# Panel Decision for dispute CAC-ADREU-008471

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| Case number | CAC-ADREU-008471 |
| Time of filing | 2023-01-10 10:43:39 |
| Domain names | www.medicopharmacia.eu |

## Case administrator

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| Organization | Iveta Špiclová (Czech Arbitration Court) (Case admin) |

## Complainant

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| Organization | LENIS farmacevtika d.o.o. |
| Organization | MEDICOPHARMACIA d.o.o. |

## Complainant representative

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| Organization | Rok Jerovšek - odvetnik |

## Respondent

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| Name | Max Windler |

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

This Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name <medicopharmacia.eu> (the "Domain Name").

FACTUAL BACKGROUND

LENIS farmacevtika d.o.o. (the "Complainant 1") is a pharmaceutical distribution company established in Slovenia. The Complainant 1 is the legal successor of Medicopharmacia d.o.o. with its seat in Ljubljana, Slovenia ("Medicopharmacia Ljubljana"). On March 31, 2022, Medicopharmacia Ljubljana was merged into the Complainant 1.

The Complainant 1 is also the current majority shareholder of several entities which operate under the names incorporating MEDICOPHARMACIA term, including Medicopharmacia d.o.o. with its seat in Zagreb, Croatia (the "Complainant 2").

Medicopharmacia Ljubljana was using the MEDICOPHARMACIA company name and trade name since its establishment in 1990.

On June 23, 1999, Medicopharmacia Ljubljana registered the Slovenian trademark MEDICOPHARMACIA No. 9871438 in classes No. 5, 10, 30, 35, 39, 41, 42. This trademark registration expired on October 15, 2008.

Moreover, Medicopharmacia Ljubljana was the owner of the domain name <medicopharmacia.eu> until March 31, 2022.

The Respondent registered the Domain Name on May 11, 2022.

On August 24, 2022, the Complainant 1 sent to the Respondent a cease-and-desist letter, demanding the Respondent stop using and transfer the Domain Name to the Complainant 1. The Respondent did not respond to this letter.

On September 2, 2022, the Complainant 1 sent to the registrar of the Domain Name – SCALEWAY SAS (the "Registrar") the request for deactivation of the Domain Name. On September 5, 2022, the Registrar deactivated the Domain Name.

The Domain Name resolved previously to the website (the "Website") which copied the content of the Medicopharmacia Ljubljana's official website located at the Domain Name at the time when Medicopharmacia Ljubljana was its owner ("Medicopharmacia's Official Website") with the with the additional few lines of text. As of the date of this Decision, as well as at the time of submitting the Complaint, the Domain Name has

resolved to inactive website.

A. COMPLAINANT

The Complainants request that the Domain Name be transferred to the Complainant 1.

First, the Complainants submit that the Domain Name is identical or confusingly similar to the MEDICOPHARMACIA trademark in which the Complainants have rights.

Second, the Complainants argue that the Respondent has no rights or legitimate interests in respect of the Domain Name.

Third, the Complainants contend that the Domain Name was registered and is being used in bad faith.

B. RESPONDENT

The Respondent did not reply to the Complainants' contentions.

DISCUSSION AND FINDINGS

In order to succeed in its Complaint, the Complainants are required under Paragraph B(11)(d)(1) of the .eu Alternative Dispute Resolution Rules (the "ADR Rules"), in connection with Article 4(4) of the Regulation (EU) 2019/517 of the European Parliament and of the Council of 19 March 2019 on the implementation and functioning of the .eu top-level domain name and amending and repealing Regulation (EC) No 733/2002 and repealing Commission Regulation (EC) No 874/2004 (the "Regulation 2019/517"), to demonstrate the following:

(i) the Domain Name is identical or confusingly similar to a name in respect of which a right is recognised or established by the national law of a Member State and/or European Union law and; either

(ii) the Domain Name has been registered by the Respondent without rights or legitimate interest in the name; or

(iii) the Domain Name has been registered or is being used in bad faith.

At the outset, considering the substantive similarities between the ADR Rules and the Uniform Domain Name Dispute Resolution Policy (the "UDRP"), this Panel also refers to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") and UDRP cases, where appropriate.

**A. The Domain Name is identical to the protected rights of the Complainants**

The first element that the Complainants must establish is that the Domain Name is identical or confusingly similar to a name in respect of which a right is recognised or established by the national law of a Member State and/or European Union law.

The Panel finds that it is uncontroverted that the Complainants have established rights in the MEDICOPHARMACIA trademark based on its decades of use as well as its registered trademark for the MEDICOPHARMACIA trademark in Slovenia, although it has expired.

As noted by the Complainants, the registered company name and the trade name MEDICOPHARMACIA was used by Medicopharmacia Ljubljana – legal predecessor of the Complainant 1 – from 1990 until March 31, 2022. The registered company name and the trade name MEDICOPHARMACIA have been also used by the Complainant 2 from 1999 until today. Moreover, the company name and trade name MEDICOPHARMACIA is currently used by the subsidiaries of the Complainant 1, including the subsidiaries in Serbia, as well as in Bosnia and Hercegovina. Finally, on June 23, 1999, Medicopharmacia Ljubljana registered the Slovenian trademark MEDICOPHARMACIA No. 9871438, which is now expired.

It is constant that the term "trademark or service mark" as used in UDRP paragraph 4(a)(i), which may serve as a reference here, encompasses both registered and unregistered trademarks. See section 1.1, WIPO Overview 3.0. To establish unregistered or common law trademark rights for purposes of the UDRP, the Complainant must show that its trademark has become a distinctive identifier which consumers associate with the complainant's goods and/or services. See section 1.3, WIPO Overview 3.0.

The Panel considers that the Complainants demonstrated such acquired distinctiveness in the present case. In this regard, the Panel notes that the Complainants have used and extensively advertised its goods and services using the MEDICOPHARMACIA trademark since 1990. Thus, the Complainants' rights in the MEDICOPHARMACIA trademark predate the registration of the Domain Name by the Respondent.

The Domain Name incorporates the MEDICOPHARMACIA trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to a registered trademark (see PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS Computer Industry (a/k/a EMS), WIPO Case No. D2003-0696).

The country-code Top-Level Domain ("ccTLD") ".eu" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See WIPO Overview 3.0, section 1.11.1.

Given the above, the Panel finds that the Domain Name is identical to the MEDICOPHARMACIA trademark in which the Complainants have rights recognised or established by the national law of a Member State and/or EU law. Thus, the first requirement under Article 4(4) of the Regulation 2019/517 and Paragraph B(11)(d)(1)(i) of the ADR Rules have been satisfied.

**B. The Domain Name has been registered by the Respondent without rights or legitimate interest**

The second requirement the Complainants must prove is that the Respondent has no rights or legitimate interests in the Domain Name.

Pursuant to Paragraph B(11)(e) of the ADR Rules, any of the following circumstances, in particular but without limitation, shall demonstrate the Respondent's rights to or legitimate interests in the Domain Name for the purposes of Paragraph B11(d)(1)(ii):

(1) prior to any notice of the dispute, the Respondent has used the Domain Name or a name corresponding to the Domain Name in connection with the offering of goods or services or has made demonstrable preparation to do so;

(2) the Respondent, being an undertaking, organisation or natural person, has been commonly known by the Domain Name, even in the absence of a right recognised or established by national and/or European Union law;

(3) the Respondent is making legitimate and non-commercial or fair use of the Domain Name, without intent to mislead consumers or harm the reputation of a name in respect of which a right is recognised or established by national law and/or European Union law.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in Paragraph B(11)(e) of the ADR Rules are present in this case. On the contrary, it has been proven by the Complainants to the Panel satisfaction that the Domain Name has been registered by the Respondent without rights or legitimate interest.

As mentioned above, there are the Complainants' rights in MEDICOPHARMACIA trademark, which predate the Respondent's registration of the Domain Name. There is no evidence in the record that the Complainants have licensed or otherwise permitted the Respondent to use the MEDICOPHARMACIA trademark or to register the Domain Name incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Name.

Moreover, it does not result from the evidence in the record that the Respondent makes use of the Domain Name in connection with a bona fide offering of goods or services, or it makes a legitimate, noncommercial or fair use of the Domain Name without intent for commercial gain. On the contrary, the Domain Name resolved previously to the Website which copied the content displayed on the Medicopharmacia's Official Website located at the Domain Name at the time when Medicopharmacia Ljubljana was its owner, with the additional few lines of text. Such use of the Domain Name does not confer rights or legitimate interests on the Respondent.

Given the above, the Respondent has failed to invoke any circumstances, which could demonstrate any rights or legitimate interests in respect of the Domain Name. Thus, there is no evidence in the case file that refutes the Complainants' prima facie case. The Panel concludes that the requirement under Article 4(4)(a) of the Regulation 2019/517 and Paragraph B(11)(d)(1)(ii) of the ADR Rules has been satisfied.

**C. The Domain Name has been registered and is being used in bad faith**

Under Article 4(4)(a)-(b) of the Regulation 2019/517 and Paragraph B(11)(d)(1)(ii)-(iii) of the ADR Rules, lack of rights or legitimate interests and registration or use in bad faith are considered alternative requirements for a successful complaint. As the Panel has found that the Respondent lacks rights or legitimate interests in the Domain Name no further discussion on bad faith registration or use is necessary.
Nevertheless, the Panel finds it highly likely that the Respondent was aware of the Complainants' rights in MEDICOPHARMACIA trademark at the time of registration of the Domain Name. As indicated above, the Complainants' rights in the MEDICOPHARMACIA trademark predate the registration of the Domain Name. This Panel finds that the Respondent was or should have been aware of the Complainants' trademark at the time of registration of the Domain Name. This finding is supported by the content of the Website copying the content of the Medicopharmacia's Official Website. Moreover, the Respondent registered the Domain Name shortly after the previous registration of the Domain Name by Medicopharmacia Ljubljana was terminated. Finally, it has been proven to the Panel's satisfaction that the MEDICOPHARMACIA trademark is well-known and unique to the Complainants. Thus, the Respondent could not likely reasonably ignore the reputation of services and products under this trademark. In sum, the Respondent in all likelihood registered the Domain Name with the expectation of taking advantage of the reputation of the MEDICOPHARMACIA trademark in which the Complainants have rights.

Moreover, the Domain Name is used in bad faith by the Respondent to attract Internet users to the Website impersonating Medicopharmacia Ljubljana by copying the content of its historic Official Website. By reproducing the Complainants' MEDICOPHARMACIA trademark in the Domain Name, as well as displaying the content of the Medicopharmacia Official Website on its Website, the Respondent intends to profit from the confusion created with Internet users. In consequence, the Panel finds that the evidence in the record demonstrates that the Respondent uses the Domain Name deliberately in order to take advantage of the Complainants' reputation and to give credibility to its operations.

Finally, on August 24, 2022 the Complainant 1 sent to the Respondent a cease-and-desist letter, demanding the Respondent stop using and transfer the Domain Name to the Complainant 1. The Respondent did not respond to this letter, which is further evidence of bad faith.

For the reasons discussed above, the Panel finds that the condition set out in Article 4(4)(b) of the Regulation 2019/517 and Paragraph B(11)(d)(1)(iii) of the ADR Rules has also been satisfied.

To sum up, all the requirements established in Paragraph B(11)(d)(1) of the ADR Rules, in connection with Article 4(4) of Regulation 2019/517, have been met in the present case.

In addition, according to Paragraph B(11)(b) of the ADR Rules, the Complainant 1 – being an undertaking that is established in the European Union (Slovenia) – satisfies the general eligibility criteria set out in Article 3 of Regulation 2019/517.

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DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name <www.medicopharmacia.eu> be transferred to the Complainant 1 - LENIS farmacevtika d.o.o.

This Decision shall be implemented by the Registry within thirty (30) days of the Parties being notified of the Decision, unless the Respondent initiates court proceedings in a Mutual Jurisdiction (see Paragraphs B12(a) and B14 of the ADR Rules) and informs the Registry thereof in due time.

## PANELISTS

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| Name | **Piotr Nowaczyk** |

DATE OF PANEL DECISION 2023-03-15

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: <medicopharmacia.eu>

II. Country of the Complainant 1: Slovenia; country of the Complainant 2: Croatia; country of the Respondent: Poland

III. Date of registration of the domain name: May 11, 2022

IV. Rights relied on by the Complainant (Art. 4(4) of the Regulation 2019/517) on which the Panel based its decision:

1. the registered company name and the trade name MEDICOPHARMACIA used by Medicopharmacia Ljubljana – legal predecessor of the Complainant 1 – from 1990 until March 31, 2022;

2. the registered company name MEDICOPHARMACIA used by the Complainant 2 from 1999 until today;

3. the company name and trade name MEDICOPHARMACIA currently used by the subsidiaries of the Complainant 1, including the subsidiaries in Serbia, as well as in Bosnia and Hercegovina;

4. the Slovenian Trademark Registration MEDICOPHARMACIA (figurative) No. 9871438 registered on June 23, 1999 in classes No. 5, 10, 30, 35, 39, 41, 42, which expired on October 15, 2008.

V. Response submitted: No

VI. The Domain Name is identical to the protected rights of the Complainants in the MEDICOPHARMACIA trademark.

VII. Rights or legitimate interests of the Respondent (Art. 4(4)(a) of the Regulation 2019/517):
1. No
2. Why: -

There are the Complainants' rights in MEDICOPHARMACIA trademark which predate the registration of the Domain Name by the Respondent. There is no evidence in the record that the Complainants have permitted the Respondent to use the MEDICOPHARMACIA trademark or to register the Domain Name incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Name.

Moreover, it does not result from the evidence in the record that the Respondent makes use of the Domain Name in connection with a bona fide offering of goods or services, or it makes a legitimate, noncommercial or fair use of the Domain Name without intent for commercial gain. On the contrary, the Domain Name resolved previously to the Website which copied the content displayed on the Medicopharmacia's Official Website located at the Domain Name at the time when Medicopharmacia Ljubljana was its owner, together with few lines of additional text. Such use of the Domain Name does not confer rights or legitimate interests on the Respondent.

Although given the opportunity, the Respondent has not submitted any evidence demonstrating the rights or legitimate interests with respect to the Domain Name.

VIII. Bad faith of the Respondent (B(11)(e) ADR Rules):
1. Yes
2. Why: -

The Respondent was or should have been aware of the Complainants' trademark at the time of registration of the Domain Name. This finding is supported by the composition of the Domain Name, as well as the content of the Website copying the content of the Medicopharmacia's Official Website. Moreover, the Respondent registered the Domain Name shortly after the previous registration of the Domain Name Medicopharmacia Ljubljana terminated. Finally, it has been proven to the Panel's satisfaction that the MEDICOPHARMACIA trademark is well known and unique to the Complainants.

Moreover, the Domain Name is used in bad faith by the Respondent to attract Internet users to the Website impersonating Medicopharmacia Ljubljana by copying the content of its historic Official Website. In sum, the Panel finds that the evidence in the record demonstrates that the Respondent uses the Domain Name deliberately in order to take advantage of the Complainants' reputation and to give credibility to its operations.

Finally, the Respondent's failure to respond to the cease-and-desist letter sent by the Complainant 1 is further evidence of bad faith.

IX. Other substantial facts the Panel considers relevant: -

X. Dispute Result: Transfer of the Domain Name

XI. Procedural factors the Panel considers relevant: -

XII. [If transfer to Complainant] Is Complainant 1 eligible? Yes