Panel Decision for dispute CAC-ADREU-004733

Case number	CAC-ADREU-004733
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Domain names	tamiflu.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	F. Hoffmann-La Roche AG, Mr. Jérôme Rhein

Respondent

Organization / Name	Anastasios Karkazis

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 other pending or decided legal proceedings relating to the disputed domain name.

FACTUAL BACKGROUND

The Complainant filed a complaint regarding the domain name <tamiflu.eu> (the "domain name") on 2007-10-30. The domain name was registered by the Respondent on 2007-07-21, as confirmed by the Eurid verification.

The Complainant and its affiliates operate in the pharmaceutical industry in more than 100 countries. It is the owner of the mark TAMIFLU for Pharmaceutical antiviral products and for which it owns trademark registrations in many countries, including Greece (filing date 1999-05-25) and other EU countries.

The Respondent registered the domain name <tamiflu.eu> which currently hosts a website of the domain name broker SEDO (www.sedo.com). The website displays links to products in the pharmaceutical sector.

A. COMPLAINANT

Complainant's contentions are as follows:

1. The domain name is identical to a trademark or service mark in which the Complainant has rights;

The Complainant’s mark TAMIFLU is protected as a trademark worldwide, including in Greece, for an antiviral pharmaceutical preparation. The Domain Name of the Respondent is identical to the Complainant’s mark.

The notoriety of the mark is further evidence of likelihood of confusion.

2. The Respondent has no rights or legitimate interests in respect of the domain name;

The Complainant has exclusive rights to the mark TAMIFLU and has not licensed or otherwise authorized its use to the Respondent.

The Respondent is not using the domain name in connection with an offering of goods or services, but to divert Internet users to a search engine with sponsored links.

The website at the domain name <tamiflu.eu> seems to be part of the Domain Name Parking Programme of SEDO GmbH, a German Internet Service provider which offers domain name holders the opportunity to earn pay-per-click-revenues for redirecting Internet users

to third parties' websites: "it is commonly known that these parking systems are offered by the internet service providers in order to offer the domain name holder profit by way of pay-per-click revenues (cf. ADR 2727 "STAEDTLER") and therefore solely as alternative to the "site under construction" design".

The Complainant cites Decision ADR 4526 "PLACEMENT, EMPRUNT".

Respondent's only reason for registering and using the contested Domain Name is to benefit from the reputation of the trademark TAMIFLU and illegitimately trade on its fame for commercial gain and profit.

3. The domain name was registered and is being used in bad faith.

The Complainant claims bad faith registration of the domain name since, at the time of the registration (2007-07-21), the defendant had knowledge of the Complainant's well-known product/mark TAMIFLU.

The Complainant cites WIPO Case No. D2005-1288 ("with the widespread fame of the TAMIFLU mark it is simply not credible to believe that Respondent registered the disputed domain name without knowledge of Complainant's mark. Only someone with knowledge of the mark – considering the fact that the mark is an invented term – could have registered the disputed domain name. Thus, Respondent registered the disputed domain name in bad faith").

The domain is also being used in bad faith. According to the Complainant, "this is obvious since when viewing the Internet-website from the Respondent … one realizes that Respondent is intentionally attempting (for commercial purpose) to attract Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's well-known mark as to the source, affiliation and endorsement of Respondent's website or of the products or services posted on or linked to Respondent's website.

The domain name leads Internet users to advertising links to websites promoting and/or offering products and services of third parties, especially in the pharmaceutical field being the business of the Complainant.

As the WIPO Arbitration and Mediation Center pointed out in UDRP Case No. D2005-0623 "L'Oréal, Biotherm, Lancôme Parfums et Beauté & Cie v. Unasi, Inc", "such exploitation of the reputation of trademarks to obtain click-through commissions from the diversion of Internet users is a common example of use in bad faith as referred to in paragraph 4(b)(iv) of the Policy and identified in many previous decisions"".

The first of the circumstances set out in Art. 21(3)(a) of Reg. 874/2004 as indicative of bad faith is also clearly present, namely:

"circumstances indicate that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name in respect of which a right is recognized or established by national and/or Community law or to a public body".

On the website, there is an information, including a link, mentioning that the domain is for sale.

"The fact that the corresponding website has no content of its own but rather contains only a series of links to other sites is also an indication that the sole reason for the Respondent's registering the domain name was in fact to offer it for sale, there being no circumstances in these proceedings which would allow it to be assumed that the Respondent has made or will make legitimate use of the domain name" (cf. ADR 2781 "KOELN2010" , Annex 9 p.6).

B. RESPONDENT

The Respondent's complete response to the complaint (except for the annex mentioned below) is the following:

"Dear Sir/Madam,

I bought this domain at an auction through Realtime.at and had no idea that a trademark existed. I have also another similar domain named birdflu.gr.

Before this ADR was filed, I received an offer through SEDO.com to sell this domain for euros 1,012. However, I refused as I did not know the identification of the buyer. During this time, I searched for EU trademark rights, but I did not find any. Hence, I received e-mails from the complainant but the supporting information send, did not convince me that EU rights existed.

Should the panelist decides that there are previously legitimate EU rights to this domain name, then I have no option but to loose this domain together with the euros 1,012 offered to me previously.

Best Regards,
Anastasios Karkazis"

DISCUSSION AND FINDINGS

According to Article 22(11) of Regulation 874/2004, the Panel must determine whether the registration of the disputed domain name is speculative or abusive as defined in Article 21 of that Regulation.

A registration of a domain name is speculative or abusive if the domain name "is identical or confusingly similar to a name in respect of which a right is recognised or established by national or Community law" and where it (a) has been registered by its holder without rights or legitimate interest; or (b) has been registered or is being used in bad faith.

The Panel is of the view that, if the .eu suffix is discounted, the disputed domain name is identical to the Complainant's "TAMIFLU" mark, protected since 1999 in several EU countries, including Greece, the country where the Respondent is located. Accordingly, the Panel finds that the first requirement of the definition of speculative or abusive registration is satisfied.

Regarding the question of whether the Respondent has a legitimate interest in the domain name, Article 21(2) of Regulation 874/2004 states that "a legitimate interest may be demonstrated where, prior to any notice of an … ADR procedure, (a) the holder of a domain name has used the domain name … in connection with the offering of goods or services or has made demonstrable preparations to do so; (b) [it] has been commonly known by the domain name …; (c) [it] is making a legitimate and non-commercial or fair use of the domain name….". These circumstances are not exhaustive.

The Complainant has established prima facie that the Respondent does not meet any of the above requirements. Further, in its Response, the Respondent does not put forward any legitimate interest that it may have to the domain name.

In fact, the Response seems to indicate that the Respondent does not have any right or legitimate interest. According to the Response, the Respondent registered the domain name simply because it was available. Further, the Respondent would accept losing the domain name if the Complainant showed "previously legitimate EU rights". As mentioned above, the Complainant has clearly established rights to the mark TAMIFLU predating the Respondent's registration of the challenged domain name.

Therefore, the Panel finds that the Respondent has no right or legitimate interest in the disputed domain name.

For the above reasons, the Panel finds that the registration of the domain name <tamiflu.eu> is speculative or abusive as defined in Article 21 of Regulation 874/2004.

Since the Respondent has no right or legitimate interest in the disputed domain name, it is unnecessary to consider whether the domain name was registered or is being used in bad faith. However, the evidence shows a strong indication that the domain name was registered and is being used in bad faith as set out in Regulation 874/2004 article 21(3)(a) and (d). The Panel is of the opinion that it is highly unlikely that the Respondent was not aware of the name TAMIFLU. Besides the existence of trademark rights of the Complainant in Respondent's home country (Greece), Complainant's product has been widely advertised in the media.

Remedy

Article 22(11) of Regulation No. 874/2004: "In the case of a procedure against a domain name holder, the ADR panel shall decide that the domain name shall be revoked, if it finds that the registration is speculative or abusive as defined in Article 21. The domain name shall be transferred to the complainant if the complainant applies for this domain name and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002."

Paragraph B.1(b)(12) of the ADR Rules: "If the Complainant requests transfer of the domain name, [it shall] provide evidence that the Complainant satisfies the general eligibility criteria for registration set out in Paragraph 4(2)(b) of Regulation (EC) No 733/2002;"

Paragraph B.11(b) of the ADR Rules: "The remedies available pursuant to an ADR Proceeding where the Respondent is the Domain Name Holder in respect of which domain name the Complaint was initiated shall be limited to the revocation of the disputed domain name(s) or, if the Complainant satisfies the general eligibility criteria for registration set out in Paragraph 4(2)(b) of Regulation (EC) No 733/2002,

the transfer of the disputed domain name(s) to the Complainant."

Paragraph 4(2)(b) of Regulation (EC) No 733/2002 setting out the general eligibility criteria requires a .eu domain name registrant to meet at least one of the following: (i) undertaking having its registered office, central administration or principal place of business within the Community, or (ii) organisation established within the Community without prejudice to the application of national law, or (iii) natural person resident within the Community.

In its Complaint, the Complainant seeks the transfer of the domain name to "a Complainant's subsidiary located in an EU based territory" (the Complainant does not identify any such subsidiary). The Complainant is based in Switzerland. Hence its request to transfer the domain name to an entity than the Complainant itself. Admittedly, the Complainant is not eligible in accordance with Regulation (EC) No 733/2002.

The provisions cited above indicate that when the Complainant requests the transfer of the domain name, it (and not a related company) must satisfy the general eligibility criteria for registration, which is not the case here. Even if the Complainant had specified a subsidiary within the EU, the Panel notes that none of the above provisions supports the transfer of the domain name to a legal entity other than the Complainant (see also ADR.eu cases 3465 ROTARY, 3924 XANGO). Therefore, the domain name cannot be transferred as requested by the Complainant.

However, in view of the Panel's finding that the registration of the domain name <tamiflu.eu> by the Respondent is speculative or abusive, the Panel orders that the domain name be revoked.

DECISION

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

the domain name TAMIFLU be revoked

PANELISTS

Name	José Checa

DATE OF PANEL DECISION 2007-12-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The domain name was registered by the Respondent on 2007-07-21.

The Complainant and its affiliates operate in the pharmaceutical industry in more than 100 countries. It is the owner of the mark TAMIFLU for Pharmaceutical antiviral products and for which it owns trademark registrations in many countries, including Greece (filing date 1999-05-25) and other EU countries.

The Panel is of the view that, if the .eu suffix is discounted, the disputed domain name is identical to the Complainant's "TAMIFLU" mark.

The Complainant established prima facie that the Respondent does not have any right or legitimate interest in the domain name. The Respondent did not put forward any legitimate interest that it may have to the domain name. Therefore, the Panel finds that the Respondent has no right or legitimate interest in the disputed domain name.

Further, the evidence presented shows a strong indication that the domain name was registered and is being used in bad faith.

The Complainant seeks the transfer of the domain name to "a Complainant's subsidiary located in an EU based territory".

The Panel notes that no provision supports the transfer of the domain name to a legal entity other than the Complainant. Therefore, the domain name cannot be transferred as requested by the Complainant.

However, in view of the Panel's finding that the registration of the domain name <tamiflu.eu> by the Respondent is speculative or abusive, the Panel orders that the domain name be revoked.