



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

F. Hoffmann-La Roche AG v. Transliner Consultants

Case No. D2007-1347

1. The Parties

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

The Respondent is Transliner Consultants, of Surat Thani, Thailand.

2. The Disputed Domain Name and Registrar

The disputed domain name <xenical-now.com> is registered with EstDomains, Inc. (the “Registrar”).

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 10, 2007, and in hard copy form, along with accompanying Annexes 1-7, on September 13, 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 12, 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 13, 2007, the Registrar provided its response to the Center through which the Registrar 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) EstDomains, Inc. is the registrar, and (b) the registration agreement is in English; and indicated that the name will remain locked during the pendency of this proceeding. However, the Registrar stated that the Registrant had not submitted, for court adjudication, to jurisdiction at the location of the principal office of the Registrar.

In response to a Complaint Deficiency notice issued by the Center and dated September 17, 2007, the Complainant amended the Complaint to consent to court jurisdiction at the location of the domain holder's address for court adjudication. Hereinafter, the term "Complaint" will refer to the Complaint, as amended.

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

On September 18, 2007, the Center formally notified the Respondent, by email letter, 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 September 18, 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 8, 2007, to file its Response with the Center and serve a copy of the Response on the Complainant.

As of October 8, 2007, the Center had not received a formal Response to the Complaint from the Respondent; hence, the Center, in an email letter October 10, 2007, notified the Respondent of his default.

On October 11, 2007, the Respondent sent two informal emails which stated “Sorry we are going to respond but do not know procedure well enough” and “I do not understand why big company wants to take from me a property which I have paid USD 420”.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated October 12, 2007, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on October 13, 2007, Mr. Michaelson accepted and returned, by facsimile 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 17, 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 October 31, 2007. However, owing to unexpected time conflicts experienced by the Panel which constituted unforeseen circumstances, the Center, at the Panel’s request, extended the due date to November 14, 2007.

This dispute concerns one domain name, specifically: <xenical-now.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 1, 2007.

A. The Complainant’s XENICAL marks

The Complainant owns numerous trademark registrations in more than 100 countries throughout the world for the mark XENICAL. The Complainant has provided, in Annex 3 to the Complaint, copies of two illustrative international registrations for that mark. Pertinent details of those registrations are as follows:

- (1) XENICAL
International registration 699 154
Registered: October 22, 1998 with priority to April 21, 1998.

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

- (2) XENICAL
International registration 612 908
Registered: March 3, 1994 with priority to August 5, 1993.

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

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 XENICAL designates an oral prescription weight loss medication used to help obese people lose weight and maintain the weight loss. That mark enjoys a good reputation among physicians.

C. The Respondent

The Respondent provides an online pharmacy. As evidenced in Annex 5 to the Complaint by hard copy printouts of various pages from the Respondent's website, the disputed domain name apparently resolves to various pages, on that site, concerning the drug Xenical and through which Internet users can make purchases of that drug without a prescription. Those pages not only provide information and solicit sales of that drug but also provide sponsored links to third-party websites offering pharmaceutical drugs that compete with those of the Complainant or goods and services, e.g., a dating game service, that apparently are totally unrelated to either the Complainant's drug or the Complainant itself.

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 XENICAL marks.

Specifically, the Complainant contends that addition of the descriptive word "now" to the mark XENICAL to form the domain name does not sufficiently distinguish the name from the mark.

Hence, the Complainant believes that it has satisfied the identity or confusing similarity 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.

The Respondent's only reason in registering and using the domain name is to benefit from the reputation of the Complainant's mark and illegitimately trade on its fame for commercial gain and profit, which 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 permission or authorization to use the mark XENICAL in a domain name. Hence, given the Complainant's exclusive rights in the mark, the Respondent

can never become commonly known by the name or mark XENICAL. Thus, the Respondent can not qualify under paragraph 4(c)(ii) of the Policy.

(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 1, 2007, the Respondent clearly had knowledge of the Complainant's mark XENICAL when the Respondent registered the name, hence reflecting bad faith registration.

As to bad faith use, the Respondent, through its website is intentionally misleading Internet users by creating a likelihood of confusion in their minds as to whether that site is somehow associated, affiliated or has a relationship with the Complainant, and is then exploiting that confusion for its own pecuniary gain through sales of goods and services advertised on that site. This gain includes click-through revenue generated through sponsored links, on its website, to third-party sites. Hence, the Respondent is illegitimately capitalizing on the fame of the Complainant's XENICAL marks.

Furthermore, various links provided on that site direct Internet users to third-party websites offering pharmaceutical drugs unrelated to those produced by the Complainant including its Xenical drug, and thus are detrimental to the reputation of the Complainant's XENICAL marks.

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 formal Response to the allegations raised in the Complaint.

6. Discussion and Findings

In view of the lack of a formal 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 XENICAL 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 XENICAL marks. The only differences between the name and the mark XENICAL is the addition, as a suffix, of the generic term "now" preceded by a hyphen, and the appending of a gTLD (generic top level domain) ".com" to the mark – with the latter being totally irrelevant

in assessing identity or confusing similarity 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. Adding the generic-word based term “-now” is clearly such a 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 *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Case No. FA 117876 (December 16, 2002).

Furthermore, 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).

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

B. Rights or Legitimate Interests

By virtue of its default, the Respondent has not provided any basis that, under the circumstances here, would legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

No evidence exists of record that the Complainant has ever authorized the Respondent to utilize its mark XENICAL or any mark confusingly similar thereto in conjunction with the goods 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 XENICAL 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 in 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 XENICAL 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 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 some 14 years prior to the date (August 1, 2007) on which the Respondent registered the domain 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.

In light of no evidence to the contrary, the Panel infers, based on the record and the default of the Respondent, that the Respondent was well aware of the Complainant and its mark XENICAL 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 pecuniary benefit and to the Complainant's ultimate detriment.

Moreover, nothing exists on the Respondent's website which would lead any Internet user to reasonably infer other than that a connection, affiliation or relationship of some sort likely exists between the Respondent's website, or at least the portion directed to the drug Xenical, and the Complainant – when, in actuality, none exists. Thus, the Respondent's use of the name is highly likely to confuse, if not actually deceive, Internet users who visit that site but do so with the intention of visiting the Complainant's site instead. See *National Football League, Toilets.com, Inc.* and *Associated Bank*, all cited *supra*; *Christian Dior Couture v. Alex Roché*, WIPO Case No. DTV2007-0004 (June 15, 2007) and *Gerber Childrenswear*, cited *supra*.

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, <xenical-now.com>, is ordered transferred to the Complainant.

Peter L. Michaelson
Sole Panelist

Dated: November 14, 2007