Decision for dispute CAC-UDRP-100509

Case number	CAC-UDRP-100509
Time of filing	2012-09-25 20:57:13
Domain names	buylexaproonlinepharmacy.com

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	H. Lundbeck A/S
Organization	Forest Laboratories

Complainant representative

Organization	Wallberg IP Advice

Respondent

Organization	Giovanni Hernandez

OTHER LEGAL PROCEEDINGS

None.

IDENTIFICATION OF RIGHTS

Complainant H. Lundbeck A/S owns a large number of registered trademarks worldwide comprising the word 'LEXAPRO', inter alia the international trademark registration no. 778106 “LEXAPRO” (word) with registration date 16 March 2002. Complainant Forest Laboratories is the owner of the US trademark No. 2684432 “LEXAPRO” (word) with registration date 3 February 2003. The Respondent is located in the United States.

FACTUAL BACKGROUND

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

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. Lundbeck was founded in 1915 by Hans Lundbeck in Copenhagen, Denmark. Today Lundbeck employs approximately 6,000 people worldwide.

Lundbeck is one of the world's leading pharmaceutical companies working with brain disorders. In 2011, the company's revenue was DKK 16.0 billion (approximately EUR 2.2 billion or USD 3.0 billion).

For more information, reference is made to the official website www.lundbeck.com.
Lundbeck markets a number of different pharmaceuticals for the treatment of brain disorders. The most recently launched compounds include: Cipralex/Lexapro® (depression), Ebixa® (Alzheimer's disease), Azilect® (Parkinson's disease), Xenazine® (chorea associated with Huntington's disease), Sabril® (epilepsy), Sycrest® (bipolar disorder) and Onfi® (Lennox-Gastaut syndrome). The trademark Lexapro® is registered in more than 100 countries around the world.

1. 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 complainants hold rights. The domain name incorporates the complainants´ registered trademark combined with the generic and descriptive term "buy" as prefix and the descriptive terms "onlinepharmacy" as suffix. The Complainants claim that for the purpose of a UDRP proceeding, when a well-known and invented mark is combined with a common noun or adjective, that combination constitutes a domain name which is confusingly similar to an invented and well known mark. Also, the Complainants assert that it is an established and recognized principle under the UDRP that the presence of the .com top level domain designation is irrelevant in the comparison of a domain name to a trademark.

2. 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 complainants´ trademark Lexapro®, in a domain name or in any other manner from the Complainants, nor has the Complainants acquiesced in any way to such use or application by the Respondent. At no time did the Respondent have authorization from the Complainants to register the disputed domain name.

Further, to the best knowledge of the Complainants, 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 Complainants´ mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

Also, to the best knowledge of the Complainants 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 terms "buy" and "onlinepharmacy" 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 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.

See also CAC Case No. 100447 BUYONLINELEXAPRO.NET in which the Panels stated

“The fact that a product is available only on prescription, when the Respondent is promoting it for sale online and, by necessary implication, without a prescription, is a relevant consideration. It is particularly relevant as it shows an intention to deceive, which is the essence of bad faith and destructive of any notion that the Respondent has the right to act as it has done. Panelists under the UDRP have a wide discretion to admit evidence and to consider submissions made by the parties and in the opinion of this panelist the issue presently under discussion is relevant. In the opinion of this panelist, the issue is not outside the ambit of the UDRP as suggested in Sanofi-aventis v. Rx World, Nils Bor (supra).”

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.

3. 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 recorded country of residence of the Respondent.

The Complainants claim that because of the distinctive nature and intensive use of the Complainants´ trademark Lexapro®, and because of the specific content of the web site, the Respondent had positive knowledge as to the existence of the Complainants´ 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 Complainants´ mark as to the source, sponsorship, affiliation or endorsement of the Respondent’s website.

PARTIES CONTENTIONS

The Respondent, although repeatedly asked, did not file the Response to Complaint and did not comment anyhow the allegations made by the Complainants

RIGHTS

The Complainants have, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants have, 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 Complainants have, 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. All procedure requirements for administrative proceeding under UDRP were met.

2. The main issues under Policy are whether:

i. the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
ii. the Respondent has no rights or legitimate interests with respect to the domain names; and
iii. the domain names has been registered and is being used in bad faith.

3. The Panel reviewed carefully all documents provided by the Complainants. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning disputed domain names, namely the WHOIS databases and related trademark registration databases.

5. The Panel therefore came to the following conclusions:

a) The Complainant H. Lundbeck A/S has clearly proven that it is an international pharmaceutical company engaged in the research, development, production, marketing and sale of pharmaceuticals across the world and is one of the world's leading pharmaceutical companies working with brain disorders. Lundbeck markets a number of different pharmaceuticals for the treatment of brain disorders. The most recently launched compounds include: Cipralex/Lexapro® (depression), Ebixa® (Alzheimer's disease), Azilect® (Parkinson's disease), Xenazine® (chorea associated with Huntington's disease), Sabril® (epilepsy), Sycrest® (bipolar disorder) and Onfi® (Lennox-Gastaut syndrome). The trademark Lexapro® is registered in more than 100 countries around the world

DOMAIN NAMES TO BE IDENTICAL OR CONFUSINGLY SIMILAR

b) It is also clear that the contested domain name is confusingly similar to the trade mark Lexapro®, in which the complainants hold rights. The domain name incorporates the complainants´ registered trademark combined with the generic and descriptive term "buy" as prefix and the descriptive terms "onlinepharmacy" as suffix. It has to be confirmed by the Panel that adding generic or descriptive terms to the registered trademark cannot avoid finding of confusing similarity especially in circumstances where such generic terms refer to the field of activity of the Complainant (as the word pharmacy does).

RESPONDENT NOT HAVING RIGHTS OR LEGITIMATE INTEREST WITH RESPECT TO THE DISPUTED DOMAIN NAMES

c) It has to be stressed that it was proven by actions of the Respondent that there are no fair rights to the disputed domain name based on the fact that this being registered with an intention to attract customers of other well known domain name/registered trademark holder. By that it is also clear that there cannot be seen any legitimate interest of the Respondent.

DOMAIN NAMES HAVE BEEN REGISTERED AND ARE USED IN BAD FAITH

d) It was proven that the 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.

e) Further, 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 Complainants´ mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

f) It is therefore clear that there is a suspicious and speculative behaving of the Respondent.

g) It is therefore clear that the Respondent has registered the domain name primarily for the purpose of disrupting the business of a Complainant and therefore the Respondent is using the domain name in a bad faith. The domain name shall

be transferred to the Complainant without delay.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BUYLEXAPROONLINEPHARMACY.COM**: Transferred

PANELLISTS

Name	**Vít Horáček**

DATE OF PANEL DECISION 2012-11-15

Publish the Decision