



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

F. Hoffmann-La Roche AG v. Transliner Consultants

Case No. D2007-1359

1. The Parties

The Complainant is F. Hoffmann-La Roche AG, Basel, Switzerland, represented internally.

The Respondent is Transliner Consultants, Koh Samui, Thailand.

2. The Domain Name and Registrar

The disputed domain name <tamiflu-buy.com> is registered with DomainHip.com.

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy"), which was adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999, and approved on October 24, 1999, and in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") as approved on October 24, 1999, and the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999, (the "Supplemental Rules").

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") in email form on September 11, 2007, and in hard copy form, along with accompanying Annexes 1-14, on September 14, 2007.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single-member panel.

After receiving the original Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on September 24, 2007, the Center requested confirmation from the Registrar as to whether the Registrar received a copy of the Complaint from the Complainant and to confirm contact and registrant information set forth in the Complaint relative to the disputed domain name. The Center also requested the Registrar to specify, for the domain name: (a) whether the Policy applies to that name, (b) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of that name, (c) the language of the registration agreement, and (d) whether that name will remain “locked” during the proceeding.

Subsequently, on September 24, 2007, the Registrar provided its response to the Center through which it specified name and contact information pertinent to the disputed domain name to the extent present in its WhoIs database, and confirmed that the Respondent is listed as the registrant for that name. The response also confirmed that: (a) eNom, Inc. is the registrar, (b) the Respondent submitted to the jurisdiction of the courts at the location of the principal office of the concerned registrar, (c) the registration agreement is in English; and (d) indicated that the name will remain locked during the proceeding. Upon the Center’s inquiry on September 27, 2007, eNom, Inc. confirmed that the domain name is registered with eNom under the DOMAINHIP registrar credential. DOMAINHIP.COM, INC. is the actual registrar that was used to register the domain name.

The Center verified that the Complaint satisfied the formal requirements of the Policy, the Rules and the Supplemental Rules.

On October 1, 2007, the Center formally notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its Exhibits, by both courier and email. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on October 1, 2007, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all the correspondence, including that between the Center and the Registrar, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on October 21, 2007, to file its Response with the Center and the Complainant.

As of October 21, 2007, the Center had not received a formal Response to the Complaint from the Respondent; hence, the Center, in an email dated October 22, 2007, notified the Respondent of its default.

Accordingly, pursuant to the Rules and Supplemental Rules, by an email letter dated October 26, 2007, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on that same day, Mr. Michaelson accepted and returned, by e-mail to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Panel finds that it was properly constituted. The Center, through an email letter dated October 31, 2007, notified the Parties of the appointment of Mr. Michaelson as Sole Panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before November 14, 2007.

This dispute concerns one domain name, specifically <tamiflu-buy.com>.

The language of this proceeding is English.

4. Factual Background

As indicated in the WhoIs registration record provided in Annex 1 to the Complaint, the Respondent registered the disputed domain name on August 12, 2007.

A. The Complainant's TAMIFLU Trademark

The Complainant owns numerous trademark registrations in more than 100 countries throughout the world for the mark TAMIFLU. The Complainant has provided, in Annex 3 to the Complaint, a copy of two of its international registrations for this mark. Pertinent details of the registrations are as follows:

- 1) TAMIFLU (stylized)
International registration 727 329
Registered: March 2, 2000 with priority to September 23, 1999

This mark was registered for use in connection with, in international class 5, antiviral pharmaceutical preparations.

- 2) TAMIFLU (block letters)
International registration 713 623
Registered: July 1, 1999 with priority to May 4, 1999

This mark was registered for use in connection with, in international class 5, antiviral pharmaceutical products.

B. The Complainant

The Complainant, together with its affiliated companies, is one of the world's leading research-focused healthcare groups in the fields of pharmaceuticals and diagnostics, and has global operations in more than 100 countries.

The mark TAMIFLU is used in conjunction with the Complainant's antiviral

pharmaceutical preparation, and specifically one designed to prevent and treat flu, including the avian flu. Over the past few years and as reported in the mass media, various governments have decided to stockpile the Complainant's product TAMIFLU for use against an epidemic of the avian flu. Consequently, the Complainant's mark TAMIFLU has attained significant notoriety.

Hard-copy printouts of the home page and various lower-level pages of the Complainant's websites at "www.roche.com", "www.tamiflu.com" and "www.rocheusa.com" respectively appear in Annexes 6, 7 and 8 to the Complaint.

C. The Respondent

The Respondent's website (hard copy printouts of the home page and lower-level pages appear in Annex 5 to the Complaint) incorporates the Complainant's marks ROCHE and TAMIFLU, and provides: (a) general information regarding the flu and the Complainant's TAMIFLU product; (b) sponsored links to third-party websites concerning flu- and non-flu-related products and services having no connection to the Complainant or its TAMIFLU product; and (c) links to various pages on one of the Complainant's websites, specifically to Complainant's "Legal Statement" and "PRIVACY Statement" located on "rocheusa.com" (copies of the pages bearing those statements appear in Annexes 9 and 10 to the Complaint, respectively).

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's TAMIFLU Marks.

Specifically, the Complainant contends that: (a) the domain name incorporates the Complainant's mark TAMIFLU; and (b) the addition of the generic word "buy", as a suffix, to the mark to form the name does not sufficiently distinguish the name from the mark.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

This lack of rights and legitimate interests is particularly evident inasmuch as the Respondent's website, by including the Complainant's marks and links to various pages on one of the Complainant's websites - all without any authorization from the Complainant, is attempting to falsely represent that it is associated with the Complainant in some fashion,

when in actuality it is not; thus fostering confusion of Internet users who visit that site.

Hence, the Respondent's only reason in registering and using the domain name is to exploit that confusion by benefiting from the reputation of the Complainant's marks and illegitimately trading on their fame for commercial gain and profit, which ostensibly does not constitute a *bona fide* offering of goods and services. Hence, the Respondent fails to qualify under paragraph 4(c)(i) of the Policy.

Further, the Complainant has neither granted the Respondent a license nor provided the Respondent with either permission or authorization to use any of the Complainant's marks, including its mark TAMIFLU, in a domain name.

(iii) Registered and Used in Bad Faith

The Complainant contends that the Respondent registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

Given that the disputed domain name was registered on August 12, 2007 - approximately 8 years after the Complainant first registered its mark TAMIFLU, the Respondent clearly had knowledge of that mark when the Respondent registered the name, hence reflecting bad faith registration.

The Respondent's actions clearly reflect bad faith use. Specifically, the Respondent through its website which bears the Complainant's marks, including its mark TAMIFLU, and which contains links to various pages on one of the Complainant's websites, is intentionally attempting to attract Internet users to the Respondent's website by confusing those users as to whether that website has some affiliation or relationship with the Complainant and then commercially exploiting that confusion by receiving click-through revenue whenever any such user engages any of the sponsored links appearing on that site.

Thus, the Respondent's use of the disputed domain name constitutes bad faith use in violation of paragraph 4(b)(iv) of the Policy.

B. Respondent

The Respondent failed to file any Response to the allegations raised in the Complaint.

6. Discussion and Findings

In view of the lack of a Response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed representations.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's TAMIFLU Marks.

From a simple comparison of the name to the marks, no doubt exists that the disputed domain name is, for all practical purposes, confusingly similar to the TAMIFLU Marks. The only differences between the name and the mark TAMILFU is the addition, as a suffix, of the generic term “buy”, and the appending of a gTLD (generic top level domain) “.com” to the mark – with the latter being totally irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that minor variations, such as adding short letter or number groups or even generic words to a mark, are each insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, adding the generic word “buy” to the mark TAMIFLU is clearly one such minor variation. See, e.g., *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064 (September 24, 2007); *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952 (August 27, 2007); *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334 (June 28, 2007); *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317 (April 24, 2007); *SPX Corp. v. Hevun Diversified Corp.*, NAF Case No. FA791657 (November 13, 2006); *Google Inc. v. Burns*, NAF Case No. FA 726096 (August 16, 2006); *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766 (September 12, 2005); *Napster, Inc. v. Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 (January 18, 2005); *Lockheed Martin Corp. v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004) and *National Collegiate Athletic Assoc. v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004); *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case No. FA 155896 (July 1, 2003); and particularly *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Case No. FA 117876 (December 16, 2002).

Such confusion, should it occur, would undoubtedly cause Internet users intending to access the Complainant’s website, but who were to reach the Respondent’s site instead, to think that an affiliation of some sort exists between the Complainant and the Respondent, when, in fact, no such relationship would exist at all. See, e.g., *Google Inc. v. Jennifer Burns*, NAF Case No. FA 726096 (August 16, 2006); *Cheesecake Factory, Napster, Caesars Entertainment, Lockheed v. Skunkworx*, and *Lockheed v. Teramani*, all cited *supra*; see also *Register.com, Inc. v. Reile*, NAF Case No. FA 208576 (January 27, 2004); *Caesars World, Inc. and Park Place Entertainment Corp. v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Case No. FA 173362 (September 16, 2003); *American Family Life Assurance Company of Columbus v. defaultdata.com aka Brian Wick*, NAF Case No. FA 123896 (October 14, 2002); *AT&T Corp. v. Abreu*, WIPO Case No. D2002-0605 (Sept. 11, 2002); *L.F.P., Inc. v. B and J Properties*, NAF Case No. FA 109697 (May 30, 2002); *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *Spence-Chapin Services to Families and Children v. Stanley Wynman*, NAF Case No. FA 100492 (December 10, 2001); *Meijer, Inc. v.*

Porksandwich Web Services, NAF Case No. FA 97186 (July 6, 2001); *MPL Communications, Limited et al v. IWebAddress.com*, NAF Case No. FA 97092 (June 4, 2001); *American Home Products Corporation v. Malgioglio*, WIPO Case No. D2000-1602 (February 19, 2001); *Surface Protection Industries, Inc. v. The Webposters a/k/a Mark's Paint Store, Inc.*, WIPO Case No. D2000-1613 (February 5, 2001); *Dollar Financial Group, Inc. v. VQM NET*, NAF Case No. FA 96101 (January 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.*, WIPO Case No. D2000-1463 (January 10, 2001); *Treeforms, Inc. v. Cayne Industrial Sales Corp.*, NAF Case No. FA 95856 (December 18, 2000); *Pep Boys Manny, Moe and Jack of CA v. E-Commerce Today, Ltd.*, e Resolution Case No. AF-0145 (May 3, 2000).

Further, by including the term “buy” with the Complainant’s mark TAMIFLU to form the disputed domain name, the potential for user confusion is likely to be exacerbated, not reduced. Using the term “buy” in conjunction with a mark, to form a domain name for a product or service designated by that mark, is calculated to lead Internet users to conclude that the site to which the name resolves is a source through which they could obtain that product or service, hence attracting users to that site. Yet, here, the Respondent’s website is not a source for the Complainant’s TAMIFLU product and, as is evident by the Respondent having no authority to use the TAMIFLU Marks, could never be one; thus increasing the potential for confusion.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s TAMIFLU Marks so as to cause confusion; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

In light of the lack of any Response, the Panel infers that no basis exists that, under the circumstances here, would legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize its mark TAMIFLU or any mark confusingly similar thereto in conjunction with the goods with which the Complainant uses that mark, nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the mark TAMIFLU or one confusingly similar thereto in connection with the identical or similar goods to those currently provided by the Complainant would violate the exclusive trademark rights now residing with the Complainant. See, e.g., *National Football League, Toilets.com, Inc.*, and *Associated Bank*, all cited *supra*; *GoDaddy.com, Inc. v. GoDaddysDomain.com, Clark Signs, Graham Clark*, WIPO Case No. D2007-0303 (May 7, 2007); *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576 (March 14, 2007); *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884 (October 14, 2005); *The Cheesecake Factory Inc., Napster and Caesars Entertainment, Inc.*, all cited *supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 28, 2004); *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360 (June 24, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services*

Corp. v. ESJ Nutritional Products, NAF Case No. FA 173362 (September 16, 2003); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, cited *supra*; *MPL Communications, Limited et al v. IWebAddress.com*, NAF Case No. FA 97092 (June 4, 2001); *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374 (December 11, 2000); and *Treeforms*, cited *supra*. Consequently, the Respondent could not legally acquire any public association between it and the mark TAMIFLU or one similar thereto, at least for the goods rendered by the Complainant, or those similar thereto.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name. Nor could the Respondent in this case ever become so known, in light of the Complainant's extensive and exclusive trademark rights, dating back approximately 8 years prior to the date (August 12, 2007) on which the Respondent registered the name, without infringing on the exclusive trademark rights of the Complainant. See, *Treeforms, Inc.*, cited *supra*.

Hence, based on the evidence before the Panel, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Moreover, since the Respondent's use of the name, which infringes the Complainant's trademark rights, does not constitute a *bona fide* use and is unquestionably commercial in nature, the Respondent's conduct does not fall within paragraphs 4(c)(i) or 4(c)(iii) of the Policy either.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) and 4(c) of the Policy.

C. Registered and Used in Bad Faith

The Panel believes that the Respondent's actions constitute bad faith registration and use of the disputed domain name.

The Panel infers, by the lack of any Response, that the Respondent was aware of the Complainant and its mark TAMIFLU when the Respondent registered the disputed domain name. Yet, in spite of that knowledge, the Respondent intentionally chose and registered the name to opportunistically exploit its potential to generate user confusion for the Respondent's eventual benefit.

In essence, by attracting Internet users to its website under false pretenses, i.e., the expectation that the site was a source for the Complainant's TAMIFLU product and/or was affiliated or related in some way to the Complainant, when in fact it was neither and could not be, the Respondent then proceeded to solicit sales from those users, via sponsored links, of third-party goods and services through which the Respondent would receive click-through revenue. By exploiting the reputation of the Complainant's mark TAMIFLU, the Respondent's website likely received increased visitor traffic and the Respondent itself received enhanced pecuniary revenue than it otherwise would have.

Hence, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy and specifically paragraph 4(b)(iv) thereof.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The disputed domain name, <tamiflu-buy.com>, is ordered transferred to the Complainant.

Peter L. Michaelson
Sole Panelist

Dated: November 14, 2007