

ADMINISTRATIVE PANEL DECISION

Biofarma v. Oleg A Fomin/Private Person

Case No. D2014-1920

1. The Parties

The Complainant is Biofarma of Suresnes, France, represented by Salans FMC SNR Denton Europe, AARPI, France.

The Respondent is Oleg A Fomin/Private Person of Minsk, Belarus.

2. The Domain Names and Registrar

The disputed domain names <coversyl.biz> and <vastarel.biz> are registered with Todaynic.com, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 31, 2014. On that date, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 3, 2014, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Restrictions Dispute Resolution Policy (the "RDRP"), the Supplemental Rules for Restrictions Dispute Resolution Policy (the "Supplemental RDRP Rules"), the Uniform Domain Name Dispute Resolution Policy (the "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "UDRP Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "WIPO Supplemental UDRP Rules").

In accordance with the UDRP Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint and that this proceeding commenced on November 5, 2014. In accordance with the UDRP Rules, paragraph 5(a), the due date for Response was November 25, 2014. The Respondent did not submit any response. Accordingly, the Center notified the parties of the Respondent's default on November 26, 2014.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on December 2, 2014. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the UDRP Rules, paragraph 7.

4. Factual Background

As reflected in the registration records for the disputed domain names in the Whois database (a copy of these records appear in Annex 1 to the Complaint), the disputed domain names <coversyl.biz> and <vastarel.biz> were both registered on May 5, 2014 and are both set to expire on May 4, 2015.

A. The Complainant's Marks

As indicated in the Complaint, the Complainant owns various national and international trademark registrations for the marks COVERSYL and VASTAREL in both block letters and stylized forms. In Annexes 11-14 to the Complaint, the Complainant has provided print-outs, from various publicly accessible trademark databases, of the entries for some of its registrations. These registrations include the following:

- (1) COVERSYL (block letters)
Community Trademark Registration No.: 005673827
Registered: November 19, 2007

This mark is registered for use in connection with: "Pharmaceutical and sanitary preparations; dietetic products; disinfectants, herbicides and preparations for destroying vermin" in international class 5.

- (2) COVERSYL (block letters)
International Registration No.: 453868
Registered: July 21, 1980

This mark is registered in connection with "Pharmaceutical and sanitary preparations, dietetic products, disinfectants, herbicides and preparations for destroying vermin" in international class 5, and has coverage in the countries of: France, Algeria, Rwanda, Uzbekistan, Albania, Armenia, Austria, Bosnia and Herzegovina, Bulgaria, Benelux, Belarus, Switzerland, Czech Republic, Germany, Egypt, Spain, Croatia, Hungary, Italy, Democratic People's Republic of Korea, Liechtenstein, Liberia, Morocco, Monaco, Montenegro, The former Yugoslav Republic of Macedonia, Mongolia, Mozambique, Portugal, Romania, Russian Federation, Serbia, Sudan, Slovenia, Slovakia, Sierra Leone, San Marino, Tajikistan, Ukraine, and Viet Nam.

- (3) VASTAREL (block letters)
Community Trademark Registration No.: 004367025
Registered: June 2, 2005

This mark is registered for use in connection with: "Pharmaceutical products, disinfectants, hygiene products, health and diet foods" in international class 5.

- (4) VASTAREL (block letters)
International Registration No.: 221430
Registered: June 30, 1959

This mark is registered in connection with "Pharmaceutical products, disinfectants, veterinary products, hygiene products, health and diet foods" in international class 5, and has coverage in the countries of: France, Algeria, Rwanda, Uzbekistan, Austria, Bosnia and Herzegovina, Bulgaria, Benelux, Belarus, Switzerland, Czech Republic, Germany, Egypt, Spain, Croatia, Hungary, Italy, Democratic People's Republic of Korea, Liechtenstein, Liberia, Morocco, Monaco, Montenegro, The former Yugoslav Republic of Macedonia, Mongolia, Mozambique, Poland, Portugal, Romania, Serbia, Sudan, Slovenia, Slovakia, Sierra

Leone, San Marino, and Viet Nam.

B. The Parties

The Complainant, a company belonging to Servier SAS based in France, is a major international pharmaceutical group created in 1954 having offices in more than 140 countries and more than 21,000 employees. The group's activities include research and development on pharmaceutical products and drugs, as well as the manufacturing and sale of these products. (See Annexes 4-6 to the Complaint).

Each of the disputed domain names resolves to a corresponding website which renders a webpage associated with an online pharmacy, named "Canadian Health & Care Mall". Through these pages, this pharmacy offers various pharmaceutical drugs for sale in a number of countries, including France. These drugs specifically include Coversyl and Vastarel which are manufactured by the Complainant and for which, in France, a prescription is required (see copies of webpages appearing in Annexes 8 and 9 to the Complaint). The drug Coversyl is used to treat high blood pressure; the drug Vastarel is used to treat unstable angina pectoris. Whenever a user clicks on the link "Buy Now" on either of these webpages, the user is diverted to an online pharmacy at "www.onlinedrugstore24h.com" to effectuate a purchase transaction. The "LegitScript" website, an independent third-party organization (non-governmental, non-regulatory and no relation to law enforcement) which apparently verifies Internet pharmacies, lists the "www.onlinedrugstore24h.com" pharmacy as a "Rouge Internet Pharmacy" based on its definition of that term (a copy of a salient report from the LegitScript website appears in Annex 10 to the Complaint). LegitScript categorizes an online pharmacy as a "Rouge Internet Pharmacy" if it is unapproved and:

"The sale, prescribing or dispensing of prescription or other drugs reasonably appears to intentionally or knowingly violate, facilitate the violation of, or offer to facilitate the violation of applicable laws or regulations where the drugs are dispensed from or where they are offered to be shipped to;

Does not adhere to accepted standards of medical and/or pharmacy practice, including standards of safety; and/or

Engages in fraudulent or deceptive business practices."

Here, the "www.onlinedrugstore24h.com" pharmacy is unapproved by LegitScript. Further, that pharmacy does not provide contact with a pharmacist, does not require a prescription to dispense a prescription drug, proposes a discount when an order is made, and offers other drugs, such as Viagra or Cialis whenever an order is placed.

In September 2014, as a result of a reverse Whois inquiry made by the Complainant, the Respondent was found to own 291 domain names (listed in Annex 16 to the Complaint). These names include many which, aside from a ".biz" generic Top-Level Domain (gTLD), are entirely composed of trademarked names of drugs produced by third-party pharmaceutical manufacturers, such as, e.g., <cafergot.biz> and <starlix.biz> with CAFERGOT and STARLIX being marks owned by Novartis AG; <cefadroxil.biz> with CEFADROXIL being a mark owned by Mylan Inc.; <imitrex.biz> with IMITREX being a mark owned by Glaxo SmithKline Laboratories; and <medrol.biz> with MEDROL being a mark owned by Pfizer Enterprises SARL. Copies of Whois entries for some of these domain names are provided in Annex 17 to the Complaint. Annex 18 to the Complaint contains copies of entries from publicly accessible trademark databases detailing trademark registrations for the marks: CAFERGOT, MEDROL, STARLIX, and IMITREX.

5. Parties' Contentions

A. Complainant

(i) *Bona fide* business or commercial use

The Complainant contends that the Respondent is not using either disputed domain name for a *bona fide* business or commercial purpose because the Respondent uses the disputed domain names in connection with websites that illegitimately offer the Complainant's eponymous drugs for sale, *i.e.* specifically through a rogue Internet pharmacy. Such an illicit use does not constitute a *bona fide* business or commercial use under the registration restrictions set forth in paragraph 4(a) of the RDRP and thus violates the RDRP.

(ii) Identical or Confusingly Similar

The Complainant contends that the disputed domain names are identical to the Complainant's marks COVERSYL and VASTAREL simply because each disputed domain name incorporates a corresponding mark in its entirety, while the ".biz" gTLD is ignored for the purposes of assessing identity or confusing similarity under the UDRP.

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

(iii) Rights or Legitimate Interests

The Complainant contends, for any of several reasons, that the Respondent has no rights or legitimate interests in either of the disputed domain names pursuant to paragraph 4(a)(ii) of the UDRP.

The Complainant has no relationship whatsoever with the Respondent and, as such, has not licensed the Respondent or otherwise permitted the Respondent to use any of the Complainant's marks or either of the disputed domain names.

Given the Complainant's trademark rights which predate, by quite a few years, the registration date of both disputed domain names, the Respondent was likely well aware of the Complainant's marks when it registered those disputed domain names. By virtue of these rights, the Respondent does not own and cannot lawfully obtain any right in the Complainant's marks or any words or phrases that incorporate or are confusingly similar to any of those marks at least for use in connection with goods for which those marks are registered - those goods here being pharmaceuticals. Hence and further in light of a lack of any evidence of record, the Respondent could not be and is not now commonly known by either of the disputed domain names.

Additionally, there is no evidence of record to the effect that, before any notice to the Respondent of the dispute, the Respondent's use of the disputed domain names was made or is being made in connection with a *bona fide* offering of goods or services. Rather, given the use of the disputed domain names in connection with offering the Complainant's pharmaceuticals through a rogue Internet pharmacy which is illicit and thus not a *bona fide* offering, the record reflects just the opposite.

Lastly, the record does not reflect that the Respondent is making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or tarnish the Complainant's marks.

(iv) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using each of the disputed domain names in bad faith pursuant to paragraph 4(a)(iii) of the UDRP.

Specifically, the Respondent was well aware of the Complainant's marks COVERSYL and VASTAREL when it registered the disputed domain names. Yet, in spite of that knowledge, the Respondent registered those disputed domain names with the intent to divert Internet users to a third-party rogue Internet pharmacy which illicitly sells the Complainant's products, and then so used those disputed domain names. Such diversion disrupts the Complainant's business for the Respondent's own pecuniary gain.

Further, as the Respondent's websites do not disclaim any relationship with the Complainant, Internet users who reach those sites are led to believe that a relationship of some sort likely exists between the parties, when, in fact, no such relationship exists at all, thus causing confusion and damaging the Complainant's reputation.

B. Respondent

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

6. Discussion and Findings

To justify the Complainant's request to transfer each disputed ".biz" domain name, the Complainant, having filed its complaint based on the RDRP and UDRP, must sufficiently prove, with respect to that disputed domain name, either: (a) under the paragraph 4(a) of the RDRP, that the Respondent's use of the disputed domain name is being or will not be used primarily for a *bona fide* business or commercial purpose; or (b) each element specified in paragraph 4(a) of the UDRP, *i.e.* identity/confusing similarity of that disputed domain name with a mark in which the Complainant has rights, the Respondent has no rights or legitimate interests in the disputed domain name, and the Respondent has registered and used the disputed domain name in bad faith.

(i) *Bona fide* business or commercial use

There can be little, if any, doubt that the Respondent is not using either of the disputed domain names for a *bona fide* business or commercial purpose in violation of paragraph 4(a) of the RDRP.

In that regard, the Respondent, ultimately through a third-party website which is associated with a rogue Internet pharmacy - at least so the Panel infers from the Complainant's undisputed assertions, illicitly offers the Complainant's branded products for sale. Each of these disputed domain names is entirely formed of a corresponding one of the names (Coversyl and Vastarel) of the Complainant's drugs and for which the Complainant has registered trademarks.

(ii) Identical or Confusingly Similar

The Panel finds that the disputed domain names <coversyl.biz> and <vastarel.biz> are identical to the Complainant's marks COVERSYL and VASTAREL, respectively.

From simply comparing each of the disputed domain names to its corresponding mark, no doubt exists that each disputed domain name is identical to the mark. In each instance, the only difference between the two is the addition of the gTLD ".biz" to the mark to form the disputed domain names, with that addition being generally irrelevant in assessing confusing similarity or identity under paragraph 4(a)(i) of the UDRP and thus typically ignored.

Thus, the Panel finds that the disputed domain names are identical to the Complainant's marks. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the UDRP.

(iii) Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to either of the disputed domain names under paragraph 4(c) of the Policy.

Specifically, the Complainant has never authorized the Respondent to utilize any of its marks nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. Given the exclusive trademark rights that reside in the Complainant, the Respondent could not legitimately acquire any public association between itself and either of the marks COVERSYL and VASTAREL or even any mark similar thereto, at least for the goods, here being pharmaceuticals, provided by the Complainant under those marks.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by either of the disputed domain names or more generally the marks COVERSYL or VASTAREL. Nor could the Respondent likely ever become commonly known by either of the disputed domain names or the marks, at least with respect to the goods provided by the Complainant under each mark, without infringing on the exclusive trademark rights of the Complainant. This is so in light of the Complainant's exclusive trademark rights which date back several decades (to 1980 for COVERSYL and 1959 in the case of VASTAREL) prior to the May 5, 2014 date on which the Respondent registered both disputed domain names. Needless to say, these rights and the Complainant's reputation which it developed over time in its marks substantially predate the date when the Respondent registered the disputed domain names. See, e.g., *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703. Hence, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Lastly, the Respondent's use of the disputed domain names to address its websites that divert Internet users to a rogue Internet pharmacy site where the Complainant's pharmaceutical products are illicitly sold does not constitute either a legitimate noncommercial or fair use within the ambit of paragraphs 4(c)(i) or (iii) of the UDRP.

Accordingly, based on the evidence presently before the Panel, the Respondent does not fall within any of paragraphs 4(c)(i)-(iii) of the UDRP.

Also, there is simply no evidence that the Respondent has acquired, through any other means, any rights or legitimate interests in either of the disputed domain names.

(iv) Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to each of the disputed domain names, constitute bad faith registration and use.

The Panel finds that not only was the Respondent well aware of the Complainant's marks COVERSYL and VASTAREL when it registered the disputed domain names but also, with that knowledge, it expressly registered the disputed domain names to opportunistically exploit the Complainant's reputation in its eponymous pharmaceutical products. With the names having been registered, the Respondent used its websites to which the disputed domain names resolved to intentionally divert Internet users to a third-party rogue Internet pharmacy website at which those Internet users could purchase those products. By doing so, the Respondent intentionally confused those Internet users, then seeking the Complainant's products but who were reached the Respondent's websites and ultimately were directed to the rogue Internet pharmacy "www.onlinedrugstore24h.com", into believing that the Respondent and/or the rogue pharmacy had a relation, affiliation or other legitimate connection with the Complainant when, in fact, it had no such relation, affiliation or connection whatsoever with the Complainant. As such, the Respondent, for its own pecuniary benefit, diverted sales of the Complainant's products from legitimate pharmaceutical outlets to the detriment of the Complainant and its reputation. Thus, the Respondent violated paragraph 4(b)(iii) and (iv) of the UDRP.

Furthermore, the Respondent, having registered many domain names each one being entirely formed - as here and ignoring the “.biz” gTLD - of a name of a third-party manufactured pharmaceutical drug protected by a registered trademark, exhibited a pattern of having prevented the owner of that trademark from reflecting its mark in a corresponding domain name, in this instance having a “.biz” gTLD. Hence, the Respondent’s conduct also violated paragraph 4(b)(ii) of the UDRP.

As such, the Panel concludes that, under paragraph 4(a)(iii) of the UDRP, the Respondent registered and used each of the disputed domain names in bad faith.

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

7. Decision

Accordingly, under paragraph 4(i) of both the RDRP and UDRP and paragraph 15 of the UDRP Rules, the Panel grants the relief sought by the Complainant. The disputed domain names <coversyl.biz> and <vastarel.biz> are ordered to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: December 15, 2014