

DISPUTE RESOLUTION SERVICE

D00022664

Decision of Independent Expert

GW Pharma Limited

and

420group

1. The Parties:

Lead Complainant: GW Pharma Limited
Sovereign House
Vision Park
Chivers Way
Histon
Cambridge
CB24 9BZ
United Kingdom

Respondent: 420group
30 Noster Hill
Leeds
WYK
LS11 8QE
United Kingdom

2. The Domain Name(s):

sativexdrugs.co.uk
sativextract.co.uk
sativexinfo.co.uk
sativexspray.co.uk
sativetrials.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

22 May 2020 08:59 Dispute received

27 May 2020 10:25 Complaint validated

27 May 2020 10:42 Notification of complaint sent to parties

15 June 2020 02:30 Response reminder sent

18 June 2020 14:54 No Response Received

18 June 2020 14:55 Notification of no response sent to parties

30 June 2020 02:30 Summary/full fee reminder sent

30 June 2020 10:56 Expert decision payment received

4. Factual Background

The Complainant

The Complainant was incorporated on 29 January 1999 and is a subsidiary company within the GW Pharmaceuticals Group ("GW"). GW was founded in 1998 and has operations in both the United States ("US") and the United Kingdom ("UK"). Its parent company , GW Pharmaceuticals plc ("the PLC"), is listed on the NASDAQ Stock Market Exchange. GW is a biopharmaceutical group which researches and commercialises novel therapeutics including plant-derived cannabinoid therapeutics. It developed the world's first prescription medicine derived from the cannabis plant (Sativex®) .The Complainant is responsible for the production and development of Sativex as one of GW's key pharmaceutical formulations. Sativex is now approved for the treatment of spasticity due to multiple sclerosis in over twenty-five countries outside of the US.

The Complainant owns trade mark rights in SATIVEX in the United Kingdom by virtue of, inter alia, the following registrations:

i) UK Trade Mark Registration No. 2304388 SATIVEX in Classes 5 and 31 filed 4 July 2002 and registered 29 November 2002;

ii) UK Trade Mark Registration No. 2395506 SATIVEX in Classes 9, 16, 41 and 44 filed 29 June 2005 and registered 16 December 2005;

iii) European Union Trade Mark ("EUTM") Registration No. 2993384 SATIVEX in Classes 5 and 31 filed 2 January 2003 and registered 29 October 2004;

iv) EUTM Registration No. 4800819 SATIVEX in Classes 9, 16, 41 and 44 filed 22 December 2005 and registered 23 November 2006;

The Complainant owns and operates, amongst others, a website located at <https://www.gwpharm.com/> (“the Website”). The Website references the trade mark Sativex in a prominent way. The Complainant owns the domain names “sativex.com” and “sativex.co.uk” which were registered respectively on 3 April 2004 and 22 January 2002. The Complainant has also received considerable attention in the media, much of which predates the registration dates of the disputed Domain Names (‘the Domain Names’).

The Respondent

The Respondent registered the Domain Names on 6 June 2016, except sativexspray.co.uk which was registered on 21 November 2019. Thus all of the Domain Names postdate the Complainant’s trade mark registrations by at least 12 years. They also resolve to another website which is described as an ‘online directory home for all things Hemp, CBD, Vape, Wax, Medical Cannabis plus news reviews and information’. Furthermore, they resolve to a page where they are listed for sale or ‘available to drive traffic’ to other websites. All the Domain Names are also currently on sale on eBay at the prices listed below:

sativextrials.co.uk – £9,000

sativexspray.co.uk – £57,000

sativexdrugs.co.uk – £537

sativextract.co.uk - £537

sativexinfo.co.uk - £537

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The Respondent has previously registered the following domain names :

- i) sativexinformation.com
- ii) sativexinfrmation.co.uk
- iii) sativexnews.co.uk
- iv) sativexnews.uk
- v) www.gwpharm.com

It has also been linked to the following domain names which correspond to well-known trade marks, namely Google and Kelloggs:

- i) googlebacklinks.com
- ii) googlelinks.com
- iii) kelloggscornflakes.com

The domain kelloggscornflakes.com has been subject of a FORUM domain complaint and the Panel found that the domain had been registered and used in bad faith.

5. Parties' Contentions

The Complainant's Rights

The Complainant contends as follows:

Sativex ('the Brand') is a strong and inherently distinctive term, given that it is a coined word chosen by the Complainant for marketing and branding purposes and to its knowledge has no other significance or meaning in the health, medical or pharmaceutical fields. It has no generic meaning and pages of online dictionary websites are produced to demonstrate this. In addition Google search results for the Brand on 20 September 2019 all refer exclusively to the Complainant and/or Complainant's SATIVEX product ('the Product'). It also refers to media reports which reference it and the Brand.

Abusive Registration

The Domain names are confusingly similar to its registered trade marks for the Brand as they all contain it in its entirety. The Domain Names also contain an additional word as a suffix. Rather than distinguishing the Domain Names from the Brand, they reinforce a connection between the them, given the suffixes relate to the pharmaceutical and/or medical fields ('trials', 'drugs') and/or describe or closely relate to the Complainant ('info'), the Product and/or its uses ('extract', 'spray'). The Domain Names have clearly been designed to be similar to the Brand, and this supports a finding of confusing similarity.

At the time of registration of the Domain Names the Respondent was very familiar with the Complainant and the Product. This is because, as well as the Domain Names containing the Brand with a suffix as above, they also resolve to a website which is described as an 'online directory home for all things Hemp, CBD, Vape, Wax, Medical Cannabis plus news reviews and information'. As the Product is derived from the cannabis plant, the Domain Names have been clearly designed to refer to the Complainant and the Product and to suggest a connection between the Respondent, Complainant and the Product.

The Complainant carefully controls the use of the Brand by third parties and the Respondent is not authorised to use the Brand or any similar term in any way.

The Domain Names resolve to a page where they are listed for sale or 'available to drive traffic' to other websites and they are all currently on sale on eBay at the prices listed above. This clearly indicates that the Domain Names were registered or otherwise acquired primarily for the purposes of selling, renting or otherwise transferring the them to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Names.

The Domain Names also act as blocking registrations, and are being used unfairly to disrupt the business of the Complainant and to gain significant profit through its registration of the Domain Names primarily due to their inclusion of the Mark.

The Complainant argues that the Domain Names are valuable because they drive traffic through to a separate website and the Respondent must consider that internet users will access them due to their reference to the Brand. Its competitors and other businesses that market and promote CBD-based products are likely to benefit from this. It is likely that not only consumers will be confused into believing that the Domain Names and associated websites are registered to, or operated or authorised by, or otherwise connected with the Complainant, but also that they may purchase third party products and/or services on such websites, resulting in public health and medical risks. Consumers may find themselves victims of fraudulent activities, leading to damage the Complainant's reputation and disruption to its business. On this basis, it contends that the Domain Names are Abusive Registrations under paragraph 5.1.1.2, 5.1.1.3 and 5.1.2 of the Policy.

The Respondent is also engaged in a pattern of registrations where it is the registrant of domain names which correspond to well-known names or trade marks in which it has no apparent rights (including those of the Complainant), and the Domain Names are part of that pattern. Thus the Domain Names are also Abusive Registrations as per paragraph 5.1.3 of the Dispute Resolution Service Policy. As above the Respondent has previously registered 5 domain names which contain the Brand as well as one which contains an element near-identical to the Complainant's company name GW Pharma. It no longer owns them but they are also for sale on eBay.

The Respondent has also been associated with domain names which correspond to other well-known trade marks, namely Google and Kelloggs and that the kelloggscornflakes.com domain has been subject of a successful FORUM domain complaint .

The Complainant submits that all of the above is clear evidence of Abusive Registrations and seeks transfer of the Domain Names .

The Respondent

The Respondent has not filed a Response and the Complainant has requested a full decision.

6. Discussions and Findings

Complainant's Rights

Under paragraph 2.1 of the Policy the Complainant must prove on the balance of probabilities that:

'2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration.'

Under paragraph 1 of the Policy *'Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning;'*

The Complainant has provided evidence of its rights in various registered trade marks in the Brand some dated as far back as 2002 and all of which substantially predate the Respondent's registrations. It has also provided unchallenged evidence of its significant use of the Brand on its website and by 3rd party media and that the Brand is well known and associated with its unique products. It has produced the google searches above which substantiate the prominence of the Brand and its strong association with the Complainant. The Expert accordingly considers that the Complainant has more than amply established that it has both registered and unregistered rights in the Brand.

The domain name .co.uk may be disregarded in the comparison of the Domain Names with the Brand for similarity. While the suffices cannot be disregarded, they do nothing to distinguish the Domain Names and only add to the perception that they are associated with the Complainant.

Accordingly in the Expert's view the Domain Names are identical or similar to the Brand (disregarding the .co.uk and the suffixes), in which the Complainant has Rights.

Abusive Registration

Under paragraph 1 of the Policy *'Abusive Registration means a Domain Name which either:*

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*
- ii. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;*

Paragraph 5.1 of the Policy provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration as follows:

5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights;

or 5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .UK or otherwise) which correspond to well-known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

Under paragraph 2.2 of the Policy the Complainant is required to prove its Complaint on the balance of probabilities. The Complaint has not filed a Response and therefore the facts asserted in the Complaint have not been formally contested by the Respondent.

Abusive Registration and Use

There is ample evidence provided of the significant profile and reputation acquired in the Brand. The Brand is a made-up word and to the Expert's knowledge has no generic meaning in the English language. The Respondent also has a track record of registering other well-known brand names as domain names. Further, the Domain Names incorporate the whole of the Brand without any differentiating features and significantly post-date the acquisition of its reputation. In light of all of these factors it can only be the case that the Respondent deliberately and consciously selected the Domain Names with a view to benefitting from the strong link with the Complainant and its Product that they would provide.

The Domain Names have been advertised for sale by the Respondent on the internet for prices well in excess of the Respondent's out of pocket costs. They also resolve to a 3rd party website which professes to be an online directory of products including for medical cannabis and CBD. As the Brand is associated with the first ever cannabis-based medicine and the Domain Names incorporate it in full , the Respondent must have intended to use this

association to direct traffic to this site and others. This is reinforced by the Respondent advertising them for sale and as 'available to drive traffic' to other websites. The Expert therefore considers that the Respondent clearly recognised the value in the Domain Names, that it could trade off the reputation and good will of the Brand and selected them in order to do that and with profit motivation. There can be no doubt that the requirements of paragraph 5.1.1.1. of the Policy have been met and that these are abusive registrations in the hands of the Respondent.

It follows from the Respondent's knowledge that the Domain Names would serve to drive traffic that it considered that the public would access the Domain Names believing them to relate to the Complainant's Product and the Brand and make the association between them. This not only makes the Domain Names more attractive to competitors of the Complainant, increasing their potential value, but also clearly demonstrates that confusion is likely to occur. The Expert considers that consumers will be confused into believing that the Domain Names and websites to which these direct are those of the Complainant or are authorised by it. Once they arrive on any of such websites they may purchase 3rd party products advertised there which are not authorised or licensed by the Complainant. Assuming these products to be or purport to be medicinal in nature and that they are not necessarily legitimate the Expert agrees with the Complainant that this could pose a risk to public health. In addition any adverse effects and consequences of buying and using such unauthorised 3rd party products may well be associated with the Complainant and the Brand thus potentially damaging its reputation . In all of these circumstances the Expert considers that the requirements of paragraphs 5.1.1.2, 5.1.1.3 and 5.1.2 are met. On this basis also the Domain Names are abusive registrations .

Lastly the Respondent has a history of registering other well-known domains one of which was held to be registered and used in bad faith by the Respondent in a Forum Panel decision. In the Expert's view this constitutes a pattern of registrations of domain names which correspond to well-known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern. As such the Expert considers that the requirements of paragraph 5.1.3 are met and the Domain Names are abusive on this basis also.

In all these circumstances the Expert finds on the balance of probabilities that this is a clear case of abusive registration and that the Domain Names have been both registered and used in a manner which takes unfair advantage and is detrimental to the Complainant's Rights and so is an Abusive Registration in accordance with both limbs of the Policy definition. Accordingly the Expert finds that the Domain Names are Abusive Registrations.

7. Decision

Having found that the Complainant has Rights in respect of a mark which is similar to the Domain Names and that the Domain Names in the hands of the Respondent are Abusive Registrations the Expert orders that they be transferred to the Complainant.

Signed: Gill Grassie

Dated: 28th July 2020