Decision for dispute CAC-UDRP-104274

Case number	**CAC-UDRP-104274**
Time of filing	**2022-03-04 10:40:54**
Domain names	**docmorris.club**

Case administrator

Organization	**Denisa Bilík (CAC) (Case admin)**

Complainant

Organization	**DocMorris N.V.**

Complainant representative

Organization	**Diekmann Rechtsanwälte**

Respondent

Name	**Berend Janssen**

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 company DocMorris Holding GmbH with its registered office at Kurfürstendamm 57, Berlin, Germany is the registered owner of:

(a) German national trademark “DocMorris” (word), application number 304396729, registration number 30439672, applied for on July 13, 2004, and registered on December 9, 2004, for goods and services in classes 3, 5, 9, 35, 38, 42;
(b) EU trademark “DocMorris” (figurative), application number 005623608, applied for on December 29, 2006, and registered on February 11, 2008, for goods and services in classes 3, 5, 9, 16, 35, 38, 41, 42, 44;
(c) EU trademark “DocMorris” (figurative) application number 006047955, applied for on December 26, 2006, and registered on July 18, 2008, for goods and services in classes 3, 5, 9, 16, 35, 38, 41, 42, 44,
(d) EU trademark “DocMorris” (figurative), application number 006047971, applied for on December 26, 2006, and registered on July 14, 2008, for goods and services in classes 3, 5, 9, 16, 35, 38, 41, 42, 44;
(e) EU trademark "DocMorris" (word"), application number 003932423, applied for on July 14,2004 and registered on November 8, 2005, for goods and services in classes 5, 9, 35, 38, 42; and
(f) EU trademark "DocMorris" (figurative) application number 005242557, applied for on July 18, 2006 and registered on

November 22, 2007, for goods and services in classes 3, 5, 9, 16, 35, 38, 41, 42, 44.

(“Licensed Trademarks”).

As evidenced by the affidavit of Mr. Marcel Ziwica, managing director of DocMorris Holding GmbH, dated 8 March 2016, the Complainant has been licensed to use the above trademarks including enforcement of rights to such trademarks.

The disputed domain name <docmorris.club> was registered on November 26, 2021.

FACTUAL BACKGROUND

As the Respondent did not file any response to the complaint, the Panel took into account the following facts asserted by the Complainant (and supported by the documentary evidence submitted by the Complainant) and unchallenged by the Respondent:

(a) The Complainant is a limited liability company established under Dutch law with offices in Heerlen, the Netherlands. It received a permit to operate a pharmacy in September 2000. The Complainant is the full-range, well known pharmacy “DocMorris” that offers medicines from its own premises and operates the mail order pharmacy “DocMorris” under the domain <docmorris.de>;

(b) The Complainant also serves German customers who are insured under German law with the costs being charged to the cost bearers of Germany’s statutory health insurance for prescription drugs. Trading medicines requiring a prescription makes up the predominant part of the Complainant´s business, including erectile dysfunction treatment medications such as Viagra;

(c) the Complainant is the Licensee of Licensed Trademarks authorized to take steps against infringement of such Trademarks; and

(d) the disputed domain name (which is identical to the Complainant´s company name “DocMorris" and Licensed Trademarks) includes a landing page with offers for erectile dysfunction medicines using sexually explicit advertising materials. When a link to such offer is clicked, it redirects to the website http://versand-apotheke.online, where the webshop for such medicines in German language is operated. No prescription is required from customers although erectile dysfunction medicines can only be obtained on prescription in Germany.

PARTIES CONTENTIONS

In addition to the above factual assertions, the Complainant also contends the following:

(a) The disputed domain name is identical to Licensed Trademarks;

(b) the disputed domain has been registered by the Respondent without any rights or legitimate interest in the disputed domain name;

(c) the disputed domain name has been registered and is being used in bad faith. It only aims to take advantage of the Complainant´s well known European mail order pharmacy name "DocMorris" and tries to divert customers to the Respondent´s fraudulent online-shop under www.docmorris.club redirecting them to another fraudulent website or at least non-registered pharmacy; and

(d) similar case has already been decided by the Czech Arbitration Court (case no. 101707 <doktormorris.com>) where the fraudulent website in question was very similar to the one operated under the disputed domain name. In that case the Panel clearly found for the Complainant.

For these reasons the Complainant requests transfer of the disputed domain name to the Complainant or, alternatively, revocation of the disputed domain name.

RIGHTS

RIGHTS

The Panel concluded that the disputed domain name is identical to Licensed Trademark within the meaning of paragraph 4(a)(i) of the Uniform Domain Name Dispute Resolution Policy ("UDRP" or "Policy").

For details, please see "Principal Reasons for the Decision".

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.

For details, please see "Principal Reasons for the Decision".

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.

For details, please see "Principal Reasons for the Decision".

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 4(a) of the Policy requires that the Complainant proves each of the following three elements to obtain an order that the disputed domain name should be transferred or revoked:

(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 in respect of the disputed domain name; and

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

The Panel will proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in this proceeding.

RIGHTS

The Panel concludes that the disputed domain name is identical to Licensed Trademarks. Also, the Panel finds that the Complainant has been authorized by the owner of such Trademarks to take steps against infringement thereof and therefore the Complainant has the standing in this dispute.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".club") must be disregarded under the identity / confusing similarity test as it is a necessary technical requirement of registration.

Therefore, the Panel concludes that the Complainant satisfied the requirement under paragraph 4(a)(i) of the UDRP.

NO RIGHTS OR LEGITIMATE INTEREST

The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP (please see, for

example, WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

The Panel believes that such prima facie case has indeed been made by the Complainant and the Respondent provided no arguments to counter it. Similarly, to the previous case involving the Complainant (CAC case no. 101707 <doktormorris.com>) the website under disputed domain name contains links which redirect to another website where the competing products are being sold (in particular pharmaceutical products treating erectile dysfunction such as Viagra) with questionable advertising standards (sexually explicit materials) and without required prescription. This is certainly not a bona fide offering of goods and services under paragraph 4(c)(i) of the Policy and it is not a legitimate non-commercial or fair use under paragraph 4(c)(iii) of the Policy.

Therefore, 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.

BAD FAITH

From the fact that the website operated under the disputed domain name includes figurative Licensed Trademarks it clearly ensues that the Respondent was fully aware of the Licensed Trademarks and registered and uses disputed domain name in a deliberate attempt to attract, for commercial gain, Internet users to such web site, by creating a likelihood of confusion with the Licensed Trademarks. Such parasitic conduct of the Respondent is prima facie example of bad faith in registration and use of the disputed domain name under 4(b)(iv) of the Policy. Further circumstances aggravating bad faith of the Respondent are (i) use of sexually explicit materials on the website operated under disputed domain name (which is clearly unacceptable practice in advertising of prescription medicines) and (ii) sale of prescription medicines without requiring customers to show prescription.

Therefore, the Panel found that 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).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DOCMORRIS.CLUB**: Transferred

PANELLISTS

Name	**Michal Matějka**

DATE OF PANEL DECISION 2022-04-02

Publish the Decision