Decision for dispute CAC-UDRP-101462

Case number	CAC-UDRP-101462
Time of filing	2017-03-02 10:03:36
Domain names	LADOVIQ.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Teva Pharmaceutical Industries Ltd.

Complainant representative

Organization	RiskIQ, Inc

Respondent

Organization	Privacy Protection Service INC d/b/a PrivacyProtect.org a/k/a Yao Zuodong, Yao Zuodong

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant (“Teva”) is the owner of the LADOVIQ trademark in sever-al jurisdictions as follows :
• LADOVIQ, U.S. trademark n° 87155180, Class 5, filed on August 30, 2016 (registered);
• LADOVIQ, EU trademark n° 015790496, Class 5, filed on August 31, 2016 (registered);
Details and official printouts of which are set out in and annexed to the Complaint filed by the Complainant.

FACTUAL BACKGROUND

The Complainant states that it is a leading global pharmaceutical company that is committed to increasing access to high-quality healthcare for people across the globe by developing, producing and marketing affordable ge-neric drugs as well as innovative and specialty pharmaceuticals and active pharmaceutical ingredients.
On August 30, 2016, the Complainant filed a trademark application in the United States (“USPTO”) for the word LADOVIQ in Class 5.
The next day, on August 31, 2016, the Respondent registered the disputed domain name <lavodiq.com>.
On August 31, 2016, the Complainant also filed a trademark application at the European Union Intellectual Property Office (“EUIPO”) for the same word and Class.

On April 3, 2017, the Respondent initiated settlement discussions by suggesting it would accept being reimbursed for the purchase of the disputed domain name. When the Complainant's counsel asked for a receipt, Respondent demanded $1,162 for "lawyer's informal advice and translations". It then refused to back up with any supporting documentation: "We have no invoice, please understand that only formal advice has an invoice but very expensive".
The Complainant originally brought this Complaint regarding two disputed domain names, but deleted one of them in the Amended Complaint without prejudice.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

THE COMPLAINANT:

On Tuesday, August 30, 2016, the Complainant filed a trademark application for the word mark LADOVIQ at the USPTO (Reg. n° 87155180) covering Pharmaceutical preparations for the treatment of Multiple Sclerosis, Lupus Nephritis and Crohn's Disease, in Class 5.
On Wednesday, August 31, 2016, the next day Teva submitted its U.S. trademark application, and on the same day it filed for the same trademark at the EUIPO (Reg. n° 015790496), the Respondent registered the disputed domain name incorporating the entirety of the mark, and adding the ".com" gTLD suffix.
Teva did not authorize, contract, license or otherwise permit the Respondent to register or use the LADOVIQ mark. The Respondent is not a vendor, supplier, or distributor for Teva, has no trademark rights in the corresponding disputed domain name, and is not commonly known by the mark, or by the disputed domain name. The Respondent has no legitimate interest in the disputed domain name. There is no evidence of the Respondent's use in connection with a bona fide offering of goods or services, nor any evidence of legitimate noncommercial or fair use without intent for commercial gain prior to notice of this proceeding.

Furthermore, the disputed domain name <lavodiq.com> contains the entirety of Teva's LADOVIQ mark, which does not have a dictionary meaning. The implication arising in the mind of the Internet user is that the Respondent is either, or in some way associated with, Teva. The disputed domain name does not resolve ("unable to connect"), which is akin to passive holding. This also constitutes bad faith registration and use.
Additionally, bad faith may be inferred from the timing of when the domain name was registered in relation to the newly filed application for LADOVIQ trademark by Teva in the U.S. Respondent lifted the mark filed by Teva and incorporated it in the disputed domain name only a day after the filing. This is hardly a coincidence. The timing of the registration in relation to the U.S. filing by Teva is persuasive evidence of the Respondent's bad-faith intent in registering the disputed domain name to profit from its trademark significance specifically to the Complainant (e.g. Teva Pharma-ceutical Industries Ltd. v. Fing Wa a/k/a xang ming a/k/a Zhao Zing a/k/a Zhangh Yuu, Case n°101431 (WIPO, April 11, 2017).

The Complainant states that it is inconceivable that the Respondent did not have Teva's marks in mind when registering the disputed domain name, and the actions suggest opportunistic bad faith.

The Complainant also notes that the Respondent initiated a settlement discussion that turned out to be a disguised demand for $1,162 in alleged fees that the Respondent refused to back up with any supporting documentation: "We have no invoice, please understand that only formal advice has an invoice but very expensive" (see email exchanges annexed to the Complaint filed by the Complainant). This is clearly evidence supporting that the purpose in registering the disputed domain name was to profit by trying to extract a fee from the Complainant based on the trademark significance of the domain to the Complainant, and having intentionally prevented it from being able to register its mark in a corresponding domain name without paying ransom fees.

Finally, the Respondent's bad faith registration is exemplified by masking false contact information used to register the disputed domain name behind proxy services. For instance, the phone number and address belong to a shopping mall called "The Gate". The Respondent does not have an organ-ization using his first and last name as indicated in the Whois output behind the proxy registration.

In summary, Teva has shown that the disputed domain name is identical to a trademark in which it has established rights, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that it was registered and is being used in bad faith opportunistically, passively held, specifically to exploit the trademark significance of the mark in the disputed domain name.

THE RESPONDENT:

The Respondent submitted a very brief statement and made the following submissions.

The Respondent registered the disputed domain name on August 31, 2016.

The Respondent claims that “the doname (sic.) name Privacy / Proxy Registration Service and The Privacy / Proxy Registration Service does not violate ICANN's policies”.

The Respondent notes that the Whois contact is “true and effective”.

The Respondent argues that LADOVIQ is just a pending trademark application and is not used in commerce. Thus, the common-law rights logically cannot precede a mark's use in commerce. See, e.g. Sony Pictures Television Inc. v. Thomas, Jeff, Case n° 1625643 (Aug. 6, 2015); MCorelab Inc. v. Melissa Domain Name Services / Shanshan Huang, Case n°1652968 (Jan. 18, 2016).

The Respondent alleges that he has not “engaged” in bad faith registration or use of the disputed domain name.

Furthermore, the Respondent explains that he made “(…) a statement that The complainant falsified evidence and framed us. The Disputed domain name from registration to now never used for parking. We have never used the disputed do-main name for hosting websites. The Dispute domain name dns never changes,It is the same as it is now”.

The Respondent argues that it has a legitimate right and/or interest on the disputed domain name and that the disputed domain name has been registered and is used in good faith.

The Respondent finally asks the Panel to make a finding of reverse domain name hijacking, pursuant to paragraph 15(e) of the Rules. The Respondent does not justify this finding.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed 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 disputed 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 disputed 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.

PRINCIPAL REASONS FOR THE DECISION

IDENTICAL OR CONFUSINGLY SIMILAR - paragraph 4(a)(i) of the Policy

The disputed domain name <ladoviq.com> is identical to a trademark in which the Complainant has rights.

The Complainant established rights in the LADOVIQ mark by registering it with the USPTO (Reg. n° 87155180) on Tuesday August 30, 2016. See Pais-ley Park Enters. v. Lawson, FA 384834 (Nat. Arb. Forum Feb. 1, 2005) (finding that the Complainant had established rights in the PAISLEY PARK mark under Policy Article 4(a)(i) through registration of the mark with the USPTO); Men's Wearhouse, Inc. v. Wick, FA 117861 (Nat. Arb. Forum Sept. 16, 2002) ("Under U.S. trademark law, registered marks hold a presumption that they are inherently distinctive and have acquired secondary meaning."); see also Janus Int'l Holding Co. v. Rademacher, D2002-0201 (WIPO Mar. 5, 2002) (finding that Panel decisions have held that registration of a mark is prima facie evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive and that the Respondent has the burden of refuting this assumption).

Additionally, the Complainant established rights in the LADOVIQ mark by registering it with the EUTM (Reg. n° 015790496) on Wednesday August 31, 2016.

The Respondent registered the disputed domain name <ladoviq.com> on Wednesday August 31, 2016, the next day Teva submitted its U.S. trademark application, and on the same day it filed for the same trademark at the EUIPO.

The Panel will only take the U.S. registration into account as it does not have information on the timing of the EU registration filed the same day as the disputed domain name.

The disputed domain name <ladoviq.com> is confusingly similar to Complainant's LADOVIQ mark, because the disputed domain name incorporates Complainant's mark in its entirety, adding only the generic top-level domain ("gTLD") ".com."

The addition of a gTLD is irrelevant. See Rollerblade, Inc. v. McCrady, D2000-0429 (WIPO June 25, 2000) (finding that the top-level of the domain name such as ".net" or ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar); see also Busy Body, Inc. v. Fitness Outlet Inc., D2000-0127 (WIPO Apr. 22, 2000) (finding that "the addition of the generic top-level domain (gTLD) name '.com' is . . . without legal significance since use of a gTLD is required of domain name registrants"). The adjunction of the gTLD ".com" is irrelevant as it is well established that it is insufficient to avoid a finding of confusing similarity (see also L'Oréal v. Tina Smith, D2013-0820 (WIPO July 30, 2013); Titoni AG v. Runxin Wang, D2008-0820 (WIPO July 15, 2008); Alstom v. Itete Peru S.A., D2009-0877 (WIPO Aug 27, 2009).

The Respondent has moreover not contested the fact that the U.S. mark is confusingly similar to the <ladoviq.com> domain name.

The Panel therefore concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

RIGHTS OR LEGITIMATE INTERESTS - paragraph 4(a)(ii) of the Policy

Policy Article 4(c) provides a list of three factors for the Panel to consider if Respondent has acquired any rights or legitimate interests to the domain name:

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the do-main name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consum-ers or to tarnish the trademark or service mark at issue.

The Respondent is not commonly known by the <ladoviq.com> disputed domain name (nor does it claim to be). The Complainant has not authorized the Respondent to make any use of its LADOVIQ trademark. Indeed, Teva did not authorize, contract, license or otherwise permit the Respondent to register or use the LADOVIQ mark. The Respondent is not a vendor, supplier, or distributor for Teva. The Respondent has not established rights in the disputed domain name pursuant to Policy Article 4(c)(ii). See RMO, Inc. v. Burbridge, FA 96949 (Nat. Arb. Forum May 16, 2001) (interpreting Policy Article 4(c)(ii) "to require a showing that one has been commonly known by the domain name prior to registration of the domain name to prevail"); see also Gallup Inc. v. Amish Country Store, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that the Respondent does not have rights in a domain name when the Respondent is not known by the mark).

Accordingly, the Panel finds the Complainant makes a prima facie case under Policy Article 4(a)(ii), the burden shifts to the Respondent to establish rights or legitimate interests in the disputed domain name. See Do The Hustle, LLC v. Tropic Web, D2000-0624 (WIPO Aug. 21, 2000) (finding that once Complainant asserts that the Respondent has no rights or legitimate interests with respect to the domain, the burden shifts to the Respondent to provide credible evidence that substantiates its claim of rights and legitimate interests in the domain name); see also “WIPO Overview 2.0”, paragraph 2.1; Croatia Airlines d.d. v. Modern Empire Internet Ltd., D2003-0455 (WIPO Aug 26, 2003); Oemeta Chemische Werke GmbH v. Zhibin Yang (aka Yang Zhibin), D2009-1745 (WIPO Mar 3rd, 2010).

The Respondent did not explain why he chose the word LADOVIQ to register the disputed domain name. The Panel notes that LADOVIQ is a fictitious word without any special meaning.

The Respondent also did not explain how the disputed domain name would be used.

The Respondent’s failure to use the disputed domain name constitutes passive holding and is not a use in connection with a bona fide offering of goods or services pursuant to Policy Article 4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy Article 4(c)(iii). Indeed, the disputed do-main name does not resolve (“unable to connect”). See Nike, Inc. v. Crystal Int’l, D2001-0102 (WIPO Mar. 19, 2001) (finding no rights or legitimate interests where the Respondent made no use of the infringing domain names); see also Chanel, Inc. v. Heyward, D2000-1802 (WIPO Feb. 23, 2001) (finding no rights or legitimate interests where “Respondent registered the domain name and did nothing with it”); see also Flor-Jon Films, Inc. v. Larson, FA 94974 (Nat. Arb. Forum July 25, 2000) (finding that the Respondent’s failure to develop the site demonstrates a lack of legitimate interest in the domain name).

In conclusion, Panel finds that the Respondent has failed to provide any strong evidence that the disputed domain name has a right or legitimate interest after the Complainant has provided prima facie evidence that the Respondent has no right or legitimate interest in the disputed domain name.

REGISTERED AND USED IN BAD FAITH - paragraph 4(a)(iii) of the Policy

UDRP Policy Article 4(b) has a non-exclusive list of four factors that can be considered to determine bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to Complainant who is the own-er of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship,

affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

Additional factors and circumstances can also be used to support findings of bad faith registration and use. See Do The Hustle, LLC v. Tropic Web, D2000-0624 (WIPO Aug. 21, 2000) (“[T]he examples [of bad faith] in Paragraph 4(b) are intended to be illustrative, rather than exclusive.”).

The Respondent’s failure to use the disputed domain name since its registration is some evidence of bad faith registration and use. See DCI S.A. v. Link Commercial Corp., D2000-1232 (WIPO December 7, 2000) (concluding that the Respondent’s passive holding of the disputed domain name satisfies the requirement of Article 4(a)(iii) of the Policy); see also Caravan Club v. Mrg-sale, FA 95314 (Nat. Arb. Forum Aug. 30, 2000) (finding that the Respondent made no use of the disputed domain name or website that connects with the disputed domain name, and that passive holding of the disputed domain name permits an inference of the registration and use in bad faith); see also Clerical Med. Inv. Group Ltd. v. Clericalmedical.com, D2000-1228 (WIPO November 28, 2000) (finding that merely holding an infringing domain name without active use can constitute use in bad faith).
As already mentioned, the Panel notes that the disputed domain name <la-doviq.com> fully included the Complainant's LADOVIQ trademark. Moreover, LADOVIQ has no common dictionary meaning and seems to be a newly created word. See Teva Pharmaceuticals USA, Inc. v. Wu Zhanshu, D2016-1110 (WIPO Aug. 15, 2016).

Additionally, bad faith may be inferred from the timing of when the disputed domain name was registered in relation to the newly filed application for LADOVIQ trademark by Teva at the USPTO. See Teva Pharmaceuticals USA, Inc. v. Wu Zhanshu, D2016-1110 (WIPO August 15, 2016). The Respondent incorporated the trademark in the disputed domain name only one day after the U.S. filing. This is cannot be a coincidence. See Teva Pharmaceutical Industries Ltd. v. Fing Wa a/k/a xang ming a/k/a Zhao Zing a/k/a Zhangh Yuu, 101431 (WIPO April 11, 2017) (finding that “the fact that each of the disputed domain names were registered by the Respondent three days after the Complainant’s respective United States trademark applications were filed leads to the conclusion that the Respondent monitors such trademark applications and quickly registers identical domain names corresponding to such applied-for trademarks”).

In this Panel’s opinion, such activity fits squarely within the scope of WIPO Overview 2.0, Paragraph 3.1 and leads to the conclusion that Respondent was aware of the Complainant’s trademark application and that the disputed domain name was registered in anticipation of such applications maturing into registrations and viable trademark rights. See, e.g. Kylie Jenner, Kylie Jenner, Inc. and Whalerock Celebrity Subscription LLC v. Thevan Thirumalla, TVM Names and Kendall Jenner, Kendall Jenner, Inc. and Whalerock Celebrity Subscription LLC v. Jorly James, Cooknames, Case Nos. D2015-1189 and D2015-1190 consolidated, (WIPO August 21, 2015); See Teva Pharmaceu-tical Industries Ltd. v. Fing Wa a/k/a xang ming a/k/a Zhao Zing a/k/a Zhangh Yuu, Case n°101431 (WIPO April 11, 2017).

The Panel also notes theRespondent's effort to extract payment without providing an invoice/receipt supports especially considering that the Respondent is the one that initiated the settlement discussion. The demand for $1,162 is clearly admissible evidence of bad faith registration and use by the Respondent. E.g., WIPO Overview 2.0, Paragraph 3.6 (Consensus View) ("Admissibility may turn to some extent on which party – the Complainant or the Respondent - initiated the settlement discussions, and on whether the Complainant itself may have solicited any offer to sell.").

In view of the above facts and arguments, the Panel finds that the Respondent's registration and use of the disputed domain name are malicious.

Reverse Domain Name Hijacking

Paragraph 1 of the Rules defines reverse domain name hijacking (RDNH) as “using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name”.

As the Complainant has succeeded in this dispute with regard to the disputed domain name, this cannot be a case of RDNH. In these circumstances, no finding of RDNH is justified.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **LADOVIQ.COM**: Transferred

PANELLISTS

Name	**Mr. Etienne Wéry**

DATE OF PANEL DECISION 2017-05-16

Publish the Decision