Decision for dispute CAC-UDRP-101041

Case number	CAC-UDRP-101041
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Domain names	tevacares.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Teva Pharmaceutical Industries Ltd.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Organization	dh

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

For these proceedings, the Complainant relies on its worldwide trademark portfolio for the TEVA mark, which predates the date of creation of the disputed domain name, and covers goods in class 5. Among these trademarks, the Complainant highlights in particular the following:

- US registration No. 1,567,918, dating back to 1989;
- Singapore trademark registration No. T9111063A, dating back to 1991;
- Australian registration No. 567236, dating back to 1991;
- Chinese registration No. 644291, dating back to 1993;
- Canadian trademark registration No. 665049-00, and 870953, respectively dating back to 1990 and 1998;

Furthermore, the Complainant relies on its established rights in the common law trademarks TevaCares and Teva Cares Foundation for its patient assistance programs in the United States.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

Formed in 1976, through its predecessors in interest, Teva Pharmaceutical Industries Ltd. (“Complainant”), together with its subsidiaries (collectively, “Teva”), was first established in 1901 with its global headquarters in Israel. It began trading on the Tel Aviv Stock Exchange in 1951, on NASDAQ in 1987, and on the New York Stock Exchange (NYSE: TEVA) in 2012.

Ranked among the 10 top pharmaceutical companies in the world, active in 60 countries, and with $20.3 billion in net revenues in 2014, Teva delivers high-quality, patient-centric healthcare solutions to millions of patients every day. In specialty medicines, Teva has a world-leading position in innovative treatments for disorders of the central nervous system, including pain, as well as a strong portfolio of respiratory products. It produces 73 billion tablets a year in 73 pharmaceutical and active pharmaceutical ingredients (APIs) facilities globally. One of every seven generic prescriptions in the United States, and one of every six generic prescriptions in Canada is filled with a Teva product. Approximately 2,500 Teva packs are dispensed in the EU every single minute.

Teva assumes corporate responsibility for providing access to high-quality healthcare, especially to those who need it the most. Teva works with organizations to distribute its products for free to patients in underdeveloped regions around the world, donates tens of millions product units annually, and makes donations in times of crisis, such as earthquakes, hurricanes, and tornadoes.

Through its charitable foundation and other patient assistance programs, Teva provides medications at no cost to low-income, uninsured, and underinsured patients across the United States, where the Respondent purportedly resides according to the relevant Whois record. Through these programs, thousands of patients in need have access to medication they could not otherwise afford. The Teva Cares Foundation Patient Assistance Programs provide certain Teva medications at no cost to patients who meet certain insurance and income criteria under the mark TevaCares, which has been used continuously since at least 2013.

PARTIES CONTENTIONS

In support of these UDRP proceedings, the main Complainant's contentions are the following.

1. Confusing similarity. ICANN Rule 3(b)(ix)(i); ICANN Policy ¶4(a)(i).

According to the Complainant, the disputed domain name is identical to the TevaCares unregistered mark in which Teva has common law rights. The ".com" top-level suffix in the domain name is disregarded under the confusing similarity test as it is a technical requirement of registration. Furthermore, the TEVA trademark is recognizable as such within the disputed domain name, with the addition of the descriptive or self-laudatory term "cares." The addition of merely descriptive wording to a trademark in a domain name is normally insufficient in itself to avoid a finding of confusing similarity under the first element of the UDRP.

Moreover, as the incorporated trademark TEVA constitutes the dominant or principal component of the disputed domain name, the latter is confusingly similar to the TEVA registered trademark in which Complainant has rights. As a matter of fact, the term "cares" lacks distinctive character. Furthermore, the fact that the Complainant uses "TevaCares" and "Teva Cares Foundation" in relation to its charitable services, may induce Internet users to actually believe that there is a real connection between the disputed domain name and the Complainant or its services.

2. Rights or Legitimate Interests. ICANN Rule 3(b)(ix)(2); ICANN Policy ¶4(a)(ii).

The Complainant points out that while the overall burden of proof rests with the Complainant, the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name.

The Respondent is using the disputed domain name to earn parking revenue that specifically capitalizes on the trademark value, which is unfair use resulting in misleading diversion. The Respondent put the disputed domain name on the

Voodoo.com domain parking platform, which prides itself on showing the most relevant ads, the most advertisers, and one of the highest revenue shares in the industry to profit from their domain names.

Panels have generally recognized that use of a domain name to post parking and landing pages or PPC links does not of itself confer rights or legitimate interests arising from a "bona fide offering of goods or services" or from "legitimate noncommercial or fair use" of the domain name, especially where resulting in a connection to goods or services competitive with those of the rights holder.

The disputed domain name resolves to a parking page which includes commercial ads related to the pharmaceutical industry generally, including specifically related to medical care assistance, and patient assistance programs. According to the Complainant the Respondent lacks rights or legitimate interests in using the disputed domain name for earning profits from PPC links relating to the trademark significance of the registered TEVA mark, and the common law marks TevaCares and Teva Cares Foundation used in relation to Complainant's charitable services.

3. Registered and used in Bad Faith. ICANN Rule 3(b)(ix)(3); ICANN Policy ¶ 4(c)(iii).

According to the Complainant, the disputed domain name has been registered and is being used in bad-faith for the following factors:

- there is no reason to incorporate the TEVA registered trademark in combination with "cares," which is also a composite common law mark used by the Respondent, other than to attempt to attract, for commercial gain, Internet uses to its web site by creating a likelihood of confusion with Complainant's TEVA registered mark, and with its patient assistance programs offered under the TevaCares and Teva Cares Foundation marks.

- the Respondent apparently used false contact information to register the disputed domain, as there is no record of an organization named "dh" in Orlando, Florida, according to corporate records. The registrant name "Shin Dongho" associated by the Respondent with the false organization happens to be a former South Korean singer who acquired fame as a singer of the boy group U-KISS. The Respondent has a history of hiding behind false contact information. For example, Respondent used his "reconstdom@gmail.com" account and the alias of "Shin Dongho" to register <HamiltonBank.com> under the pretences of an organization named "dh"' in Orlando, Florida. Historical domain Whois records show that the Respondent previously registered <HamiltonBank.com> using these same initials, but in that case specifically as "DH Corp.," purportedly in New York. Using the alias of Shin Dongho, the Whois record was updated to use Respondent's "reconstdom@gmail.com" account instead of his "richbystock@yahoo.com" account, which is clearly under common ownership or control of the Respondent as evidenced by the domain updates to <hamiltonbank.com>. Prior to expiry of the domain, it was extended by the Respondent using his "richbystock@yahoo.com" account.

-The Registrant e-mail address "reconstdom@gmail.com" has been used to register typos of third-party trademarks and strings identical to third-party trademarks using the same registrant name and address in Florida that appears in the Whois record for the disputed domain. In this respect, the Complainant cites <alibeba.com>, which is clearly a typo of the famous ALIBABA trademark, <nissanguide.com>, which incorporates the famous NISSAN trademark, <HamiltonBank.com> and <birkinbag.com>, which incorporates Hermes International's famous BIRKIN registered trademark in relation to its handbags.

All of these domain names are used by the Respondent for domain parking revenue keyed to the trademark significance of the trademarks that the domains incorporate. This pattern and practice is another strong indication of bad-faith registration and use.

- Although the Respondent has not taken active steps to sell the disputed domain name to the Complainant, it has taken steps to prominently advertise the fact that the domain is for sale, which when coupled with the display of highly related commercial ads, is indicative of bad faith use.

- The Respondent uses the disputed domain name to host multiple commercial links to goods and services, some of which

related to the Complainant’s trademark, indicating Respondent knowingly used Complainant’s trademarks and evidences that the Respondent unfairly and opportunistically benefited from the goodwill associated with Complainant’s marks.

- The disputed domain name has attracted viewers for commercial gain, by creating a likelihood of confusion within the meaning of paragraph 4(b)(iv) of the Policy as a result of pay-per-click links. Whether this revenue accrues directly to the Respondent or to the host, or to both, is immaterial.

Furthermore, the day after the expiration of the deadline to file a Response, the Complainant submitted, to the ADR Center, a copy of an e-mail received from the Respondent stating as follows: "hello, I'am a owner of the domain name tevacares.com. I recently check your email related to domain dispute". If you really wanna make a case, I'll running the case in Korean Court because I 'm not good at english. domain will be transferred to Korean Registrar. however, for the fast and smooth transaction, can you may some money for the domain name" I really wanna make it easy, fast, smooth Regareds, Shin".

The Complainant submitted this e-mail as a new fact that was not available at the time the Complaint was filed, in further support of the Respondent's bad faith in the registration and use of the disputed domain name.

As far as the Respondent is concerned, no Response has been filed. However, the day after the expiration of the deadline to file a Response, the Respondent sent an e-mail to the ADR Center asking for a "little" compensation for the disputed domain name, and for the modification of the language of the proceedings from English to Korean. Furthermore, as mentioned above, on the same day the Respondent contacted the Complainant offering to transfer the disputed domain name for "some money" and threatening to change the actual Registrar to a Korean one, in order to change the language of the proceeding from English to Korean.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

In this proceeding, the Panel had to take into consideration the following two procedural factors.

First, the Respondent requested to change the procedural language from English to Korean arguing that he is not fluent in English.

The Panel is of the opinion that the Respondent's request to conduct the proceeding in Korean should be denied. Under Para. 11 of the Rules, "[u]nless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding".

In the instant case, the language of the Registration Agreement is English, and there is no reason that would justify the requested change of language. The Whois data for the <tevacares.com> indicates a Registrant's address located in Orlando,

Florida, US. The telephone number listed in the Whois information is also a US number. The Respondent wrote its communications to both the Complainant and the ADR Center in English. Furthermore, the <tevacares.com> domain name leads to a website containing English links, and the wording that the disputed domain name is available for sale is also in English. Thus, there are strong elements to believe that the Respondent can manage English in a way sufficient to prepare and file a Response. On the contrary, the Complainant would be strongly prejudiced if the change of language were accepted, as it would be forced to have the Complaint translated into Korean, with a substantial and unjustified increase of costs. The change of language would also affect the length of the proceeding.

For all these reasons, the Panel decides to maintain English as the language for these proceedings.

As far as the second procedural issue is concerned, it relates to the Complainant's unsolicited and late filing of the Respondent's e-mail seeking for a compensation in exchange of the transfer of the disputed domain name. The Panel agrees to accept this unsolicited filing, because it refers to a new fact that occurred after the filing of the Complaint, because it does not affect the duration of the proceedings, and it does not impair the Respondent's right for an equal treatment, as it refers to an e-mail originating from the Respondent, which as such does not require any further comment or clarification.

PRINCIPAL REASONS FOR THE DECISION

1. The disputed domain name is identical or confusingly similar to a Complainant's trademark (Para. 4(a)(i)of the Policy).

The Panel finds that the disputed domain name is confusingly similar to the Complainant's earlier trademark TEVA, which is protected in numerous countries worldwide, including in the US, where the Respondent is located according to the relevant Whois record.

The disputed domain name fully includes the TEVA trademark. The additional word "cares" simply refers to the Complainant's activity, and is therefore a descriptive term. Previous Panelists have stated that the addition of a descriptive term to a third party's trademark does not exclude a finding of likelihood of confusion. In the instant case, this is even more so considering that the Complainant's trademark TEVA is a fanciful word, as such autonomously recognizable within the disputed domain name.

Accordingly, the Panel finds that the Complainant succeeds under the first element of the Policy.

As the Complainant has successfully proved that <tevacares.com> is confusingly similar with its earlier registered TEVA trademark, there is no need to examine the Complainant's common law rights in the unregistered trademark TEVA CARES.

2. Respondent's lack of rights or legitimate interests in the disputed domain name (Para. 4(a)(ii)of the Policy)

The Panel finds that the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The domain name <tevacares.com> leads to a parking page containing pay-per-click links to websites referring to activities in competition with the Complainant's activities. Furthermore, the disputed domain name is prominently offered for sale, and the Respondent contacted the Complainant after receiving notice of this UDRP, asking for a compensation in exchange of the transfer of the domain name.

The Complainant did not authorize the Respondent to include its trademark in the disputed domain name, nor to capitalize from the goodwill and reputation of its trademark to earn profits from pay-per-click links, and/or from the sale of the <tevacares.com> domain name. Therefore, the Respondent is not using <tevacares.com> in connection with a bona fide offering of goods or services, nor is making a legitimate noncommercial or fair use of the disputed domain name.

The Respondent could have rebutted the Complainant's arguments to substantiate its rights and legitimate interests in the disputed domain name, but decided not to do so. Hence, the Panel is satisfied that also the second condition under the Policy is met.

3. The disputed domain name has been registered and is being used in bad faith (Para. 4(c)(iii) of the Policy)

The Panel finds that the disputed domain name has been registered in bad faith.

The Complainant provided evidence that the TEVA trademark is to be considered well-known among the public of reference. It is clear that the Respondent was well aware of the existence of the TEVA trademark when it registered the disputed domain name. This circumstance can be inferred from the fact that the Respondent chose to register the TEVA trademark in combination with the generic term "cares", which directly refers to the Complainant's activity. It is therefore clear that the Respondent accurately chose a domain name that could mislead Internet users looking for the Complainant on the Internet.

Moreover, in an attempt to conceal its true identity, the Respondent provided false contact information at the time it registered the disputed domain name. In the absence of any contrary information from the Respondent, the Panel accepts the Complainant's statement that there is no record of an organization named "dh" in Orlando, Florida, and that the registrant name "Shin Dongho", associated by Respondent with the "dh" organization, is a former South Korean singer who acquired fame as a singer of the boy group U-KISS.

Furthermore, the Respondent appears to have provided the same false contact information in relation to the registration of other domain names including third parties' well-known trademarks in the past (i.e., <HamiltonBank.com>, <alibeba.com>, <nissanguide.com>, <birkinbag.com>).

Providing false contact information is an element of bad faith according to many previous Panelists' UDRP decisions. This is even more so when the Respondent has engaged in a pattern of such conduct, like in the instant case.

The Panel also finds that the disputed domain name is being used in bad faith.

The Respondent is using <tevacares.com> to attract Internet users to a web page containing pay-per-click links to activities in competition with the Complainant's activities. The disputed domain name is also prominently offered for sale. Furthermore, as soon as the Respondent received notice of this UDRP, it contacted the Complainant threatening the transfer of the <tevacares.com> domain name to a Korean Registrar (in order to change the language of the proceeding) and asking for a compensation for the transfer of the domain name to the Complainant.

In light of the foregoing, the Panel finds that the Respondent is using <tevacares.com> to capitalize from the goodwill and reputation of the Complainant's trademark, both by attracting, for commercial gain, Internet users to an on-line location, by creating a likelihood of confusion with the Complainant's mark, and by attempting to sell the disputed domain name to the Complainant, or to one of its competitors for a consideration in excess of the documented out-of-pocket costs directly related to the domain name.

Therefore the Panel is satisfied that also the third condition under the Policy is met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **TEVACARES.COM**: Transferred

PANELLISTS

Name	**Angelica Lodigiani**

DATE OF PANEL DECISION 2016-01-03