



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE

DOMAIN NAME DISPUTE ADMINISTRATIVE PANEL DECISION

CIIDRC case number:	24698-CDRP	Decision date: April 18, 2025
Domain Name:	narcankits.ca	
Panel:	Richard S. Levy (Chair) The Hon. Neil Brown, KC R. John Rogers	
Complainant:	Emergent Operations Ireland Limited	
Registrant:	Ajey Sabharwal	

1. OVERVIEW

1. This matter concerns a registered domain name, **narcankits.ca** (the “Domain Name”) which was registered on July 12, 2018.
2. This matter is a proceeding under the Canadian Dispute Resolution Policy (“CDRP”) and the Canadian Dispute Resolution Rules (“Rules”) of the Canadian Internet Registry Authority (“CIRA”). The Canadian International Internet Dispute Resolution Centre (“CIIDRC”) is a recognized service provider to the CIRA Domain Name Dispute Resolution Policy (the “Policy”) of the Canadian Internet Registration Authority (“CIRA”).

2. PROCEDURAL HISTORY

3. The procedural history of this case was set out in a letter from CIIDRC to the Panel dated March 20, 2025. On February 6, 2025, Daniel Anthony of Smart & Biggar LLP, filed a Complaint on behalf of Emergent Operations Ireland Limited with respect to the domain name <narcankits.ca> pursuant to the CDRP and the Resolution Rules. The complaint was in administrative compliance with CIRA's requirements under Rule 3.2.
4. On February 7, 2025, CIRA was notified of this proceeding and on the same day, CIRA transmitted by email to CIIDRC its verification response informing that the Registrant of the Disputed Domain Name is Ajey Sabharwal. CIRA also confirmed that the Disputed Domain Name was placed on a Registrar LOCK.
5. Pursuant to Resolution Rule 4.4, CIIDRC notified the Registrant of this administrative proceeding and forwarded a Notice of Complaint along with the Complaint to the Registrant on February 11, 2025.
6. On February 19, 2025, the Registrant requested an extension of the deadline for filing the Response. The original deadline for delivery of the Response was March 3, 2025.
7. On February 20, 2025, CIIDRC granted the request to extend the deadline for the Registrant's Response to March 10, 2025.
8. The Registrant filed its response on March 10, 2025.
9. On March 18, 2025, Mr. Anthony filed the Complainant's Reply submission and requested CIIDRC to bring the Reply to the Panel for consideration.
10. On March 19, 2025, the Registrant made a request to the Provider that the Panel grant him permission to file a reply to the Complainant's Reply.
11. On March 20, 2025, in accordance with Paragraph 6 of the Rules, the Provider appointed a three-member Panel, with consideration to the nominees of the parties, and selected a Chair. CIIDRC named The Hon. Neil Brown, KC, and R. John Rogers, as panelists. Richard S. Levy was named Chair of the Panel.
12. On April 7, 2025, the Panel issued an Order:
 - a. Giving the Registrant a deadline of 7 days from the date the CIIDRC sends him an email permitting him to submit a Reply;
 - b. Extending the deadline for the Panel to submit its Decision from April 10, 2025 to that date which is 7 days after the date Registrant submits a Reply or, in the absence of his Reply, 7 days after the above deadline date set for the Registrant's Reply.

13. On April 14, 2025, the Registrant submitted a Reply to the Provider, which transmitted it to the Panel on the same day.

14. The deadline for the Panel to submit its Decision is therefore April 21, 2025.

3. **FACTS**

15. the relevant facts are included in the contentions of the parties below.

4. **CONTENTIONS OF THE PARTIES**

- **The Complainant makes the following contentions:**

16. The Complainant is an Irish company engaged in the provision of pharmaceutical products and related goods and services.

17. The Complainant satisfies the Canadian Presence Requirements of the Policy as it is the owner of the registered Canadian trademark NARCAN, registration number TMA 995971, registered on May 4, 2018 (“the NARCAN trademark” or the “Trademark”).

18. The Complainant uses the NARCAN trademark in association with the drug naloxone as a nasal spray (“the NARCAN Product”).

19. In addition to its NARCAN trademark, the Complainant has registered the domain names <narcancan.com>, <narcannasalspray.ca> and <ordernarcancan.ca>, which it uses in its business and in particular to promote the NARCAN Product.

20. The Registrant registered the <narcankits.ca> domain name on July 12, 2018 (“the Disputed Domain Name”).

21. The disputed domain name includes in its entirety the NARCAN trademark to which the Registrant has added the generic word “kits” and the Top-Level Country Code “.ca” for Canada.

22. The Registrant has caused the Disputed Domain Name to resolve to a website at www.firststephealthsolutions.com (the “Registrant’s Website”) which offers naloxone kits that include the drug naloxone (such as in a nasal spray) or are kits intended to be used with the drug naloxone.

23. The disputed domain name is confusingly similar to the NARCAN trademark for the following reasons:

- (a) the domain name includes the NARCAN trademark and, hence, so clearly resembles it in appearance, sound or the ideas suggested by the trademark as to be likely to be mistaken for it, within the meaning of paragraph 3.3 of the Policy;

- (b) the inclusion of the generic word “kits” in the domain name cannot negate a finding of confusing similarity, as the NARCAN trademark is the dominant feature of the Disputed Domain Name;
- (c) the presence of the generic word “kits” in the Disputed Domain Name heightens the confusing similarity between the domain name and the trademark as it gives to the domain name as a whole the meaning that it relates to kits in which the Narcan product is provided.

24. The Registrant has no legitimate interests in the Disputed Domain Name. That is so because:

- (a) as the Disputed Domain Name is not a Mark within the meaning of paragraph 3.2(a) of the Policy, the Registrant cannot have used any such mark in good faith and could not have had rights in any such mark within the meaning of paragraph 3.4(a);
- (b) in using the Disputed Domain Name, the Registrant has not used a clearly descriptive or generic name within the meaning of paragraphs 3.4(b) and (c) of the Policy as NARCAN is a registered trademark;
- (c) the Registrant is not using the Disputed Domain Name for a non-commercial activity within the meaning of paragraph 3.4(d) of the Policy;
- (d) the Disputed Domain Name is not the legal name of the Registrant within the meaning of paragraph 3.4(e) of the Policy; and
- (e) the Disputed Domain Name is not a geographical location within the meaning of paragraph 3.4(f) of the Policy.

25. In its Reply Submission, Complainant states that:

- a. Registrant admits that it sells naloxone kits in vials and ampoules that do not contain NARCAN brand naloxone.
- b. The Distributor Agreement dated February 1, 2024, between the Complainant’s Canadian affiliate and Registrant’s affiliated company, annexed to the Reply, includes section 12.4 that prohibits use by Registrant of Complainant’s trademarks, without permission, which permission was not given.
- c. The agreements attached to the Response by the Registrant do not grant the Registrant the right to use the NARCAN trademark in any manner, let alone as part of the Disputed Domain Name.

- d. The Registrant's incorporation of NARCAN into a domain name to acquire internet traffic therefore puts it as an unfair advantage over all the other distributors of NARCAN brand naloxone nasal spray.
26. The Complainant submits it has therefore provided evidence that the Registrant has no legitimate interests in the Disputed Domain Name.
27. The Registrant has registered the Disputed Domain Name in bad faith. That is so for the following reasons:
- (a) (In accordance with paragraph 3.5(c)), the Registrant registered the Disputed Domain Name to disrupt the business of a competitor as it resolves to a website where the Registrant offers naloxone kits that compete with the Complainant's NARCAN product.
 - (b) (In accordance with paragraph 3.5(d)), as the Disputed Domain Name is confusingly similar to the NARCAN trademark and is used to promote a competing product, internet users will be confused as to the source or affiliation of the Registrant's website.
28. The Complainant submits that finding for the Complainant and ordering that the registration of the Disputed Domain Name should be transferred to the Complainant is consistent with the Trademarks Act (Canada).
29. The Complainant also submits that its aforesaid submissions are supported by and consistent with prior Domain Name Dispute Resolution Policy decisions.
- **The Registrant makes the following contentions:**
30. The Registrant is a principal in First Step Health Solutions Inc. ("FSHS") which is a Canadian healthcare company which is part of the First Step Group, a group which has been involved in the delivery of opioid replacement therapy for over 25 years. As part of this group, FSHS has been making opioid replacement therapy kits ("Kits") since 2016.
31. The First Step Group is an innovative and agile group of companies which over these 25 years has developed, initiated, and launched many businesses in healthcare, including Addiction Clinics, Medical Clinics, Weight Management, Rehabilitation, Specialty Pharmacy, Clinical Trials and Medical Kits Assembly.
32. As is evident from the Quality Agreement between FSHS and the Complainant dated October 9, 2018, FSHS has been an authorized distributor of the Narcan Product since 2018 and as a distributor has contributed to over \$18 million in sales of the Narcan Product for the benefit of the Complainant. FSHS' first purchase of the Narcan Product was done prior to the registration of the Disputed Domain Name by the Registrant.

33. The Narcan Product, a nasal spray, contains naloxone, the distribution and use of which in various forms has been supported by Canadian provincial health authorities both through retail pharmacies and provincial programs since 2016 (collectively the “Government Programs”).
34. FSHS makes the Kits which are required for the distribution and use of the Narcan Product, as the Government Programs require the inclusion of a Kit in the distribution of the Narcan Product. FSHS as one of the first sources of Kits, including Kits using the Narcan Product, holds a license from Health Canada for the assembly of an assortment of kits containing drugs and medical devices.
35. Under the Government Programs, Kits could include a naloxone drug, nitrile gloves, CPR mask, bilingual identification cards, Good Samaritan legislation language and provincial information and instruction, as well as syringes, alcohol pads, amp breakers for injection kits, stickers, info cards, all of which are placed in a case with carabiners.
36. FSHS does not sell a nasal product other than the Narcan Product, so that people looking for NARCAN sold in Kits, who include the name of the Narcan Product and the word “kits” in their search parameters would properly be directed to the Registrant’s Website to be able to purchase a Narcan Kit.
37. As evidence of FSHS’ focus on Kits, on June 12, 2018, the same date as the Registrant registered the Disputed Domain Name, the Registrant registered the domain name <overdosekits.ca> for use by FSHS.
38. FSHS as part of its involvement in the Government Programs includes education and training in the proper dispensing of all forms of naloxone to ensure that parties involved filled the requirements of the Government Programs. Such education and training include the proper dispensing of the Narcan Product.
39. Prior to 2024, the Complainant did not provide Kits, instead relying on other parties to produce them. For this reason, FSHS created the Registrant’s Website to which the Disputed Domain Name resolves as being a site for customers looking for Kits which enables the delivery of opioid replacement therapy. In other words, the purpose of the Registrant’s Website is to sell Kits and the purpose of having the Disputed Domain Name resolve to the Registrant’s Website is to enable the party searching for Kits to find Kits offering the Narcan Product as well as other naloxone products.
40. The Complainant’s position that FSHS is a competitor of the Complainant is misleading and false, because amongst the numerous agreements between FSHS and the Complainant which specify how FSHS is to distribute the Narcan Product, none prohibit FSHS from marketing other forms of naloxone delivery alongside the Narcan Product. In addition, under these agreements FSHS, as a

distributor, is required to provide the Complainant with monthly reporting on its sales of the Narcan Product clearly demonstrating that the Complainant is well aware of FSHS's sales of the Narcan Product and its marketing efforts with respect thereto.

41. Prior to the February 2024 Distribution Agreement, there was no prohibition preventing Registrant from using the Narcan Trademark in any way to promote its marketing of the Narcan Product.
42. As is also clearly demonstrated by the Complainant's recent communication to FSHS entitled "MINIMUM ADVERTISED PRICE POLICY CANADA", FSHS is required to use the Trademark in all of its advertising when referencing the Narcan Product, including any reference thereto on the "Internet or similar electronic media". The Complainant therefore was obviously well aware of the use by FSHS of the Disputed Domain Name and the use by FSHS of the Trademark therein, all of which clearly demonstrate a legitimate interest that FSHS has in the use of the Trademark.
43. In 2024, the Complainant was faced with competition for a product like the Narcan Product, because an additional player entered the market with a competitive nasal formulation of naloxone. When this occurred, the Complainant introduced its own Kit, bringing it, for the first time, into direct competition with the Registrant.
44. It is for this reason that after six years of permitting the Registrant to utilize the Trademark in the Disputed Domain Name in good faith for the mutual benefit of both parties, the Complainant has now filed the Complaint seeking to have the Domain Name transferred to the Complainant.

- **Remedies Sought**

45. The Complainant requests that the Disputed Domain Name be transferred to it.
46. The Registrant submits that the request of the Complainant should be denied. Registrant also claims that failure by the Complainant to object at a much earlier date to the use by FSHS of the Disputed Domain Name and the failure by the Complainant in the Complaint to disclose the distribution arrangement between the Complainant and FSHS demonstrates clear bad faith on the part of the Complainant, and entitles the Registrant to claim, in accordance with the provisions of paragraph 4.6 of the Policy, costs incurred by the Registrant in the preparation of and filing of this Response.

5. DISCUSSION AND FINDINGS

5.1 Eligibility

47. Section 1.4 of the Policy requires that in order to initiate the Complaint, the Complainant, at the time of the initiation of the Complaint, must satisfy the Canadian Presence Requirements for Registrants,

version 1.3 (“CPR.”), unless the Complaint relates to a trademark registered in the Canadian Intellectual Property Office (“CIPO”) and the Complainant is the owner of that trademark.

48. Section 17 of the CPR states that permission to apply to CIRA for the registration of a .ca domain name based on a trademark registered in Canada is limited to an application to register consisting of or including the exact word component of that registered trademark.
49. Complainant is the owner of a Canadian trademark registration for the mark NARCAN, registered under Canadian Trademark Registration No. TMA995971.
50. The disputed domain name, **narcankits.ca**, includes the exact word component, NARCAN, of the registered trademark owned by the Complainant.
51. The Panel therefore determines that the Complainant has satisfied the provisions of section 1.4 of the Policy. Based upon the information provided by CIIDRC and the Complainant in the Complaint, the Panel finds that all technical requirements for the prosecution of this proceeding have been met.

5.2 Requirements of the Complainant

52. In accordance with Paragraph 4.1 of the CDRP, the onus is on the Complainant to prove that:
- (a) the Disputed Domain Name is Confusingly Similar to a trademark or service mark in which the Complainant had rights prior to the date of registration of the Disputed Domain Name and continues to have such Rights: and
 - (b) the Registrant registered the Disputed Domain Name in bad faith.

and the Complainant must provide some evidence that:

- (c) the Registrant has no legitimate interest in the Disputed Domain Name.

53. The Panel will consider each of these requirements in turn.

5.3 Analysis

5.3.1 Whether the Disputed Domain Name is Confusingly Similar to a Mark in which the Complainant has Rights

54. The first question that arises is whether the Complainant has a trademark on which it can rely in this proceeding. That requirement comes from paragraph 3.1.1 of the Policy which provides in effect that the Complainant must establish that the Disputed Domain Name is confusingly similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights. Thus, it must first be established that the Complainant has a “mark”,

defined in paragraph 3.2.3 of the Policy to include “a trade-mark, including the word elements of a design mark, that is registered in CIPO...”

55. The Complainant has established that requirement because it has adduced evidence showing that it is the owner of the Canadian trademark registration for NARCAN, registered under the Trade-marks Act (Canada) R.S.C. 1985, c.T-13 with the Canadian Intellectual Property Office (CIPO), Number TMA995971 and registered on May 4, 2018. Such a trademark clearly comes within the definition of “Mark”
56. The evidence is that Complainant has had rights in the NARCAN trademark prior to the date on which the Disputed Domain Name was registered, namely July 12, 2018, and that it continues to have such rights.
57. The foregoing facts have been established by documentary evidence that the Panel has inspected and finds to be in order. The Complainant has thus made out this first requirement.
58. The next question that arises is whether the Disputed Domain Name is confusingly similar to the NARCAN trademark. In answering that question, the Panel is obliged to make a straight comparison between the wording of the domain name and the trademark without regard to extraneous matters, such as the use of the domain name. That must be left to the remaining issues of legitimate interests and bad faith. It is “the Registrant’s dot-ca domain name” that must be found to be confusingly similar and only that.
59. The Panel finds that the Disputed Domain Name is confusingly similar to the NARCAN trademark for the following reasons. The domain name includes the entirety of the trademark, and panels have consistently found that where that happens it is more likely than not that the domain name will be confusingly similar to the trademark because the trademark will dominate the domain name, as in the present case. The main effect of the Disputed Domain Name is to invoke the NARCAN trademark. Thus, internet users will likely see the domain name as relating to the goods and services of the Complainant offered under the Trademark.
60. The addition of the word “kits” will not negate that impression, because internet users would simply conclude that the domain name is related to kits that are available to be used in connection with the NARCAN product of the Complainant.
61. The Top-Level Country Code “.ca” for Canada, like all such extensions, is disregarded for the purpose of this comparison, as are all domain names must have such an extension.
62. Therefore, the Complainant has satisfied the onus placed on it by Paragraph 4.1 of the Policy to prove, “on a balance of probabilities...and the Complainant and provide some evidence that...the

Registrant's dot-ca domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights."

63. The Complainant has therefore made out the first element it is required to prove under the Policy.

5.3.2 Whether the Registrant registered the Disputed Domain Name in Bad Faith

- **The Position of the Complainant**

64. The Complainant submits that the Registrant registered the Disputed Domain Name in order to disrupt its business as the Disputed Domain Name resolves to a website where FSHS offers naloxone kits that contain a form of the drug naloxone made by competitors of the Complainant and are thereby competing with the Complainant's Narcan Product.

65. As the Disputed Domain Name is confusingly similar to the Trademark and as the Disputed Domain Name is used to promote products offered by the Complainant's competitors, as well as by Complainant, internet users will be confused as to the source or affiliation of the Website with the Complainant.

66. Therefore, the Complainant submits, the registration of the Disputed Domain Name by the Registrant was done in bad faith.

67. It is noted that in the Complainant's submissions, there is no reference to the allegation of the Registrant that in 2024 the Complainant decided to compete directly against the Registrant in selling its own Kits containing the Narcan Product.

- **The Position of the Registrant**

68. The Registrant submits that prior to 2024, FSHS was not a competitor of the Complainant but rather that since 2018 FSHS was an authorized distributor of the Narcan Product and, in this role, offered services which the Complainant did not prior to 2024. Therefore, the Registrant submits, the relationship between the Complainant and the FSHS was, at the date of the registration of the Disputed Domain Name by the Registrant and lasting until the Complainant entered into the Kits market, a symbiotic complementary relationship with the commercial gain therefrom directly benefiting the Complainant as well as the Registrant.

69. Specifically, with respect to paragraph 3.5 of the Policy, the Registrant notes:

- (a) In its registration of the Disputed Domain Name, there was no intention on the part of the Registrant to sell the Disputed Domain Name to the Complainant. If such was the case and if that had been its intention, as the Registrant has owned the Disputed Domain Name since 2018, it would have made such an offer to the Complainant well prior to the present;

- (b) The Registrant did not register nor prevent the Complainant from registering the Trademark, nor is FSHS restricted from using the Trademark in the distribution of the Narcan Product by FSHS. Indeed, as above demonstrated, FSHS is required to use the Trademark in reference to its distribution of the Narcan Product;
- (c) Neither the Registrant nor FSHS disrupted the Complainant's business in any manner, certainly not prior to 2024 when Complainant came out with its own Kits. Rather, by offering Kits which enable the delivery of the Narcan Product, FSHS is in fact supporting the Complainant's business; and
- (d) There is no likelihood that confusion is created by the use by the Registrant of the Trademark in the Disputed Domain Name, as by incorporating the Trademark into the Disputed Domain Name it assures a party searching for the Narcan Product that FSHS is offering Kits containing the Narcan Product as an authorized distributor of the Complainant and that this confirmation clearly benefits the Complainant.

70. Therefore, the Registrant submits, the Registrant was and is not restricted in any manner, including any restriction arising from any of the agreements between FSHS and the Complainant or its affiliates, at the time of registration of the Disputed Domain Name or thereafter, from using the Trademark and therefore it did not register the Disputed Domain Name in bad faith.

- **The Panel's Decision**

71. From the evidence before the Panel, the Disputed Domain Name is owned by the Registrant and not by its affiliate, FSHS. The Registrant in the Response states that the Registrant is a "Principal" of FSHS. The Registrant in the Response also states that the Registrant's Website to which the Disputed Domain Name resolves is owned by FSHS and that FSHS is the active participant in the distribution arrangement with the Complainant whereby FSHS distributes the Narcan Product contained in the Narcan Kits offered by FSHS.

72. A preliminary question facing the Panel is how the distribution relationship between FSHS and the Complainant should affect the Complainant's claim that the Registrant registered the Disputed Domain Name in bad faith.

73. The Panel has determined, on the preponderance of the evidence before it, including the fact that the Registrant has confirmed that he is a "Principal" of FSHS and has filed his Response clearly linking his rights and obligations with respect to the Disputed Domain Name to those of FSHS, that the Panel should treat the Registrant and FSHS as one related party.

74. Applying the first three of the four provisions of paragraph 3.5 of the Policy to the facts before the Panel, the Panel finds that:

- a) The Domain Name was not registered primarily for the purpose of transferring the Disputed Domain Name for valuable consideration in excess of the Registrant's actual costs in registering the Disputed Domain Name,
- b) The Registrant, acting alone or in concert with others, did not register the Disputed Domain Name to prevent the Complainant from registering the Trademark as a domain name, and
- c) The Registrant did not register the Disputed Domain Name primarily for the purpose of disrupting the business of the Complainant.

75. However, the Panel determines that the provisions of paragraph 3.5(d) do apply. The Registrant's contention that it registered and used the Disputed Domain Name for the benefit of the Complainant as such does not obviate the fact that the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant's Website by creating a likelihood of confusion with the Trademark as to the source, sponsorship, affiliation, or endorsement of the Registrant's Website by the Complainant. In other words, mutual benefit and creating a likelihood of confusion are not mutually exclusive.

76. The Panel fully understands the Registrant's frustration that, after what appears to have been a six-year relationship to the mutual benefit of it and Complainant, the Complainant now wants the Disputed Domain Name transferred to it, having recently decided to enter the Kit business.

77. The Panel notes that the Registrant submits that the Complainant should have acted sooner if it objected to the Registrant's use of the Domain Name. However, the Panel observes that the Registrant was aware of the existence of the trademark NARCAN prior to its registration of the Disputed Domain Name incorporating that trademark and that, therefore, the Registrant could not properly assume that its right to use the Disputed Domain Name was more than temporary.

78. The Panel, therefore, finds evidence that the Registrant has registered the Disputed Domain Name in bad faith in accordance with the provisions of paragraph 3.5(d) of the Policy.

5.3.3 Whether the Registrant has No Legitimate Interest in the Disputed Domain Name

79. Paragraph 3.4 of the Policy states:

"Legitimate Interests. For the purposes of paragraphs 3.1(b) and 4.1(c), any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate that the Registrant has a legitimate interest in a domain name:

- a. the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;

- b. the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of: (i) the character or quality of the wares, services or business; (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or (iii) the place of origin of the wares, services or business;
- c. the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;
- d. the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
- e. the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or
- f. the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

In paragraph 3.4(d) "use" by the Registrants includes, but is not limited to, use to identify a web site.

80. A *prima facie* case is all that is required to prove this element and, if such a case is made by the Complainant, the burden of proof shifts to the Registrant to rebut it. The Panel is entitled to look to UDRP decisions for guidance, as the "no legitimate interest" requirement in the Canadian Policy is similar to the requirement under the UDRP. CIIDRC case number 16308-UDRP, regarding the disputed domain name interviews-grahambuilds.com and others, confirms that:

"Even though the Policy requires the complainant to prove that the respondent has no rights or legitimate interests in the Disputed Domain Name, it is the consensus view among UDRP panels that a complainant has to make only a *prima facie* case to fulfill the requirements of Paragraph 4(a)(ii) of the Policy. As a result, once a *prima facie* case is made, the burden of coming forward with evidence of the respondent's rights or legitimate interests in the disputed domain name will then shift to the respondent." (at p. 5)

81. The Panel has examined the evidence and contentions of the Registrant in deciding whether he has met this burden. The Panel first looked at the particular circumstances enumerated in section 3.4 of the Policy. Regarding paragraph (a), the Panel does not find that Registrant had Rights in the Mark. Regarding paragraph (b), the Panel does not find that the Trademark was clearly descriptive. Regarding paragraph (c), the Panel does not find that the Trademark is a generic name in any language. Regarding paragraph (d), the Panel does not find that Registrant's activity was non-commercial. Regarding paragraph (e), the Panel does not find that the Disputed Domain Name comprised the legal name or common identification of the Registrant. Regarding paragraph (f) the Panel does not find that the Disputed Domain Name is a geographical name.

82. As the enumerated circumstances in section 3.4 are not limitative, the Panel examined the other circumstances proposed by the Registrant. Registrant contends that as an authorized distributor of

Complainant it has not only a legitimate interest but also an obligation to use the Trademark when showing a photograph of the Narcan Kit on its website. In Annex #5 of its Response, the Registrant



shows that its website offers NARCAN branded naloxone in a nasal spray:

83. However, the Panel believes it is highly likely that the brand NARCAN on the nasal spray container within the Kit was *placed there by Complainant*.
84. There is no evidence that the Complainant gave Registrant, its distributor, the right to create Kits or other products on which Registrant has the right to mark the Trademark. There is also no evidence that Complainant gave Registrant the right to use the Trademark in a domain name leading to a website.
85. Registrant did not present any disputed domain name decision in which a non-exclusive distributor of a product has been held, by virtue of that relationship alone, to have implied Rights in a trademark.
86. The Complainant, on the other hand, contends that prior domain name decisions constitute precedent that distributors cannot, save for very limited circumstances, secure a domain name containing the trademark of its supplier. Complainant submits:

“In Reply to the Registrant’s argument that a distributor can secure domains containing a trademark, the UDRP/CDRP case law is clear that such conduct is normally bad faith, and can only be justified in highly limited circumstances (see *Oki Data Americas, Inc. v. ADS, Inc.* WIPO Case No. D2001-1903, which has been cited twice for the same principal in CDRP cases, namely, CIIDRC case: CDRP-2122 – *alfakher.ca*, and CIIDRC case: 14476-CDRP – *Nalgene.ca*). The Oki Data test was well summarized in CIIDRC case: 17459-UDRP – *expertshopify.com*, where panelist Muscovitch stated at page 6: *the following cumulative requirements will be applied*:

- (i) *the respondent must actually be offering the goods or services at issue;*
- (ii) *the respondent must use the site to sell only the trademarked goods or services;*
- (iii) *the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and*
- (iv) *the respondent must not try to “corner the market” in domain names that reflect the trademark.*

87. Complainant further contends:

“...requirements (ii) and (iii) are not present since that site does not disclose the relationship with the trademark holder and does not sell exclusively the trademarked goods” instead, marketing kits both with and without NARCAN brand naloxone.

88. The Panel agrees with that contention and holds that the *Ok! Data* test does not give Registrant a right or legitimate interest in the Disputed Domain Name.
89. As paragraph 12.4 of the Distribution Agreement requires *prior written consent* to use of trademarks, such as NARCAN, and then provides an exception for “trademarks”... “authorized by the provisions of this Agreement” the Panel holds that Registrant had the onus of demonstrating, on a balance of probabilities that it had either received prior written consent to use the Trademark in the Disputed Domain Name or that such use was authorized elsewhere by the provisions of the Agreement. The Panel finds that Registrant did not demonstrate either of these conditions and that, therefore, the Registrant did not discharge his onus.
90. Registrant’s reference to the six years during which Complainant did not object to Registrant’s use of the Disputed Domain Name raises the question of **delay or laches** as providing a circumstance which gives Registrant a legitimate interest in the Disputed Domain Name. This issue was discussed in WIPO Domain Name Decision: DCO2018-0032 re the domain name dunkin.co as follow:

“The Panel notes that Respondent hints that Complainant’s claim is barred by the equitable doctrine of laches. Respondent argues that Complainant has not contacted Respondent regarding the disputed domain name in the eight years that Respondent has owned the disputed domain name. UDRP panels have generally declined to apply laches to domain name disputes. See, e.g., *Program Consulting Oy v. Whois Watchdog*, WIPO Case No. D2010-1393 (“It is by now well established that trademark doctrines of laches or estoppel have not been incorporated into the Policy.”); see also section 4.10 of WIPO Jurisprudential Overview 3.0. Further, laches requires a showing of prejudice caused by the delay, and Respondent has not even attempted to show that he was prejudiced by any delay in bringing this proceeding. Accordingly, the Panel declines to find that Respondent has a defense on the ground of laches.”

91. The WIPO Overview section on *laches*, now found in section 4.17, which, although not binding on the Panel expresses a similar view, namely:

“4.17 Does “delay” in bringing a complaint bar a complainant from filing a case under the UDRP?

Panels have widely recognized that mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits. Panels have noted that the UDRP remedy is injunctive rather than compensatory, and that a principal concern is to halt ongoing or avoid future abuse/damage, not to provide equitable relief. Panels have furthermore noted that trademark owners cannot reasonably be expected to permanently monitor for every instance of potential trademark abuse, nor to instantaneously enforce each such instance they may become aware of, particularly when cybersquatters face almost no (financial or practical) barriers to undertaking (multiple) domain name registrations.

Panels have therefore declined to specifically adopt concepts such as laches or its equivalent in UDRP cases.

Panels have however noted that in specific cases, certain delays in filing a UDRP complaint may make it more difficult for a complainant to establish its case on the merits, particularly where the respondent can show detrimental reliance on the delay.”

92. Registrant did not provide any evidence of detrimental reliance on the delay and therefore the Panel holds that laches does not apply in this matter.

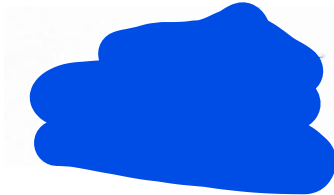
6 DECISION and ORDER

93. For the above reasons, in accordance with Paragraph 4 of the CDRP, Paragraph 12 of the Resolution Rules, the Panel accepts the Complaint and orders that:

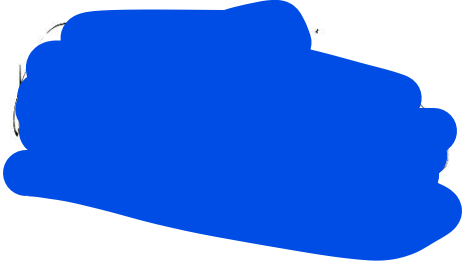
- a. The Disputed Domain Name registration be transferred to the Complainant.
- b. The request by Registrant for its costs is dismissed.

Made as of April 18, 2025.

SIGNATURE OF PANEL



/Neil Brown/



Richard S. Levy, Chair

Hon. Neil Brown, KC

R. John Rogers

