Panel Decision for dispute CAC-ADREU-004132

Case number	CAC-ADREU-004132
Time of filing	2007-02-01 16:02:19
Domain names	acompliaoriginal.eu, acompliacapsules.eu, acompliapills.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	SANOFI-AVENTIS, Mrs. Carole TRICOIRE

Respondent

Organization / Name	DE JONG M.

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 informed of other legal proceedings.

FACTUAL BACKGROUND

The Complainant, a French pharmaceutical company, was created by Sanofi-Synthelabo's 2004 acquisition of Aventis shares.

On February 16, 2004, during an information meeting, which the content was dispersed on Internet, the Complainant announced early results of two Phase III studies with new Acomplia product (Complainant trademark), indicating that overweight and obese patients with untreated dyslipidemia lost weight in one year while improving their lipid and glucose profiles, and that smokers who had previously unsuccessfully tried to quit smoking, were able to quit in 10 weeks without post cessation weight gain.

These results were presented to the scientific community at the American College of Cardiology annual meeting in New Orleans on March 9, 2004.

The Complainant filed several trade mark applications for ACOMPLIA in more than 100 countries including The Netherlands. The CTM trade mark registration for Acomplia has been filed on December 2, 2003.

The Complainant also registered numerous domain names worldwide containing the ACOMPLIA trade mark, for example www.acomplia.eu, www.acomplia.fr, www.acomplia.com etc.

On April 7, 2006, the Respondent registered the three domain names <acompliaoriginal.eu>, <acompliacapsules.eu>, <acompliapills.eu>

On April 28, 2006, the Complainant sent a cease and desist letter to the Respondent, requiring the transfer of the contentious domain names. The Respondent did not answer to this letter

On November 13, 2006, the Panel decided to grant request to change the language of the ADR proceeding so that the language of the proceedings is English (see Sanofi-Aventis v. De Jong, case n°3177).

A. COMPLAINANT

Complainant has a valid ground, since it satisfies the criteria set up within article 21 of the Public Policy Rules (EC Regulation 874/2004) which deals with speculative and abusive registration, and provides 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(1) 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.

1. The domain names <acompliacapsules.eu>, <acompliaoriginal.eu>, and <acompliapills.eu> are confusingly similar to the ACOMPLIA trademarks.

2. The Respondent should be considered as having no right or legitimate interest in respect of the domain names <acompliacapsules.eu>, <acompliapills.eu>, <acompliaoriginal.eu>.

The Complainant has prior rights in the ACOMPLIA trademarks, which precede the Respondent's registration of the disputed domain names.

3. The domain names should be considered as having been registered and used in bad faith:

- the Respondent has no prior right and no authorization given by the Complainant concerning the ACOMPLIA trademarks;
- the Respondent's awareness that ACOMPLIA is a revolutionary drug against obesity;
- the addition of generic words to the ACOMPLIA trademarks misleading Internet users since it makes them believe they are official web sites of the Complainant.
- the registration of a multiple domain names containing the ACOMPLIA trademark,
- the contentions domain names lead to no active web site.

B. RESPONDENT

The Respondent did not reply to the Complainant's contentions.

DISCUSSION AND FINDINGS

1. The domain names <acompliacapsules.eu>, <acompliaoriginal.eu>, and <acompliapills.eu> are confusingly similar to the ACOMPLIA trademarks for the following reasons:

The Respondent's registration consists of the Complainant's trademarks with the adjunction of generic words such as the "capsules", "pills" and "original" and the tld ".eu".

Regarding ADR cases, panelists have already considered that the addition of generic words to trademarks was not sufficient to escape the finding of similarity and does not change the overall impression of the designations of the designations as being connected to the Complainant. For instance, the domain names <volvobil.eu> and <volvogroup.eu> are considered confusingly similar to the trademark VOLVO, being understood that the Swedish word "bil" means "car" (Case n°01954).

Therefore, there is no doubt that the reproduction of the trademark ACOMPLIA, as the sole distinctive element of the domain names concerned, generates confusion. Indeed, persons accessing the domain name would be bound to think that the domain names have a connection with the Complainant.

Furthermore, the addition of the TLD ".eu" which is required for registration of a domain name, has no distinguishing capacity in the context of the domain name and does not alter the value of the trademark represented in the domain name.

Consequently, because of this identity, there is a high risk of confusion, since a consumer may think that the domain names directly refer to the Complainant or its products.

2. Complainant owns trademarks for ACOMPLIA in 100 countries including The Netherlands, where the Complainant is located. The CTM

trade mark registration for Acomplia has been filed on December 2, 2003.

The Complainant has prior rights in the ACOMPLIA trademarks, which precede the Respondent's registration of the disputed domain names.

3. The Respondent should be considered as having no right or legitimate interest in respect of the domain names <acompliacapsules.eu>, <acompliapills.eu>, <acompliaoriginal.eu>.

The disputed domain names are not used by the Respondent, since the contentious domain names do not lead to any active web site.

The Respondent does not use the domain names in connection with the bona fide offering of goods or services. Furthermore, there is no license, consent or other right by which the Respondent would have been entitled to register or use the domain names incorporating the Complainant's trademark.

Since the contentious domain names contain the generic words "capsules" or "pills", there is no doubt that the Respondent is aware that ACOMPLIA corresponds to a medical product and therefore to a trademark. Indeed, the Respondent would have not registered the disputed domain names if they had not known that ACOMPLIA was a revolutionary drug against obesity.

As a result the Respondent, who has no right and legitimate interest in respect of the domain names <acompliacapsules.eu>, <acompliapills.eu>, <acompliaoriginal.eu> has registered these domain names with the intention to divert consumers and to prevent the Complainant from reflecting the mark in corresponding domain names.

4.The domain names has been registered in bad faith:

- The Respondent has no prior right and no authorization given by the Complainant concerning the ACOMPLIA trademarks. Thus, the registrations of the disputed domains name have not been made with bona fide intention.

- The Respondent knowing the Complainant plan to market a revolutionary drug under the name of ACOMPLIA, by the Complainant, registered the litigious domain names.

Various panelists considered that the fact to register a domain name after the Complainant product launch leads to an inference of bad faith (see WIPO case n°D2003-0011 Medestea Internazionale S.r.l. v. Chris Gaunt; WIPO case n°D2001-1043 America online Inc v. Chan Chunkwong; WIPO case n°D2001-0043 Guardant Inc v. youngcho kim).

Indeed, in the present case, there is no doubt that the Respondent knowing the launch of a new product under the trademark ACOMPLIA by the Complainant, has registered the contentious domain names in order to prevent the Complainant, from reflecting the mark in corresponding domain names.

It is an opportunistic act, which seek to disrupt the Complainant's business.

It is also important to state that the mere holding of a domain name that is identical or confusingly similar to a trademark belonging to a third party, in itself, can be considered disrupting the business of the right owner.

- The addition of generic words to the ACOMPLA trademark misleads internet users since it makes them believe that the product is available or that they are the official web sites of Sanofi-Aventis

The contentious domain names consist of the Complainant trademarks and the addition of the generic words such as "capsules", "pills" or "original".

- The registration of multiple domain names including the Complainant trademarks

The registration of multiple domain names including the Complainant trademarks is also evidence of bad faith (see WIPO Case No D2000-0351, WIPO Case No D2001-0108).

- The contentious domain names lead to no active web site

The fact that the contentious domain names do not lead to any active web site also support the bad faith of the Respondent.

In that respect, the Panel ordered the transfer of the domain name <glendimplex.eu> to the Complainant, considering, in particular, that the passing holding of a domain name inferred registration or use in bad faith (see Glen Dimplex Uk Ltd v. Zheng Qingying, case n°02325).

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name ACOMPLIAORIGINAL, ACOMPLIACAPSULES, ACOMPLIAPILLS be transferred to the Complainant

PANELISTS

Name	Ignace Vernimme

DATE OF PANEL DECISION 2007-06-01

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant filed several trade mark applications for ACOMPLIA in more than 100 countries including The Netherlands. The CTM trade mark registration for Acomplia has been filed on December 2, 2003.

The Complainant also registered numerous domain names worldwide containing the ACOMPLIA trade mark, for example www.acomplia.eu, www.acomplia.fr, www.acomplia.com etc.

On April 7, 2006, the Respondent registered the three domain names <acompliaoriginal.eu>, <acompliacapsules.eu>, <acompliapills.eu>

Complainant has a valid ground, since it satisfies the criteria set up within article 21 of the Public Policy Rules (EC Regulation 874/2004).

The domain names <acompliacapsules.eu>, <acompliaoriginal.eu>, and <acompliapills.eu> are confusingly similar to the ACOMPLIA trademarks.

The Complainant has prior rights in the ACOMPLIA trademarks, which precede the Respondent's registration of the disputed domain names.

The Respondent should be considered as having no right or legitimate interest in respect of the domain names <acompliacapsules.eu>, <acompliapills.eu>, <acompliaoriginal.eu>.

The domain names should be considered as having been registered and used in bad faith:

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