



## DISPUTE RESOLUTION SERVICE

D00015666

Decision of Independent Expert

Novo Nordisk A/S

and

CypDomains.com LTD

### 1. The Parties:

Complainant: Novo Nordisk A/S  
Novo Allé  
Bagsværd  
Denmark  
DK-2880  
Denmark

Respondent: CypDomains.com LTD  
3rd Floor, La Ciotat,  
Mont Fleuri  
1820  
Seychelles

### 2. The Domain Name(s):

saxenda.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 such a nature as to call in to question my independence in the eyes of one or both of the parties.

18 March 2015 07:46 Dispute received  
18 March 2015 09:26 Complaint validated  
18 March 2015 09:33 Notification of complaint sent to parties  
08 April 2015 02:30 Response reminder sent  
09 April 2015 10:35 Response received  
09 April 2015 10:36 Notification of response sent to parties  
14 April 2015 02:30 Reply reminder sent  
14 April 2015 11:17 Reply received  
14 April 2015 11:20 Notification of reply sent to parties  
14 April 2015 11:20 Mediator appointed  
17 April 2015 15:36 Mediation started  
29 April 2015 14:33 Mediation failed  
29 April 2015 14:42 Close of mediation documents sent  
12 May 2015 02:30 Complainant full fee reminder sent  
12 May 2015 09:15 Expert decision payment received  
19 May 2015 14.42 Expert issues Paragraph 13a request for evidence  
26 May 2015 14.37 Complainant provides evidence in accordance with Paragraph 13a request  
26 May 2015 Respondent comments on evidence provided by Complainant in accordance with Paragraph 13a request  
28 May 2015 11.42 Expert issues second paragraph 13a request for comment by Complainant on evidence  
29 May 2015 14.12 Complainant replies to second paragraph 13a request by Expert for comment on evidence

### **4. Factual Background**

The Complainant is a global healthcare company with trade mark registrations in, inter alia, the EU for SAXENDA, for a product to treat obesity. The trade mark registrations were applied for mid to late 2013 and registered March 2014. It owns the domain name saxenda.com.

SAXENDA is distinctive. There was extensive publicity surrounding the expected approval of the SAXENDA product a few days prior to the registration of the Domain Name. The company made an announcement re the probable approval by the FDA for the SAXENDA treatment on

September 11, 2014.

The Domain Name was registered on September 12, 2014. It has been used to point to a holding page at Saxenda.dk relating to search engine optimisation.

## **5. Parties' Contentions**

The Complainant's contentions in the Complaint can be summarised as follows:

The Complainant is a global healthcare company with trade mark registrations in, inter alia, the EU for SAXENDA, for a product to treat obesity. The trade mark registrations were applied for mid to late 2013 and registered March 2014. It owns the domain name saxenda.com.

Since the ccTLD denominator .co .uk shall be ignored for comparison, the Domain Name is identical to the Complainant's trade mark SAXENDA.

The Respondent has not received any licence or consent to use the trade mark SAXENDA from the Complainant or to register the Domain Name.

The Respondent does not have any rights or legitimate interests in the Domain Name. It did not use SAXENDA prior to the registration of the Domain Name as a trade mark or otherwise. It is not commonly known by the name.

SAXENDA is distinctive. There was extensive publicity surrounding the expected approval of the SAXENDA product a few days prior to the registration of the Domain Name. The company made an announcement re the probable approval by the FDA for the SAXENDA treatment on September 11, 2014.

The Respondent has registered the Doman Name either for the purposes of selling the Domain Name to the Complainant or to a competitor or as a blocking registration or for the purposes of unfairly disrupting the business of the Complainant.

At present the Domain Name is used to redirect Internet users to a web site at saxenda.dk which is a parking site with no real content. There is no company on the Danish register of companies operating under the SAXENDA name.

The Respondent's contentions in its Response can be summarised as follows:

The Respondent works with on line optimisation for many clients around the world. Before registering the Domain Name it searched in trade mark registers and the results were negative and so it registered the Domain Name in the UK as it could not see any infringement there.

The Complainant has no business in the UK and has no product for sale in the UK at the time the Domain Name was registered. The Complainant has not registered other SAXENDA domain names.

SAXENDA is without brand value and could mean a lot of different things. For the Respondent it is a combination of several business buzz words.

The Respondent is not in competition with the Complainant.

The Complainant's submissions in its Reply can be summarised as follows:

The trade mark SAXENDA is an invented word that has been created by a branding agency for the Complainant. It has no other meaning, nor is it suggestive. The Respondent produced no evidence that SAXENDA is a combination of several business buzz words.

Even if the Respondent is engaged in online optimization, the registration is still abusive.

Contrary to the contentions of the Respondent, the Complainant has registered domain names containing the SAXENDA mark including saxenda.com which is used as a web site for US health care professionals.

#### Paragraph 13 a Request

In response to a request by the Expert for evidence under a paragraph 13 a request the Complainant produced evidence that the announcement re

FDA approval for SAXENDA was published on at least two internationally accessible web sites on September 11, 2014. The Domain Name was registered on September 12, 2014.

## **6. Discussions and Findings**

### General

To succeed in this Complaint, the Complainant has to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, secondly, that the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy). Right is defined as 'rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning'.

### Complainant's Rights

The Complainant is the proprietor of, inter alia, a Community registered trade mark for SAXENDA for pharmaceutical preparations registered in March 2014 and applied for in October 2013. As such the Expert is satisfied that the Complainant has Rights under the Policy as set out above.

The ccTLD .co.uk is not taken into account for the purposes of comparison of a domain name with a complainant's trade mark.

Accordingly, the Expert finds that the Complainant has Rights in respect of the SAXENDA name or mark, which is identical to the Domain Name for the purposes of the Policy as it consists only of the ccTLD .co.uk and the name 'Saxenda'. As such the first limb regarding Rights has been satisfied.

### Abusive Registration

This leaves the second limb. Is the Domain Name, in the hands of the Respondent, an Abusive Registration? Paragraph 1 of the Policy defines "Abusive Registration" as:-

"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. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.”

A non-exhaustive list of factors, which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3a of the Policy. There being no suggestion that the Respondent has given false contact details, is engaged in a pattern of registrations, has caused confusion on the Internet or has a relationship with the Complainant, the only potentially relevant 'factors' in paragraph 3 are to be found in subparagraph i which reads as follows:

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

A. 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;

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

C. for the purpose of unfairly disrupting the business of the Complainant;”

The Respondent denies being aware of the Complainant and its rights in the SAXENDA mark, alleging that the former carried out a trade mark search against SAXENDA which was negative. However at the time the Domain Name was registered the Complainant did have a Community trade mark registration for the SAXENDA name. Further there was international publicity re the likely FDA approval for the Complainant's SAXENDA product on internationally accessible news sites on the Internet on September 11, 2014. The Domain Names were registered on September 12, 2014.

Given the distinctive nature of the SAXENDA name, the Expert finds it likely on the balance of probabilities, on the facts as disclosed by the evidence, particularly the publicity about the Complainant's product at the time of registration of the Domain Name, that the Respondent had the Complainant in mind when the Domain Name was registered and should have been aware that selection of the Domain Name would be a blocking registration or would ride on

the Complainant's rights in the distinctive SAXENDA mark, taking undue advantage and causing detriment. In so doing, the Respondent's registration and use of the Domain Name is, and, in the opinion of the Expert the Respondent must have realised it would be, unfairly disruptive to the Complainant's business.

As a result of the above conclusions the Expert has not found it necessary to have to decide if the Respondent was seeking as part of a long term plan to sell the Domain Name at a profit, It is sufficient that on the balance of probabilities the Expert finds that the Respondent was aware of the Complainant's Rights and registered the Domain Name consisting of the actual distinctive name of the Complainant's product knowing that it would be a blocking registration or would be unfairly disruptive of the Complainant's business.

Accordingly, in the view of the Expert in its registration and use of the Domain Names the Respondent took unfair advantage of and caused unfair detriment to the Complainant's Rights.

Accordingly, the Expert finds that the Domain Name is an Abusive Registration within the definition of that term in paragraph 1 of the Policy.

## **7. Decision**

In light of the foregoing findings, namely that the Complainant has Rights in respect of a mark which is identical to the Domain Name for the purposes of the Policy and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name, saxenda.co.uk be transferred to the Complainant.

**Signed Dawn Osborne**

**Dated 04 June 2015**