

ADMINISTRATIVE PANEL DECISION

Eli Lilly and Company v. Anonymize, Inc.
Case No. D2022-1783

1. The Parties

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

Respondent is Anonymize, Inc., USA.

2. The Domain Name and Registrar

The disputed domain name <e-cialis.org> (the “Domain Name”) is registered with Epik, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 17, 2022. On May 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 18, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on May 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 8, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 9, 2022.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on June 15, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Complainant, Eli Lilly and Company, is a corporation organized under the laws of the State of Indiana, USA. Complainant owns numerous registered CIALIS trademarks and trademark applications, including 138 trademark registrations and five pending trademark applications for the CIALIS mark, covering 128 countries worldwide. Complainant's rights in the CIALIS mark date back to as early as June 17, 1999, when its predecessor-in-interest, Lilly ICOS LLC, filed for registration of the CIALIS trademark in the United States, later registered under USA trademark registration No. 2,724,589 on June 10, 2003. Complainant also owns Turkish trademark registration for the CIALIS mark under trademark registration no. 99/020073 registered on November 22, 2000 in Türkiye, where Respondent appears to be operating or targeting. Further, Complainant has three pending trademark applications and 83 trademark registrations for the CIALIS Tablet figurative trademark covering 75 countries, and 57 trademark registrations of the Swirl Logo figurative trademark covering 75 countries.

Complainant also owns and operates the domain name <cialis.com>, which is used to advertise and provide information regarding the Cialis product. The domain name <cialis.com> was registered by Complainant's predecessor-in-interest on August 10, 1999 and has been used by Complainant since June 2001.

Sales of pharmaceutical products identified by the CIALIS mark began on January 22, 2003 in the European Union, followed thereafter by sales in Australia and New Zealand. Sales began in the US and in Türkiye in 2003. In 2004, approximately USD 39 million was spent to market and sell CIALIS brand product worldwide, with USA sales of the CIALIS brand product totaling more than USD 206 million, and worldwide sales of CIALIS brand product around USD 550 million. In 2019, worldwide sales of CIALIS brand product were over USD 890 million and in 2020, over USD 605 million.

Respondent registered the Domain Name on May 10, 2016. The Domain Name redirects to a web page that features and prominently displays Complainant's CIALIS trademark, Complainant's CIALIS tablet and Swirl logo figurative marks, and promotes and sells allegedly authentic CIALIS products. The website also claims that Respondent is the "main and sole" sales distributor of CIALIS brand product in Türkiye for Complainant.

Complainant sent a letter to the Registrar on or around April 22, 2022, notifying the Registrar of Respondent's conduct and requested that Respondent's account be suspended. Complainant also requested, in the alternative, that the identity of Respondent be disclosed. The Registrar did not suspend the account, nor disclose Respondent's identity, and suggest that Complainant file a UDRP action.

Complainant then filed the current UDRP action.

5. Parties' Contentions

A. Complainant

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

In particular, Complainant contends that it has trademark registrations for CIALIS and owns domain names incorporating the CIALIS trademarks. Complainant contends Respondent registered and is using the Domain Name to confuse Internet users looking for *bona fide* and well-known CIALIS products and services.

Complainant notes that it has no affiliation with Respondent, nor authorized Respondent to register or use a domain name, which includes Complainant's trademarks, and that Respondent has no rights or legitimate interests in the registration and use of the Domain Name. Rather, Complainant contends that Respondent has acted in bad faith in acquiring and setting up the Domain Name, when Respondent clearly knew of Complainant's rights.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

(i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

(ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Domain Name was registered and is being used in bad faith.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that failure to respond to the complainant's contentions would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true.

Thus, although in this case Respondent has failed to formally respond to the Complaint, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

A. Identical or Confusingly Similar

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant provided evidence of its rights in the CIALIS trademarks, as noted above. In particular, Complainant's use and registration of the CIALIS trademarks long predate the registration of the Domain Name. Complainant has also submitted evidence which supports that the CIALIS trademarks are widely known and a distinctive identifier of Complainant's products and services. Complainant has therefore proven that it has the requisite rights in the CIALIS trademarks.

With Complainant's rights in the CIALIS trademarks established, the remaining question under the first element of the Policy is whether the Domain Name, typically disregarding the Top-Level Domain ("TLD") in which it is registered (in this case, ".org"), is identical or confusingly similar to Complainant's trademark. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. [D2010-0842](#).

Here, the Domain Name is confusingly similar to Complainant's CIALIS trademarks. These trademarks, which are fanciful and inherently distinctive, are recognizable in the Domain Name. The incorporation of the CIALIS trademark with the addition of the letter with a dash: "e-", in the Domain Name does not prevent a finding of confusing similarity between Complainant's trademarks and the Domain Name.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with

evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and the CIALIS trademarks, and does not have any rights or legitimate interests in the Domain Name. Complainant has confirmed that Respondent is not affiliated with Complainant, or otherwise authorized or licensed to use the CIALIS trademarks or to seek registration of any domain name incorporating the trademarks. Respondent is also not known to be associated with or commonly known by the CIALIS trademarks.

In addition, Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, the evidence demonstrates that the Domain Name resolved to a webpage that features Complainant's CIALIS trademarks and its figurative trademarks, purportedly offering allegedly authentic CIALIS brand pharmaceutical products, while claiming on its website that it is the "main and sole" sales distributor of CIALIS brand product in Türkiye for Complainant.

Such use does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#). Moreover, there is no evidence showing that Respondent has been commonly known by the Domain Name.

Further, the nature of the Domain Name carries a risk of implied affiliation with Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

Accordingly, Complainant has provided evidence supporting its *prima facie* claim that Respondent lacks any rights or legitimate interests in the Domain Name. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Name. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Name and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Respondent's actions indicate that Respondent registered and is using the Domain Name in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, namely:

"(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who 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

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location."

The Panel finds that Complainant provided ample evidence to show that registration and use of the CIALIS trademarks long predate the registration of the Domain Name. Complainant is also well established and known. Indeed, the record shows that Complainant's CIALIS trademarks and related services are widely known and recognized. Therefore, and also noting the composition of the Domain Name itself, Respondent was likely aware of the CIALIS trademarks when it registered the Domain Name, or knew or should have known that the Domain Name was confusingly similar to Complainant's trademarks. See [WIPO Overview 3.0](#), section 3.2.2; see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

Further, the registration of the Domain Name incorporating Complainant's CIALIS trademark with the addition of the term "e-" before CIALIS - suggests Respondent's actual knowledge of Complainant's rights in the CIALIS trademark at the time of registration of the Domain Name and its effort to opportunistically capitalize on the registration and use of the Domain Name.

In addition, Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, the evidence demonstrates that the Domain Name resolved to a webpage that features Complainant's CIALIS trademarks and its figurative trademarks, purportedly offering allegedly authentic CIALIS brand pharmaceutical products, while claiming on its website that it is the "main and sole" sales distributor of CIALIS brand product in Türkiye for Complainant.

Such use does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, *supra*. Moreover, there is no evidence showing that Respondent has been commonly known by the Domain Name. See section 3.3 of the [WIPO Overview 3.0](#).

Further, the nature of the Domain Name carries a risk of implied affiliation with Complainant (see [WIPO Overview 3.0](#), section 2.5.1), interfering with Complainant's reputation, goodwill and business activities.

Lastly, in the present circumstances, including the distinctiveness and reputation of the CIALIS trademarks, the failure of Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, the use of a privacy service, and the implausibility of any good faith use to which the Domain Name may be put, support a finding of bad faith. Accordingly, the Panel finds that Respondent has registered and is using the Domain Name in bad faith and Complainant succeeds under the third element of paragraph 4(a) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <e-cialis.org> be transferred to Complainant.

/Kimberley Chen Nobles/

Kimberley Chen Nobles

Sole Panelist

Date: June 24, 2022