Panel Decision for dispute CAC-ADREU-005174

Case number	**CAC-ADREU-005174**
Time of filing	**2008-08-28 09:54:16**
Domain names	**lunesta.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**Sepracor, Inc.**

Respondent

Organization / Name	**Adil Akkus**

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 legal proceedings relating to the disputed domain name.

FACTUAL BACKGROUND

The Complainant, Sepracor, Inc., is a research based pharmaceutical company located in Marlborough, Massachusetts, USA. The Complainant's business is dedicated to treating and preventing human disease by discovering, developing, and commercialising innovative pharmaceutical products.

The Respondent is Adil Akkus, an individual based in the UK.

The Respondent registered the domain name 'lunesta.eu' (the 'Domain Name') on 16 May 2008.

The Complainant filed its Complaint with the Czech Arbitration Court on 28 August 2008.

On 4 September 2008, the case administrator at the Czech Arbitration Court sent a notification to the Complainant asking it to address a number of minor deficiencies in its Complaint. These deficiencies were then swiftly addressed by the Complainant.

On 8 September 2008, ADR proceedings were formally commenced and a notification of such was sent to the Respondent.

On 19 September 2008, a non standard communication was submitted by the Respondent. This was followed up by a non standard communication submitted by the Complainant on 9 October 2008 which attached email correspondence between the Complainant's representative and the Respondent.

On 15 October 2008, a 'Response' form was submitted through the ADR.eu online platform. The content of this Response consisted of a simple message directed to the Complainant's representative. It appears, however, that this message was generated by the Respondent's Registrar, and not by the Respondent or on the Respondent's behalf.

The Czech Arbitration Court issued a Notification of the Respondent's Default on 11 November 2008, as the 'Response' filed was deficient in a number of respects.

On 14 November 2008, the Complainant filed a non standard communication attaching some brief email correspondence between the Complainant's representative and the Respondent's registrar.

On 20 November 2008, having received a Statement of Acceptance and Declaration of Impartiality, the Czech Arbitration Court appointed Steve Palmer as the Panel in these ADR proceedings.

A. COMPLAINANT

The Complainant seeks the transfer of the Domain Name to its subsidiary in Ireland: Sepracor Pharmaceuticals Limited.

It is submitted that the Domain Name is identical or confusingly similar to LUNESTA - a trade mark in which the Complainant has rights.

The Complainant states that, through extensive use and advertising of the LUNESTA prescription sleep drug, the LUNESTA mark has developed a very strong reputation among consumers as being associated with a well-respected brand of prescription sleep drug.

The Complainant states that the LUNESTA trade mark is 'well known' and 'famous' throughout the European Union, United States and worldwide (however, no substantive evidence was filed in support of this claim).

The Complainant has over thirty registered and pending trade mark applications around the world, which contain or consist of the LUNESTA mark. This includes the Complainant's Community Trade Mark for LUNESTA (word mark), registered under number 5454351 in Class 5 for 'pharmaceutical preparations for the prevention and treatment of sleep disorders'.

The Complainant also owns numerous country specific domain names featuring the LUNESTA mark.

As the disputed Domain Name is identical to a trade mark in which the Complainant has rights, the Complainant is not required to demonstrate confusion. Even so, it is highly likely that consumers who wish to gain access to online information about the LUNESTA brand of sleep drug in the European Community and elsewhere will access the Domain Name and be confused.

The Respondent cannot seek to distinguish the Domain Name on the basis that it contains the .eu suffix. The Domain Name is identical to Complainant's LUNESTA trade mark in all material respects, and there is an obvious likelihood of confusion between the Domain Name and Complainant's registered trade mark.

The Respondent has no rights or legitimate interests in respect of the Domain Name. In this regard:
- the domain name does not resolve to any website;
- the Respondent is not commonly known by the name 'Lunesta', a word which is fanciful and used only in connection with the Complainant's pharmaceutical products;
- there is no legitimate non-commercial use being made of the Domain Name, and in fact, there is no use of the name at all;
- the Complainant has never licensed or otherwise permitted the Respondent to use the Complainant's LUNESTA trade mark, nor to register any domain name including the LUNESTA trade mark;
- there is no relationship between the parties; and
- the Respondent registered the Domain Name without the authorisation, knowledge, or consent of the Complainant.

In conclusion, therefore, the Respondent has no legitimate interest or rights in the Domain Name.

The Complainant is not required to establish bad faith on the part of the Respondent, given that the Respondent has no rights or legitimate interest in the Domain Name (paragraph B.11(d)(1) of the ADR Rules). However, the evidence clearly establishes that the Respondent also registered the Domain Name in bad faith. In this regard:
- the domain name is identical to the Complainant's LUNESTA trade mark, and other domain names owned by the Complainant;
- the Respondent must have known of the Complainant's prior rights in the LUNESTA mark when registering the domain name, as the LUNESTA mark is famous and well-known throughout the world;
- the Domain Name is made up entirely of the Complainant's fanciful word mark LUNESTA, which has no meaning other than as the Complainant's product name, so it would be very unlikely that the Respondent registered the Domain Name by pure coincidence;
- registration of the Domain Name with knowledge of the Complainant's prior rights is evidence of a clear effort, on the Respondent's part, to create a likelihood of confusion and to fool the public into thinking that any website at that domain name would be connected to, affiliated with, or sponsored by the Complainant;
- the lack of a website accessible via the Domain Name establishes that the Domain Name is being used to prevent the Complainant from reflecting its trade mark in the corresponding domain name;
- the mere holding of a domain name that is identical or confusingly similar to a trade mark belonging to a third party, in itself, can be considered disrupting the business of the right owner, and is therefore evidence of bad faith; and
- The fact that the Respondent does not have an active website at the Domain Name, when coupled with the facts described above, clearly establishes bad faith.

Finally, Article 22(11) of Commission Regulation (EC) No. 874/2004 ('Public Policy Rules') states that a disputed 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 (the '.eu Regulation'). Further, paragraph B.11(b) of the ADR Rules provides that the remedies available pursuant to this proceeding include transfer of the disputed domain name to the Complainant as long as the Complainant satisfies the general eligibility criteria for registration set out in Paragraph 4(2)(b) of the .eu Regulation.

Article 4(2)(b) of the .eu Regulation provides that the Registry shall register domain names in the .eu TLD requested by (i) any undertaking having its registered office, central administration or principal place of business within the Community, or (ii) any organisation established within the Community without prejudice to the application of national law, or (iii) any natural person resident within the Community. The Complainant states that it meets this requirement as it has subsidiaries located in both Ireland and in the United Kingdom. In this regard, the Complainant requests that the Domain Name be transferred to Sepracor Pharmaceuticals Limited, a company which is registered in Ireland.

B. RESPONDENT

In his non standard communication of 19 September 2008, the Respondent states:
- he received documents in these proceedings '…with astonishment…' and that he has never before heard of the Domain Name;
- that '…I am not sure how my address has made it to your records (or potentially into the whois records) but I am in no way affiliated with this domain name… I certainly am not the owner of this domain name nor do I have any claim over it…'; and
- that he would like the 'misunderstanding... resolved at once'.

In an email to the Complainant's representative (on 29 September 2008), the Respondent then states '…mistery [sic] solved. One of my friends had registered this. He is asking for $50 and is quite happy to transfer it'. The offer to transfer the Domain Name to the Complainant was then reduced to USD25 (Respondent's email of 2 October 2008). However, both of these offers were rejected by the Complainant's representative as 'inappropriate' and 'improper' demands for money.

DISCUSSION AND FINDINGS

*** Preliminary issue***

As a preliminary issue, and having regard to paragraphs B.7(b), B.7(d) and B.8 of the ADR Rules, the Panel has decided to admit and consider the contents of the following non-standard communications submitted by the two parties in these proceedings:

- the Respondent's sole non-standard communication (filed 19 September 2008). This document appears to have been filed in direct response to the Complaint and is of relevance to the case. In the Panel's view, it would be unfair not to take notice of this non-standard communication; and

- The Complainant's non-standard communication (filed 9 October 2008) attaches email correspondence between the Complainant's representative and the Respondent. This correspondence follows on from the Respondent's non-standard communication and is of relevance to the case. In the circumstances, it would be unfair not to take notice of this email correspondence. Further, as the email correspondence was produced after the (amended) Complaint was filed by the Complainant, it should be allowed on this basis that the Complainant could not reasonably have known the existence or relevance of the further material when it made its primary submissions.

However, the Panel has decided it shall not consider the contents of the defective Response (filed 15 October 2008), nor the contents of the email correspondence attached to the Complainant's non standard communication of 14 November 2008. The reason being that these documents relate to comments made by the Respondent's Registrar, and not by the Respondent himself (nor on the Respondent's behalf).

*** Identical or confusingly similar Domain Name ***

The first requirement of Art 21(1) Public Policy Rules is, in the Panel's view, satisfied.

The Domain Name is identical to the Complainant's CTM which is registered for the word mark LUNESTA. The '.eu' suffix serves no relevant distinguishing purpose. As such, the Panel does not need to consider whether or not the Domain Name is identical or confusingly similar to the myriad of other rights which were claimed and/or put forward in evidence by the Complainant's representatives.

*** No rights or legitimate interest ***

The Domain Name shall be subject to revocation if it has been registered by the holder without rights or legitimate interest in the name (Art 21(1)(a) Public Policy Rules).

On the evidence made available to (and accepted by) the Panel, it appears to the Panel that the holder of the Domain Name does not have any rights or legitimate interest to the Domain Name. Art 21(2) Public Policy Rules sets out a list of factors which may demonstrate a legitimate interest (the mirror provisions found at paragraph B.11(e) of the ADR Rules). It is not necessary in this case for the Panel to go through the list of factors in detail (save to say that it is clear that none of those factors are present in this case) as the Respondent, in his non standard communication of 19 September 2008, expressly disclaims any right of ownership and/or 'claim over' the Domain Name. Further, whilst it is true that the Respondent then claimed that the Domain Name was in fact registered by one of his 'friends', the Respondent failed to elaborate any further on this point; other than to offer, on behalf of this so-called friend, to sell the Domain Name to the Complainant for a nominal sum.

The Panel therefore concludes that, on the balance of probabilities, the Domain Name was registered by its holder without rights or legitimate interest in the name. The registration is therefore speculative or abusive, and should be subject to revocation under Art 21(1)(a) Public Policy Rules.

Bad faith

In view of the Panel's finding under Art 21(1)(a), it is not necessary to consider whether the Domain Name is also subject to revocation under Art 21(1)(b) Public Policy Rules (which requires a finding that the Domain Name was registered or is being used in bad faith).

Transfer or revocation

Article 22(11) Public Policy Rules provides that the Domain Name shall be transferred to the Complainant if the Complainant applies and satisfies the general eligibility requirements.

Paragraph B.1(b)(12) of the ADR Rules states that '…if the Complainant requests transfer of the domain name, [the Complainant shall] provide evidence that the Complainant satisfies the general eligibility criteria for registration set out in Paragraph 4(2)(b)' of the .eu Regulation.

Paragraph B.11(b) of the ADR Rules states that the '…remedies available pursuant to an ADR Proceeding …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 the .eu Regulation], the transfer of the disputed domain name(s) to the Complainant'.

It is therefore clear from this that the Panel can only transfer the Domain Name to the Complainant, and only where the Complainant satisfies the general eligibility criteria as set out in 4(2) of the .eu Regulation. In this regard, Article 4(2) of the .eu Regulation states that the '…Registry shall… (b) register domain names in the .eu TLD through any accredited .eu Registrar requested by any: (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…'.

The Complainant requests transfer of the Domain Name to its Irish subsidiary - on the basis that it satisfies the general eligibility requirements of Article 4(2)(b) of the .eu Regulation. This request cannot be accepted: Article 22(11) of the Public Policy Rules provides that the domain name shall be transferred to the Complainant if the Complainant applies and satisfies the general eligibility requirements. There is no provision for transferring the domain name to another legal entity, even if that entity is a subsidiary of the Complainant. The domain name must therefore 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 LUNESTA be revoked

PANELISTS

Name	**Steve Palmer**

DATE OF PANEL DECISION 2008-12-22

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant owns a Community Trade Mark registration for LUNESTA in class 5.

The disputed Domain Name is not being used and the Respondent disclaims any right to the Domain Name.

The Complainant, a US company, requests transfer of the Domain Name to its Irish subsidiary.

The Panel finds that the Domain Name is identical to a name in which the Complainant has a right recognised by Community law, and that the Respondent has no right or legitimate interest in it. The registration is therefore speculative or abusive under Article 21 of the Public Policy Rules.

However, as there is no provision to transfer the domain name to an entity other than a successful Complainant, and that the Complainant does not meet the eligibility requirements of Article 4(2)(b) of the .eu Regulation, the Domain Name must be revoked.