

ADMINISTRATIVE PANEL DECISION

STADA Arzneimittel AG, Britannia Pharmaceuticals Limited v. Smart
Technology, smatech
Case No. DCO2022-0012

1. The Parties

The Complainants are STADA Arzneimittel AG, Germany (“First Complainant”) and Britannia Pharmaceuticals Limited, United Kingdom (“Second Complainant”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States of America.

The Respondent is Smart Technology, smatech, Nigeria.

2. The Domain Name and Registrar

The disputed domain name <britannipharm.co> (the “Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 9, 2022. On February 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 10, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainants on February 11, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on February 14, 2022.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 8, 2022.

The Center appointed Nicholas Smith as the sole panelist in this matter on March 14, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainants are German and United Kingdom companies involved in the development and manufacturing of pharmaceutical products. The Second Complainant was founded in 1982 and acquired by the First Complainant in 2007. The Complainants operate websites promoting their services including a website at “www.britannia-pharm.co.uk”. This website features the Second Complainant’s logo, which consists of a stylized form of the words “Britannia Pharmaceuticals Ltd” and the letters “b” and “p” intertwined to create the shape of a globe.

The Complainants are the owner of numerous trade mark registrations for BRITANNIA (the “BRITANNIA Mark”) in various jurisdictions including a United Kingdom registration, registered on September 13, 1996, (registration number 2043054) for goods in classes 5 and 10.

The Domain Name <britanniapharm.co> was registered on July 25, 2020. The Domain Name is presently inactive but prior to the commencement of the proceeding resolved to a website (“the Respondent’s Website”) purporting to offer services in competition with the Complainants. The Respondent’s Website reproduces the Second Complainant’s logo and the names of both Complainants to suggest that it is a website operated by one or both of the Complainants.

5. Parties’ Contentions

A. Complainants

The Complainants make the following contentions:

- (i) that the Domain Name is identical or confusingly similar to the Complainants’ BRITANNIA Mark;
- (ii) that the Respondent has no rights nor any legitimate interests in respect of the Domain Name; and
- (iii) that the Domain Name has been registered and is being used in bad faith.

The Complainants are the owners of the BRITANNIA Mark, with the Second Complainant having registered the BRITANNIA Mark in the United Kingdom. The Domain Name is confusingly similar to the BRITANNIA Mark since it wholly incorporates the BRITANNIA Mark and adds the descriptive abbreviation “pharm”.

There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Respondent is not commonly known by the Domain Name nor does the Respondent have any authorization from the Complainants to register the Domain Name. The Respondent is not making a legitimate noncommercial or fair use of the Domain Name. Rather the Respondent is using the Domain Name to resolve to a website that appears to be a website for, or otherwise associated with, the Complainants. Such use is not a *bona fide* offering of goods or services.

The Domain Name was registered and is being used in bad faith. The Respondent has used the Domain Name containing Complainants’ trademark which clearly shows its awareness of the Complainants at the time of registration. By using the Domain Name to resolve to a website that offers competing services, the Respondent is using the Domain Name to divert Internet users searching for the Complainants to the Respondent’s Website for commercial gain. Such conduct amounts to registration and use of the Domain Name in bad faith.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

A. Consolidation of Multiple Complainants

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) provides at section 4.11.1, in respect of the issue “Multiple complainants filing against a single respondent” that:

“Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.”

The present proceeding involves two Complainants bringing a single complaint against a common Respondent. The Complainants have made a request for consolidation and bear the onus of establishing that such a consolidation is justified.

The Panel is satisfied, based on the material filed, that the Complainants have a specific common grievance against the Respondent, in that the Complainants have a common legal interest as related entities that hold and use the BRITANNA Mark.

The Panel has considered whether it would be equitable and procedurally efficient to permit the consolidation. In the present case, it is no doubt equitable and procedurally efficient. The Panel grants the Complainants' request for consolidation.

B. Identical or Confusingly Similar

To prove this element the Complainants must have trade or service mark rights and the Domain Name must be identical or confusingly similar to the Complainants' trade or service mark.

The Complainants are the owners of the BRITANNA Mark, having registered the BRITANNA Mark as a trademark in the United Kingdom. The Domain Name wholly incorporates the BRITANNA Mark, and adds the term “pharm” and the “.co” country-code Top-Level Domain (“ccTLD”), which may be disregarded as an essential element of any domain name. The addition of a term (whether descriptive, geographical, pejorative, meaningless, or otherwise) to a complainant's mark does not prevent a finding of confusing similarity; see section 1.8 of the [WIPO Overview 3.0](#).

The Panel finds that the Domain Name is confusingly similar to the BRITANNA Mark. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

C. Rights or Legitimate Interests

To succeed on this element, a complainant must make out a *prima facie* case that a respondent lacks rights or legitimate interests in a domain name. If such a *prima facie* case is made out, then the burden of production shifts to the respondent to demonstrate rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a domain name:

“Any of the following circumstances, in particular but without limitation, if found by the panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Respondent is not affiliated with the Complainants in any way. It has not been authorized by the Complainants to register or use the Domain Name or to seek the registration of any domain name incorporating the BRITANNA Mark or a mark similar to the BRITANNA Mark. There is no evidence that the Respondent is commonly known by the Domain Name or any similar name. In particular, while the Respondent’s Website purports to be the website of an entity known as Britannia Pharmaceuticals Ltd, for the reasons set out below the Panel is satisfied that the Respondent is not a legitimate entity and is simply impersonating the Second Complainant. There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a legitimate noncommercial or fair use.

The Respondent has used the Domain Name to operate a website that impersonates the Second Complainant. It does so by prominently reproducing the Second Complainant’s logo and name on the website and, notwithstanding that the Respondent is based in Nigeria, purporting to operate from the same country (the United Kingdom) as the Second Complainant, and purporting to offer services in direct competition with the Complainants, under the BRITANNA Mark. Such conduct does not, on its face, amount to the use of the Domain Name for a *bona fide* offering of goods or services.

The Complainants have established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has had the opportunity to put on evidence of its rights or legitimate interests, including submissions as to why its conduct amounts to a right or legitimate interest in the Domain Name under the Policy. In the absence of such a Response, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

For the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location (paragraph 4(b) of the Policy).

The Panel finds that the Respondent was aware of the Complainants and their reputation in the BRITANNA Mark at the time the Domain Name was registered. The Respondent's Website purports to offer services in direct competition with the Complainants and makes direct reference to both of the Complainants. The registration of the Domain Name in awareness of the BRITANNA Mark and in the absence of rights or legitimate interests amounts under these circumstances to registration in bad faith.

The Respondent has used the Domain Name (which wholly incorporates the BRITANNA Mark) to operate a website that impersonates the Second Complainant and purports to offer services in competition with the Complainants. Consequently the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainants and the Complainants' BRITANNA Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website (paragraph 4(b)(vi) of the Policy).

Accordingly, the Panel finds that the Respondent has registered and used the Domain Name in bad faith under paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <britanniaparm.co> be transferred to the Second Complainant as requested in the Complaint.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: March 18, 2022