Panel Decision for dispute CAC-ADREU-008105

Case number	**CAC-ADREU-008105**
Time of filing	**2021-04-26 14:18:41**
Domain names	**androgel.eu**

Case administrator

Organization	**Denisa Bilík (CAC) (Case admin)**

Complainant

Organization	

Respondent

Organization	**Versio BV**

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel has not been made aware of any other pending or decided legal proceedings related to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is a corporation seated in Luxembourg.

The Complainant is a holder of: i) international trademark registration no. 475204 ANDROGEL (registered on March 3, 1983), and ii) international trademark registration no. 797636 Androgel (registered on February 6, 2003).

The Complainant is a registrant of the domain names: i) <androgel.fr> created on May 19, 2004 and ii) <androgel.nl> created on December 23, 2011.

The Respondent is a corporation seated in Leeuwarden, Netherlands.

The Respondent is a registrant of the disputed domain name <androgel.eu>. The disputed domain name <androgel.eu> was created on July 30, 2015, through AXC B.V. Registrar. The disputed domain serves as a portal to another website, <https://www.mijnmedicijn.net/apotheek/testosteron-gel-online-kopen/>, which is a web-shop for testosterone supplement pharmaceuticals where users may actually buy such products.

On January 12, 2021, the Complainant filed the Complaint in the subject ADR proceedings.

On January 12, 2021, EURid confirmed that the Respondent is the registrant of the disputed domain name, and that the same domain name will be locked during the pending ADR proceedings.

On January 14, 2021, the Complainant was notified about the formal deficiencies in the Complaint and was invited to provide the name of the Respondent and information regarding how to contact Respondent, or any representative of Respondent, in sufficient detail to allow the Provider to send the Complaint in accordance with ADR Rules, Paragraph A2 (a) (b) (ADR Rules, Paragraph B1 (b) (5). In this respect, the Complainant was invited to correct said deficiencies and file the amended Complaint within seven (7) days as of receiving the same notification.

On January 14, 2021, the Complainant submitted the amended Complaint.

On January 14, 2021, the Czech Arbitration Court issued a Notification on Commencement of the subject ADR proceedings.

Having been notified about the Complaint and commencement of the present ADR proceedings, the Respondent did not submit the Response within the required time period. Consequently, Notification of the Respondent's Default was issued on March 18, 2021.

Following the selection of panelist and filing of the panelist's Statement of Acceptance and Declaration of Impartiality and Independence, on March 24, 2021, the Czech Arbitration Court notified the Parties about appointment of the panel and the projected decision date.

On March 29, 2021, the Case was transmitted to the Panel for decision-making. The Panel considers itself properly constituted.

A. COMPLAINANT

The Complainant asserts that:

- Is a pharmaceutical company, founded in 1885, specialized in obstetrics, gynecology, urology and andrology;

- It owns several ANDROGEL trademarks, such as the international trademark ANDROGEL No. 475204 registered since 1983-03-03; and the international trademark ANDROGEL No. 797636 registered since 2003-02-06;

- It owns several domain names comprising the term ANDROGEL such as <androgel.fr> registered since 2004-05-19, and <androgel.nl> registered since 2011-12-23;

- It has established its brand ANDROGEL as the world leading replacement therapy for treating testosterone deficiency and has become the global leader in testosterone-based replacement therapy, with nearly two-thirds of all worldwide sales. ANDROGEL is the world's leading replacement therapy for treating testosterone deficiency. This product is indicated in adults as testosterone replacement therapy for male hypogonadism when testosterone deficiency has been confirmed by clinical features and biochemical tests. The term "Androgel" has no meaning, except in relation of the Complainant and its products;

- The disputed domain name <androgei.eu> is identical to its trademark ANDROGEL, the addition of the ccTLD ".eu" is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant's trademark, and it does not change the overall impression of the designation as being connected to its trademark;

- The Respondent has no rights or legitimate interests in respect of the disputed domain name, as the Respondent is not affiliated with nor authorized by the Complainant in any way. Namely, the Complainant does not carry out any activity for, nor has any business with, the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark ANDROGEL or apply for registration of the disputed domain name by the Complainant;

- The disputed domain name points to a website that makes direct references to ANDROGEL products and offers these products for sale. The Respondent has registered the disputed domain name with the trademark of the Complainant on the extension ".eu" only to divert internet users for commercial gain by proposing the selling of pharmaceutical drugs on its online pharmacy website and, as such, demonstrates a lack of legitimate interest in respect of the disputed domain name;

- The disputed domain name was registered and is being used in bad faith, as it is identical to its trademark ANDROGEL, and it has been registered many years after the registration of the trademarks ANDROGEL;

- The Respondent must have been aware of the Complainant's ANDROGEL trademark at the time the Respondent registered the disputed domain name, and it is reasonable to infer that the Respondent has registered and used the domain name with full knowledge of the Complainant's trademark given the fact that the website makes direct references to ANDROGEL products and places links to "BUY PRODUCTS" which direct to the online pharmacy <https://www.mijnmedicijn.net/> which also offers several medicines;

- The Respondent is in the business of the sale of pharmaceuticals, and no doubt knew of the Complainant's trademarks at the time of registration of the disputed domain name, and 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 Internet users seeking the Complainant's product, so as to generate revenue from selling unrelated or competing pharmaceuticals. There is also evidence of bad faith use, in that the Respondent is using the disputed domain names to direct Internet traffic to a for-profit on-line pharmacy that sells pharmaceuticals that directly compete with the Complainant.

B. RESPONDENT

The Respondent did not respond to the Complaint.

DISCUSSION AND FINDINGS

The Panel now proceeds to consider this matter on the merits in the light of the Complaint, the absence of a response, Regulation (EC) No. 733/2002 of the European Parliament and of the Council of 22 April 2002 on the implementation of the .eu Top Level Domain ("Regulation"), Commission Regulation (EC) No. 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and principles governing registration ("Commission Regulation"), .eu Alternative Dispute Resolution Rules of the Czech Arbitration Court ("ADR Rules") and Supplemental ADR Rules of the Czech Arbitration Court ("Supplemental Rules").

Article 22, Paragraph 1 of the Commission Regulation provides that an ADR procedure may be initiated by any party where the registration is speculative or abusive within the meaning of Article 21 of the Commission Regulation. In Article 21, Paragraph 1 of the Commission Regulation, it is stated that 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, Paragraph 1 of the Commission Regulation, 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.

Article 21, Paragraphs 2 and 3 of the Commission Regulation set out a number of circumstances which, without limitation, may be effective to demonstrate the existence of the legitimate interest within the meaning of Article 21, Paragraph 1, Point a), as well as of bad faith within the meaning of Article 21, Paragraph 1, Point b) of the Commission Regulation.

According to the Commission Regulation, ADR Rules and previous practice established in .eu ADR proceedings (see relevant decisions in cases CAC 06457, CAC 6516, CAC04478), the burden of proof is on the side of the Complainant, i.e., the Complainant must establish the existence of the aforementioned requirements envisaged in Article 21, Paragraph 1, of the Commission Regulation. The standard of proof in the majority view of .eu ADR Panels and in this Panel's view, is that an assertion is to be proven on the balance of probabilities (more likely to be true than not). With regard to legitimate interest within the meaning of Article 21, Paragraph 1, Point a), the majority view, with which this Panel concurs, and which the Complainant rightly points out, is that 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 burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If a respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied the requirement set out in Article 21, Paragraph 1, Point a) of the Commission Regulation. If the respondent does come forward with some allegations or evidence of relevant rights or legitimate interest, the panel then weighs all the evidence, with the burden of proof always remaining on the complainant.

Additionally, given the Respondent's default, and in accordance with Article B, 7, (a) of the ADR Rules, this Panel conducted its own independent investigation to the extent it deemed necessary in order to establish potential legitimate interest of the Respondent in an unbiased manner.

1. Identical or confusingly similar domain name

The first requirement under Article 21, Paragraph 1 of the Commission Regulation is to establish whether the disputed domain name is identical or confusingly similar to a name in respect of which the Complainant has the right recognized or established by national and/or Community law, such as the rights mentioned in Article 10, Paragraph 1 of the Commission Regulation ("Prior Rights"). Prior rights include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works.

In line with Article B, 1, (b), (9) of the ADR Rules, the Complainant is explicitly required to specify names in respect of which a right is recognized or established by the national law of a Member State and/or Community law.

The Complainant claims its Prior Rights on the basis of previously registered trademarks. As proof of its assertions in regards to trademark ownership, the Complainant submitted excerpts from the World Intellectual Property Office ("WIPO"), proving its ownership over international trademark registration No. 475204 ANDROGEL, registered in 1983, and international trademark registration no. 797636 Androgel, registered in 2003 (provided as annex to the Complaint). Besides its trademarks, the Complainant claims its rights in domains containing word "androgel". As proof of its assertions in regards to domain name ownership, the Complainant submitted screenshots

from the respective Registrars proving ownership over <androgel.fr> and <androgel.nl> domains (provided as annex to the Complaint).

The Panel now proceeds with assessing the level of similarity of the disputed domain name and the Complainant's registered trademarks.

When comparing the disputed domain name <androgel.eu> on one side, and the Complainant's trademarks IR475204 ANDROGEL, and IR797636 Androgel, on the other side, it is obvious that all of them contain the same word - "androgel". The Complainant states that term "androgel" has no meaning, except in relation of the Complainant and its products. Although it does not affect this proceeding and decision-making, it is the Panel's view that term "androgel", even if it is not used as such in the most spoken world languages, is actually composed of the Greek prefix for male, man, or masculine ("andro"), and the English word "gel", meaning a "semi-solid substance". The Panel does agree with the Complainant that that as such, the word has no meaning in the English language.

Among the panels, it is the consensus view that for assessing identity or confusing similarity the .eu suffix has to be disregarded. Concerning confusing similarity the panel's review consist of a comparison between the disputed domain name and the name for which a right is recognized or established by national and/or Community law (Section III. Point 1. of the Overview of CAC Panel Views on Selected Questions of the Alternative Dispute Resolution for .EU Domain Name Disputes, 2nd Edition - "CAC .EU Overview 2.0").

Regarding the Complainant's domains <androgel.nl> and <androgel.fr> on one side, and the disputed domain name, it is obvious that they all contain word "androgel". In relation to the extension .eu, and .nl / .fr, it has to be affirmed that these domain name suffixes do not have any distinctive character and therefore cannot contribute to making a substantial difference between the domain names androgel.eu and androgel.nl / androgel.fr.

Following the aforementioned, it can be concluded that the disputed domain name is identical to the Complainant's trademarks and domain names, and there is undoubtedly a high risk of confusion among consumers and in the market in general. The Panel accepts the Complainant's assertions in that sense.

Given all of the above, this Panel determines that the first requirement stipulated in Article 21, Paragraph 1 of the Commission Regulation, as well as Article B, 11, (d), (1), i) of the ADR Rules for issuing a remedy (i.e., the requirement that the Respondent's domain name be identical or confusingly similar to a name in respect of which the Complainants right is recognized or established by Member State national law and/or Union law) is fulfilled.

The Panel will now assess whether the domain name has been registered by the Respondent without rights or legitimate interest in the name, or if the domain name has been registered or is being used in bad faith.

2. Legitimate interest / Bad faith

The second requirement under Article 21, Paragraph 1 of the Commission Regulation is to establish whether the disputed domain name has been registered by the Respondent without rights or legitimate interest in the name, or if the domain name has been registered or is being used in bad faith.

a) Legitimate interest

Under Article 21, Paragraph 2, of the Commission Regulation, and Article B, 11, (e) of the ADR Rules, a legitimate interest may be demonstrated where:

- prior to any notice of the dispute (ADR procedure), the Respondent has used the disputed domain name in connection with the offering of goods and services or has made demonstrable preparations to do so;

- The Respondent, being an undertaking, organization or natural person has been commonly known by the domain name;

- The Respondent is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers;

In case of Respondent's Default, the Panel may regard factual allegations and submitted documentation of the Complainant which are not inherently implausible as being true, and consider the Default as an indication of a lack of rights and legitimate interests, and/or bad faith of the Respondent. If the Panel determines that the Complainant has lifted the burden of proof and shifted the onus to the Respondent who Defaults, the Panel will follow the evidence submitted by the Complainant.

Section IV. Point 5. of the CAC .EU Overview 2.0, provides that the overall burden of prove lies with the complainant. Cases have shown that it is often impossible for a complainant to prove negative facts because some required information in only within the knowledge of the respondent. Therefore, the complainant is only able to make a prima facie case that the respondent lacks rights and legitimate interests in the disputed domain name. The burden of proof shifts to the respondent then. If the respondent fails to show evidence of rights or legitimate interests it is deemed to have none.

The Complainant stated that the Respondent is not affiliated with nor authorized by the Complainant in any way, that the Complainant does not carry out any activity for, nor has any business with, the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark ANDROGEL or apply for registration of the disputed domain name by the Complainant. In this Panel's view, the Complainant made a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name. The Respondent did not respond to the Complaint, nor submitted any evidence to prove its legitimate interest, therefore, it can be deemed that it does not have any.

After reviewing evidence submitted by the Complainant, namely the website screenshots submitted as annexes to the Complaint, as well as by conducting an independent research, this Panel determines following facts:

- Statements placed on a webpage created under the disputed domain (i.e. "Androgel-Online Androgel Bestellen") can lead the visitor to a wrong conclusion that this page is related to the Complainant and its ANDROGEL products;

- even though the disputed domain appears to advertises/offers for selling the Complainant's products, the pictures of the products placed on this page are actually pictures of another product – TESTOGEL. At the same time, text below the pictures falsely, expressly states that the products are ANDROGEL;

- different links on the website, which expressly state "BUY PRODUCT", direct a visitor to a different website, namely <https://www.mijnmedicijn.net/apotheek/testosteron-gel-online-kopen/> (which is a web-shop through which potential customers may actually purchase the advertised TESTOGEL products manufactured by the Complainant's competitors).

The Panel concludes that the purpose of the disputed domain is not actually offering any goods or services, but it only serves as a portal through which potential customers are redirected to another website. The Respondent does not appear to be commonly known by the domain name, and the Respondent does not appear to be making a legitimate non-commercial or fair use of the domain name, whereas by using the Complainants trademark in its entirety, is actually misleading customers and directing them to a different web-shop for hormone pharmaceuticals, as is rightly stated by the Complainant.

Given that the Respondent failed to demonstrate legitimate interest by establishing even one of the elements stipulated in Article 21, Paragraph 2 of the Commission Regulation, this Panel determines that the second requirement stipulated in Article 21, Paragraph 1, Point a) of the Commission Regulation as well as Article B, 11, (d), (1), (ii) of the ADR Rules for issuing a remedy, (i.e., the requirement that the domain name has been registered by the Respondent without rights or legitimate interest in the name), is fulfilled.

The Panel would, generally, not find it necessary to argue on the question of bad faith on the side of the Respondent. However, for the sake of completeness, the Panel will further argue on the possibility of bad faith registration or use of the domain name by the Respondent below.

b) Bad faith registration

Under Article 21, Paragraph 3, Point b) of the Commission Regulation, and Article B, 11, (f) (4) of the ADR Rules, evidence of the registration or use of a domain name in bad faith may the following:

- the domain name was intentionally used to attract Internet users, for commercial gain to the Respondent's website or other online location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or European Union 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 Complainant states that the Respondent is in a business of the sale of pharmaceuticals. After commencing an independent investigation/on-line search of the Respondent, the Panel determined that the Respondent is actually in a domain name business (registering and transferring the domains). Accordingly, it is to be expected that the Respondent is familiar with relevant regulations prescribing legal requirements for registering, holding, managing and transferring the domains.

The Complainant contends that the Respondent must have been aware of the Complainant's ANDROGEL trademark at the time the Respondent registered the disputed domain name, and that it is reasonable to infer that the Respondent has registered and used the domain name with full knowledge of the Complainant's trademark given the fact that the website makes direct references to ANDROGEL products and places links to "BUY PRODUCTS" which direct to the online pharmacy <https://www.mijnmedicijn.net/> which also offers several medicines. The Respondent is using the disputed domain name to direct Internet traffic to a for-profit on-line pharmacy that sells pharmaceuticals that directly compete with the Complainant.

The Panel agrees with the Complainant in this regard, and determines that, even though the nature of the domain name is descriptive, it is extremely unlikely that the Respondent registered such a domain name by pure chance. This is further bolstered by the fact that the disputed domain name advertises the Complainant's products, making it practically impossible for the Respondent not to have known about the Complainant's trademarks and brand name products. This form of wilful blindness is, in this Panel's view and in view of the majority of ADR panelists, enough to indicate bad faith on the side of the Respondent.

In this Panel's view, the domain name was intentionally used to attract Internet users, for commercial gain, to the Respondent's domain name website and to other on-line location, by creating a likelihood of confusion with a name – ANDROGEL, on which a right is recognized or established by national and/or Community law, 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 holder of a domain name.

Therefore, this Panel determines that the third requirement stipulated in Article 21, Paragraph 1, Point b), of the Commission Regulation as well as Article B, 11, (d), (1), (iii) of the ADR Rules for issuing a remedy, i.e., the requirement that the Respondents domain name has been registered or is being used in bad faith, is fulfilled.

DECISION

For all the foregoing reasons, in accordance with Article B12 (b) of the Rules, the Panel orders that
the domain name ANDROGEL.EU be transferred to the Complainant.

PANELISTS

Name	**VUKMIR & ASSOCIATES, Mladen Vukmir**

DATE OF PANEL DECISION 2021-04-21

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: ANDROGEL.EU

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

III. Date of registration of the domain name: July 30, 2015

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. international word trademark registered in AT, BA, BX, CH, CN, CY, CZ, DE, DZ, EG, ES, HR, HU, IT, KE, KG, LI, MA, MC, ME, MK, PL, PT, RS, RU, SI, SK, SM, TJ, UA, reg. No. 475204, for the term ANDROGEL, filed on March 3, 1983, registered on March 3, 1983 in respect of goods and services in class 5.
2. international combined trademark registered in BX, CN, DZ, EG, ES, IT, MA, RU, UA, VN, GB, TR reg. No. 797636, for the mark ANDROGEL, filed on February 6, 2003, registered on February 6, 2003 in respect of goods and services in classes 5 and 38.

V. Response submitted: No

VI. Domain name is identical 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. The Respondent has no rights or legitimate interests in respect of the disputed domain name, as the Respondent is not affiliated with nor authorized by the Complainant in any way. The Respondent does not appear to be commonly known by the domain name, and the Respondent does not appear to be making a legitimate non-commercial or fair use of the domain name, whereas by using the Complainants trademark in its entirety, is actually misleading customers and directing them to a different web-shop for hormone

pharmaceuticals. The Complainant made a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name. The Respondent did not respond to the Complaint, nor submitted any evidence to prove its legitimate interest.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. The domain name was intentionally used to attract Internet users, for commercial gain, to the Respondent's domain name website and to other on-line location, by creating a likelihood of confusion with a name – ANDROGEL, on which a right is recognized or established by national and/or Community law, 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 holder of a domain name.

IX. Other substantial facts the Panel considers relevant: None

X. Dispute Result: Transfer of the disputed domain name to the Complainant

XI. Procedural factors the Panel considers relevant: None

XII. Is Complainant eligible? Yes