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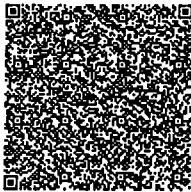
INDIA NON JUDICIAL

Government of National Capital Territory of Delhi

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Certificate Issued Date : 08-Feb-2024 11:27 AM
Account Reference : IMPACC (IV)/ di717303/ DELHI/ DL-DLH
Unique Doc. Reference : SUBIN-DL71730343069746503490W
Purchased by : AJAY GUPTA ARBITRATOR
Description of Document : Article 12 Award
Property Description : Not Applicable
Consideration Price (Rs.) : 0
(Zero)
First Party : AJAY GUPTA ARBITRATOR
Second Party : OTHERS
Stamp Duty Paid By : AJAY GUPTA ARBITRATOR
Stamp Duty Amount(Rs.) : 100
(One Hundred only)



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INDRP ARBITRATION CASE NO.1815
THE NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: AJAY GUPTA

Viatrix Specialty LLC

Vs.

Merimed

Statutory Alert:

DISPUTED DOMAIN NAME: "vigra.in"

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Ajay

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THE NATIONAL INTERNET EXCHANGE OF INDIA (NIXI)

ADMINISTRATIVE PANEL DECISION
SOLE ARBITRATOR: AJAY GUPTA

VIATRIS SPECIALTY LLC

3711 Collins Ferry Road, Morgantown,
West Virginia 26505

[United States of America].

... Complainant

VERSUS

MERIMED

471, Atterna

Sonepat-131023 (HARYANA).

India

... Respondent

Disputed Domain Name: "vigra.in"



1. THE PARTIES

- 1.1 The Complainant in this administrative proceeding is Viatrix Specialty LLC, having address at 3711 Collins Ferry Road, Morgantown, West Virginia 26505 [United States of Americas].
- 1.2 The Complainant's authorized representative in these proceedings is SAIKRISHNA & ASSOCIATES, B-140, SECTOR 51, NOIDA- 201301.
- 1.3 The Respondent, in this arbitration proceedings is Merimed ,471, Atterna Sonapat (HARYANA) - [INDIA] as given by the WHOIS database maintained by the National Internet Exchange of India (NIXI).

2. THE DOMAIN NAME AND REGISTRAR

- 2.1 The disputed domain name is "vigra.in" and the Registrar with which the disputed domain name registered is : GoDaddy.com, LLC 2155 E Godaddy Way Tempe, AZ, 85284-3409 [UNITED STATES].

3. PROCEDURAL HISTORY [ARBITRATION PROCEEDINGS]

- 3.1 This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy [INDRP], adopted by the National Internet Exchange of India (NIXI). The INDRP Rules of Procedure [the Rules] were approved by NIXI on 28th June 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to the resolution of the disputes under the .IN Dispute Resolution Policy and Rules framed thereunder.

email on 01.02.2024. The hard copy of the complaint along with annexures was also

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3.2 The history of this proceeding is as follows :

3.2.1 That as required by the NIXI, I submitted the Statement of Acceptance & Declaration of Impartiality and Independence Dated 01.02.2024 to NIXI in accordance with Rules 2(a) and 4(a). NIXI on 01.02.2023 formally notified the Respondent of the complaint along with a copy of the complaint & annexures, and appointed me as the Sole Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, and the Rules framed thereunder, IN Domain Resolution Policy and the Rules framed thereunder.

3.2.2 This panel on receipt of the copy of the complaint from NIXI via email dated 01.02.2024, further via its email dated 05.02.2024 directed the Complainant to update the complaint with Respondent's missing details as mentioned in WHOIS details given by NIXI. This panel on receipt of updated complaint from the Complainant, commencing the arbitration proceedings sent an Arbitration Notice Dated 07.02.2024 via email dated 07.02.2024 to all the parties including Respondent and Complainant panel under Rule 5(c) of INDRP Rules of Procedure, with direction to the Respondent to file a reply of the complaint, if any, within 10 days, i.e., by 16.02.2024. The authorized representative of the Complainant via its mail dated 12.02.2024 informed this panel about serving of the copy of complaint, annexures and Arbitration Notice to the respondent through email on 07.02.2024. The hard copy of the complaint along with annexures was also

dispatched through courier at Respondent's postal address by complainant's authorized representative, but the same was returned undelivered with remark "**Consignee Refused to accept**", and as a proof of the same Complainant authorised representative attached a tracking report with its email dated 12.02.2024.

3.2.3 This panel vide its Arbitration Notice dated 07.02.2024 had directed the Respondent to file the reply of complaint, if any, within 10 days of the notice and therefore respondent was supposed to file the reply of the complaint by 16.02.2024. However, the respondent failed to file the reply of complaint, 'if any' in time despite the receipt of soft copy and also refused to accept the hard copy of the complaint sent through courier. In view of the aforesaid facts and circumstances, the respondent was proceeded ex-parte on 17.02.2024 and information about the same was communicated by this panel to the respondent, complainant and others via mail dated 17.02.2024.

4. **THE RESPONDENT'S DEFAULT**

4.1 It is a well-established principle that once a Complainant makes a prima facie case showing that a Respondent lacks rights to the domain name at issue; the Respondent must come forward with proof that it has some legitimate interest in the domain name to rebut this presumption. The disputed domain name in question is "vigra.in".

4.2 INDRP Rules of Procedure require under Rule 8(b) that the arbitrator must ensure that each party is given a fair opportunity to present its case. Rule 8(b) reads as follows :



"In all cases, the Arbitrator shall ensure that the parties are treated with equality and that each party is given a fair opportunity to present its case."

4.3 The Respondent was notified of this administrative proceeding per the Rules. The .IN discharged its responsibility under Rules paragraph 2(a) to employ reasonably available means calculated to achieve actual notice to the Respondent of the complaint.

4.4 The panel finds that the Respondent has been given a fair opportunity to present his case. The Respondent was given direction to file a reply of the Complaint 'if any', but the Respondent neither replied to the notice sent by this tribunal nor filed the reply of the complaint, thus failed to comply with the directions of this tribunal. The 'Rules' paragraph 12 states, "In the event, any party breaches the provisions of INDRP rules and/or directions of the Arbitrator, the matter can be decided ex parte by the Arbitrator and such arbitral award shall be binding in accordance to the law". In these circumstances, the panel's decision is based upon the Complainant's assertions, evidence, inferences, and merits only as the Respondent has not replied despite opportunity given in this regard and was proceeded ex parte.

5. BACKGROUND OF THE COMPLAINANT & ITS SUBMISSIONS ABOUT THE TRADEMARK "VIAGRA", ITS STATUTORY AND COMMON LAW RIGHTS ADOPTION :

5.1 The Complainant, in the present arbitration proceedings to support their case, has relied and placed on records documents as Annexures and made the following submissions :



5.1.1 The Complainant submits that it is formerly known as Upjohn US 1 LLC, and has changed its name to Viatris Specialty LLC, its present name, on January 1, 2022. The ultimate parent company of the Complainant is Viatris, Inc., a global healthcare company formed in the year 2020 through the combination of Mylan and Upjohn, a legacy division of Pfizer.

5.1.2 The Complainant submits that it was founded more than six decades ago in the year 1961, the Complainant's predecessors (Mylan) began operations as a distributor, purchasing finished goods and reselling them to pharmacies and pharmaceutical manufacturers. Over a period of time, it has grown to become one of the largest manufacturers of generic drugs in the U.S. The Complainant submits that its strategy then led to many acquisitions which have played a significant role in the evolution of the company. These acquisitions assisted in creating robust research, manufacturing, supply chain and commercial platforms on a global scale; substantially expanding its portfolio of medicines; diversifying by geography, product type and channel; maintaining its commitment to quality; and cultivating its global workforce. Today, with products selling in more than 165 countries with around 50 manufacturing facilities and nearly 45,000 of the colleagues globally, the Complainant is one of the world's largest Active Pharmaceutical Ingredient (API) manufacturers. The Complainant submits its global scale and differentiated portfolio include brands, generics, and complex medicines across a wide variety of therapeutic areas.



5.1.3 The Complainant submits that in the year 1998, the Complainant's predecessor launched "VIAGRA", a revolutionary product for the treatment of male erectile dysfunction in the United States, after extensive research and clinical trials. The drug "VIAGRA" was approved by the U.S. Food and Drug Administration on March 27, 1998.

5.1.4 The Complainant further submits that the path breaking discovery of the Viagra drug took the pharmaceutical industry by surprise and even before its official launch, the Viagra drug was covered in reputed magazines, news articles, and journals, such as Newsweek, The Wall Street Journal, etc., as well as in popular television programs including "20/20" and "Today". The FDA Approval in the United States in March 1998 was also highly publicized, including front page coverage in the 'New York Times' the following day, and featured in articles in other major publications such as 'USA Today'. The Complainant further submits that it officially launched the products under its trademark "VIAGRA" in India in December 2005. However, the Complainant's vast reputation and goodwill accrued for its Mark "VIAGRA" had spilled over into India even before the formal launch of "VIAGRA" products by way of the extensive media coverage.

6. SUBMISSIONS OF COMPLAINANT ABOUT THE TRADEMARK "VIAGRA", ITS STATUTORY AND COMMON LAW RIGHTS ADOPTION.

6.1 The Complainant submits that in addition to the common law rights accruing in favour of the Complainant's "VIAGRA" trademark, the Complainant is also the

registered proprietor of the said mark in various jurisdictions around the world, including India. The Complainant submits that, registration for the mark "VIAGRA" in India dates back to July 18, 1996 and the said registration is still valid and subsisting. It is submitted that registration for the mark "VIAGRA" has been assigned in favour of Upjohn US 1 LLC and, the name of Upjohn US 1 LLC has changed to Viatri Specialty LLC and the relevant request for the rerecord of the same is currently pending.

- 6.2 The Complainant further submits that to consolidate and maintain a formidable presence on the Internet, the Complainant registered its domain name <VIAGRA.COM> on June 19, 1997. This domain hosts the Complainant's website located at <www.viagra.com>. It is noteworthy that the mark "VIAGRA" is displayed prominently on each webpage. The Complainant submits that the Complainant is the registered owner of various domain names, including but not limited to:

Sr. No.	Domain Name	Registration Year
1.	VIAGRA.COM	1997
2.	VIAGRA.CO. UK	1997
3.	MYVIAGRA.COM	2001
4.	BLUE-VIAGRA.COM	2002
5.	CHOOSEVIAGRA.COM	2002
6.	CHOOSEVIAGRA.NET	2002
7.	GENERICVIAGRA.COM	2002

8.	GENERIC-VIAGRA-SALES.COM	2003
9.	SHOPVIAGRA.COM	2003
10.	VIAGRA.CN	2003
11.	VIAGRA.IN	2005

6.3 The Complainant further submits that pertinently, the domain name, **VIAGRA.IN**, was transferred to the Complainant *vide* order dated December 19, 2005, passed by the Hon'ble High Court of Delhi pursuant to the suit titled "*Pfizer Products Inc. Vs. Altamash Khan & Ors. (MANU/DE/0269/2006)*" filed by Complainant's predecessor "Pfizer".

7. ENFORCEMENT ACTIONS BY COMPLAINANT AND DISPUTE RESOLUTIONS

7.1 The Complainant submits that it has been active and vigilant in enforcing and protecting its rights in its mark "**VIAGRA**".

7.2 The Complainant further submits that actions taken by the Complainant includes filing domain name complaints, filing oppositions with the Indian Trade Marks Registry, sending Legal Notices/ take down notices, filing civil suit for infringement and passing off against the third party's unauthorized use and applications for the registration of the marks deceptively similar or identical to the "**VIAGRA**" mark.

7.3 The Complainant submits that additionally, the Complainant's mark "**VIAGRA**" has also been determined and acknowledged as a "**well-known trade mark**" in several domain name disputes under the Uniform Domain-Name Dispute- Resolution Policy.

7.4 The complainant in this regard has also relied on the decision of Hon'ble High Court of Delhi in *Pfizer*

Products Inc. v. Mittal Nathalal Patel and Ors [CS(OS) 3271/2012], basis the analysis and evaluation of the documents filed in support of the envious reputation and goodwill of the mark VIAGRA globally and India , determined the mark "VIAGRA" as a **"well-known trademark"** in India. The Complainant further submits that in addition to this, the mark "**VIAGRA**" has also been determined to be a **"well-known trade mark"** by foreign courts.

8. THE ISSUES INVOLVED IN THE DISPUTE

8.1 The Complainant in its complaint has invoked paragraph 4 of the INDRP, which reads :

"Types of Disputes

Any person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the.IN Registry on the following premises :-

The disputed domain name is identical or confusing similar to a trademark in which the Complainant has statutory /common law rights.

The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The disputed domain name has been registered or is/is being used in bad faith.

The above-mentioned 3 essential elements of a domain name dispute are being discussed hereunder in light of the facts and circumstances of this complaint."

9. Parties Contentions

9.1 **The Registrant's Domain Name is Identical and/or Confusingly similar to a Mark in Which the Complainant has Rights.**

COMPLAINANT

9.2 The Complainant submits that the present complaint is being filed on account of the unauthorized and illegal

use of the Complainant's registered trademark **"VIAGRA"** by use of a deceptively similar term **'VIGRA'** as part of the Respondent's domain name <vigra.in>.

- 9.3 The Complainant submits it offers for sale product for the treatment of male erectile dysfunction under the trademark **"VIAGRA"** and is the registered proprietor of the well-known brand/ trademark **"VIAGRA"**.
- 9.4 The Complainant submits that it adopted the trademark **"VIAGRA"** globally in 1998 and officially launched the same in India in December 2005.
- 9.5 The Complainant submits that it is the rightful proprietor of the trademark **"VIAGRA"** by virtue of priority in adoption, registration, continuous and extensive use, widespread advertising, and the tremendous reputation accruing in the course of trade.
- 9.6 The Complainant submits that the Disputed Domain Name is virtually identical/confusingly similar to the Complainant's registered and well-known trademark **"VIAGRA"**. The disputed domain name comprises of the term **'VIGRA'**, which is virtually identical/confusingly similar to the Complainant's well-known trademark **"VIAGRA"**, except for the letter **'A'**. The Respondent is deliberately using a misspelling of the Complainant's well-known trademark **"VIAGRA"** by omitting the letter **'A'** from the same with an intent to ride upon the goodwill and reputation of the Complainant. In light of the conspicuous similarity between the Disputed Domain Name and the Complainant's trademark, an Internet user may be misled when coming across the Disputed Domain Name. In this regard, the Complainant has put reliance on the findings in **Carrefour SA v.**

Sophie Schemann, Personal Use, Case No.D2022-0966 <https://www.wipo.int/amc/en/domains/decisions/pdf/2022/d2022-0966.p@>, wherein the Panel stated that "...Misspelling a mark in a domain name such as the omission of one letter does not prevent the domain name containing that misspelling being confusingly similar to a complainant's mark ... ". Given that the Complainant's prior registered and well-known trademark **"VIAGRA"** has been blatantly misused by the Respondent in the Disputed Domain Name by misspelling the same, is sufficient to establish confusion for the purposes of the Policy.

9.7 The Complainant has also put reliance on the Panel's decision in *Pfizer Inc. (Pfizer) v. Individual, C/0John Callum, Case No.D2003-0419* (<https://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0419.html>), the Panel held that "... the Domain Name is identical to the registered trademark save for a "y" being used instead of an "i" resulting in "vyagra" instead of "viagra ... ". It is pertinent to note that the Learned Panel had passed the favorable order in favor of the Complainant's predecessor - Pfizer - that had initiated the complaint basis the mark VIAGRA which forms the subject matter of the instant complaint.

9.8 The Complainant further submitted that it has established its rights in the trademark **"VIAGRA"** on account of its extensive global use and trademark registrations. The Complainant further submits that since the Disputed Domain Name is virtually identical/confusingly similar to the Complainant's mark in which the Complainant has prior rights, the relevant public and the people visiting the Disputed Domain Name will



definitely associate the said Disputed Domain Name with the Complainant alone. The Complainant has also relied on the case of LEGO Juris A/S Vs. Domain Administrator, Rich Premium Limited/C/o WHOIS trustee.com Limited (WIPO Case No.D2014-1565) (<https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2014-1565>) wherein it was held that *"The Panel finds that the Complainant has rights in the Trade Mark acquired through use and registration which predate the date of registration of the disputed domain names by several decades. The disputed domain names are identical to the Trade Mark. The Panel therefore finds that the disputed domain names are confusingly similar to the Trade Mark"*.

9.9 The Complainant submits that pursuant to the already existing goods of the Complainant under the trademark **"VIAGRA"**, there exists a very high chance of association of the disputed domain name with the Complainant's mark in the minds of the Internet users. The user will be forced to associate/ derive a nexus between the Respondent's website and that of the Complainant's popular trademark **"VIAGRA"**. It is pertinent to mention that the Frequently Asked Questions (FAQ) section in the disputed domain name mentions the name of the Respondent's products as 'VIAGRA' instead of 'VIGRA'.

9.10 The Complainant further submits that given that a consumer on visiting the disputed Domain Name will come across mention of the Complainant's prior registered and well-known trademark **"VIAGRA"**, the Internet users will naturally assume that the Disputed Domain Name belongs to or has been authorized by the Complainant. In this regard, complainant has relied on

the case of Apple Inc. v. Fred Bergstrom, Lotta Carlsson, Georges Chaloux and Marina Bianchi, WIPO , wherein the Panel held that *'merely causing Internet users to wonder whether the domain name is associated with the complainant is confusion enough.'* As such, Internet users will naturally be confused by the identity of the Disputed Domain Name and the Complainant's registered trademarks which will further be enhanced by the Disputed Domain Name mentioning the Complainant's prior registered and well-known trademark "VIAGRA".

9.11 The Complainant further submits that an Internet user who carries out a Whois search for the Disputed Domain Name will find that the registration of <vigra.in> is in the name of the Respondent, or, alternatively, is not in the name of the Complainant. It is submitted that, it will further upsurge the severe confusion in the mind of such a user and would mislead a user into believing that the Respondent is in some way associated with or affiliated to the Complainant, or that the Respondent is acting with the consent or endorsement of the Complainant, which is not the case.

9.12 The Complainant submits that the disputed domain name <vigra.in> is virtually identical/confusingly similar to the Complainant's well-known brand/trademark "**VIAGRA**".

RESPONDENT

9.13 The Respondent has not replied to Complainant's contentions.

PANEL OBSERVATIONS

9.14 This Panel on pursuing the pleadings, documents and records submitted by Complainant observes that the

Complainant, is one of the largest manufacturers of generic drugs in the U.S. and also one of the world's largest Active Pharmaceutical Ingredient (API) manufacturers. The Complainant launched "**VIAGRA**", a revolutionary product for the treatment of male erectile dysfunction in the United States and this product because of its reputation and goodwill is famous worldwide including in India. This panel further observes that by virtue of media publicity and recognition 'VIAGRA' has acquired distinctiveness and is associated solely with the Complainant.

9.15 This panel observes that in addition to the common law rights accruing in favour of the Complainant's "**VIAGRA**" trademark, the Complainant is also the registered proprietor of the said mark in various jurisdictions around the world, including India. The Complainant, in order to prove that it has trademark rights and other rights in the mark "VIAGRA", has submitting substantial information and documents in support of it. It is further observed by this panel that the Complainant's use of the VIAGRA Name and Marks also precedes the date of registration of the disputed domain name.

9.16 It is further observed by this panel that, the Disputed domain "vigra.in" comprises the Complaint's trademarks "viagra" except letter 'A' , and mere deletion of the letter "A" from the mark VIAGRA, and the country-code top level domain .IN does nothing to distinguish the domain name from the VIAGRA Name and Marks.

9.17 This panel, therefore, is of opinion that by registering the disputed domain name "vigra.in", there is a likelihood of confusion between the disputed domain

name and the Complainant's trademark "VIAGRA, and the domain names associated with it. The disputed domain name registered by the Respondent is confusingly similar to the trademark "VIAGRA" of the Complainant.

9.18 It is the responsibility of the Respondent to find out before registration that the domain name he is going to register does not violate the rights of any proprietor/ brand owner and the respondent has miserably failed in following this condition.

9.19 This Panel, therefore, in light of the contentions raised by the Complainant concludes that the disputed domain name "vibra.in" is confusingly similar to the Complainant marks "VIAGRA". Accordingly, the Panel concludes that the Complainant has satisfied the first element required by Paragraph 4(a) of the INDR Policy.

10. The Respondent has no rights or legitimate interests in respect of the domain name.

COMPLAINANT

10.1 The Complainant submits that the Respondent has no proprietary or contractual rights in the Complainant's trademark "**VIAGRA**" in whole or in part. The Respondent could have no possible justification for registering the Disputed Domain Name which comprises the term '**VIGRA**', which is virtually identical/confusingly similar to the Complainant's inherently distinctive, coined, and well-known trademark "**VIAGRA**". The Respondent has, therefore, registered a domain name without the Complainant's consent or authorization and with no rights or legitimate interests with respect of the disputed domain name.

10.2 The Complainant submits that the Respondent is not commonly known by the Disputed Domain Name nor does the Respondent engage in any business or commerce under the trademark and/or trade name **"VIAGRA"**. The Respondent is not a licensee of the Complainant, nor has ever been authorized by the Complainant to use the Complainant's trademark or register the Disputed Domain Name. The Complainant further submits that the Complainant has not entered into any agreement granting the Respondent any right. The Complainant has no relationship with the Respondent. In this regard, reference may also be made to the decision of the Hon'ble Tribunal in *The Toro Company v. Dick Egy, USDRP Case No.FA1404001553926* wherein it was held that *"if a Respondent is not commonly known by the disputed domain name, then the Respondent cannot have any legitimate rights or interests in the same"*. The Complainant relied on the findings by the Panel in *F. Hoffmann-La Roche AG v. WHOIS Guard Protected, WhoisGuard, Inc. I Samantha Park (WIPO Case No.D2018-2495)* , wherein, it was held that *"... the Complainant makes it clear that it has given no license or authorization to the Respondent to use the KLONOPIN trademark, and that its use without the Complainant's authorization would violate the Complainant's rights in its KLONOPIN trademark ... "* Accordingly, it is submitted that the disputed domain name violates the Complainant's rights in its registered trademark **"VIAGRA"** as the Complainant has not authorized the Respondent to use the said trademark. This substantiates the Respondent has no rights or legitimate interest in the disputed domain name.

10.3 The Complainant submits that the Respondent's Disputed Domain Name <vigra.in> hosts the website **<https://>**

vigra.in/ on which the Respondent is selling the VIGRA products and the same are used for the identical purpose of Erectile Dysfunction. Pertinently, the Respondent has used the Complainant's mark "VIAGRA" to refer to its mark "VIGRA".

10.4 The Complainant submits that clearly, the Respondent is using the Disputed Domain Name which is identical/ confusingly similar to the Complainant's inherently distinctive and well-known mark "VIAGRA" and is offering for sale the products which competes with VIAGRA branded products. It follows that the Respondent is dishonestly attempting to pass-off its goods as that of the Complainant's goods with a view to make an illegal gain by riding over the goodwill and reputation of the Complainant in its VIAGRA mark. In this regard, the complainant has relied on the Panel decision in *Pfizer Inc v. Blank Canvas Projects Limited Case No.D2005-0152* www.wipo.int/amc/en/domains/decisions//ztml/2005/d20050152.lztznzl), wherein it was held that *"it is not a legitimate use of the trademark to use it in this way to attract customers and re-direct them to competing products"*. Further, a reference can be made to the Panel decision in *Sneaker Villa, Inc. d/b/a/ Villa Join The Movement v. Perfect Privacy, LLC I Charles Osorio, Sneakersvilla Case No. D2016-2651* wherein it was held that *"Respondent uses a domain name nearly identical to Complainant's mark to offer for sale goods that compete with Complainant. Such use cannot be considered a bona fide offering of goods under the Policy"*. The Complainant submits that the Respondent's rights and legitimate interests in the Disputed Domain Name are highly questionable.

RESPONDENT

10.5 The Respondent has not replied to Complainant's contentions.

PANEL OBSERVATIONS

10.6 This Panel holds that the second element that the Complainant needs to prove and as is required by paragraph 4(b) of the INDRP is that the Respondent has no legitimate right or interests in the disputed domain name.

10.7 This panel observes that the Complainant by placing documents/records and evidence in the form of annexures along with the complaint has been able to prove, that the Complainant is manufacturer of its product 'VIAGRA'. The Complainant by virtue of its product's reputation and goodwill worldwide including in India, has acquired the exclusive right to use the 'VIAGRA' mark in respect of its product, used for the treatment of male erectile dysfunction.

10.8 It is observed by this panel that the Respondent has failed to rebut the allegations of the complainant that the Respondent has no proprietary or contractual rights in the Complainant's trademark "**VIAGRA**" in whole or in part. The Respondent further failed to rebut the allegations of the Complainant that the Respondent could have no possible justification for registering the Disputed Domain Name which comprises the term '**VIGRA**', which is virtually identical/ confusingly similar to the Complainant's inherently distinctive, coined, and well-known trademark "**VIAGRA**", and the Respondent has, therefore, registered a domain name without the Complainant's consent or authorization and with no rights or

legitimate interests with respect of the disputed domain name.

10.9 It is observed by this panel that the Respondent has failed to rebut the allegations of the complainant, that the Respondent is not commonly known by the Disputed Domain Name nor does the Respondent engage in any business or commerce under the trademark and/or trade name "**VIAGRA**", and the Respondent is not a licensee of the Complainant, nor has ever been authorized by the Complainant to use the Complainant's trademark or register the Disputed Domain Name. The Respondent also failed to rebut the allegation of the Complainant that the Complainant has not entered into any agreement granting the Respondent any right, and the Complainant has no relationship with the Respondent.

10.10 It is observed by this panel that the Respondent has failed to rebut the allegations of the complainant that the disputed domain name violates the Complainant's rights in its registered trademark "**VIAGRA**" as the Complainant has not authorized the Respondent to use the said trademark and which substantiates that the Respondent has no rights or legitimate interest in the disputed domain name.

10.11 It is observed by this panel that the Respondent has failed to rebut the allegations of the complainant that the Respondent's Disputed Domain Name <vigra.in> hosts the website <https://vigra.in/> on which the Respondent is selling the VIGRA products and the same are used for the identical purpose of Erectile Dysfunction and , the Respondent has used the Complainant's mark "VIAGRA" to refer to its mark "VIGRA".

10.12 It is observed by this panel that the Respondent has failed to rebut the allegations of the complainant that the Respondent is using the Disputed Domain Name which is identical/ confusingly similar to the Complainant's inherently distinctive and well-known mark "VIAGRA" and is offering for sale the products which competes with VIAGRA branded products, and the Respondent is dishonestly attempting to pass-off its goods as that of the Complainant's goods with a view to make an illegal gain by riding over the goodwill and reputation of the Complainant in its VIAGRA mark.

10.13 It is observed by this panel that once the Complainant makes a prima facie case showing that the Respondent does not have any rights or legitimate interest in the domain name, the burden to give evidence shifts to the Respondent to rebut the contention by providing evidence of its rights or interests in the domain name. The Respondent has failed to place any evidence to rebut the allegations of the Complainant.

10.14 It is further observed by this panel that para 6 of the IN Domain Name Dispute Resolution Policy (INDRP) states :

Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for Clause 4 (b) :

"(a) before any notice to the Registrant of the dispute, the Registrant's 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; (b) the Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or (c) the Registrant is making a legitimate non-commercial 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."

- 10.15 This panel observe that the respondent also failed to full fill any of the requirements as mentioned in para 6 of INDRP Policy which demonstrates the Registrant's rights to or legitimate interests in the domain name for Clause 4 (b). For these reasons, the Panel holds that the Complainant has proved that the Respondent does not have any rights or legitimate interests in the disputed domain name 'VIGRA.IN'.

The Registrant has Registered or Used the Domain Name in Bad Faith

COMPLAINANT

- 10.16 The Complainant submits that the Paragraph 7 of the Policy lists three circumstances that, without limitation, shall be evidence of the registration and use of a domain name in bad faith. These circumstances should be given close attention in the light of the facts of this case :

circumstances indicating that you have registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant, who bears the name or is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

you have registered the domain name to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, if you have engaged in a pattern of such conduct; or

by using the domain name, you intentionally attempt to attract Internet users to your website and other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location; or

10.17 The Complainant submits that the Respondent has registered the Disputed Domain Name solely with an ulterior motive to make monetary profits by riding upon the goodwill and reputation of the Complainant's prior registered and well-known trademark. The Complainant further submits that the Respondent applied for the Disputed Domain Name on February 12, 2023, which is much subsequent to the date of adoption, use, and registration of the trademark "**VIAGRA**" by the Complainant, *i.e.*, 1990s.

10.18 The complainant submits that the mention of the Complainant's well-known and registered trademark 'VIAGRA' on the Disputed Domain Name without any authorization suggests the Respondent's strong bad faith. The Disputed Domain Name was registered by the Respondent after complete knowledge of the Complainant's well-known trademark "**VIAGRA**" with an ill-motive to gain unfair advantage. It cannot be a mere con-incidence that the Respondent adopted and registered the Disputed Domain Name which is nearly identical to the Complainant's well-known and coined trademark "VIAGRA". The dishonesty and *nuzla fide* are

further accentuated with the fact the same has been registered for offering products that compete with the VIAGRA branded products. The Complainant submits that it is undisputed that the Respondent has registered the Disputed Domain Name to illegally benefit from the goodwill and reputation of the Complainant's well-known trademark "**VIAGRA**" and such dishonest use amounts to use and registration in *bad faith*. Further, the Disputed Domain Name is not only registered in *bad faith* but is also being used by the Respondent in *bad faith*, as it offers identical products for identical purpose as claimed by the Complainant's well-known trademark "VIAGRA". Moreover, the Disputed Domain Name mentions the Complainant's well-known trademark "VIAGRA" in the Frequently Asked Questions (FAQ) section. In this regard, complainant has relied on the Panel's decision in New Dream Network, LLC v. Yuanjin Wu, Case No. DCO2010-0013 , the Panel held that "... *the Respondent by using the disputed domain name, intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. The evidence in this case is suggestive of such bad faith...*". Further, the Complainant relies on the Panel's decision in AB Kvillstidningen Expressen Vs. Privacy Contact, UnoEuroWebhosting, Case No. D2018-1049 , the Panel held that "...*It is likely that the Respondent knew of the Complainant and its business when the Respondent registered the Domain Name, in particular taking into account the name of the Complainant's newspaper, and the misspelling and mimicking of the Complainant's official web page. The misspelling and mimicking mislead consumers to*

*believe that they have entered the Complainant's genuine site... ". It is submitted that in the present case as well, the Disputed Domain Name is a misspelling of the Complainant's well-known trademark "VIAGRA" and hence, Internet users are bound to be confused regarding the source of the Disputed Domain Name. It is further submitted that moreover, the website hosted on the Disputed Domain offers the goods for identical purpose and finds mention of the Complainant's well-known trademark further indicates the strong *bad faith* on the Respondent's part.*

10.19 The Complainant submits that in light of the fact that the Disputed Domain Name mentions the Complainant's well-known trademark "VIAGRA", establishes that the Respondent was aware of the Complainant's trademarks when registering the disputed domain name. This is clear evidence that the registration of the Disputed Domain Name was made to gain monetary benefits by misleading and diverting Internet users. This also confirms that the Respondent knew the Complainant and its trademarks rights and is a clear case of use in bad faith. The Complainant places reliance on Koenigsegg Automotive AB Vs. Registration Private, Domains By Proxy, LLC / MPH Club (Case No. D2021-2891)

10.20 The Complainant further submits that the date of registration of the Disputed Domain Name is February 12, 2023, and is significantly subsequent to the dates of adoption & use of the Complainant's mark **VIAGRA**. The Complainant is extremely well-known and popular amongst the Indian populace and there is virtually no possibility that the Respondent was unaware of its existence or presence in the market. This is further substantiated by the fact that the Respondent itself is

mentioning the Complainant's well-known trademark "VIAGRA" on the Disputed Domain Name. The Complainant submits as the Respondent was evidently aware of Complainant's presence, popularity, and stature, there can be no legitimate ground or reason for which the Respondent would register a domain name which is virtually identical to the well-known trademark of another company to attract Internet users to its website. It has been observed in *Signify Holding B.V. v. Private Registration ITomas Baran*, WIPO Case No.D2019-3135 at that "In any event it is well established that registration of a well-known trade mark as a domain name is itself likely to give rise to a finding of bad faith". Previously in *Mari Clarie Album v. Marie-Claire Apparel Inc.* (D2003-0767), *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. Herreveld*, (D2000-0776), *Adidas-Salomon AG v. Domain Locations* (D2003-0489), it has been held that registration of a well-known trademark of which the Respondent must reasonably have been aware is sufficient to amount to bad faith. It is accordingly submitted that by no stretch of imagination can it be conceived that the Respondent was unaware of the staggering presence of the Complainant and its rights in the trademark "**VIAGRA**".

- 10.21 The Complainant submits that the Respondent has registered the Disputed Domain Name primarily for the purpose of disrupting the business of the Complainant, and the Disputed Domain Name, therefore, has been registered in bad faith.

RESPONDENT

- 10.22 The Respondent has not replied to Complainant's contentions.

PANEL OBSERVATION

10.23 This panel while going through the complaint and documents which are placed in the form of annexures has observed that Complainant adopted the mark VIAGRA prior to the date on which Respondent registered the domain <vigra.in>. It is observed by this panel that the Complainant has statutory and common law rights in the mark VIAGRA and is also using the mark VIAGRA, in other domain names, and as a trading name prior to registration of disputed domain name. There is also nothing on record to show that Respondent has ever registered the mark VIAGRA.

10.24 It is observed by this panel, that there is nothing on record to show that the respondent has any relationship with complainant or with the complainant's mark "VIAGRA". It is further observed by this panel that the registration and use of the disputed domain name diverts potential customers looking for Complainant's business and products to the Respondent's website under the disputed domain name. It is rightly submitted by the Complainant that, it cannot be a mere con-incidence that the Respondent adopted and registered the Disputed Domain Name which is nearly identical to the Complainant's well-known and coined trademark "VIAGRA", and the dishonesty and mala fide are further accentuated with the fact the same has been registered for offering products that compete with the VIAGRA branded products. It is also rightly submitted that customers may mistakenly believe that the disputed domain name is affiliated to complainant and may further mistakenly believe that the services offered on this website are offered by a channel partner/affiliate of the complainant. The

Complainant has been able to prove that by registering and using the disputed domain name, the Respondent has intentionally attempted to attract Internet users for commercial gains, disrupting the business of the Complainant, and there is likelihood of confusion with the complainant's well-known VIAGRA brand and its products. This is clear evidence of the Respondent's bad faith, and the Respondent's domain name registration meets the bad faith elements outlined in para 7(c) of the INDRP Policy.

10.25 It is observed by this panel that in view of the above-mentioned facts and circumstances, it is impossible to conceive that the Respondent could have registered the disputed domain name in good faith or without knowledge of the Complainant's rights in the mark VIAGRA.

10.26 The complainant has rightly established that the respondent has registered the disputed domain name in bad faith. The Respondent's domain name registration meets the bad faith elements outlined in para 4 (c) of the INDRP Policy. Therefore, the Panel concludes that the registration by Respondent is in bad faith. Consequently, it is established that the disputed domain name was registered in bad faith or used in bad faith and the Respondent has wrongfully acquired/registered the domain name VIGRA.IN in bad faith.

11. REMEDIES REQUESTED

11.1 It is submitted by the complainant that the Respondent /Registrant's domain name <vigra.in> be transferred to the Complainant and award of cost against the Respondent.

12. DECISION

12.1 This panel after going through the complaint and documents annexed with it, come to conclusion that the following circumstances are material to the issue in the present case :

- (i) Through its contentions based on documents/ records and evidence, the Complainant has been able to establish that the mark "VIAGRA" is related to a well-established product/medicine of the complainant used for the treatment of erectile dysfunction and which is famous worldwide including in India. The Complainant has also established that the trademark VIAGRA is inherently distinctive of the product of the Complainant and has secured trademark protection worldwide including in India by registering trademarks;
- (ii) The Respondent despite proper opportunity given, however, has failed to provide any evidence that it has any rights or legitimate interests in respect of the domain name, and the Respondent is related in any way to the Complainant. The Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the Disputed Domain Name;
- (iii) The incorporation of VIGRA by the respondent in the disputed domain name causes a false association between the same and the VIAGRA brand and leads the average Internet user to believe that the disputed domain name is owned by the complainant and relates to genuine VIAGRA product of the Complainant. The Respondent has

registered the disputed domain name in bad faith with full knowledge of complainant's rights and to intentionally attract, complainant's customers for commercial gains;

(iv) Taking into account the nature of the disputed domain name 'VIGRA', and in particular mere deletion of the letter "A" from the Complainant well known VIAGRA mark and the country-code top level domain, .IN thereafter does nothing to distinguish the domain name from the mark VIAGRA in any way;

(v) The Respondent also failed to comply with Para 3 of the INDRP, which requires that it is the responsibility of the Respondent to ensure before the registration of the impugned domain name by him that the domain name registration does not infringe or violate someone else's rights. The Respondent should have exercised reasonable efforts to ensure there was no encroachment on any third-party rights.

12.2 This panel is of the view that it is for the Complainant to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such a prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name but the Respondent has miserably failed to do that. The Respondent's registration and use of the domain name [www.vigra.in] are in bad faith. The Respondent has no rights or legitimate interests in respect of the domain name and also the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

RELIEF

Following INDRP Policy and Rules, this Panel directs that the disputed domain name [vigra.in] be transferred from the Respondent to the Complainant; with a request to NIXI to monitor the transfer.

New Delhi, India
Dated : February 21, 2024


AJAY GUPTA
Sole Arbitrator