

## **ADMINISTRATIVE PANEL DECISION**

Rotation Medical, Inc. v. Horev Anton Aleksandrovich  
Case No. D2024-2181

### **1. The Parties**

The Complainant is Rotation Medical, Inc., United States of America (“United States” or “USA”), represented by Viering, Jentschura & Partner Patent- und Rechtsanwälte mbB, Germany.

The Respondent is Horev Anton Aleksandrovich, Russian Federation.

### **2. The Domain Name and Registrar**

The disputed domain name <rotationmedical.com> is registered with RU-CENTER-MSK (Regional Network Information Center, JSC dba RU-CENTER) (the “Registrar”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on May 28, 2024. On May 28, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 29, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Privacy protection service - whoisproxy.ru) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 11, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on June 13, 2024.

On June 5, 2024, the Center informed the Parties in Russian and English that the language of the registration agreement for the disputed domain name is Russian. On June 5, 2024, the Complainant confirmed its request for English to be the language of the proceeding. The Respondent did not submit any comments on the Complainant’s request.


The Center verified that the Complaint together with the amendment to 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 the Respondent in English and Russian of the Complaint, and the proceedings commenced on June 17, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 7, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 9, 2024.

The Center appointed Assen Alexiev as the sole panelist in this matter on July 15, 2024. 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**

The Complainant is a medical device company that developed a technology named "Rotation Medical Rotator Cuff Repair System", advancing the treatment of rotator cuff disease. In 2010, the Complainant adopted its current name "Rotation Medical, Inc." In 2017, the Complainant's Rotator Cuff Repair System technology was acquired by the healthcare company Smith & Nephew plc, while the Complainant remained in existence as a legal entity and its trademarks continued to be used beyond the 2017 acquisition.

The Complainant is the owner of the German trademark  (the "ROTATION MEDICAL trademark") with registration No. 302023120310, registered on December 19, 2023 for goods in International Class 5.

The disputed domain name was initially registered by the Complainant in 2010, and resolved to a website that contained information about the Complainant and its Rotation Medical Rotator Cuff Repair System. After the acquisition of the Rotation Medical Rotator Cuff System technology by Smith & Nephew in 2017, the distribution of this technology was integrated in the Smith & Nephew distribution organization, and visitors of the website at the disputed domain name were forwarded to the respective section of the Smith & Nephew website. The Complainant's registration of the disputed domain name eventually expired in 2020. Later in the same year, the disputed domain name was registered by a new owner with a seat in the Russian Federation, which, according to the Complainant, was the Respondent. The Respondent started using the disputed domain name to promote the online dispensing of prescription medication, including, among others, Viagra. The Respondent's website copied the Complainant's previous website, including the trademark and logo, background pictures and other content and using the Complainant's postal address.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

The Complainant states that the disputed domain name is confusingly similar to its ROTATION MEDICAL trademark, because it consists entirely of the textual elements of this trademark. The Complainant notes that the Respondent registered the disputed domain name before the registration of the ROTATION MEDICAL trademark, but this does not preclude the Complainant's standing in this proceeding or the finding of identity or confusing similarity under the first element. The Complainant adds that through its extensive use of the terms "ROTATION MEDICAL", "Rotation Medical Rotator Cuff System" and the "ROTATION MEDICAL" logo in the years 2010 through to 2018, it has acquired common law trademark rights in them, and these rights had already arisen at the time the Respondent registered the disputed domain name.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it is using it for illegitimate purposes. The Complainant points out that through the website at the disputed domain name, the Respondent offers prescription medication explicitly without

having a pharmacy license in the USA or elsewhere. The Respondent's website at the disputed domain name copies the content of the Complainant's former website, including colors, fonts, general layout, the Complainant's "ROTATION MEDICAL" logo, the background images, and the original content of the Complainant's former website, even where such content clearly deals with the Complainant's implant technology rather than with the Respondent's prescription medication scheme, and uses that content to give the Respondent's illegal operation the appearance of a distinguished and trustworthy business.

The Complainant states that when it discovered the registration and use of the disputed domain name by the Respondent, it contracted a private investigator to assess whether the Respondent carried on a legitimate business or was a scam scheme operation. The investigator identified the Respondent as the scam operation "Canadian Neighbor Pharmacy" and found out that numerous scammers operated websites with the phone number indicated on the website at the disputed domain name. The Complainant adds that according to the website of the Canadian International Pharmacy Association, "Canadian Neighbor Pharmacy" belongs to a group of rogue websites that do not disclose who they are or where they are located and engage in a variety of unsafe practices, including the sale of medications without prescription and of substandard and even counterfeit products.

The Complainant maintains that, irrespective of whether the Respondent uses the disputed domain name to sell original pharmaceuticals without a pharmacy license, sells counterfeit pharmaceuticals, or uses a pretend online pharmacy website to collect credit card and other personal data for spamming and phishing purposes, its conduct does not give rise to rights or legitimate interests in the disputed domain name.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It points out that the Respondent uses the Complainant's company name within the disputed domain name and the Complainant's long established and distinctive "ROTATION MEDICAL" logo on the associated website, thereby creating a likelihood of confusion among the visitors of this website that it belongs to the Complainant, which exposes the Complainant to potential private law or criminal law claims related to the illegitimate activities carried out by the Respondent.

The Complainant states that the ROTATION MEDICAL trademark was registered after the Respondent had registered the disputed domain name, and notes that in situations where the respondent is clearly aware of the complainant, and it is clear that the aim of the registration was to take advantage of the confusion between the domain name and any potential complainant rights, bad faith has been found. The Complainant points out in this regard that the Respondent has copied the content of the Complainant's previous website, which shows that it was aware of the existence of the Complainant when it registered the disputed domain name, and that it registered it with the aim to take advantage of the confusion between the disputed domain name and the ROTATION MEDICAL trademark and the company name of the Complainant.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

### **6.1. Procedural issue – Language of the Proceeding**

The language of the Registration Agreement for the disputed domain name is Russian. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the

proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English. It points out that the Respondent conducts its business under the disputed domain name entirely in English, pretending to be the Complainant, which is a company registered in the United States, while the content of the website at the disputed domain name is focused primarily on customers within the United States and has no connection to the Russian Federation or the Russian language. The Complainant adds that the disputed domain name consists of English words, which are identical with the English language company name and trademark of the Complainant. According to the Complainant, the above shows that the Respondent is able to conduct business in English with English speaking customers. The Complainant adds that ordering the Complainant to translate the Complaint into Russian would create a potential unfairness and an unwarranted delay, since almost all of the website content at the disputed domain name and almost all of the evidence attached to the Complaint are in English.

The Center has sent all its communications to the Respondent in both English and Russian, and has invited the Respondent to express its views on the language of the proceeding. The Respondent has not submitted a Response or any objections to the Complainants' request that the proceeding be conducted in English.

Having considered all the matters above, the Panel considers that the Respondent would not be disadvantaged if the language of the proceeding is English, and that using the English language in this proceeding would be fair and efficient.

Therefore, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

## **6.2. Substantive issues**

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of the ROTATION MEDICAL trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The ROTATION MEDICAL trademark was registered in 2023, while the disputed domain name was registered by the Respondent in 2020. This however does not by itself preclude a complainant's standing to file a UDRP case, nor a panel's finding of identity or confusing similarity under the first element. [WIPO Overview 3.0](#), section 1.1.3.

The entirety of the ROTATION MEDICAL trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the ROTATION MEDICAL trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the first element of the Policy has been established.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or

legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

[Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The disputed domain name is identical to the registered trade mark and earlier trade name of the Complainant, who was its previous registrant until 2020, and the Respondent registered it to itself later in the same year. The current website of the Respondent at the disputed domain name offers pharmaceutical products and copies a large portion of the content of the Complainant's website that was active at the disputed domain name while the Complainant was its registrant, including the Complainant's ROTATION MEDICAL logo, information about the Complainant, including its physical address, and information and reviews about the Complainant's technology, and contains no disclaimer for the lack of relationship with the Complainant – it even purports to include a copyright notice. The Respondent has not submitted a Response and has not provided any plausible explanation why it has chosen to register the disputed domain name and to put such content on the associated website.

In view of the above, and the absence of any evidence pointing to a different conclusion, the Panel accepts that the Respondent has targeted the Complainant with the registration and use of the disputed domain name in an attempt to attract traffic to the associated website where to offer visitors various pharmaceutical products, confusing them that the provider of the website is the Complainant. Such conduct cannot give rise to rights or legitimate interests of the Respondent in the disputed domain name.

Panels have held that the use of a domain name for illegal activity (here, claimed sale of counterfeit goods or illegal pharmaceuticals, phishing) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Complainant also claims that the Respondent uses the disputed domain name either to sell original pharmaceuticals without a pharmacy license, or sells counterfeit pharmaceuticals, or uses a pretend online pharmacy website to collect credit card and other personal data for spamming and phishing purposes. The Respondent does not deny that it carries out either of these activities and does not submit any evidence that it carries out a legitimate and legally-compliant business. Assuming the Complainant's allegations are true, that would provide an additional support for the finding that the Respondent does not have rights or legitimate interests in the disputed domain name.

The Panel therefore finds that the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Here, the Respondent registered the disputed domain name in 2020, while the Complainant registered its ROTATION MEDICAL trademark in 2023. As discussed in section 3.8.1 and 3.8.2 of the [WIPO Overview 3.0](#), where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent. As an exception to this general proposition, in certain limited circumstances where the facts of the case establish that the respondent's intent in registering the domain name was to unfairly capitalize on the complainant's nascent (typically as yet unregistered)

trademark rights, panels have been prepared to find that the respondent has acted in bad faith. Such scenarios include registration of a domain name: (i) shortly before or after announcement of a corporate merger, (ii) further to the respondent's insider knowledge (e.g., a former employee), (iii) further to significant media attention (e.g., in connection with a product launch or prominent event), or (iv) following the complainant's filing of a trademark application.

The Complainant has submitted evidence that in 2010 it adopted the name Rotation Medical, Inc. and that it is still using this name. It has also shown that it registered the disputed domain name in 2010 and used it until 2017 for its business, prominently displaying on it its ROTATION MEDICAL logo, which is identical to the ROTATION MEDICAL registered trademark. There is evidence that the Complainant's 2017 acquisition by Smith & Nephew received wide media coverage. The current website of the Respondent copies much of the design and content of the former website of the Complainant at the disputed domain name, including the Complainant's ROTATION MEDICAL logo, address, and information about its technology that was the focus of the 2017 publications about the deal with Smith & Nephew, but which technology has nothing to do with the sales of pharmaceutical products, which is the Respondent's alleged business, and there is no mention of the absence of relationship with the Complainant. The Respondent has not provided any explanation why it has chosen to register the disputed domain name, which is identical to the Complainant's trade name and the textual elements of its ROTATION MEDICAL logo, and to activate at it an online pharmacy website that impersonates the Complainant. This leads the Panel to the conclusion that the Respondent's intent in registering the disputed domain name was to unfairly capitalize on the Complainant's rights, which supports a finding that the Respondent has registered and used the disputed domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegal activity (here, claimed sale of counterfeit goods or illegal pharmaceuticals and phishing) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

As discussed in the section on rights and legitimate interests, the Complainant claims that the Respondent uses the disputed domain name either to sell original pharmaceuticals without a pharmacy license, or sells counterfeit pharmaceuticals, or uses a pretend online pharmacy website to collect credit card and other personal data for spamming and phishing purposes. The Respondent does not deny that it carries out any of these activities and does not submit any evidence that it carries out a legitimate and legally-compliant business. Assuming the Complainant's allegations are true, that would provide an additional support for the finding that the Respondent registered and is using the disputed domain name in bad faith.

The Panel therefore finds that the Complainant has established the third element 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 disputed domain name <rotationmedical.com> be transferred to the Complainant.

*/Assen Alexiev/*

**Assen Alexiev**

Sole Panelist

Date: July 29, 2024