraph 4(b)(i));
(ii) the registration of a domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct (Policy

Paragraph 4(b)(ii));
(iii) the registration of a domain name primarily for the purpose of disrupting the business of a competitor (Policy Paragraph 4(b)(iii)); and
(iv) the use of a domain name for intentionally attempting to attract, for commercial gain, Internet users to a web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's web site or location or of a product or service on Respondent's web site or location (Policy Paragraph 4(b)(iv)).

According to the Panel, the awareness of a respondent of the complainant and/or the complainant's trademark rights at the time of registration can evidence bad faith (See BellSouth Intellectual Property Corporation v. Serena, Axel, WIPO Case No. D2006-0007).

In the present case, the Respondent must have known the Complainant's trademark rights, as the word "pradaxa" has no dictionary meaning, and as the Respondent subsequent use of the domain name has clearly been targeting the Complainant's PRADAXA trademarks.

The Panel considers that the Respondent is using the domain name in bad faith, as the Respondent is using the Complainant's PRADAXA trademarks in an attempt to attract Internet users with an apparent intent of commercial gain, and with the express intent to disrupt the Complainant's business. While the Panel recognizes the Respondent's right to campaign and to conduct its campaigns by way of the internet, the Domain Name is not necessary for that purpose.

Considering the above, the Panel finds that the Complainant has made out the three elements that it must establish

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PRADAXA.LAWYER**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2016-03-04

Publish the Decision