

Decision for dispute CAC-UDRP-103802

Case number CAC-UDRP-103802

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Domain names daflon500mg.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization BIOFARMA

Complainant representative

Organization IP TWINS

Respondent

Organization Whois Privacy Corp.

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 name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of numerous trademarks worldwide for DAFLON including, but not limited to:

- Community Trademark Registration DAFLON n°010567592, dated January 17, 2012, covering products in international class 05;
- International Trademark Registration DAFLON n°554961, dated June 8, 1990, duly renewed in 2020, covering products in international class 05 and notably designating the USA and China;
- Community Trademark Registration DAFLON n°011853249, dated May 29, 2013, covering products in international classes 05 and 10.

The Complainant is also the holder of numerous domain names incorporating its DAFLON trademark, notably <daflon500.com>.

FACTUAL BACKGROUND

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

Factual and Legal Grounds :

I. The disputed domain name is identical or confusingly similar to the protected mark

The Complainant "BIOFARMA", is part of the Servier Group; the largest independent French pharmaceutical group. Servier is present in 150 countries worldwide, 100 millions of patients are treated each day with the group's various medicines.

DAFLON designates one of the Complainant's products which treats symptoms of venous insufficiency and functional signs linked to haemorrhoidal episodes. A full website dedicated to DAFLON is accessible at <https://www.daflon.fr/>.

The Complainant's trademark consists of the word "Daflon". The disputed domain name <daflon500mg.com> includes the entirety of the Complainant's trademark in attack position. The position of the "daflon" term within the domain name is important insofar as domain names are read from left to right and the average internet user will very likely identify DAFLON within the disputed domain name.

Several WIPO panel decisions have held that when a domain name wholly incorporates a complainant's registered mark, this is sufficient to establish identity or confusing similarity for the purposes of the Policy.

The second level of the disputed domain name incorporates the whole of the Complainant's registered trademark DAFLON, with the addition of the word "500mg".

The Complainant contends that the distinctive component of the disputed domain name is "DAFLON", which is the Complainant's trademark. In the present case, the addition of the term "500mg" does not lessen the inevitable confusion of the disputed domain name with the Complainant's trademark. On the contrary, the Complainant contends that the association of its trademark with "500mg" aggravates the confusing similarity of the disputed domain name with its DAFLON trademark, as "500mg" refers to one of the pill dosages applied to the drug DAFLON.

It is also well established that the specific top level of the domain name such as ".net" or ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

The disputed domain name <daflon500mg.com> as registered by the Respondent is at the very least confusingly similar to the Complainant's trademark. Therefore, the Complainant contends that the first condition of Paragraph 4(a) of the Policy is deemed satisfied.

II. The Respondent does not have any rights or legitimate interest in the disputed domain name

The UDRP Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in the disputed domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii)

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making 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.” (Policy, para. 4(c))

To the best of the Complainant’s knowledge, DAFLON has no meaning in any dictionary. Arbitrary and fanciful marks are among the strongest varieties of marks and, consequently, are generally accorded strong protection against infringement. See Merrell Pharmaceuticals Inc. and Aventis Pharma SA. v. Lana Carter, Case No. D2004-1041. The Respondent cannot claim to need the disputed domain name, or the term “daflon” for their descriptive, generic meaning.

A worldwide trademark search failed to reveal any DAFLON trademarks other than those in the name of the Complainant or its affiliates. To the best of the Complainant's knowledge, the Respondent cannot therefore claim to have trademark rights over the word "daflon".

The Complainant has no business relationship with the Respondent, who does not enjoy any license, partnership or authorization from the Complainant.

In addition, the use of the disputed domain name, which redirects towards an error page, does not show any use that would indicate a bona fide offering of goods or service attached to the disputed domain name.

The Complainant has therefore not succeeded in finding:

- any use by the Respondent or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or service either prior to or subsequent to registration of the disputed domain name;
- any prior rights of the Respondent to "Daflon" as a trademark, company name, trade or business name or any other prior use of same in the course of business;
- any indication that the Respondent has been commonly known by the domain name either as an individual, business or other organization pursuant to paragraph 4(c)(ii) of the Policy;
- any indication that the Respondent is making 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.” (Policy, paragraph 4(c)).

In light of the above developments, given that the Complainant has made a prima facie case that the Respondent lacks legitimate rights or interest in the disputed domain name, the burden of proof shifts to the Respondent, who should come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. See Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455.

Therefore, the Complainant contends that the second condition of Paragraph 4(a) of the Policy is deemed satisfied.

III. The disputed domain name has been registered and is being used in bad faith

The Policy states that for the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith (see paragraph 4(b)):

- (i) circumstances indicating that you have registered, or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark

or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location.

As stated above, "daflon" is a fanciful, arbitrary, distinctive term. The combination of the distinctiveness of the Complainant's Trademark and its extensive use makes it highly unlikely that the Respondent did not know about the Complainant before the registration of the disputed domain name.

Therefore, at the very least, the Respondent knew or should have known that, when registering and using the disputed domain name, he would do so in violation of the Complainant's earlier rights.

This is all the more true when the Respondent specifically combines "daflon" with one of its available pill dosages: "500mg". The Complainant contends that the Respondent clearly had the Complainant's trademark DAFLON in mind while registering the disputed domain name.

In light of the above and provided the absence of any authorization from the Complainant, The Complainant strongly believes that the disputed domain name was registered in bad faith by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the disputed domain name and any related service or document.

Under these circumstances, the Complainant sees no possible way whatsoever in which the Respondent would use the disputed domain name in connection with a bona fide offer of products or services.

Currently, the disputed domain name redirects towards a parking page displaying automatically generated, "pay per click" commercial links. Such use, in the context of an intensively used trademark such as DAFLON, qualifies as bad faith use according to section 4(b)(iv) of the Policy.

Without prejudice of the above and should the parking page the disputed domain name resolves to be considered a "passive use" of the disputed domain name, WIPO Overview 3.0 explicitly states that "panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding.

While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put".

As discussed in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003, the relevant issue is not limited to whether the Respondent is undertaking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith. The distinction between undertaking a positive action in bad faith and acting in bad faith may seem a rather fine distinction, but it is an important one. The significance of the distinction is that the concept of a domain name "being used in bad faith" is not limited to positive action.

In light of all the elements above, the Complainant contends that the disputed domain name was registered, was used and is being used in bad faith by the Respondent. Considering the above, the Complainant cannot imagine a good-faith registration and use of the disputed domain name by the Respondent.

Therefore, the Complainant contends that the third condition of Paragraph 4(a) of the Policy is deemed satisfied.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed 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).

This is a case of adding a generic term "500mg" to a well-established trademark and in respect of the practice that the specific top level of a domain name such as ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar, the overall conclusion of the Panel is that the disputed domain name in its entirety is confusingly similar to Complainant's trademark DAFLON.

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 disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

The Complainant has no business relationship with the Respondent, who does not enjoy any license, partnership or authorization from the Complainant. Furthermore the actual use of the disputed domain name, which redirects towards an error page, does not demonstrate any use that would indicate a bona fide offering of goods or service attached to the disputed domain name.

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 Policy).

Given the circumstances of the case, including the provided information of the use and reputation of the Complainant's trademark DAFLON and the distinctive nature of this mark, it is inconceivable to the Panel in the current circumstances that the Respondent registered the disputed domain name without prior knowledge of the Complainant and the Complainant's mark. The Panel, therefore, finds that the disputed domain name was registered in bad faith.

The disputed domain name redirects towards a parking page displaying automatically generated, "pay per click" commercial links. Whether such use is seen as "active" or "passive" holding, in the context of a well-established trademark such as DAFLON, doesn't influence on the conclusion of the Panel that the disputed domain name is being used in bad faith.

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. The three essential issues under the paragraph 4(a) of the Policy are whether:

i. the disputed 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 disputed domain name; and

iii. the disputed domain name has been registered and is being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited websites and public information concerning the disputed domain name, namely the WHOIS databases.

3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

4. The Panel, therefore, came to the following conclusions:

a) The Complainant states and proves that the disputed domain name is confusingly similar to its trademarks and its domain names. Indeed, the trademark is fully incorporated in the disputed domain name.

The disputed domain name is therefore deemed identical or confusingly similar.

b) The Respondent is not generally known by the disputed domain name and have not acquired any trademark or service mark rights in the name or mark, nor is there any authorization for the Respondent by the Complainant to use or register the disputed domain name.

The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the disputed domain name.

c) It is clear that the Complainant's trademarks and website were used by the Complainant long before the disputed domain name was registered which must have been known by the Respondent. There is no present bona fide use of the disputed domain name.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DAFLON500MG.COM**: Transferred

PANELLISTS

Name	Lars Karnoe
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DATE OF PANEL DECISION 2021-06-16

Publish the Decision
