

DISPUTE RESOLUTION SERVICE

D00010884

Decision of Independent Expert

Astellas Pharma Europe Ltd.

and

Soluan Investments Ltd.

1. The Parties:

Lead Complainant: Astellas Pharma Europe Ltd.
Lovett House
Lovett Road
Staines
Middlesex
TW18 3AZ
United Kingdom

Respondent: Soluan Investments Ltd.
28th October Street 319
Limassol
Limassol
3105
Cyprus

2. The Domain Name(s):

astellas-europe.co.uk (the "Domain Name")

3. Procedural History:

The Complaint was submitted to Nominet on 7 February 2012. On 8 February 2012, Nominet validated the Complaint and notified it to the Respondent. The Respondent was informed in the notification that it had 15 working days, that is, until 29 February 2012 to file a response to the Complaint.

The Respondent did not file a response and the case did not proceed to the mediation stage. On 1 March 2012, the Complainant paid the fee for referral of the matter for an expert decision pursuant to paragraph 8 of Nominet's Dispute Resolution Service Procedure Version 3 ("the Procedure") and paragraph 7 of the corresponding Dispute Resolution Service Policy Version 3 ("the Policy").

On 12 March 2012, Andrew D S Lothian, the undersigned, ("the Expert") confirmed to Nominet that he was not aware of any reason why he could not act as an independent expert in this case. Nominet duly appointed the Expert with effect from 7 March 2011.

4. Outstanding Formal/Procedural Issues

The Respondent has failed to submit a response to Nominet in time in accordance with paragraph 5(a) of the Procedure.

Paragraph 15(b) of the Procedure provides *inter alia* that "If in the absence of exceptional circumstances, a Party does not comply with any time period laid down in the Policy or this Procedure, the Expert will proceed to a Decision on the complaint."

Paragraph 15(c) of the Procedure provides that "If in the absence of exceptional circumstances, a Party does not comply with any provision in the Policy or this Procedure or any request by us or the Expert, the Expert will draw such inferences from the Party's non compliance as he or she considers appropriate."

In the view of the Expert, if the Respondent does not submit a response, the principal inference that can be drawn is that the Respondent has simply not availed itself of the opportunity to attempt to demonstrate that the Domain Name is not an Abusive Registration. This does not affect the primary requirement upon the Complainant, on whom the burden of proof rests, to demonstrate Abusive Registration, nor does it in the Expert's view entitle an expert to accept as fact all uncontradicted assertions of the Complainant, irrespective of their merit.

5. Factual Background

The Complainant is the European Headquarters and a wholly-owned subsidiary of Astellas Pharma Inc. of Japan. The Complainant and its parent company are producers and manufacturers of pharmaceutical products. Under an intra-company agreement, the Complainant uses various global trade mark registrations for the mark ASTELLAS, the proprietor of which is its said parent company, including UK registered trade mark no. 2372794 for the word mark ASTELLAS registered on 29 July 2005.

The Respondent appears to be a limited company based in Cyprus. The Respondent registered the Domain Name on 21 August 2010. The website associated with the Domain Name has the appearance of a 'blog site' and is headed "Astellas Europe" with the sub-heading "Pharmaceutical news & tips". Under an 'About' tab, the site states that it provides free information to the public about common pharmaceuticals and medications while under a 'Product' tab, it explains that the site describes "some popular pharmaceutical products" including "erectile dysfunction pills" and "prostate cancer".

6. Parties' Contentions

Complainant

The Complainant asserts that its group of companies was formed from a merger between two Japanese pharmaceutical companies in 2005, after which the group adopted the name and mark ASTELLAS. The Complainant notes that its parent company's various registered trade mark rights date from 2004. The Complainant also produces evidence showing that its own corporate name was changed to Astellas Pharma Europe Limited on 3 May 2005.

The Complainant submits that the Domain Name is identical or similar to its parent company's registered trade mark ASTELLAS because it consists of that mark with the addition of the non-distinctive word "Europe". The Complainant notes that the addition of the word "Europe" does not alter the phonetic, graphic or conceptual identity of the Complainant's parent company's trade mark and that of the Domain Name. The Complainant also asserts that in light of its parent's trade mark registrations and established global use of its well known mark, the Respondent will have been well aware of the Complainant's rights before and at the time of registration of the Domain Name. The Complainant adds that the Domain Name is not generic or descriptive.

The Complainant submits that the Domain Name is an Abusive Registration as it is being used in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or

authorised by, or otherwise connected with the Complainant. The Complainant asserts that the manner and use of the Complainant's ASTELLAS mark on the Respondent's web page attempts to convey that the site is the legitimate site of the Complainant's business in Europe. The Complainant notes that the pharmaceutical areas upon which the Respondent's website claims to focus are identical to the legacy pharmaceutical franchise areas of the Complainant. The Complainant also states that the website's "About" page emphasises the false impression that the site originates or is endorsed by the Complainant. The Complainant adds that nothing on the site indicates that it is wholly unconnected to the Complainant.

The Complainant asserts that it has obtained evidence of actual confusion. The Complainant produces a recently drafted article by the magazine *Lawyer Monthly* dated 18 January 2012 which makes reference to the Domain Name as if it were the Complainant's domain. The Complainant submits that this demonstrates that the Respondent's activities are causing considerable damage to the Complainant.

The Complainant contends that the Respondent is deriving commercial gain from the website associated with the Domain Name although it also notes that it does not know how such gain is being made. The Complainant indicates that it is doing so either by generating pay per click revenue or by obtaining visitors' email addresses for onward supply as the site invites users to enter their email address details. The Complainant notes that it can think of no other reason why the Respondent has registered and used the Domain Name in the manner complained of.

The Complainant submits that the Respondent has no rights in the Domain Name nor any rights in the name ASTELLAS. The Complainant states that the service on offer on the Respondent's website is wholly without authority from the Complainant and that there is no record of any agreement between the Respondent and the Complainant with regard to use of the trade mark ASTELLAS or the Domain Name.

Respondent

The Respondent did not file a Response and has not replied to the Complainant's contentions.

7. Discussions and Findings

General

In terms of paragraph 2(b) of the Policy the onus is on the Complainant to prove to the Expert on the balance of probabilities each of the two elements set out in paragraph 2(a) of the Policy, namely that:

- (i) The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- (ii) The Domain Name, in the hands of the Respondent, is an Abusive Registration.

Complainant's Rights

Paragraph 1 of the Policy provides that Rights means "rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning".

The requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.

In the present case, the Complainant has produced evidence that its parent company is the proprietor of a range of registered trade marks, including that noted in the Factual Background section above, in respect of the mark ASTELLAS. The Complainant is not itself the owner of these marks, however it states that it uses them "under an intra-company agreement". While the terms of that agreement have not been produced, the Expert is prepared to find on the balance of probabilities that it constitutes or contains a licence of those trade marks covering the territory for which the Complainant is responsible, given that in the Expert's experience this is a typical arrangement between many group companies and their corresponding parent in a multi-national structure. The Expert is accordingly prepared to find that the Complainant has Rights in various registered trade marks for the term ASTELLAS derived via a licence from its parent company, which is the proprietor of those marks.

Clearly the Domain Name is not identical to the mark ASTELLAS but is it similar? The first (.uk) and second (.co) levels of the Domain Name are first disregarded for the purposes of comparison as is customary in cases under the Policy. This leaves a comparison between the mark ASTELLAS and the Domain Name astellas-europe from which it can be seen that the Domain Name contains the additional element -europe. The Expert accepts the

Complainant's submission that this element is non-distinctive as it merely reflects a geographic region and accordingly that the sole distinctive element within the Domain Name, and its principal focus, is the trade mark in which the Complainant has Rights. On this basis, the Expert is prepared to find on the balance of probabilities that the Domain Name is similar to the trade mark in which the Complainant has Rights.

Abusive Registration

Paragraph 1 of the Policy defines "Abusive Registration" as a domain name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*
- ii. has been used in a manner, which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;*

This general definition is supplemented by paragraph 3 of the Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 4 of the Policy provides a similar non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.

In the present case, the Complainant's submissions focus on the Respondent's use of the Domain Name and in particular the assertion that the Domain Name is being used in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. This submission is consistent with paragraph 3(a)(ii) of the Policy. In support of its submissions on confusion, the Complainant also produces a recent draft of an article from the magazine *Lawyer Monthly* in which the author cites the Domain Name as the location of the Complainant's official website.

It is clear to the Expert that the Domain Name itself incorporates the Complainant's parent company's distinctive trade mark. This is coupled to a geographic term which is indicative of one of the regions in which the Complainant's corporate group is commercially active. The website associated with the Domain Name unambiguously states that it is a resource for pharmaceutical information, pharmaceuticals being the Complainant's line of business. The website goes on to list specific areas of pharmaceutical activity in which the Complainant has previously engaged. It does not make clear to visitors, whether by a prominent disclaimer or otherwise, that it is entirely unaffiliated with the Complainant or its corporate group. Indeed, the nature of the Domain Name and the selection of the associated website

content give rise to the distinct impression in the mind of the Expert that in registering and using the Domain Name the Respondent has intentionally set out to create confusion as to whether the Domain Name and/or its associated website are operated or authorised by the Complainant. The Complainant may well be right that the Respondent has done this with a view to commercial gain however the Complainant is not required to prove the nature of the Respondent's motivation, whether it be for gain or otherwise, in order to make out a case in terms of paragraph 3(a)(ii) of the Policy.

The Complainant goes on to produce evidence that the site has already confused a journalist during his preparation of an article focusing on the Complainant's in-house counsel. The draft article lists the Domain Name alongside the Complainant's parent company's principal domain name. It is clear that the author of the draft was under the impression that the Domain Name was the location of the official European website for the Complainant.

The Expert notes that the instance of actual confusion cited by the Complainant is but a single example, albeit a significant one in that it could reasonably be expected that a journalist would be more cautious than most in checking sources and identifying corporate domain names and websites. That said, it is not necessary for the Complainant to prove that actual confusion has taken place to be able to make out a case in terms of paragraph 3(a)(ii) of the Policy. On balance, however, the Expert considers that the cited example adds further support to the Complainant's proposition that the manner of use of the Domain Name is likely to lead to confusion.

For its part, the Respondent has chosen to take no part in the present proceedings and has not therefore provided any statement to the Expert as to why it registered the Domain Name and/or its reasons for the present use thereof. In any event, the Expert has been unable to conceive of any explanation which might have been tendered by the Respondent, whether in terms of paragraph 4 of the Policy or otherwise, which would demonstrate that the present use of the Domain Name is not likely to lead to confusion within the meaning of paragraph 3(a)(ii) of the Policy.

In all of the above circumstances, the Expert finds that the Respondent is using the Domain Name in a way which is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant and therefore that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

8. Decision

The Expert finds that the Complainant has proved that it has Rights in a name or mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert

therefore directs that the Domain Name be transferred to the Complainant.

Signed

Dated 14 March, 2012

Andrew D S Lothian