Decision for dispute CAC-UDRP-105197

Case number	CAC-UDRP-105197
Time of filing	2023-02-15 10:50:52
Domain names	mobic.store

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Boehringer Ingelheim Pharma GmbH & Co.KG

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	Ilgam Nurtdinov

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 the stylised word figurative mark MOBIC registered as an international mark no. 563599 in various countries and applied for on 28 November 1990. It has many national marks and a portfolio of marks worldwide.

The Complainant also owns several domain names including the word “MOBIC”, such as <mobic.info> registered since 2001.

FACTUAL BACKGROUND

The Complainant is a family-owned pharmaceutical group founded in 1885, by Albert Boehringer in Ingelheim am Rhein. BOEHRINGER INGELHEIM has become a global research-driven pharmaceutical enterprise and today has some 52,000 employees. The three business areas of the group are Human Pharma, Animal Health and Biopharmaceutical Contract Manufacturing. In 2021, the group had net sales of some EUR 20.6 billion. One of the Complainant’s products is MOBIC (generic name: meloxicam) a nonsteroidal anti-inflammatory drug (NSAID) that reduces hormones that cause inflammation and pain caused by osteoarthritis or rheumatoid arthritis.

The disputed domain name <mobic.store> was registered on 4 February 2023 and resolves to a page entitled “Buy Mobic (Meloxican) online – Best Price.” The tab “BUY SAFE” resolves to an online pharmacy entitled “Mobic – Pain Relief” where the Complainant’s MOBIC branded products are offered for sale. Nothing is known about the Respondent.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain name <mobic.store> is identical to its trademark MOBIC and the disputed domain name includes the mark in its entirety. The Complainant says the addition of the new gTLD suffix “.STORE” does not change the overall impression or prevent the likelihood of confusion.

As to Legitimate Rights and interests, the Complainant asserts that as the Respondent is not identified in the Whois as the disputed domain name, the Respondent is not commonly known by the disputed domain name. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is not related in any way with the Complainant. The Complainant has no business dealings with the Respondent. Neither licence nor authorization has been granted to the Respondent. The Complainant says the use made of the disputed domain name does not represent a bona fide offering of goods or services or a legitimate use.

As to bad faith, the Complainant contends that the disputed domain name <mobic.store> is identical to its trademark MOBIC and includes it in its entirety. Moreover, the Complainant contends that the Respondent must have been aware of the Complainant’s trademark when it registered the disputed domain name as the disputed domain name resolves to a website that makes direct reference to the MOBIC products and offer these products for sale. The Respondent deliberately sought to use their goodwill to attract Internet users seeking the Complainant's product. The Respondent has registered and used the disputed domain name in order to deceive such Internet users seeking the Complainant's product, so as to generate revenue from selling unrelated or competing pharmaceuticals. This constitutes bad faith registration and use within the meaning of the Policy. Per WIPO Case No. D2016-0823, Boehringer Ingelheim Pharma GmbH & Co. KG. v. Williams Shorell.

RESPONDENT:

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).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has not, 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

The Complainant has not, 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).

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

The Complainant contends that the disputed domain name <mobic.store> is identical to its trademark MOBIC and that the disputed domain name includes the name and mark in its entirety. The Complainant correctly contends that for the first factor under the Policy, the addition of the suffix ".STORE" is not relevant. It can be relevant to the other factors.

The Panel finds the Complainant has registered rights in a name or mark similar to the disputed domain name.

This case turns on the second factor.

The Panel accepts the Complainant's assertions that the Respondent is not affiliated with nor authorised by the Complainant. However, this is not the end of the inquiry. Under paragraph 4(a)(ii) of the Policy, a Complainant must prove that the Respondent has no rights or legitimate interests in respect of the domain name. The non-exhaustive grounds upon which it may rely are set out in paragraph 4(c) of the Policy and so the following may evidence rights or legitimate interests: (i) a bona fide offering of goods or services; (ii) being commonly known by the name; and (iii) making legitimate non-commercial or fair use of the domain name. The first category of bona fide offering encompasses third parties such as resellers, sales agents and licensees who have a right in law to use the mark in issue. The third category maps to the various defences in international trade mark norms for free speech and descriptive and nominative use of marks. Both are potentially engaged here on the face of the matter.

The Complainant submitted evidence which shows the disputed domain name is used to resolve to a page which shows the following: "Buy Mobic (Meloxican) online – Best Price" and the tab "BUY SAFE" resolves to an online pharmacy entitled "Mobic – Pain Relief" where the Complainant's MOBIC branded products are offered for sale. This is at http://worldpharm24.com/categories/Pain-Relief/Mobic

The Panel could not access the pharmacy site. But based on the evidence, the links were to advertisements for the Complainant's own drug and the drug offered at that online pharmacy was the genuine drug, made by the Complainant. The pharmacy is held out as a Canadian pharmacy. No evidence has been provided of its compliance with local law or whether it has a notice about requiring a valid prescription. The Complainant has not provided any evidence on this topic and the Panel was not able to locate that evidence in the public domain or from the site.

Purchases and imports of medicines from online foreign pharmacies for limited amounts for personal use appear (from online public resources viewed by the Panel) to be legal (in the UK at least) provided a prescription can be produced to customs on request, if any. It seems online domestic pharmacies can be legitimate in the US if they comply with basic local law requirements (which require a valid prescription, a physical address, a local license where the pharmacy is operating and a licensed pharmacist to answer questions).

See http://www.fda.gov/Drugs/ResourcesForYou/Consumers/BuyingUsingMedicineSafely/BuyingMedicinesOvertheInternet/BeSafeRxKnowYourOnlinePharmacy/default.htm.

At the FAQ. Outside the US jurisdiction, other countries legal approaches vary. This Panel therefore considers these activities can in theory be honest and bona fide.

The Panel notes also that the press release at the link given above discusses enforcement action against 9,600 websites selling unapproved prescription medicines. It is not possible on the evidence here for the Panel to determine legitimacy or compliance with relevant laws and no evidence was submitted as to this. Therefore, these matters have been disregarded in this decision.

Therefore, as noted above, this appears to be a reseller case where the pharmacy is re-selling the genuine MOBIC product even though it also stocks and offers other competing products (just as offline pharmacies do). This can be honest descriptive and nominative use. In the Panel's view, no greater commercial connection would be assumed by consumers than in the case of offline pharmacies.

Here the use appears to be use by a genuine reseller. This is the case even if the pharmacy is an unofficial or unauthorized seller, or re-seller; this is prima facie legitimate use. This flows from the test in OKI Data, WIPO Case D2001 -0903, which has four requirements: (1) actual use of the domain name to offer the goods/services; (2) use to sell only the trade marked goods; (3) a disclaimer to explain accurately the relationship (or not) with the trade mark owner; (4) not corner the market in the domain names that reflect the trade mark.

It is relevant here that the .com is not used by the Respondent and .store indicates retail sale and a seller and not the manufacturer, so the disputed domain name does not purport to "impersonate" the Complainant or corner the commercial names.

Under EU law, point (2) and (3) of the rule are too strict and as just as a bricks and mortar store can sell a range of products and advertise them by reference to their names and marks, provided it is in accordance with honest practices, so too can online stores.

In short, on the face of it, the Respondent has rights or a legitimate interest in and is making the fair use of the mark in the disputed domain name to offer the genuine item for sale under its name and mark. There is no representation that the Respondent is the Complainant or the manufacturer.

According to the WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., 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 Policy.

The Panel finds that although the Respondent has not come forward, even on the face of it, it is making fair use and so the Complainant has not satisfied its burden on this limb of the Policy.

Bad Faith usually follows the result of the finding under the second limb and in this case that also follows. The Panel finds the Complainant has not satisfied its burden on this limb of the Policy either.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **mobic.store**: Remaining with the Respondent

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2023-03-24

Publish the Decision