



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

#### **F. Hoffmann-La Roche AG v. sysadmin admin**

**Case No. D2007-1349**

#### **1. The Parties**

The Complainant is F. Hoffmann-La Roche AG, Basel, Switzerland, represented internally.

The Respondent is sysadmin admin, balata.com ltd., Hong Kong, SAR of China, represented pro se.

#### **2. The Domain Names and Registrar**

The disputed domain names, <valium-diazepam.info> and <valiumdiazepam.org>, are registered with Gal Communications (CommuniGal) Ltd. d/b/a Galcomm (the “Registrar”).

#### **3. Procedural History**

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the “Policy”), which was adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on August 26, 1999, and approved on October 24, 1999, and in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) as approved on October 24, 1999, and the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999, (the “Supplemental Rules”).

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) in email form on September 10, 2007, and in hard copy form, along with accompanying Annexes 1-15, on September 13, 2007.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this

proceeding. Through the Complaint, the Complainant requested a single-member panel.

After receiving the original Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on September 13, 2007, the Center requested confirmation from the Registrar as to whether the Registrar received a copy of the Complaint from the Complainant and to confirm contact and registrant information set forth in the Complaint relative to the disputed domain name. The Center also requested the Registrar to specify, for the domain name: (a) whether the Policy applies to that name, (b) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of that name, (c) the language of the registration agreement, and (d) whether that name will remain "locked" during the proceeding.

Subsequently, on September 19, 2007, the Registrar provided its response to the Center through which the Registrar specified name and contact information pertinent to the disputed domain name to the extent present in its WhoIs database, and confirmed that the Respondent is listed as the registrant for that name. The response also confirmed that: (a) Galcomm is the registrar, (b) the Respondent submitted to the jurisdiction as the location of the principal office of the Registrar for court adjudication and (c) the registration agreement is in English; and indicated that the name will remain locked during the pendency of this proceeding.

In response to an email communication from the Center and dated September 21, 2007 advising the Complainant of various deficiencies in the Complaint, the Complainant amended the Complaint on September 25, 2007 by email accordingly. Hereinafter, the term "Complaint" will refer to the Complaint, as amended.

The Center verified that the Complaint satisfied the formal requirements of the Policy, the Rules and the Supplemental Rules.

On September 26, 2007, the Center formally notified the Respondent, by email letter, of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its Exhibits, by both courier and email. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on September 26, 2007, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all the correspondence, including that between the Center and the Registrar, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on October 16, 2007, to file its Response with the Center and serve a copy of the Response on the Complainant.

On October 16, 2007, the Center timely received a Response from the Respondent.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated October 25, 2007, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a sole Panelist for this dispute. Subsequently, on the same day, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Panel finds that it was properly constituted. The Center, through an email letter dated October 29, 2007, notified the Parties of the appointment of Mr. Michaelson as Sole Panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before November 12, 2007.

This dispute concerns two domain names, specifically <valium-diazepam.info> and <valiumdiazepam.org>.

The language of this proceeding is English.

#### **4. Factual Background**

As indicated in the WhoIs registration records provided in Annex 1 to the Complaint, the Respondent registered the disputed domain names <valium-diazepam.info> and <valiumdiazepam.org> on August 19, 2007 and September 8, 2007, respectively.

##### **A. The Complainant's VALIUM Marks**

The Complainant owns numerous trademark registrations in more than 100 countries throughout the world for the mark VALIUM. The Complainant has provided, in Annex 4 to the Complaint, a copy of its international registration for this mark. Pertinent details of the registration are as follows:

VALIUM  
International registration 2R 250 784  
Registered: December 20, 1961 with priority to October 20, 1961  
Last Renewal: January 17, 2002

This mark was registered for use in connection with various products including, in international class 5, pharmaceutical drugs and preparations.

##### **B. The Complainant**

The Complainant, together with its affiliated companies, is one of the world's leading research-focused healthcare groups in the fields of pharmaceuticals and diagnostics and has global operations in more than 100 countries.

The mark VALIUM designates a sedative and anxiolytic drug, belonging to the benzodiazepine family, from which the Complainant established a world-wide reputation in psychotropic medications. As indicated in the news article (a copy of which appears in Annex 8 to the Complaint) "A Host of Anxiety Drugs, Begat by

Valium”, *The New York Times*, February 22, 2005, the Complainant’s drug and hence its mark VALIUM are both extremely well-known and notorious.

### **C. The Respondent**

The Respondent’s website is a search engine that provides pages containing various sponsored links to third-party websites and their products and services, apparently all unrelated to the Complainant. Copies of corresponding sets of the home and various lower-level pages of the site that resolve to <valium-diazepam.info> and to <valiumdiazepam.org> respectively appear in Annexes 10 and 11 to the Complaint. As the pages provided in both sets are identical, then apparently both names appear to resolve to the same site.

## **5. Parties’ Contentions**

### **A. Complainant**

#### **(i) Identical or Confusingly Similar**

The Complainant contends that each of the disputed domain names is confusingly similar to the Complainant’s VALIUM Marks.

Specifically, the Complainant contends that each name includes the mark VALIUM plus the international non-proprietary name (INN) of the drug, namely “diazepam”. Merely adding the well-known INN to the mark does not sufficiently distinguish the resulting name from the mark.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

#### **(ii) Rights or Legitimate Interests**

The Complainant contends that the Respondent has no rights or legitimate interests in either of the disputed domain names pursuant to paragraph 4(a)(ii) of the Policy.

The Respondent’s only reason in registering and using the domain names is to benefit from the reputation of the Complainant’s mark and illegitimately trade on the fame of that mark for commercial gain and profit, which ostensibly does not constitute a *bona fide* offering of goods and services. Hence, the Respondent fails to qualify under paragraph 4(c)(i) of the Policy.

Further, the Complainant has neither granted the Respondent a license nor provided the Respondent with either permission or authorization to use the mark VALIUM in a domain name. Hence, given the Complainant’s exclusive rights in the mark, the Respondent can never become commonly known by the name or mark VALIUM. Thus, the Respondent can not qualify under paragraph 4(c)(ii) of the Policy.

#### **(iii) Registered and Used in Bad Faith**

The Complainant contends that the Respondent registered and is now using both of the disputed domain names in bad faith under paragraph 4(a)(iii) of the Policy.

Given that the disputed domain names were registered approximately 40 years after the Complainant first registered its mark VALIUM, the Respondent clearly had knowledge of that mark when the Respondent registered both names, hence reflecting bad faith registration.

As to bad faith use, the Respondent, through its website, is intentionally misleading and attracting Internet users by creating a likelihood of confusion in their minds with respect to the Complainant's mark VALIUM and as to whether that site or its products is somehow associated or affiliated with, or endorsed by the Complainant, when it is not, and thus is exploiting that confusion for its own pecuniary gain through sales of goods advertised on that site.

Thus, the Respondent's use of the disputed domain names constitutes bad faith use in violation of paragraph 4(b)(iv) of the Policy.

## **B. Respondent**

The Respondent contends that it registered both domain names in good faith based on its belief that the combination of two words "valium" and "diazepam" would not violate any of the Complainant's rights in the term VALIUM. As proof of this, the Respondent lists several other existing domain names that also include that term. Hence, the Respondent concludes, as to each of the disputed domain names, "we can't see any reason preventing us from using the domain for business purposes".

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The Panel finds that each of the disputed domain names is confusingly similar to the Complainant's VALIUM Marks.

From a simple comparison of each of the domain names to the marks, no doubt exists that both disputed domain names are confusingly similar to the VALIUM Marks. The only basic differences between the name and the mark VALIUM is the addition of the INN "diazepam" and the appending of a gTLD (generic top level domain) to the mark – with the latter being totally irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that minor variations, such as adding short letter or number groups or even generic words to a mark, are each insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. See, e.g., *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064 (September 24, 2007); *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952 (August 27, 2007); *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334 (June 28, 2007); *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317 (April 24, 2007); *SPX Corp. v. Hevun Diversified Corp.*, NAF Case No. FA791657 (November 13, 2006); *Google Inc. v. Burns*, NAF Case No. FA 726096 (August 16, 2006); *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766

(September 12, 2005); *Napster, Inc. v. Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 (January 18, 2005); *Lockheed Martin Corp. v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004); and *National Collegiate Athletic Assoc. v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004); *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case No. FA 155896 (July 1, 2003); and particularly *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Case No. FA 117876 (December 16, 2002).

While a sufficient number of variations or even one such variation itself made to a mark may suffice, under a specific factual situation, to impart requisite distinctiveness to a resulting domain name and there through dispel user confusion (see, e.g., *National Football League*, cited *supra*; *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576 (March 14, 2007); and *CP Films, Inc. v. Solar Lunar Performance Film*, NAF Case No. FA861127 (February 6, 2007)), such is clearly not the case here when both each of the names at issue and the marks are viewed, as they must, in their entirety with respect to each other.

Here, adding the well-known INN diazepam, i.e., that associated with the underlying pharmaceutical composition itself, to the Complainant's mark for its own version of that same composition to form the domain names does essentially nothing to dispel user confusion inasmuch as the INN and the mark are product synonyms, namely two terms for the same composition sourced from the Complainant. One, the name diazepam, is a nonproprietary name; the other, the mark VALIUM, is not. While other sources might manufacture and distribute their own versions of the same composition and designate it by the same INN, those secondary sources are of no concern here. The focus in this analysis is only on the Complainant by virtue of its sole ownership of the VALIUM Marks, through which it (and those, if any, to whom it has granted permission to use those marks) has exclusivity in branding its own version of the diazepam composition. While not every Internet user may recognize the INN, nevertheless some will and immediately realize its equivalence here. See, *F. Hoffman-La Roche AG v. Den*, WIPO Case No. D2006-0182 (May 3, 2006).

Consequently, Internet users who attempt to access the Complainant's website through use of either of the disputed domain names would reach the Respondent's site instead and thus likely think that an affiliation of some sort exists between the Complainant and the Respondent, when, in fact, no such relationship would exist at all. Hence, confusion would result. See, e.g., *Google Inc. v. Jennifer Burns*, NAF Case No. FA 726096 (August 16, 2006); *Cheesecake Factory, Napster, Caesars Entertainment, Lockheed v. Skunkworx*, and *Lockheed v. Teramani*, all cited *supra*; see also *Register.com, Inc. v. Reile*, NAF Case No. FA 208576 (January 27, 2004); *Caesars World, Inc. and Park Place Entertainment Corp. v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Case No. FA 173362 (September 16, 2003); *American Family Life Assurance Company of Columbus v. defaultdata.com aka Brian Wick*, NAF Case No. FA 123896 (October 14, 2002); *AT&T Corp. v. Abreu*, WIPO Case No. D2002-0605 (September 11, 2002); *L.F.P., Inc. v. B and J Properties*, NAF Case No. FA 109697 (May 30, 2002); *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *Spence-Chapin Services to Families and Children v. Stanley Wynman*, NAF Case No. FA 100492 (December 10, 2001); *Meijer, Inc. v. Porksandwich Web Services*, NAF Case No. FA 97186 (July 6, 2001); *MPL*

*Communications, Limited et al v. IWebAddress.com*, NAF Case No. FA 97092 (June 4, 2001); *American Home Products Corporation v. Malgioglio*, WIPO Case No. D2000-1602 (February 19, 2001); *Surface Protection Industries, Inc. v. The Webposters a/k/a Mark's Paint Store, Inc.*, WIPO Case No. D2000-1613 (February 5, 2001); *Dollar Financial Group, Inc. v. VQM NET*, NAF Case No. FA 96101 (January 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.*, WIPO Case No. D2000-1463 (January 10, 2001); *Treeforms, Inc. v. Cayne Industrial Sales Corp.*, NAF Case No. FA 95856 (December 18, 2000); *Pep Boys Manny, Moe and Jack of CA v. E-Commerce Today, Ltd.*, e Resolution Case No. AF-0145 (May 3, 2000).

Therefore, the Panel finds that each of the disputed domain names is confusingly similar to the Complainant's VALIUM Marks as to cause confusion; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

The Respondent has not provided any basis that, under the circumstances here, would legitimize a claim to either of the disputed domain names under paragraph 4(c) of the Policy.

No evidence exists of record that the Complainant has ever authorized the Respondent to utilize its mark VALIUM or any mark confusingly similar thereto in conjunction with the goods which the Complainant uses that mark, nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the mark VALIUM or one confusingly similar thereto in connection with the identical or similar goods to those currently provided by the Complainant would violate the exclusive trademark rights now residing in the Complainant. See, e.g., *National Football League, Toilets.com, Inc.*, and *Associated Bank*, all cited *supra*; *GoDaddy.com, Inc.*, v. *GoDaddysDomain.com, Clark Signs, Graham Clark*, WIPO Case No. D2007-0303 (May 7, 2007); *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576 (March 14, 2007); *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884 (October 14, 2005); *The Cheesecake Factory Inc., Napster and Caesars Entertainment, Inc.*, all cited *supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 28, 2004); *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360 (June 24, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Case No. FA 173362 (September 16, 2003); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, cited *supra*; *MPL Communications, Limited et al v. IWebAddress.com*, NAF Case No. FA 97092 (June 4, 2001); *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374 (December 11, 2000); and *Treeforms*, cited *supra*. Consequently, the Respondent could not legally acquire any public association between it and the mark VALIUM or one similar thereto, at least for the goods rendered by the Complainant, or those similar thereto.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by either of the domain names. Nor could the Respondent in this case ever become so known, in light of the Complainant's extensive and exclusive trademark rights, dating back approximately 40 years prior to the dates on which the

Respondent registered those names, without infringing on the exclusive trademark rights of the Complainant. See, *Treeforms, Inc.*, cited *supra*.

Hence, based on the evidence before the Panel, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Moreover, since the Respondent's use of each of the domain names, which infringes the Complainant's trademark rights, does not constitute a *bona fide* use and is unquestionably commercial in nature, the Respondent's conduct does not fall within paragraphs 4(c)(i) or 4(c)(iii) of the Policy either.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in either of the disputed domain names within paragraph 4(a)(ii) and 4(c) of the Policy.

### **C. Registered and Used in Bad Faith**

The Panel believes that the Respondent's actions constitute bad faith registration and use of both of the disputed domain names.

The Respondent believed, however erroneously, that, at the time it registered these domain names, combining the term VALIUM and the INN diazepam would not violate any of the Complainant's trademark rights. Given this, it is eminently clear to this Panel that implicit in this belief, was the fact that the Respondent was well aware of the mark VALIUM when the Respondent registered those names. Yet, in spite of that knowledge, the Respondent intentionally chose and registered each of those names to opportunistically exploit its potential to generate user confusion for the Respondent's eventual pecuniary benefit.

Through subsequent use of each domain name, the Respondent intentionally diverted Internet users who then sought the Complainant's website to the Respondent's site instead with the expectation that some of those users may transact with any of the sponsored third-party websites appearing thereon. This, in turn, increased the traffic to the Respondent's website as well as the click-through revenue which the Respondent ultimately received as a result.

Yet, nothing exists on the Respondent's website which would lead any Internet user to reasonably infer other than that a connection, affiliation or relationship of some sort likely exists between the Respondent's website and the Complainant – when, in actuality, none exists. Thus, the Respondent's use of the names was and continues to be highly likely to confuse, if not deceive, those Internet users who visit that site but do so with the intention of visiting the Complainant's site instead. See *Christian Dior Couture v. Alex Roché*, WIPO Case No. DTV2007-0004 (June 15, 2007) and *Associated Bank and Gerber Childrenswear*, both cited *supra*.

Hence, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy and specifically paragraph 4(b)(iv) thereof.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to each of the disputed domain names, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

**7. Decision**

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The disputed domain names, <valium-diazepam.info> and <valiumdiazepam.org>, are ordered transferred to the Complainant.

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Peter L. Michaelson  
Sole Panelist

Dated: November 12, 2007