



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE

DOMAIN NAME DISPUTE

ADMINISTRATIVE PANEL DECISION

CIIDRC case number:	16060-CDRP	Decision date: September 28, 2021
Domain Name:	daiichisankyo.ca	
Panel:	Steven M. Levy, Esq.	
Complainant:	Daiichi Sankyo Company, Limited	
Complainant's representative:	Douglas M. Isenberg, Esq.	
Registrant:	Nameshield Inc.	
Registrant's representative:	Mark Ready	

1. PROCEDURAL HISTORY

The Canadian International Dispute Resolution Centre ("CIIDRC") is a recognized service provider pursuant to the Domain Name Dispute Resolution Policy (v 1.3, August 22, 2011) (the "Policy") and the Canadian Dispute Resolution Rules (the "Rules") of the Canadian Internet Registration Authority ("CIRA"). On August 20, 2021, the Complainant filed a Complaint with the CIIDRC seeking an order in accordance with the Policy and the Rules directing that the registration of the disputed domain name <daiichisankyo.ca> (the "Domain Name") be transferred to the Complainant. The Complainant has elected for a Panel consisting of a single member. The CIRA was notified of this proceeding on August 20, 2021 and, on the same date, the CIRA transmitted by email to the CIIDRC its verification response confirming the Registrant's identity. On August 20, 2021, the CIIDRC, as Service Provider, confirmed compliance of the Complaint and commencement of the dispute resolution process.

The CIIDRC determined the Complaint to be in administrative compliance with the requirements of Paragraph 3.2 of the Rules and, pursuant to Resolution Rule 4.4, the CIIDRC notified the Registrant of this administrative proceeding and forwarded a Notice with login information and a link to the Complaint to the Registrant via email and by express post on August 23, 2021. The Registrant filed an incomplete response on September 13, 2021 and was advised of this shortcoming by the CIIDRC by email of the same date. On September 14, 2021 the CIIDRC sent an email to Respondent advising that it may request the acceptance of a late response. No reply was received to either of these emails.

By letter dated September 20, 2021 the undersigned was appointed by the CIIDRC as the single Panelist in this matter pursuant to Paragraph 6 of the Rules. The undersigned has confirmed to the CIIDRC that he can act impartially and independently as the Panel in this matter.

On September 23, 2021, at the request of the Panel, the CIIDRC sent an email to Respondent granting it 48 hours to file a Response. A similar message was conveyed in a phone call between the CIIDRC and Respondent's Representative on the same day and the Representative confirmed his understanding of this deadline. No further communication has been received from or on behalf of Respondent.

The Panel determines that it has been properly appointed and constituted to determine the Complaint in accordance with the Rules.

2. REMEDY SOUGHT

The Complainant seeks an order from the Panel in accordance with Paragraph 4 of the Policy and Paragraph 12 of the Rules that the Domain Name be transferred to the Complainant.

3. UNCONTESTED FACTS

- **Complainant**

Complainant is a global pharmaceutical company, traded on the Tokyo Stock Exchange, with corporate origins in Japan that was established in 2005 by joint holding company of Sankyo Co., Ltd. (founded as Sankyo Shoten in 1899) and Daiichi Pharmaceutical Co., Ltd. (founded as Arsemin Shokai in 1915). The company creates innovative new and generic medicines, and new methods of drug discovery and delivery. Through its 15,000 employees Complainant offers products and services in more than 20 countries around the world under the trademark DAIICHI SANKYO. It promotes its goods and services through its website at the domain name <daiichisankyo.com> which was registered on February 25, 2005. It has also obtained over 380 trademark registrations for marks that consist of or incorporate the terms DAIICHI SANKYO in at least 54 jurisdictions worldwide. These include two registrations with the Canadian Intellectual Property Office ("CIPO") in 2015 and one in 2010 which was filed on August 24, 2005 and claims a priority date of March 8, 2005 based upon Complainant's prior trademark application in Japan for the same mark and goods.

- **Registrant**

No substantive Response has been submitted. The Panel notes that, according to the relevant Whois record, the disputed Domain Name was registered on April 27, 2006.

4. DISCUSSION AND FINDINGS

Eligibility

The Complainant is an eligible complainant under paragraph 1.4 of the Policy. The Complaint relates to a trade-mark registered with the CIPO and the Complainant is the owner of such trade-mark.

Requirements

In accordance with Paragraph 4.1 of the CDRP, the onus is on the Complainant to prove, on a balance of probabilities, that:

- Registrant's dot-ca domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights; and
- the Registrant has registered the domain name in bad faith as described in paragraph 3.5;
- the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

The Panel will consider each of these requirements in turn.

Analysis

- Is the Domain Name confusingly similar to a Mark in which the Complainant has Rights per Policy 4.1(a)?

The definition of a “Mark” is set out in Paragraph 3.2 of the Policy. Most applicable to the present situation, subparagraph (c) thereof states that a “Mark” can be: “a trade-mark, including the word elements of a design mark, that is registered in CIPO”.

Complainant asserts that it has obtained at least 386 registrations of the DAIICHI SANKYO trademark in at least 54 jurisdictions around the world. It provides screenshots from the CIPO website of three of its asserted trademark registrations, one of which was filed on August 24, 2005 and registered on September 9, 2017, the other two of which were filed on September 24, 2012 and registered on May 20, 2015. It is noted that the earliest of these registrations claims a filing priority date of March 8, 2005 based upon a prior-filed trademark application in Japan. Complainant also submits a written table listing a large number of trademark registrations for the DAIICHI SANKYO mark in many other countries and jurisdictions, though no further trademark office printouts or registration certificates are provided for these. Based upon the evidence presented, the Panel finds that, based on its registration with the CIPO, the Complainant has established that the DAIICHI SANKYO trade-mark qualifies as a “Mark” for the purposes of Paragraph 3.2(a) of the Policy.

Next, Paragraph 3.1(a) of the Policy requires that the Complainant have “Rights” in its Mark. Although the word appears with an initial capital letter, the term “Rights” is not defined in the Policy. However, Complainant has submitted evidence that it has registered the DAIICHI SANKYO trade-mark, as noted above, and that it promotes the same through its website at <https://www.daiichisankyo.com>. From this evidence, and in the absence of any counter-argument or evidence from Respondent, the Panel concludes that Complainant has demonstrated its ownership of “Rights” in the DAIICHI SANKYO mark for the purpose of Paragraph 3.2(a) of the Policy.

Next, Paragraph 4.1(a) of the Policy requires Complainant to demonstrate that “the Registrant’s dot-ca domain name is Confusingly Similar to a Mark in which the Complainant had Rights *prior to the date of registration of the domain name and continues to have such Rights*” (emphasis added). As noted above, one of the submitted registrations of the DAIICHI SANKYO trade-mark claims a filing priority date of March 8, 2005 and the Panel accepts this as being prior to the date on which the Domain Name was registered. Furthermore, Complainant’s cited CIPO registrations remain in effect as of the date of this decision.

Since Paragraph 1.2 of the Policy defines the Domain Name for the purpose of this proceeding to exclude the .ca suffix, the portion of the Domain Name consisting of “daiichisankyo” is the portion of the Domain Name relevant for consideration here. The second level of the Domain Name consists of the Japanese words “daiichi” and “sankyo”. This is the entirety of Complainant’s trade-mark and thus is not distinguishable therefrom in appearance, sound or the ideas suggested by the mark. In *Loxone Electronics GmbH v. Heinz Kreutz*, 15909-CDRP (CIIDRP Sep. 18, 2021), the Panel found that “the disputed domain name reproduces the trademark in its totality, namely, ‘LOXONE’”. Here, the Panel similarly concludes that the daiichisankyo.ca Domain Name identically copies the DAIICHI SANKYO trade-mark and thus, that Complainant has met the Confusingly Similar requirement of Paragraph 4.1(a).

B. Did the Registrant register the domain name in bad faith per Policy 4.1(b)?

Paragraph 4.1(b) of the Policy is satisfied when Complainant demonstrates, by a balance of probabilities, that the Registrant registered the Domain Name in bad faith. The Policy provides four frequently occurring examples of bad faith scenarios in Paragraph 3.5 but these are not exclusive and other situations may still qualify. Of the listed examples, the one most applicable to the current situation is contained in Paragraph 3.5(d) which provides as follows:

- (d) the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant’s website or other on-line location, by creating a likelihood of confusion with the Complainant’s Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant’s website or location or of a product or service on the Registrant’s website or location.

Prior Panels have held that the use of a domain name to host monetized “pay-per-click” links can demonstrate bad faith. See *Home Depot International, Inc. & Home Depot of Canada Inc. v. Oliver Twist Domains Inc.*, DCA-2082 (CIRA May 23, 2019) (where “[t]he Domain Name at times resolves to a pay-per-click parking page with

links categorized under various headings and leading to sites of others, unrelated to the Complainants”, the Panel “finds that the Registrant registered the domain name, homedepotprint.ca, in bad faith under paragraphs 3(b), 3(c) and 3(d) of the Policy.”¹) Complainant has submitted a screenshot of the resolving daiichisankyo.ca website and this shows links titled “Pharmaceutical Company”, “Labs”, “Pharma Company”, and “Sales”. Complainant asserts that this is “a monetized parking page that contains affiliate links for goods and services associated with Complainant’s DAIICHI SANKYO Trademark”. While Respondent has submitted a document titled “Response To Complaint” that lists Respondent and its Representative, and contains a list of named candidates titled “Administrative Panel”, the remainder of the document consists of 34 blank pages. This is not the first time that Respondent has submitted such an odd and incomplete Response.² As such, the Panel concludes that Respondent does not contest Complainant’s evidence or its characterization of the daiichisankyo.ca website. The Panel agrees with Complainant that the pay-per-click links at Respondent’s website are related to Complainant’s line of business. This, combined with the words that make up the Domain Name, leads to the conclusion, on a balance of probabilities, that Respondent is seeking to attract, for commercial gain, internet users to its daiichisankyo.ca website by creating a likelihood of confusion with the Complainant’s DAIICHI SANKYO mark. The facts of this case fit the scenario of paragraph 3.5(d) of the Policy and thus Complainant has satisfied the requirement of paragraph 4.1(b).

Complainant further argues that sub-paragraph 3.5(b) applies to Respondent’s actions. This states that bad faith may be evidenced where the Registrant registered the domain name in order to prevent the Complainant from registering the Mark as a domain name provided that Registrant has engaged in a pattern of registering domain names for a similar purpose. The existence of prior adverse domain name dispute decisions against a respondent may be used to support a claim of such pattern of conduct. See *Webster Financial Corporation and Webster Bank, National Association v. Above.com Domain Privacy*, FA 1464477 (FORUM Nov. 30, 2012) (where the record reflects that the Respondent had been a respondent in other UDRP proceedings in which it was ordered to transfer disputed domain names to various complainants, this establishes a pattern of bad faith registration and use of domain names under Policy ¶ 4(b)(ii)). In addition to the decisions cited in Footnote 2 of this decision, Complainant points out three other cases that have been decided adverse to Respondent. See *American Express Marketing and Development Corp v. Nameshield Inc. c/o Daniel Mullen*, DCA-00249 (CIRA Feb. 5, 2014) (transfer of <americanexpresscreditcards.ca>); *Optrex Limited v. Nameshield Inc.*, DCA-00274 (CIRA Dec. 19, 2014) (transfer of <optrex.ca>); and *Virox Technologies Inc. v. Nameshield Inc.*, DCA-00344 (CIRA Oct. 6, 2017) (transfer of <virox.ca>). Based on this evidence of prior adverse decisions and the fact that the daiichisankyo.ca Domain Name prevents Complainant from reflecting its Mark *per se* in the .ca ccTLD, the Panel finds further support in sub-paragraph 3.5(b) for its conclusion that Respondent has registered the Domain Name in bad faith.

C. Does the Registrant have no Legitimate Interest in the Domain Name per Policy 4.1(c)?

Paragraph 4.1(c) of the Policy states that “[t]o succeed in the Proceeding, the Complainant must prove, on a balance of probabilities, that:”

(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

Paragraph 3.4 provides seven examples of scenarios, any one of which, if supported by evidence, could lead to the conclusion that Respondent has a legitimate interest in the Domain Name. These are as follows:

a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;

¹ A reading of this decision indicates that the Panel is referring to paragraphs 3.5(b), 3.5 (c) and 3.5 (d) of the Policy.

² In *Kate Spade LLC v. Nameshield Inc.*, DCA-2221 (CIRA July 13, 2020), “Registrant provided a certificate signed on behalf of the Registrant and the first page of the Response Transmittal Coversheet with the names of the parties and the Registrant’s nominees to administrative panel, but no response to the Complaint.” See also, *Dell Inc. v. Nameshield Inc./Daniel Mullen*, DCA-1677 (CIRA Aug. 2015) (“Registrant submitted its Response. Upon review, the Centre found that three of out five pages of the Response were empty. The Centre contacted the Registrant by email and phone to attempt to recover the missing pages, but its attempts were unsuccessful.”)

- b) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of:
 - (i) the character or quality of the wares, services or business;
 - (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or
 - (iii) the place of origin of the wares, services or business;
- c) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;
- d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
- e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or
- f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

It is to be noted that, in Paragraphs 3.4(a), (b), (c), and (d), there is a requirement that the Registrant act "in good faith". There is no evidence before the Panel that the Registrant used the Domain Name and its associated website in good faith or that it in any other way fit within the scenarios set out in the above-mentioned subparagraphs. To the contrary, there is evidence that the Respondent used the Domain Name to trade upon the goodwill of the Complainant and its distinctive DAIICHI SANKYO mark in furtherance of commercial gain through a pay-per-click website. Therefore, the Panel finds that the provisions of these four sub-paragraphs do not apply here.

Further, the Registrant's name is listed in the relevant Whois record as "Nameshield" and its administrative contact is listed as "Daniel Mullen". These names bears no resemblance to the Domain Name. Also, there is no geographical reference in the Domain Name and it does not identify the location of any non-commercial or legitimately operated place of business by Respondent. As such, the provisions of sub-paragraphs 3.4(e) and 3.4(f) do not apply. The Panel finds that Complainant has provided adequate evidence that the Registrant has no legitimate interest in the Domain Name and Respondent has chosen not to rebut Complainant's assertions or evidence or to otherwise explain its actions in any way.

In light of the submitted evidence and on a balance of probabilities, the Panel finds that Registrant has no legitimate interest in the Domain Name.

5 DECISION and ORDER

The Panel finds that the Complainant has satisfied its burden of proof with respect to all three elements of Paragraph 4.1 of the Policy. For the reasons stated above, and in accordance with Paragraph 4 of the Policy and Paragraph 12 of the Rules, the Panel orders that the domain name daiichisankyo.ca be transferred to the Complainant.

Panel:
Steven M. Levy, Esq.