

# Alternative Dispute Resolution (ADR)

**DECISION**

2010-06-11

**TICKETNUMBER**

395

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**APPLICANT**

Eli Lilly and Company

Indianapolis, Indiana 46285

USA

**Counsel:**

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USA

**OPPONENT**

Denis Kozenko

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**MATTER**

Alternative dispute resolution for the domain name **cialisinfo.se**

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.SE decides as follows

**DECISION**

The domain name <cialisinfo.se> is transferred to the Applicant Eli Lilly and Company.

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## **BACKGROUND TO THE DISPUTE**

The disputed domain name was first registered on June 2, 2009.

The Applicant, having trademark rights to the word CIALIS, filed an Application for alternative dispute resolution regarding the domain name <cialisinfo.se> on April 1, 2010.

The Opponent has not responded within the given deadline.

On May 11, 2010, Petter Rindforth was appointed as the sole Adjudicator in this matter. The Projected Decision Date was June 11, 2010.

## **CLAIMS**

The Applicant claims that the disputed domain name <cialisinfo.se> shall be transferred to the Applicant, Eli Lilly and Company.

## **FACTS OF THE CASE / PARTIES' CONTENTIONS**

The applicant is in the pharmaceutical business. Sales of pharmaceutical products identified by the CIALIS mark began on January 22, 2003 in the European Union, followed soon thereafter by sales in Australia and New Zealand. Sales began in the United States in November, 2003. The Applicant owns more than one hundred (100) registrations for the CIALIS mark covering more than one hundred and twenty (120) countries (Copies of Certificates of Registration for a number of these registrations provided as Annex 5 of the Complaint).

The Applicant is the owner of the Community Trademark Registration No 1223916 CIALIS (word), filed on June 24, 1999 and registered on July 18, 2000, covering goods in Class 5.

Copies of some of the certificates of registration for the CIALIS mark are attached as Annex 5 to this Application.

Total worldwide sales for CIALIS brand product in 2007 were \$1.216 billion dollars, and for the full-year of 2009, worldwide CIALIS brand product sales increased to \$1.559 billion. Referring to these and other sales and marketing figures, the Applicant concludes that the CIALIS trademark is well-known.

The Applicant is the holder of the domain name <cialis.com>, registered by Applicant's predecessor-in-interest on August 10, 1999. Applicant has used this domain name to identify a website since at least as early as June, 2001, and to advertise and provide information regarding its pharmaceutical product (Annex 11 of the Complaint).

The Applicant argues that the disputed domain name is virtually identical to Applicant's CIALIS mark. The only difference in the domain name is the addition of the <.se> designation and the descriptive term "info." According to the Applicant, the

addition of a descriptive term to Applicant's CIALIS trademark does not prevent a finding of confusing similarity.

The Applicant further submits that the CIALIS mark is an invented word that has a high degree of individuality, inherent distinctiveness and no common colloquial use.

The Applicant concludes that <cialisinfo.se> is identical and confusingly similar to the Applicant's trademark.

The Applicant states that the Opponent has no rights or legitimate interests in the disputed domain name, as the Opponent does not appear to be generally known by the name CIALIS. Instead, Opponent is using the domain name for a commercial purpose to mislead consumers in search of Applicant's CIALIS brand product to a website that links consumers to various commercial sites that advertise and sell "generic" products, as well as products manufactured by Applicant's competitors. By linking consumers to these sites, Opponent is likely recognizing a financial gain. Finally, the Applicant has not given the Opponent any permission, authorization, consent or license to use its CIALIS mark in any fashion.

The Applicant argues that the disputed domain name was registered and is being used in bad faith. The Opponent has registered a domain incorporating the Applicant's trademark in its entirety which has prevented Applicant from being able to register and use the domain name to advertise Applicant's CIALIS brand product. Moreover, the Opponent is using Applicant's trademark in the domain name to attract Internet consumers to its website from which Opponent likely derives a financial benefit by providing click-through traffic to numerous commercial websites.

Lastly, Opponent's use of Applicant's CIALIS mark in the Domain Name is potentially harmful to the health of many unsuspecting consumers who may purchase unlawfully sold pharmaceutical products advertised through Opponent's website under the mistaken impression that they are dealing with Applicant and, therefore, will be receiving safe and effective drugs approved by the European Medicines Agency (EMA), the U.S. Food and Drug Administration (FDA) or other health authorities around the world.

### Opponent

The Opponent has not contested the allegations of the Applicant.

## **FINDINGS OF THE ADJUDICATOR**

A domain name may, in accordance with .SE's Terms and Conditions of Registration paragraph 6.4(c), in connection to an ADR proceeding be cancelled or transferred to the Applicant requesting such proceeding if

- a) the disputed domain name is identical or confusingly similar to a trade mark, trade name or similar name right, to which the Applicant have rights and such rights are in legal force in Sweden, *and*
- b) the domain name holder has no rights or legitimate interest in the domain name, *and*
- c) the disputed domain name has been registered or used in bad faith.

### Identical or Confusingly Similar

The Applicant has established rights in the CIALIS trademark in Sweden through the abovementioned Community Trademark Registration.

The relevant part of the domain name is <cialisinfo>, consisting of the Applicant's trademark CIALIS and the generic term "info", see *Google, Inc. v. Edmunds G., Case No. 265* (finding <igoogle.se> identical to applicant's GOOGLE mark because the ".se" designation after the domain should be disregarded).

The generic term "info" is commonly used on the Internet to suggest a site providing information on certain products, companies and trademarks, and is therefore not enough to distinct from the connected trademark CIALIS. See *Google Inc. v Ulf P, Case No 294* (finding the addition of the descriptive word "phone" to the <googlephone.se> domain does not imply that the domain escapes being considered confusingly similar to applicant's GOOGLE mark)

Accordingly, the Adjudicator finds that the domain name is confusingly similar to the Applicants trademark CIALIS.

### Rights or Legitimate Interest

The Opponent is obviously not an authorized agent or licensee of the Applicant's products or services and has no other permission to apply for any domain name incorporating the trademark CIALIS.

By not submitting a Response, the Opponent has failed to invoke any circumstance which could demonstrate any rights or legitimate interests in the domain name.

In addition, the fact that the domain name resolves to a web page displaying information and services in competition with the Applicant, as well as selling illegitimate copies of Applicant's product, is not a bona fide offering of goods and services and such use can therefore not establish any rights or legitimate interest.

The Adjudicator therefore concludes that the Opponent has no rights or legitimate interests in the domain name.

### Registered or Used in Bad Faith

The Applicant, in support of its claim that the CIALIS trademark is well-known (and presumably so also at St Helena, the alleged place of living of the Opponent), has provided samples of news articles, as well as marketing and sales figures. The Adjudicator has no reason to question the Applicant's statement that CIALIS is a mark with reputation.

The Opponent's registered address may be of St Helena, but the site connected to the disputed domain name is in Swedish, and the links provided to other on-line pharmacies offering similar products or copies of Applicant's products are located in the US and Canada. The Adjudicator therefore concludes that the Opponent is well informed of the market for the specific product and trademark, and that the domain name was registered especially with the Complainant in mind and in order to take advantage of the fame of the mark CIALIS.

The Opponent has used <cialisinfo.se> for a site with information and links – presumably commercial – to sites offering competitor’s products and copies of the Applicant’s branded products, therewith using the fact that Swedish customers looking for the Applicant may well be confused by Opponent’s web address and the initial page suggesting a commercial connection to the Complainant or an endorsement from the Complainant.

The Adjudicator concludes that the Opponent registered and has used the disputed domain name in bad faith.

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On behalf of .SE

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Petter Rindforth