Panel Decision for dispute CAC-ADREU-007080

Case number	**CAC-ADREU-007080**
Time of filing	**2016-03-18 14:03:06**
Domain names	**www.doktormorris.eu**

Case administrator

Lada Válková (Case admin)

Complainant

Organization	**DocMorris N.V.**

Respondent

Name	**Melissa Jones**

FACTUAL BACKGROUND

The Complainant is DocMorris N.V., a limited liability company registered under the law of the Netherlands. It is a pharmacy called “DocMorris” that operates in Europe and offers medicines from its own premises, though mainly sends drugs ordered remotely via its website www.docmorris.de to its customers.

The Complainant is the licensee of Apotheke DocMorris Holding GmbH with regard to the following trademarks:

- German national trademark DocMorris (word) number 304396729, applied for on July 13, 2004, and registered on December 9, 2004, for goods and services in classes 3, 5, 9, 35, 38, 42
- community trademark 800 DocMorris (word) CTM 001388529, applied for on November 18, 1999, and registered on March 29, 2005, for goods and services in classes 5, 9, 35, 38, 42
- community trademark DocMorris (word) CTM 003932423, applied for on July 14, 2004, and registered on November 8, 2005, for goods and services in classes 5, 9, 35, 38, 42
- community trademark DocMorris (figurative) CTM 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
- community trademark DocMorris (figurative) CTM 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
- community trademark DocMorris (figurative) CTM 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, and
- community trademark DocMorris (figurative) CTM 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.

The Respondent is Melissa Jones. The domain name in dispute, docmorris.eu, was registered by the Respondent on August 26, 2015. Under the domain in dispute, doktormorris.eu, the Respondent offers customers prescription medicines in the Federal Republic of Germany in the German language.

The Complainant filed its Complaint on November 9, 2015. The formal date of the commencement of the ADR proceedings was fixed by the Czech Arbitration Court as November 23, 2015, and the Complaint notified to the Respondent. The

Respondent did not respond, and a Notification of Respondent's Default was issued on February 1, 2016.

On February 12, 2016, the panelist, having filed the necessary Statement of Acceptance and Declaration of Impartiality and Independence, had been appointed.

On February 19, 2016, the Complainant was asked to provide additional evidence in the form of copies of the license agreements concerning the Community trademarks CTM 001388529, CTM 003932423, CTM 005242557, CTM 005623608, CTM 006047955, CTM 006047971, and the German trademark DE 30439672, together with an English translation thereof, and an English translation of the press release of May 25, 2013, attached as an annex to the Complaint.

On February 26, 2016, the Complainant provided the English translation of the press release of May 25, 2013. On March 9, 2016, the Complainant provided a statutory declaration dated March 8, 2016, of Mr. Marcel Ziwica, one of the managing directors of DocMorris Holding GmbH, holder of the Community Trademarks CTM 001388529, CTM003932423, CTM 005242557, CTM 005623608, CTM 006047955, CTM 006047971 and the German trademark DE 30439672, stating that the aforementioned trademarks are licenced to the Complainant DocMorris N.V. without any limitation including the right to take legal action against any trademark infringements or impairments.

A. COMPLAINANT

The Complainant claims that it is a full-range, well known pharmacy that operates throughout Europe and offers medicines from its own premises, though mainly sends drugs ordered remotely via its website www.docmorris.de to its customers. 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 drugs requiring a prescription make up the predominant part of the Complainant´s business.

The Complainant is the licensee of the following German trademarks and Community Trademarks "DocMorris": CTM 001388529; CTM 003932423; CTM 005242557; CTM 005623608; CTM 006047955; CTM 006047971 and DE 304396729 that have been licensed to the Complainant by its holding company Apotheke DocMorris Holding GmbH.

Consequently, the Complainant claims prior trademark rights to the abovementioned trademarks, pursuant to sections 4 no. 1, 14 (1) of the German Trademark Law and section 6, (9) 1 of the Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark.

The Complainant claims that he enjoys not only prior trademark rights, but also prior rights to use the name "DocMorris", as defined under section 12 of the German Civil Code (BGB), as well as prior, exclusive rights to the business designation and the well known trademark "DocMorris" within the meaning of sections 4 no. 2 and 3, 14 (1), 15 (1) of German Trademark Law, at least with respect to pharmacy services and the sale of medicines.

The Complainant claims that the sign "DocMorris" enjoys an exceedingly great notoriety - at least amongst the German public. According to a survey among 192 pharmacists, 50 decision-makers from pharmaceutical companies and 600 consumers the term "DocMorris" can claim a (brand) awareness of 62% (highest among mail-order pharmacies).

The Complainant has become aware of the registration of the domain name docmorris.eu by the Respondent. Under the domain in dispute the Respondent offers customers in the Federal Republic of Germany in German language prescription medicines without a prescription.

According to the Complainant, that existing registration causes damage to the Complainant's rights, as well as to the trademarks DocMorris, the Complainant' s company name and his domain docmorris.eu.

According to the Complainant, the domain name "doktormorris" is partially identical, at least sufficiently similar to cause confusion to the Complainant´s designation "DocMorris" to which the Complainant holds prior trademark rights. Also identical goods and services are offered under the two designations / domains. According to the Complainant, the domain in dispute is obviously solely based on the company/business designation and trademark of the Complainant´s name

"docmorris" in order to make the Complainant´s customers believe that the offers on www.doktormorris.eu are offers by the Complainant.

The Complainant claims that the risk of confusion is also established by the fact that if the search term “doktormorris.eu” is entered as part of a simple Google search, it is the Complainant´s online shop that is listed as the first search result.

According to the Complainant, the disputed domain name doktormorris.eu has been registered by the Respondent without any rights or legitimate interest. The Complainant claims that the Respondent wanted to take advantage of the name of its well-known European mail order pharmacy name “DocMorris” and tries to divert customers to the Respondent´s fraudulent online-shop under www.doktormorris.eu. In the light of the aforesaid, the registrant acted in bad faith.

The Complainant requests that the Panel issue a decision that the domain name www.doktormorris.eu be revoked.

B. RESPONDENT

The Respondent has not replied.

DISCUSSION AND FINDINGS

In order to render a decision, the Panel has to establish whether the conditions of Article 21(1) of Regulation (EC) No. 874/2004 (“the Regulation”) are satisfied.

“A registered domain name shall be subject to revocation, using an appropriate extra-judicial or judicial procedure, where that name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law, such as the rights mentioned in Article 10(1), and where it: (a) has been registered by its holder without rights or legitimate interest in the name; or (b) has been registered or is being used in bad faith.”

Established Rights:

Article 10(1) lists as relevant prior rights, inter alia, registered national and Community trademarks and, where they are protected under national law, trade names, business identifiers and company names.

The Complainant has established his rights to several trademarks mentioned above.

In addition, based on the Complainant’s evidence and historical description, it should be concluded that the Complainant’s „DocMorris” trademark and corresponding tradename have become well-known (at least in the German market) at least from May 25, 2013, that is the date of publication of the survey according to which the term "DocMorris" can claim a (brand) awareness of 62% (highest among mail-order pharmacies).

Similarity

The next step after establishing the Complainant’s prior rights to the trademarks and trade name DocMorris is deciding whether the disputed domain name is identical or confusingly similar to Complainant’s trademarks.

It is well-established that the TLD extension of a domain name, in this case “.eu”, does not affect the domain name for the purpose of determining whether it is identical or confusingly similar pursuant to Article 21 (1) of the Regulation.

Accordingly, „doktormorris” should be compared to “DocMorris”.

Both signs consist of two parts: the word “doc” / “doktor" and “morris”. Consequently, the second part of both signs is identical. With regard to the first part of the signs, i.e. the words “doc” / “doktor", it should be noted that “doc” is a well-known and often used abbreviation of the word “doctor”, and the vast majority of consumers will perceive it as such. The word “doctor” will be perceived as “doctor” by the vast majority of consumers.

In light of the above circumstances, it should be concluded that the disputed domain name is confusingly similar to the Complainant's trademarks and trade name.

Rights or legitimate interest

The Complainant contends that the Respondent has no right, including trademark or any other right, corresponding to the domain name, or any kind of legitimate interest to use the domain name. By not submitting a Response, the Respondent has failed to invoke any circumstance which could demonstrate any rights or legitimate interests in the disputed domain name.

There is nothing in the Respondent's name that indicates the Respondent has been conducting business under a trade name which may have become commonly known by the disputed domain name, or any evidence in the present record to indicate that the Respondent is making any legitimate noncommercial or fair use of the disputed domain name. On the contrary, the Respondent is using the domain to run a website which offers customers in the Federal Republic of Germany in German language prescription medicines – an activity which falls directly within the scope of the Complainant's trademark rights.

It should be therefore concluded that the Respondent has no rights or legitimate interests in respect of doktormorris.eu.

Bad Faith

As shown by the Complainant, at the time the disputed domain was registered, the Complainant had been conducting his business for a number of years, and has achieved (brand) awareness of 62% (highest among mail-order pharmacies) in Germany.

According to clause B11(f)(3) and (4) of the ADR Rules, for purposes of Paragraph B11(d)(1)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, may be evidence of the registration or use of a domain name in bad faith:

- the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor; or

- the domain name was intentionally used to attract Internet users, for commercial gain to the Respondent's website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or Community law, or it is a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the Respondent.

The Respondent's use of the domain to run a website which offers customers in the Federal Republic of Germany in German language prescription medicines – an activity which falls directly within the scope of the Complainant's activity and trademark rights - clearly shows that the domain is being used in bad faith, by intentionally choosing a domain name which would attract Internet users, for commercial gain to the Respondent's website, by creating a likelihood of confusion with the Complainant's „DocMorris" trademarks and trade name.

Therefore, it should be concluded that the disputed domain is being used in bad faith.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the domain name DOKTORMORRIS be revoked.

PANELISTS

Name	**Mariusz Kondrat**

DATE OF PANEL DECISION 2016-02-19

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: doktormorris.eu

II. Country of the Complainant: Netherlands, country of the Respondent: Germany

III. Date of registration of the domain name: August 26, 2015

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:

1. word trademark registered in Germany, reg. No. 304396729, for the term DocMorris, filed on July 13, 2004, registered on December 9, 2004, in respect of goods and services in classes 3, 5, 9, 35, 38, 42
2. word CTM, reg. No. CTM 001388529, for the term 800 DocMorris, filed on November, 18, 1999, registered on March 29,2005, in respect of goods and services in classes5, 9, 35, 38, 42
3. word CTM, reg. No. CTM 003932423, for the term DocMorris, filed on July 14, 2004, registered on November 8, 2005, in respect of goods and services in classes 5, 9, 35, 38, 42
4. figurative CTM, reg. No. CTM 005242557, for the term DocMorris, filed on July 18, 2006, registered on November 22, 2007, in respect of goods and services in classes 3, 5, 9, 16, 35, 38, 41, 42, 44
5. figurative CTM, reg. No. CTM 005623608, for the term DocMorris, filed on December 29, 2006, registered on February 11, 2008, in respect of goods and services in classes 3, 5, 9, 16, 35, 38, 41, 42, 44
6. figurative CTM, reg. No. CTM 006047955, for the term DocMorris, filed on December 26, 2006, registered on July 18, 2008, in respect of goods and services in classes 3, 5, 9, 16, 35, 38, 41, 42, 44, and
7. figurative CTM, reg. No. CTM 006047971, for the term DocMorris, filed on December 26, 2006, registered on July 14, 2008 in respect of goods and services in classes 3, 5, 9, 16, 35, 38, 41, 42, 44.
7. unregistered trademark: DocMorris
8. trade name: DocMorris

V. Response submitted: No

VI. Domain name is confusingly similar to the protected right/s of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No
2. Why: Respondent has not shown any prior rights, and is using the domain name in bad faith

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: The domain name is used for a commercial web site offering the same type of goods as the Complainant

IX. Other substantial facts the Panel considers relevant:

X. Dispute Result: Revocation of the disputed domain name

XI. Procedural factors the Panel considers relevant: