Panel Decision for dispute CAC-ADREU-004722

Case number	CAC-ADREU-004722
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Domain names	sustiva.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	BRISTOL-MYERS SQUIBB PHARMA COMPANY, .

Respondent

Organization / Name	Hanoki, Ltd., Hanoki, Ltd.

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 is not aware of any legal proceedings which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant is the owner of several trademarks containing name “sustiva”.

The Respondent registered the domain name “sustiva.eu”. The Complainant requests that the domain name “sustiva.eu” be revoked in compliance with the meaning of Article 22(11) of the Commission Regulation (EC) 874/2004.

A. COMPLAINANT

1. FACTUAL GROUNDS

The Complainant as the successors-in-interest of companies E.R. Squibb & Sons, Bristol-Myers and DuPont Pharmaceuticals Company, is a US pharmaceutical company dedicated to research and production of medicines for human use. With the acquisition of DuPont Pharmaceuticals Company in 2001, the Complainant added “Sustiva” medicine to its portfolio.

“Sustiva” is a brand name of a pharmaceutical product for human use, non-nucleoside reverse transcriptase inhibitor for treatment for HIV and AIDS, produced by the Complainant. The product is distributed and well known among healthcare professionals worldwide.

The Complainant, owner of the domain name sustiva.com, is the holder of numerous trademarks throughout the world intended to protect the “Sustiva” denomination, including in Europe – these are, inter alia, (i) Austrian Trademark “Sustiva” (word), Reg. No. 169299, application date: 21 February 1997, registration date 16 April 1997; (ii) BeNeLux Trademark “Sustiva” (word), Reg. No. 607899, application date: 24 February 1997, registration date: 4 November 1997; (iii) Czech Trademark “Sustiva” (word), Reg. No. 209211, application date: 25 February 1997, registration date: 28 April 1998; (iv) French Trademark “Sustiva” (word), Reg. No. 97665304, application date: 24 February 1997, registration date: 1 August 1997; (v) German Trademark “Sustiva” (word), Reg. No. 39707938, application date: 22 February 1997, registration date: 22 April 1997; (vi) UK Trademark “Sustiva” (word), Reg. No. 2124440, application date: 20 February 1997, registration date: 29 August 1997 and (vii) Community Trademark “Sustiva” (combined word and design), Reg. No. 969717, application date: 27 October 1998, registration date: 24 February 2000. These trademarks constitute rights to the name within meaning of the Article 10 of the Commission Regulation (EC) 874/2004.

On April 7, 2006, the Respondent registered the domain name sustiva.eu, which is not used by the Respondent. As a consequence, the Complainant requests revocation of the domain name based on Article 21 of Commission Regulation (EC) No 874/2004.

2. LEGAL GROUNDS

The contested domain name should be revoked within the meaning of Article 21 of the Commission Regulation (EC) 874/2004 as it is (i) 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) of the Commission Regulation (EC) 874/2004, and since it (ii) has been registered by the Respondent without rights or legitimate interest therein as well as because (iii) it has been registered and is being used in bad faith.

2.1 Identity to Complainant Trademarks

The above listed trademarks registered by the Complainant constitute sufficient rights established and recognized by national and/or Community law as mentioned in the 10(1) of the Commission Regulation (EC) 874/2004. Thus, it can be concluded that the domain name is identical to various Complainant's trademarks.

2.2. Respondent Has No Rights or Legitimate Interest regarding the Domain Name

The Respondent has registered the domain name without any rights or legitimate interest in the domain name. The Respondent has obviously no trademark rights, right to a company name or any other right (as mentioned in the Article 10(1) of the Commission Regulation (EC) 874/2004), which could legitimate registration of the domain name.

To the Complainant's best knowledge, prior to any notice of an alternative dispute resolution (ADR) procedure the holder of the domain name has neither used the domain name in connection with the offering of goods or services, nor made demonstrable preparation to do so. The Respondent has not been commonly known by the domain name; in fact the Respondent's company name is utterly different from the contested domain name. There is no website or any other content available on the internet address consisting of the disputed domain name. Apparently, the Respondent is not using the domain name at all. In light of the above, it can be concluded that the Respondent is not making legitimate and non-commercial, or fair use of the domain name.

In light of the foregoing, the Respondent has registered the domain name without rights or interest to it within the meaning of the Article 21(2) of the Commission Regulation (EC) 874/2004.

2.3 Disputed Domain Name Has Been Registered in Bad Faith

The Complainant obtained registration of the cited trademark rights prior to the date on which the Respondent registered the disputed domain name. The Complainant's rights to the trademarks are prior to the Respondent's rights in the domain name.

It is very likely that the Respondent was aware of the Complainant's trademark registration or of the Complainant's pharmaceuticals labeled therewith. In addition, to the Complainant's best knowledge, the name "Sustiva" has no meaning either in English and or in any other language. It was artificially created by the Complainant for its pharmaceutical products. For this reason, the Complainant finds it very unlikely that the Respondent would have registered the domain name (consisting of such uncommon and imaginative name) by a pure coincidence.

In light of the above, circumstances indicate that the Respondent has registered the domain name primarily for purposes of "cyber squatting," i.e. for purposes of selling, renting or otherwise transferring the domain name to the Complainant, who has recognized rights to the name that constitutes the domain name.

Moreover, a strong argument can be made that the Respondent tried to take advantage of the Complainant's reputation and well-known status of the "sustiva" brand in the area of pharmaceutical products in order to attract and mislead consumers who would be confused by the identity of names. In light of the foregoing, the Respondent has registered the domain name in bad faith within meaning of the Article 21(3) of the Commission Regulation (EC) 874/2004.

Therefore, the Complainant requests that the domain name "sustiva.eu" be revoked in compliance with meaning of Article 22(11) of the Commission Regulation (EC) 874/2004.

B. RESPONDENT

The Respondent has not responded to the Complaint.

DISCUSSION AND FINDINGS

According Article B11(d)(1) of the ADR Rules the Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that the Complainant proves in ADR proceeding where the Respondent is the holder of the domain name in respect of which the Complaint was initiated that

(i) the domain 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 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.
Article 21(1) of the Commission Regulation (EC) 874/2004 of 28 April 2004 contains similar provision.

I. Condition according to Article B11(d)(1)(i) of the ADR Rules

The Complainant submitted several excerpts from the trademark registers to prove the existence of the registered trademarks containing the name “sustiva”. The word element “sustiva” is the most distinctive part of the combined (word/image) Community trademark (No. 969717). Besides that, the several Complainant’s trademarks are word trademarks with the only word “sustiva” (e.g. Austrian trademark No. 169299, BeNeLux trademark No. 607899, Czech trademark No. 209211, French trademark No. 97665304). It may be stated that “sustiva” is a dominant element of all these trademarks.

Without a doubt, the Complainant has proven the existence of its rights to the name “sustiva” as recognized by national law of a Member State (e.g. Austrian, BeNeLux, Czech, French, German and UK trademarks) and Community law (CTM 969717) consisting of a dominant element “sustiva”.

The Panel therefore came to the conclusion that the domain name “sustiva.eu” is identical with the prevailing element of the trademarks of the Complainant. Therefore, the Panel concludes that the condition set forth under Article B11(d)(1)(i) of the ADR Rules has been fulfilled. This conclusion could not be affected by the existence of the suffix “.eu” as a part of the “sustiva.eu” domain name, as this suffix is not relevant for the consideration of the identity and similarity of the domain name as stated in ADR 596 (RESTAURANTS), ADR 475 (HELSINKI) and ADR 387 (GNC) decisions.

II. Condition according to Article B11(d)(1)(ii) of the ADR Rules

The Complainant contends that the Respondent has no rights or legitimate interest in the domain name. The Panel is of the opinion that it is very difficult for the Complainant to prove the non-existence of rights or legitimate interest of the Respondent. It is predominantly upon the Respondent to demonstrate the existence of his rights or legitimate interest in the domain name, but the Respondent has not responded to the Complaint at all. Therefore, the Panel had to review the existence of the Respondent’s right or legitimate interest on the basis of Complainant’s arguments and evidence only.

The legitimate interest is defined in more detail in Article 21(2) of the Commission Regulation (EC) 874/2004 (and similarly in Article B11(e) of the ADR Rules) which contains a demonstrative enumeration of the circumstances which may prove the rights or legitimate interest.

The Complainant proved that the domain name is not used for the purposes of the website (there is no website or any other content available on the internet address consisting of the “sustiva.eu” domain name) nor any other service connected to the domain names. The Panel concludes that it has not been demonstrated that the Respondent has really used the domain name prior to the notice of an ADR procedure in connection with the real offer of goods or services. Furthermore, it has not been demonstrated that the Respondent has made demonstrable preparation to do so (Article B11(e)(1) of the ADR Rules).

Furthermore, it has not been proven that the Respondent has been commonly known by the domain name (Article B11(e)(2) of the ADR Rules), nor was making a legitimate and non-commercial or fair use of the domain name without intent to mislead consumers or harm the reputation of a name on which a right is recognized or established (Article B11(e)(3) of the ADR Rules).

No circumstance demonstrating the existence of right or legitimate interest of the Respondent has been proven. Therefore, the Panel concludes, that the domain name “sustiva.eu” has been registered by the Respondent without rights or legitimate interest in the name.

III. Condition according to Article B11(d)(1)(iii) of the ADR Rules

The Complainant contends that the Respondent registered and uses the domain name in bad faith. The bad faith is defined in more detail in Article 21(3) of the Commission Regulation (EC) 874/2004 (and similarly in Article B11(f) of the ADR Rules) which contains a demonstrative enumeration of the circumstances which may prove the registration or use of a domain name in bad faith.

The bad faith of the Respondent follows from:

(a) high degree knowledge of the name “sustiva” as being a name of the pharmaceutical product, and from the fact that the Respondent registered at least one other domain name which he had no rights or legitimate interests in – see ADR 04108 (YOUNGLIFE) – the Panel is of the opinion that the domain name “sustiva.eu” has been registered in order to prevent the Complainant (or its affiliates) from reflecting this name in the corresponding domain name. Furthermore, the pattern of such conduct of the Respondent is demonstrated by the above mentioned ADR decision. Therefore, the condition set up in Article 21(3)(b)(i) of the Commission Regulation (EC) 874/2004 is met;

(b) the fact that word “sustiva” has most likely no meaning either in English and or in any other language, was created by the Complainant for its products and it would be very unlikely that the Respondent would have registered the domain name consisting of such imaginative name by a pure coincidence.

(c) the fact that there is no website, and most likely any other service, accessible via domain name “sustiva.eu” and the “sustiva.eu” domain name is therefore in fact used to prevent the Complainant from reflecting “sustiva” word in the corresponding domain name. Therefore, the Panel concludes, that the domain name 4711.eu has been registered by the Respondent in bad faith.

The Complainant has satisfied the requirements of the Article 21(1) of Commission Regulation (EC) 874/2004 and Article B11(d)(1) of the ADR Rules. Therefore, the Panel finds the Complaint as justified.

DECISION

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

the domain name SUSTIVA be revoked.

PANELISTS

Name	**Petr Hostas**

DATE OF PANEL DECISION 2008-03-03

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant is the owner of several national and Community trademarks with dominant (or only one) word element “sustiva”. The domain name “sustiva.eu” registered by the Respondent is therefore identical with the prevailing element of the trademarks of the Complainant.

The Respondent has not responded to the Complaint and has not provided the Panel with any evidence demonstrating the existence of Respondent’s rights or legitimate interest in the name “sustiva.eu”. Besides that, from the evidence provided by the Complainant, no circumstance demonstrating the existence of right or legitimate interest of the Respondent has been proven. Therefore, the Panel concluded, that the domain name “sustiva.eu” was registered by the Respondent without rights or legitimate interest in the name.

Furthermore, the Panel is of the opinion that the domain name “sustiva.eu” was registered by the Respondent in bad faith as it has been highly probably registered in order to prevent the Complainant from reflecting this name in the corresponding domain name as the name “sustiva” is known as a name of the pharmaceutical products, is an imaginative name created by the Complainant for the purposes of his products, and is not used for the purposes for any website nor any other service accessible via domain names.

From these reasons, registration without rights or legitimate interest and registration in bad faith, the Panel decided in favor of the Complainant and ordered that the domain name be revoked.