

.nz Dispute Resolution Service

DRS Reference: 609

Allergan, Inc. v Prem Lobo

Key words -

1. Parties

Complainant:
Allergan, Inc.
2525 Dupont Drive
Irvine, CA 92612
Irvine
United States

Represented by: Ms Cecilia Borgenstam, Melbourne IT Digital Brand Services

Respondent:
Prem Lobo
G.P.O Box No 635
Sydney, NSW, 2001
Sydney
Australia

2. Domain Name/s

lapband.co.nz ("the Domain Name")

3. Procedural history

- 3.1 The Complaint was lodged on 20/12/2010 and Domain Name Commission (DNC), notified the Respondent of the validated Complaint on 23/12/2010. The domain/s were locked on 20/12/2010, preventing any changes to the record until the conclusion of these proceedings.
- 3.2 There was no response filed by the Respondent.
- 3.3 The Complainant paid Domain Name Commission Limited the appropriate fee on 2/2/2011 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").
- 3.4 Mr Andrew Brown QC, the undersigned, ("the Expert") confirmed to the DNC on 3/2/2011 that he knew of no reason why he could not properly accept the invitation to act as expert in this case and that he knew of no matters which ought to be drawn to the attention of the parties,

which might appear to call into question his independence and/or impartiality.

3.5 On 9/2/2011 the Domain Name Commission received a letter from solicitors for Mr Robert Cable, attaching an email exchange between the Complainant and Mr Cable concerning the Domain Name. The letter advised that up until 1/2/2011, Mr Cable was not aware of the Complaint or its terms. The letter sought urgent advice as to the status of the complaint.

3.6 On 14/2/2011, the Expert issued a Procedural Direction in the following terms:

“3. It is important for the integrity of the DRS Policy that time limits be adhered to. However, I am prepared to allow until 5.00 p.m. on Friday 18 February 2011 for Mr Cable to provide a statutory declaration explaining:

- (a) What claim he has to the Domain Name and his relationship to the Respondent;
- (b) If he has a claim to the Domain Name, why the Domain Name is not registered in his name;
- (c) When he first received notice of the Complaint from the Respondent and what steps he took.

Accompanying submissions should explain whether Mr Cable seeks time to file a Response and, if so, why the Expert should grant that request.

4. I will then seek the views of the Complainant before making a final decision as to whether to allow any submission from Mr Cable to be received and considered.”

3.7 On 18/2/2011, Mr Cable’s legal representative advised “that Mr Cable had reached an agreement with the Complainant and therefore will not be taking this matter any further”. A copy of that Response has been sent to the Complainant who has advised that “the Complainant has not reached an agreement with the Respondent”. (Mr Cable is of course not the Respondent.). The Complainant has requested that the Expert proceed to issue a decision.

4. Factual background

4.1 The Complaint discloses that the Complainant, Allergan, Inc, is a company incorporated in the United States but with offices in a number of parts of the world, including Australia. It employs over 5,000 people and markets its products in over 100 countries. It describes itself as a “global technology-driven multi-speciality healthcare company pursuing therapeutic advances to help patients live life to their fullest potential”.

- 4.2 The Complainant is the owner of a registered trade mark LAP-BAND in both Australia and New Zealand in class 10. Details of the registrations – both of which date from 2005 – are as follows.

Australia

Mark	No.	Application Date	Applicant	Class	Specification
LAP-BAND	1069373	10/8/05	Allergan, Inc	10	Laparoscopic gastric band for use in the treatment of morbid obesity

New Zealand

Mark	No.	Application Date	Applicant	Class	Specification
LAP-BAND	736530	3/10/05	Allergan, Inc	10	Medical apparatus, devices and instruments of use in the treatment of obesity; parts, fittings and accessories for the aforementioned goods

- 4.3 The Domain Name lapband.co.nz was registered on 21 March 2006. The Respondent is recorded as the registrant of the Domain Name and is the web services director of an organisation called "Your Practice Online". The Respondent has re-directed the Domain Name to the website www.obesitysurgeon.co.nz. This website is operated by a Mr Robert Cable and the website describes him as both an "obesity surgeon" and a "Consultant General and Laparoscopic Surgeon with a special interest in Surgical Solutions for Morbid Obesity".
- 4.4 The website contains pages describing laparoscopic gastric banding.
- 4.5 The Complainant asserts that its trade marked LAP-BAND device is an adjustable gastric banding system which reduces the amount of food that a user's stomach can hold at any one time. This, it is claimed, helps the user to lose weight and keep it off. The Complainant claims that its LAP-BAND product is a preferred minimally invasive surgical treatment for the seriously overweight.
- 4.6 The Complainant on several occasions in 2010 contacted the Respondent to seek a voluntary transfer of the Domain Name. On 7 September 2010, an email was sent by the practice manager for Mr Cable (and copied to the Respondent) stating:

"Thank you for your email. Mr Cable advises he is agreeable to your proposal and wishes you to start this process."

- 4.7 The Complainant then sent instructions to the Respondent and to Mr Cable on what was necessary to effect a transfer. The Respondent replied on 15 September 2010 stating:

"... will discuss this with Mr Cable and will forward the registry key (UDAI) asap. Kind regards Prem

Dr Prem Lobo
Web Service Director
Your Practice Online"

- 4.8 Continued efforts to achieve a transfer led to an email from Mr Cable on 22 October 2010 in which he stated:

"In reply to your email of 15/10/2010, my position is this. The lap-band domain name was available when I purchased it. It is Allergan's predecessor's fault not mine that they did not choose to do so then.

I chose to use *lap-band* as a domain name because it was (and is) the generic name that all laparoscopic gastric bands are referred to, i.e., it is a generic term as distinct from the specific brand name, Lap-Band™, that you assert.

It is common usage for surgeons to refer to lap choles, lap nissens, lap hernias, etc. Does Allergan claim exclusivity over the abbreviation *lap*? Similarly, do they claim the word *band* for their own, especially as they were not the first to use it?

I have obtained a legal opinion and to bring this to a conclusion, although my preference is to maintain the status quo, if Allergan wishes to purchase the domain name from me, the details can be discussed in future correspondence."

- 4.9 As a result of this Response and earlier correspondence, the Complainant chose to initiate this Complaint.

Parties' contentions

a. Complainant

- 4.10 The Complainant seeks the transfer of the Domain Name in that:
- (a) The Complainant has rights in respect of a name or mark that is identical or similar to the Domain Name. In particular, the Complainant points to its registered trade marks in Australia and New Zealand in class 10 that predate registration of the Domain Name;
 - (b) The Domain Name was registered after the Australian application had in fact been registered and simultaneously as the New Zealand trade mark matured into registration;

- (c) There is no such word as “lapband” “in the common English dictionary” and it is not a generic term for any stomach banding procedure;
- (d) The Domain Name has been used by the Respondent in a manner which is taking advantage of the Complainant’s Rights which existed at the date of registration;
- (e) The Domain Name is an unfair registration because 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 it is registered to, operated or authorised by or otherwise connected with the Complainant (para 5.1.2 of the Policy);
- (f) The Respondent is taking advantage of the Complainant’s trade marks and the Domain Name “will damage the image of the brand”;
- (g) The Respondent has taken advantage of the Domain Name by re-directing it to a third party website. The Domain Name is blocking the Complainant from mirroring its trade mark under the .co.nz domain name space;
- (h) The Respondent appears to have instructed Mr Cable to transfer the Domain Name to the Complainant initially but this has been blocked by Mr Cable.

b. Respondent

4.11 The Respondent did not file a Response.

5. Discussion and findings

Rights

5.1 Under the Policy, the term *Rights* is defined as:

“... includes but is not limited to rights enforceable under New Zealand law. However a Complainant will be unable to rely on rights to a name or term which is wholly descriptive of the Complainant's business.”

5.2 The Expert finds that the Complainant clearly has rights in respect of the LAP-BAND trade mark as a result of its prior trade mark registrations in both Australia and New Zealand. The Expert is satisfied that the trade mark rights were established prior to registration of the Domain Name. Although the New Zealand mark was not in fact physically registered until after the Domain Name was registered, it took effect (once registered) from 3 October 2005, some five months before the Domain Name was registered. The Australian trade mark took effect from 10 August 2005.

- 5.3 The Expert is satisfied that the trade mark rights in the LAP-BAND mark were established and existed prior to registration of the Domain Name on 21 March 2006.
- 5.4 The trade mark is not wholly descriptive of the Complainant's business. The fact that both IPONZ and IP Australia have seen fit to allow the mark to proceed to registration in respect of specific goods in class 10 for use in the treatment of obesity, is a clear indication that both Offices were satisfied as to the distinctive character of the mark.
- 5.5 The Complainant has also provided evidence that its LAP-BAND system has been proven in studies to significantly reduce weight and body mass steadily. It has attached an extract from its website www.lapband.com referring to FDA approval and showing publicity for its LAP-BAND device. The Complainant is also the owner of the Domain Names *lap-band.com*, *lap-band.net* as well as *lapband.com*.

Identical or Similar

- 5.6 The Domain Name is not identical to the Complainant's trade mark registrations as it does not incorporate the hyphen. However the Domain Name is certainly similar (and indeed closely similar) to the trade mark registrations. It is well established that the level and country code identifiers i.e. .co and .nz are not to be taken into account when determining identity or similarity (*Mountain Buggy Trade Marks Limited v Campbell Gower DRS 186; Compagnie Gervais Danone v Triple 8 Holdings Limited DRS 257*)

Unfair Registration

- 5.7 Under rule 4.2.1 of the Policy and the definition of Unfair Registration, the Complainant must show, on the balance of probabilities, that the Domain Name is an unfair registration in that it:
- “(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, or is likely to be, used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.”
- 5.8 Before turning to the findings on this section, it is desirable to say something about the Respondent. The Respondent is the Web Services Director of Your Practice Online, a web advertising company. The real user of the Domain Name is Mr Cable who is not named a registrant at all but who has asserted in correspondence with the Complainant that he has purchased the Domain Name. In the correspondence it is clear that the Respondent deferred to Mr Cable

and was not able to take steps to transfer the website without Mr Cable's approval and authority.

- 5.9 However, the Respondent has certainly allowed Mr Cable to make use of the Domain Name and must have facilitated the Domain Name being redirected to Mr Cable's website *www.obesitysurgeon.co.nz*.
- 5.10 It appears that the Complainant is not making complaint as to the original registration of the Domain Name. This is just as well because registration occurred on 21 March 2006 more than three years before the Complaint (20 December 2010). Paragraph 5.4 of the Policy prevents the Expert from taking into account any acts or omissions amount to unfair registration or use which occurred more than three years before the date of the Complaint.
- 5.11 Rather the Complainant points to the current use of the website and claims that the Domain Name has been and is being used by the Respondent in a way which is taking unfair advantage of the Complainant's Rights under the second limb of the definition of Rights. In evidence filed in support of the Complaint, the Complainant relies on a screenshot from the Domain Name as at the time of the Complaint.

Para 5.1.2

- 5.12 The grounds specified in paragraph 5.1 of the Policy are a non-exhaustive list of factors which may be evidence that the Domain Name is an unfair registration.
- 5.13 Under Article 5.1.2 (relied on in the Complaint) the Policy states:
- "Circumstances demonstrating that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant"
- 5.14 In fact (as the Complainant points out) the Respondent himself is not using the Domain Name but rather is allowing Mr Cable to use the Domain Name.
- 5.15 The circumstances of Mr Cable's use of the Domain Name (authorised and allowed by the Respondent) are such that members of the public encountering the Domain Name, are likely to be confused, misled or deceived into believing that they are going to the Complainant's website or a website that is associated with or licensed by the Complainant. The Complainant has established that it has both trade mark rights and reputation in the LAP-BAND mark in relation to a technology or device for the treatment of obesity.
- 5.16 The Domain Name contains a page entitled "*Lap.gastric banding overview*" that contains a description and page on goods that fall squarely within the specification of goods in the Complainant's

registered New Zealand trade mark. This reinforces the likelihood of confusion or deception.

- 5.17 Further, it is well established that confusion, misleading or deception can arise when members of the public go into a business (or in this case visit a website) thinking it is connected with a trade mark owner - even though they might be disabused of their confusion after going there. This is often known as *initial interest confusion*. The New Zealand Court of Appeal has accepted the applicability of initial interest confusion in cases of misleading or deception under s9 of the Fair Trading Act (*Trustbank Auckland Limited v ASB Bank Limited* (1989 15 IPR 222, 226).
- 5.18 Evidence of an Unfair Registration under paragraph 5.1.2 of the Policy has therefore been established.
- 5.19 The correspondence between the Respondent and the Complainant and the initial authority for a transfer of the Domain Name given by Mr Cable lend strong support to this decision – although ultimately it is not necessary to base the decision on this.

6. Decision

- 6.1 For the foregoing reasons the Expert orders that the Domain Name lapband.co.nz be transferred to the Complainant.

Place of decision Auckland

Date 21 February 2011

Expert Name Mr Andrew Brown QC

Signature

