

ADMINISTRATIVE PANEL DECISION

Eli Lilly and Company v. Mila Banfield
Case No. D2023-3849

1. The Parties

Complainant is Eli Lilly and Company, United States of America (United States), represented by Faegre Drinker Biddle & Reath, LLP, United States.

Respondent is Mila Banfield, United States.

2. The Domain Name and Registrar

The disputed domain name <cialis.icu> is registered with Hosting Concepts B.V. d/b/a Registrar.eu (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 14, 2023. On September 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 18, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Whois Privacy Protection Foundation) and contact information in the Complaint. The Center sent an email communication to Complainant on September 18, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on September 18, 2023.

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 Respondent of the Complaint, and the proceedings commenced on September 26, 2023. In accordance with the Rules,

paragraph 5, the due date for Response was October 16, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on October 17, 2023.

The Center appointed Lorelei Ritchie as the sole panelist in this matter on November 9, 2023. 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

Complainant is a multinational company, based in the United States. Since at least 2003, Complainant has used the mark CIALIS in connection with the treatment of erectile dysfunction.

Complainant has numerous registered trademarks for its CIALIS mark in jurisdictions throughout the world. These include, among others, United States Registration No. 2724589 (registered June 10, 2003) and Canada Registration No. TMA599624 (registered January 15, 2004). Complainant also owns the registration for domain names incorporating its CIALIS mark, including <cialis.com>, which Complainant uses to connect with its global consumer base online.

The disputed domain name was registered on May 23, 2023. Respondent has used the disputed domain name to resolve to a website that appears to offer counterfeit versions of Complainant, with the message "welcome to cialis" -- a reference to Complainant's mark, but in lower-case letters - and touting an online product as the "very same" as "typical Cialis" - a reference to Complainant's actual mark, in upper-case letters.

5. Parties' Contentions

A. Complainant

Complainant contends that the (i) disputed domain name is identical or confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the disputed domain name; and (iii) Respondent registered and is using the disputed domain name in bad faith.

In particular, Complainant contends that it has established rights in the distinctive and globally-recognized CIALIS mark, for which Complainant has garnered billions of dollars in sales, and which has been referenced in global media sources including The Wall Street Journal, Forbes.com, BusinessWeek, and The Sun. Complainant contends that Respondent has incorporated in full its famous CIALIS mark along with a generic Top-Level Domain ("gTLD"). Complainant asserts that Respondent has no rights or legitimate interests in the domain name registration or use of the disputed domain name. Rather, Complainant contends that Respondent has acted in bad faith in setting up a website meant to confuse consumers looking for legitimate goods offered by Complainant under the CIALIS mark, presumably for Respondent's own commercial gain.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

This Panel must first determine whether the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy. The Panel finds that it is.

The disputed domain name incorporates in full Complainant's CIALIS mark. Typically, a gTLD may be ignored for purposes of considering this first element. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11.1.

The Panel therefore finds that the disputed domain name is identical to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Policy provides some guidance to respondents on how to demonstrate rights or legitimate interests in the domain name at issue in a UDRP dispute. For example, paragraph 4(c) of the Policy gives examples that might show rights or legitimate interests in a domain name. These examples include: (i) use of the domain name "in connection with a *bona fide* offering of goods or services;" (ii) demonstration that Respondent has been "commonly known by the domain name;" or (iii) "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."

Specifically, the Panel finds that because the disputed domain name is identical to Complainant's trademark any use of such domain name by Respondent carries a high risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

Respondent did not submit a reply to Complainant's contentions, and Respondent did not allege or otherwise provide any information that would support a finding that Respondent has rights or legitimate interest in the disputed domain name. Accordingly, the Panel finds that Complainant has made an un rebutted *prima facie* showing of Respondent's lack of rights or legitimate interests in the disputed domain name, which Respondent has not rebutted.

C. Registered and Used in Bad Faith

There are several ways that a complainant can demonstrate that a domain name was registered and used in bad faith. For example, paragraph 4(b)(iv) of the Policy states that bad faith can be shown where "by using the domain name [respondent has] intentionally attempted to attract, for commercial gain, Internet users to [respondent's] 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 [respondent's] website or location or of a product or service on [the] website or location". As noted in Section 4 of this Decision, Respondent has used the disputed domain name to resolve to a website that appears to offer counterfeit versions of Complainant, with the message "welcome to cialis" -- a reference to Complainant's mark, but in lower-case letters -- and touting an online product as the "very same" as "typical Cialis" -- a reference to Complainant's actual mark, in upper-case letters.

Respondent is thus trading on the goodwill of Complainant's trademarks to attract Internet users, presumably for Respondent's own commercial gain, and with prior knowledge of Complainant's rights in the globally well-known CIALIS mark. See *Eli Lilly and Company v. Private Registration, WhoisGuard Service.com*, WIPO Case No. [D2016-1737](#); *Krispy Kreme Doughnut Corporation, HDN Development*

Corporation v. Privacy Service Provided by Withheld for Privacy ehf / SALEH BAHJAT, WIPO Case No. [D2022-2376](#). Finally, Respondent has failed to participate in this proceeding, and thus, for the Panel, there is no conceivable good faith use to which the disputed domain name could be put that would not capitalize on or target Complainant.

The Panel finds that Respondent registered and used the disputed domain name in bad faith for purposes of paragraph 4(a)(iii) of the Policy.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <cialis.icu> be transferred to Complainant.

/Lorelei Ritchie/

Lorelei Ritchie

Sole Panelist

Dated: November 23, 2023