

Nominet UK Dispute Resolution Service

DRS 00048

PHARMACIA AB and Steve Wagstaff

Decision of Independent Expert

1. Parties:

Complainant: PHARMACIA AB
Address: Lindhagensgatan 133
Stockholm
Postcode: 11287
Country: Sweden

Respondent: Steve Wagstaff
Address: c/o Roger Lovejoy
Poste Restante
Calstock
Cornwall
Postcode: PL18 9QA
Country: United Kingdom

2. Domain Name:

pharmacia.org.uk (“the Domain Name”).

3. Procedural Background:

The Complaint was lodged on 11 October 2001 and received in full by Nominet on 17 October 2001. Nominet validated and notified the Respondent of the Complaint on 17 October 2001, stating that a Response was due within 15 working days. A reply was received on 3 November 2001 from Roger Lovejoy, informing Nominet that he, and not Steve Wagstaff, was the owner of the Domain Name. Roger Lovejoy also wrote to Nominet on 4 November 2001 requesting information on Nominet’s authority in these proceedings.

Nominet replied to Roger Lovejoy on 5 November 2001 stating that it will only be able to accept a response from the legal registrant Steve Wagstaff, unless it receives a signed letter from him indicating that Roger Lovejoy may act on his behalf. On the 7 November 2001, Nominet received a fax signed by Mr. Wagstaff confirming that he had inadvertently entered his own name as the owner of the Domain Name, that the Domain Name was bought for Roger Lovejoy and requesting that Nominet deal with Roger Lovejoy in all future matters relating to the Domain Name.

Also on 7 November 2001, Nominet received the Response from Roger Lovejoy, forwarded to the Complainant on 8 November 2001. On 16 November 2001 Nominet informed the parties that the dispute was entering the informal mediation stage. On 12 December 2001, Nominet confirmed that mediation had been unsuccessful. On 20 December 2001, the Complainant paid the fee for an Expert’s decision pursuant to paragraph 8 of the Nominet UK Dispute Resolution Service Procedure (“the Procedure”). On 22 December 2001 the Respondent sent Nominet an addendum to his Response, forwarded to the Complainant on 2

January 2002. On 3 January 2002, the Complainant replied to the Addendum. The Respondent sent a further response dated 4 January 2002.

On December 31, 2001, Richard Kemp, the undersigned (“the Expert”) confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as expert in this case and further confirmed 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. The appointment date for the Expert is 4 January 2002, and the deadline for the decision is set at 18 January 2002.

On 8 January 2002, the Expert requested clarification from the Complainant on its trademark registrations, in accordance with paragraph 13 of the Procedure. This was received on 9 January 2002.

4. Outstanding Formal/Procedural Issues (if any):

There are no outstanding formal or procedural issues.

5. The Facts:

The Complainant is a pharmaceutical company incorporated under the laws of Sweden. The Complainant is a wholly owned subsidiary of Pharmacia Corporation, a company created through the merger of Pharmacia & Upjohn with Monsanto Company and its G.D. Searle unit. The Complainant has the benefit of a portfolio of registered trade marks in several classes for the mark “PHARMACIA”. Copies of the registrations in the United Kingdom, Sweden, Ireland, Canada and the United States of America have been annexed to the Complaint.

The UK, Irish, Canadian and US registrations are in the Complainant’s name. The Swedish registration appears to still be in the Complainant’s former name of Pharmacia & Upjohn AB, since the Complainant’s name change has not yet been recorded against all its registrations. The earliest UK registrations for the PHARMACIA mark date from 1 October 1981, and the registrations are in several classes. The Complainant’s parent company, Pharmacia Corporation, operates a web site at www.pharmacia.com.

On 21 March 2001 the Respondent registered the domain name pharmacia.org.uk. A Nominet WHOIS search confirms that the registration was made via the service provider UK2Net. This Domain Name displays a page saying “Loading www.pharmacia.org.uk ... an independent critique of Pharmacia’s acquisition of Monsanto”. The user is then taken to the website <http://www.love.telinco.co.uk/Pharmacia/start.htm>. At the head of this site are links to www.pharmacia.com and www.monsanto.com. Below this is the statement “The links (pharmacia and monsanto).com, above, are provided for ease of access. They are not an indication that either related company condones this site”.

6. The Parties’ Contentions:

Complainant:

The Complainant’s contentions are summarised as follows:-

- a. The Complainant’s parent company Pharmacia Corporation employs 59,000 people worldwide and has operations in more than 60 countries. The roots of this company date back to 1853 and the name “Pharmacia” was introduced in 1911.

- b. The mark “PHARMACIA” has been used since the early 20th century in commerce in connection with Pharmacia’s well known pharmaceutical business and products.
- c. Pharmacia owns trade mark registrations throughout the world for the mark “PHARMACIA” including in the UK, Ireland, Sweden, Canada and the USA. The Complainant submits copies of these registrations, which are in the Complainant’s name or in the Complainant’s former name of Pharmacia & Upjohn AB. The Complainant states that some registrations have not been updated to reflect its change of name, and submits a copy of the notarised Name Change Certificate from Pharmacia & Upjohn AB to Pharmacia AB. These registrations are valid, subsisting and incontestable.
- d. By virtue of the long and substantially exclusive use of the trade mark “PHARMACIA” in commerce, the said name and mark have been and are well-known, especially among healthcare professionals, in the UK and many other countries world-wide. The trade mark “PHARMACIA” is a famous mark and the name and mark are accordingly valuable assets of the Complainant.
- e. The Domain Name is identical and/or confusingly similar to the trade mark “PHARMACIA” in which the Complainant has rights.
- f. The Domain Name is an abusive registration because it was registered and has since been used in a manner which took unfair advantage of and was unfairly detrimental to the Complainant’s rights.
- g. The Respondent has registered the Domain Name primarily for the purpose of disrupting the business of Pharmacia Corporation. The Domain Name is pointed to an anti-Pharmacia website containing material that goes way beyond sound criticism. The site also links with the site monsanto.org a site which makes defamatory statements about Pharmacia Corporation’s subsidiary, Monsanto Company, and its products.
- h. There may be a number of reasons for Monsanto deciding not to act against monsanto.org. The fact that it has not cannot be taken as evidence that the content of the site is not defamatory. The site contains statements such as “Monsatan” and “Monsanto [...] giving kiddies cancer”.
- i. By stating that the Domain Name was registered to increase the possibility of the contents of the related website being found, the Respondent acknowledges that his registration is disrupting the business of Pharmacia. This is because people seeking information about Pharmacia or its products will instead end up at the Respondent’s website.
- j. Where the Respondent states that his purposes was to encourage queries of Pharmacia, he can have nothing else in view than to encourage users to refrain from buying Pharmacia’s products and this disrupt Pharmacia’s business.
- k. The website also aims to confuse its visitors as it is said to be managed by an organisation called “Pharmacia and Monsanto Product Advice Service”.
- l. The site is hyperlinked to Pharmacia Corporation’s homepage without Pharmacia’s consent. The creation of a link can constitute an infringement in cases where the domain name is a registered trade mark (Webster, M Nicholson,

Graham & Jones, July 2001], Unauthorised Hypertext Links, p.6). Due to the legal uncertainty it is customary to ask for permission before adding a hyperlink to a website. If the Respondent was honest in his intention to use the site for serious debate with Pharmacia and others, and not for a smear campaign, he would have asked for such permission.

- m. By registering the Domain Name the Respondent has precluded Pharmacia from using its mark in a corresponding domain name.
- n. An important part of Pharmacia's domain name strategy is to register its house mark under all top-level domains where the company owns trademark rights. Pharmacia and Monsanto have separate legal departments and possibly also separate policies on how to deal with cyber-squatting. Therefore, the Respondent's allegation that action has not been taken against domain names containing the word "Monsanto" cannot be taken as an indication that Pharmacia makes no efforts to obtain control of domain names corresponding to its trademarks.
- o. The mark "PHARMACIA" is registered under 95 generic and country-code top-level domains. Pharmacia is engaged in several disputes and negotiations all over the world in order to secure PHARMACIA under new TLDs, amongst these, pharmacia.it, pharmacia.es, pharmacia.jp, pharmacia.co.kr and pharmacia.cz.
- p. By linking to a domain name like monsanto.org.uk, which holds no other content that information about the commercial value of the domain name (prima facie evidence of an abusive registration), the Respondent associates himself with the owners of that domain name, the Millennium Domain Name Syndicate.
- q. Through its network, the Respondent is engaged in a pattern of making abusive registrations. Both pharmacia.org.uk and monsanto.org were registered with false registration data. The former is registered for Steve Wagstaff and the latter for Rowena Tollitt, but both are claimed as owned by Roger Lovejoy. These registrations were made in breach of Nominet's Terms and Conditions, Article 5.2. Roger Lovejoy probably was aware that the registration and use of these domain names were prone to be challenged and considered abusive. It was not until this likelihood was realised that he was forced to reveal his true identity.
- r. Accordingly this Domain Name registration is without question an abusive registration.

Respondent:

The Respondent's response is summarised as follows:-

- a. The Domain Name was registered in the name of Steve Wagstaff, and not in the name of Rover Lovejoy, who claims ownership. This is because Roger Lovejoy did not possess a credit card and therefore asked Steve Wagstaff to make the registration on his behalf. The entry of Steve Wagstaff as the Domain Name owner was a mistake. The Domain Name is controlled by Roger Lovejoy, who will have responsibility for the Domain Name and all correspondence in these proceedings. A letter from the Respondent, Steve Wagstaff, confirming this, has been received by Nominet.
- b. The Respondent admits that the main part of the Domain Name is identical to the trade mark "Pharmacia". The Respondent however states that registration of

“Pharmacia” as a trade mark does not allow the registrant to prohibit its use by others in providing information about “Pharmacia” or any of its products or actions via any media, including, in this case, electronic data storage and retrieval systems.

- c. The Respondent quotes Halsbury’s Laws of England Vol.48 Fourth Edition (2000 Reissue), Para 337 on “Cybersquatting” to state that “Care has to be taken to distinguish [the registration of domain names comprising famous names and marks of others] from perfectly legitimate uses of domain names. Thus an individual cannot be prevented from registering a domain name comprising his surname and setting up a website thereunder, simply because his name was the name of a famous supermarket Similarly, a website whose subject matter is a famous person (e.g. the website of a fan club) for example, might legitimately use that name in its domain name. Of course, the courts are astute to examine any such excuse carefully ..”.
- d. The Respondent further quotes “There is no property in a name as such, and consequently, in the absence of malicious intention or misrepresentation, a person has a right to use his own name or adopt another name for himself or his property as he pleases, even though inconvenience or annoyance may be caused.”
- e. The use of the word “Pharmacia” here clearly indicates the topic of the information. The domain names are by analogy “Chapter Headings”. The Respondent could equivalently have entitled a book or a paragraph disclosing information about the company “Pharmacia”. The Respondent does not need permission to speak or write about anyone or to use their name as a heading to information about them.
- f. The suffix “.org” denotes a non-profit making website. The Internet contains many pages of information about Pharmacia and its subsidiaries.
- g. The appropriate domain names have been registered so that the contents of www.love.telinco.co.uk/Pharmacia/index/htm and www.love.telinco.co.uk/Monsanto/index.htm may be more noticeable. The Domain Name is therefore used to bring public attention to qualities, actions and products of Pharmacia and its subsidiary Monsanto, and to increase the possibility of the contents of these websites being found.
- h. The Respondent sees no reason why he cannot link to another site without prior agreement from the authors of that site. Newspapers and other media constantly direct people to other publications. Further, Monsanto linked to Greenpeace and Friends of the Earth to show it was not worried about the content of those sites.
- i. The Respondent makes no case for sale of the Domain Name, nor does he sell any thing via the Domain Name.
- j. No-one has ever contacted the Respondent via the Domain Name.
- k. The site has always contained information stating that it is independent. The words “Pharmacia and Monsanto Product Advice Service” have been removed and the “warnings” are more noticeable.
- l. All material published on the website is recently published material and neither the Complainant nor Monsanto has challenged this content as being untrue or

unfairly disparaging. The content of the site may be disparaging but is not defamatory. Hence Monsanto has decided not to take issue with the content.

- m. Whilst the content of the Respondent's website may encourage queries of the Complainant, this need not be seen as disruptive unless the Complainant is unable to tolerate criticism. If the content goes beyond sound criticism, the Complainant has the option to issue libel proceedings, but neither it nor Monsanto has done so or discussed the alleged content with the Respondent. Monsanto threatened to sue for trademark violation and libel, but backed down when the Respondent requested information as to which parts of the publication were incorrect.
- n. The Respondent states that it would be helpful to ascertain which pages in the Respondent's site are considered abusive by the Complainant. The Respondent offers to remove or amend any statements that can be shown to be untrue rather than uncomfortable.
- o. The Respondent will discuss the matter of transferring the Domain Name and using a suitable alternative method of publishing his content if he can agree the content of any site under the Domain Name with the Complainant.
- p. In relation to Pharmacia's strategy to register of its house mark under all top-level domains, Pharmacia's non-registration of the Domain Name may be an unfortunate error on its part. The Respondent points out that the domain name www.monsanto.org.uk has also been purchased by a third party and is being offered for sale for £100,000. The Respondent itself has registered www.monsanto.org. The Respondent states that there seems to be no real effort by the Complainant to obtain control of associated domain names.
- q. The Respondent does not maintain any link to www.monsanto.org.uk, nor does he have any intention of doing so.
- r. The Respondent denies being engaged in a pattern of making abusive registrations. His only "network" is the link to www.monsanto.org. The Respondent also claims to have registered www.rogerlovejoy.co.uk. Since there are no decisions of the Respondent having made abusive registrations, there cannot be a "pattern" of his doing so.

7. Discussion and Findings:

General

Under paragraph 2 of the Nominet UK Dispute Resolution Service Policy ("the Policy") the Respondent must submit to proceedings under the Dispute Resolution Service if the Complainant asserts that :-

- (i) the Complainant has Rights in respect of a name which is identical or similar to the Domain Name; and
- (ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration.

"Rights" and "Abusive Registration" are defined in paragraph 1 of the Policy.

The Complainant does make these assertions in the Complaint. The Expert therefore finds that the Respondent must submit to these proceedings.

Burden of Proof

The Complainant must prove both elements (i) and (ii) above on the balance of probabilities to succeed in its Complaint. However, under paragraph 4(b) of the Policy,

- (i) where the Domain Name (not including the first and second level suffixes) is identical to the name in which the Complainant asserts Rights, without any addition; and
- (ii) the Respondent is using or intends to use the Domain Name for the purposes of a tribute or criticism site without the Complainant's authorisation,

the burden will shift to the Respondent to show that the Domain Name is not an Abusive Registration.

Complainant's Rights

"Rights", for the purposes of the Policy, "includes, but is not limited to, rights enforceable under English law". The Policy also provides that "a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business".

When assessing if the Complainant has Rights in a name identical or similar to the Domain Name, the first and second level suffixes of the Domain Name, being generic, should be discounted. The questions are therefore (a) whether the Complainant has Rights in the name "Pharmacia", and (b) if so, whether the Complainant can rely on such Rights in these proceedings.

The Complainant is registered owner of the mark "PHARMACIA" in several territories (including the UK). The Complainant further asserts that "Pharmacia" has been used by its parent company since 1911 and is a famous mark, under which the Complainant and other companies within its group have substantial world-wide operations. The information on the Complainant's group website www.pharmacia.com verifies this. Given the Pharmacia group's substantial commercial undertakings under and long-standing use of the "PHARMACIA" name, it is likely that the Complainant has reputation and goodwill in "PHARMACIA" sufficient to form enforceable common law rights.

"Pharmacia" is not wholly descriptive of the Complainant's pharmaceutical business, as it is distinctive of the Complainant. Certainly, the Respondent does not use the term "pharmacia" in the Domain Name in any generic sense, but in order to identify the Complainant.

The Expert therefore finds that on the balance of probabilities the Complainant has Rights in a name identical to the Domain Name (discounting the first and second level suffixes), which may be relied upon in these proceedings.

Abusive Registration

An "Abusive Registration", for the purposes of this Policy, is "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.”

The Policy provides non-exhaustive lists of factors which may be evidence that a domain name is an Abusive Registration (at paragraph 3 of the Policy) and factors which may be evidence that the Domain Name is not an Abusive Registration (at paragraph 4).

The Expert finds as follows :-

- a. In this case, the Domain Name (excluding suffixes) consists of the mark “Pharmacia”, which is identical to the name in which the Complainant has Rights. The Respondent runs a criticism site on the Complainant and its group companies under the Domain Name without the Complainant's authorisation. Therefore paragraph 4(b) of the Policy applies and the Domain Name is presumed to be an Abusive Registration unless the Respondent can show that it is not, on the balance of probabilities. This presumption applies despite this Domain Name using the non-commercial “.org” suffix.
- b. The Respondent's primary argument against the Domain Name being an Abusive Registration is legitimate fair use of the Domain Name for a criticism site on the Complainant (paragraph 4(a)(i)(C) of the Policy). The Respondent has also made several other arguments in trying to show that the Domain Name is not an Abusive Registration. The Expert will assess these first, before going on to assess the issue of legitimate fair use.

Initial arguments

- c. The Respondent asserts that he has not tried to sell the Domain Name and the Complainant has adduced no evidence to counter this. The Expert therefore accepts that the Respondent has not registered or otherwise acquired the Domain Name primarily for the purposes of sale (paragraph 3(a)(i)(A) of the Policy). The Expert agrees that the Respondent's reference in its submission to www.monsanto.org.uk does not constitute an association of the Respondent with that site or those running it.
- d. Although it may be the Complainant's house strategy to have wanted to register the Domain Name, it does not follow that the Respondent did so simply to block the Complainant. The Respondent states that his purpose in registering the Domain Name was to use it to point towards his criticism site, and he has used it for this purpose. The Expert therefore finds that the Respondent did not register or acquire the Domain Name as a blocking registration (paragraph 3(a)(i)(B)).
- e. Aside from the Domain Name, the only other domain names claimed by the Respondent are www.rogerlovejoy.co.uk (the Respondent's own name), and www.monsanto.org (used as a criticism site on Monsanto). The latter is a top-level domain. It is not for the Expert in these proceedings to decide if that domain name is being used abusively or contrary to the policy and rules under which it was registered. The Expert does not consider these sufficient to regard the Respondent as being engaged in a “pattern” of making Abusive Registrations (paragraph 3(a)(iii)).
- f. The Expert accepts the Respondent's explanations for registration of the Domain Name in the name of Steve Wagstaff and not Roger Lovejoy, and does not consider that the Respondent gave false registration details to Nominet (paragraph 3((a)(iv))). This is particularly as the Respondent has not evaded Nominet's communications to him under these proceedings.

- g. The Expert also finds, however, that none of the above arguments are sufficient to rebut the presumption that the Domain Name is an Abusive Registration, particularly on the grounds that the registration was made primarily to unfairly disrupt the Complainant's business (paragraph 3(a)(i)(C)) and/or that the Domain Name is being used in a way which has confused people or businesses into believing that it is registered to, operated or authorised by, or otherwise connected with the Complainant (paragraph 3(a)(ii)).
- h. The Expert also notes that the Policy only provides a non-exhaustive list of factors which may be evidence of an Abusive Registration. Where the Policy expressly presumes an Abusive Registration, the presumption may still stand despite a rebuttal of each factor set out in the Policy, if the Expert maintains that there is an Abusive Registration on the basis of some other factor.

Legitimate fair use

- i. The Respondent's arguments that he has used the Domain Name in a way analogous to a chapter heading in a book or merely to describe the information he is displaying, do not completely or fairly represent the Respondent's use of the "PHARMACIA" name in this case. The Respondent primarily uses the "PHARMACIA" name in the Domain Name to enhance the likelihood of the criticism site he runs on the Complainant being found. The Complainant has not licensed the Respondent to use its trademark.
- j. No evidence that internet users have been confused by the Domain Name has been submitted (although the absence of actual evidence of confusion is not unusual in these cases). The Respondent also states that no-one has ever contacted him via the Domain Name. However, the Respondent admits that he chose this Domain Name consisting of the "Pharmacia" mark, to increase the likelihood of his criticism site being found. This clearly shows that the Respondent himself regards the Domain Name as indicating the Complainant and likely to appeal to users looking for information on the Complainant and its products.
- k. A company's trade mark may in certain circumstances be legitimately used by an unconnected party in a Domain Name to indicate a criticism site relating to that company or its products. However, the nature of use of the mark must at all times be clear and should not create the impression of a connection or affiliation with the trademark owner, even momentarily. Any unconnected party using a company's trade mark in this way should therefore take significant care to distance his use of the Domain Name and any site to which it relates from that company.
- l. In this case, the Domain Name does not of itself indicate that it would lead to a criticism site, as would, for example, a "[company]sucks.org.uk" domain. On the contrary, since the Domain Name comprises only of the Complainant's mark, an internet user typing in the Domain Name would expect to reach an official "Pharmacia" site.
- m. The Respondent's stated purpose in registering the Domain Name is to increase the likelihood of users finding his site, which criticises the Complainant and its business. Users looking for an official site on the Complainant may be attracted to the Domain Name because it comprises of a name identical to the Complainant's mark. Such users may then be encouraged by the contents of the Respondent's site to refrain from buying the Complainant's products.

- n. The Expert finds that Respondent's primary purpose in registering the Domain Name was to disrupt the Complainant's business by unfairly diverting users seeking information on the Complainant and its products to his criticism site via use of the Complainant's trademark, thereby taking unfair advantage of the Complainant's mark.
- o. The site's disclaimers and warnings that it is an "independent critique" of Pharmacia and Monsanto are ineffective in undoing the unfair advantage gained by the Respondent in using the Complainant's mark. In the Expert's opinion, these disclaimers are also insufficient to prevent an internet user incorrectly concluding, even fleetingly, that the site and the Domain Name are somehow endorsed by these companies as a forum for criticism or otherwise connected with these companies.
- p. In this case, (i) the site links to the official sites of Pharmacia and Monsanto, (ii) the disclaimer wording is in small print compared to the links to Pharmacia and Monsanto, (iii) the names "Pharmacia" and "Monsanto" are used several times on the home page so that a visitor to the site would have to read the page quite carefully to realise that the site is unofficial, and (iv) some pages within the site appear to be linked to www.monsanto.org (a domain consisting of the name of the Complainant's subsidiary, which the Expert is informed is registered on behalf of the Respondent), which adds to the impression that the site has official endorsement or connection.
- q. The Respondent's arguments that his site contains fair, and not defamatory criticism of the Complainant, are not convincing as to whether the Domain Name itself is being used fairly. Moreover, the Respondent's assertion that the site's criticism should not be regarded as disruptive to the Complainant unless the Complainant is unable to tolerate criticism, is not particularly helpful, nor are the assertions that the remedy of defamation proceedings is always open to the Complainant/Monsanto.
- r. The Expert is not required for the purposes of this decision to make a finding on whether a party may legitimately link to the site of another without permission. The current significance of the Respondent's links to pharmacia.com and monsanto.com is that they add to the impression that the site and the Domain Name are official or somehow endorsed by these companies.
- s. The Expert is of the opinion that the Respondent has not done enough here to ensure that he is not using the Domain Name abusively or unfairly, especially since the Domain Name itself does not indicate the nature of the site.
- t. Although the Respondent offers to discuss alternatives for publishing his content via the Domain Name, the Respondent has used the Domain Name abusively since its registration in March 2001 and there is no reason to suggest that the Domain Name will be used otherwise in the future. In these circumstances, it is unreasonable to expect the Complainant to continually monitor the Respondent's use of the Domain Name to ensure that there is no further abusive use.
- u. Therefore, the Expert finds that the Respondent has not proven legitimate fair use of the Domain Name to the extent necessary to rebut the presumption of an Abusive Registration.

8. Decision:

The Expert finds that on the balance of probabilities, the Complainant has rights in a name which is identical to the Domain Name and that the Domain Name is, in the hands of the

Registrant, an Abusive Registration. The Expert therefore grants the Complainant's requested remedy of transfer, and directs that the Domain Name be transferred to the Complainant.

Richard Kemp

Date